

MANU/DE/1703/2007

Equivalent Citation: (2007)ILR 2Delhi1231, MIPR2007(2)396, 2007(35)PTC177(Del)

IN THE HIGH COURT OF DELHI

I.A. Nos. 651, 1366 and 2611/2007 and CCP 22/2007 in CS (OS) No. 102/2007

Decided On: 10.07.2007

Appellants: **(India TV) Independent News Service Pvt Limited**
Vs.

Respondent: **India Broadcast Live LLC and Ors.**

Hon'ble Judges/Coram:

Sanjay Kishan Kaul, J.

Counsels:

For Appellant/Petitioner/plaintiff: Prathiba M. Singh and Bishwajit Dubey, Advs

For Respondents/Defendant: P.V. Kapur, Sr. Adv. and Sumeet Mehra and Thomas George, Advs. for Defendant No. 1

Subject: Civil

Subject: Intellectual Property Rights

Acts/Rules/Orders:

Trademarks Act, 1999 - Section 2(1), Trademarks Act, 1999 - Section 9, Trademarks Act, 1999 - Section 9(1), Trademarks Act, 1999 - Section 9(5), Trademarks Act, 1999 - Section 134, Trademarks Act, 1999 - Section 134(1), Trademarks Act, 1999 - Section 134(2); Anti cyber squatting Consumer Protection Act, 1999; Code of Civil Procedure, 1908 (CPC) - Section 20, Code of Civil Procedure, 1908 (CPC) - Order 39 Rule 1, Code of Civil Procedure, 1908 (CPC) - Order 39 Rule 2, Code of Civil Procedure, 1908 (CPC) - Order 39 Rule 4; Indian Penal Code (IPC)

Cases Referred:

Modi Entertainment Network and Anr. v. W.S.G. Cricket Pte. Ltd. (2003) 4 SCC 341; Airbus Industrie GIE v. Patel and Ors. [1998] 2 All ER 257 HL; Pennoyer v. Neff 95 U.S. 714 : 24 L.Ed. 565; Cybersell Inc v. Cybersell Inc and Ors. Case No. 96-17087 D.C. No. CV-96-0089-EHC; Ballard v. Savage 65 F.3d 1495; GTE Media Services Incorporated v. Bell South Corporation et al. 199 F. 3d 1343; Zippo Mfg Co v. Zippo Dot Com., Inc. 952 F. Supp 1119; Rothschild Berry Farm v. Serendipity Group LLC No. C-3-99-281; Panavision International LP v. Dennis Toppen; Network Solutions Inc. D.C. Case No. CV-96-03284-DDP; Berthold Types Limited v. European Mikrograf Corporation 102 F. Supp. 2d. 928; Compuserve Inc. v. Patterson 89 F. 3d 1257 6th Cir. 1996; Casio India Co. Ltd v. Ashita Tele Systems Pvt. Ltd 2003 (27) PTC 265 (Del); Dow Jones & Co. Inc. v. Gutnic (2002) HCA 56; New Zealand Post Ltd. v. Leng 45 IPR 263; Spiliada Maritime Corporation v. Cansulex Ltd. [1986] 3 All E.R. 844; Kusum Ingots & Alloys Limited v. Union of India and Anr. (2004) 6 SCC 254; ONGC v. Utpal Kumar Basu and Ors. 1994 (4) SCC 711; Surbhi Kumar v. Nitin Kumar and Ors. CS(OS) 2047/2006; Citi Corporation and Anr. v. Todi Investors and Anr. 2006 (33) PTC 631; Satyam Infoway Ltd. v. Sifynet Solutions Pvt. Ltd (2004) 28 PTC 566; Imperial Tobacco Co. of India Ltd. v. The Registrar of Trademarks and Anr. AIR 1977 Calcutta 413; Hi-Tech Pipes Ltd. v. Asian Mills Pvt. Ltd. 2006 (32) PTC 192 (Del); Geepee Ceval Protiens & Investment Private Limited v. Saroj Oil Industry 2003 (27) PTC 190 (Del.); Bharat Tiles and Marble Private Ltd. v. Bharat Tiles Manufacturing Co. 1978 GLR 518; Hindustan Radiators Co. v. Hindustan Radiators Limited 1987 PTC 73; Hospitality Services Ltd. v. Ceasar Park Hotels & Resorts Inc 1999 (19) PTC 430; Registrar of Trademarks v. Chandra Rakhit Ltd. AIR 1955 SC 558; Godfrey Phillips India Ltd. v. Girnar Food and Beverages (P) Ltd 2005 (30) PTC 1; Info Edge (India) Pvt. Ltd. and Anr. v. Shailesh Gupta and Anr. 2002 (24) PTC 255 (Del); Living Media India Ltd. v. Jitender v. Jain and Anr. 2002 (25) PTC 61 (Del); Bhartiya Coffee Workers Catering Service (P) Ltd. v. Indian Coffee Workers Cooperative Society Ltd. AIR 1999 Kerala 169; Online India Capital Co. Pvt. and Anr. v. Dimension Corporate (2000) V AD (Del) 860; Manish Vij and Ors. v. Indra Chugh and Ors. AIR 2002 Del 243; Digital City, Inc v. Smalldomain Case No. D2000-1283; Computer Vision v. Computer Vision 1975 RPC 171; Berkeley Hotel Co. Ltd. v. Berkely International (Mayfair) Limited and Anr. 1971 FSR 300; B.L. and Co. and Ors. v. Pfizer Products Incl. 2001 PTC 797 (Del); The Gillette Co. and Ors. v. A.K. Stationery and Ors. 2001 PTC 513 (Del); Hindustan Pencil Private Limited v. India Stationery Product Co. 1989 (9) PTC 61 (Del); Liverpool Electric Cable Co Ltd's case (1929) 46 RPC 99

Citing Reference:

Case Note:

Intellectual Property Rights - Trade Mark - Sections 9(1)(a), (b) and (c), 134 of the Trade Marks Act, 1999 - Institution of suit - Jurisdiction - Rule of Forum convenience - Section 20 of the Code of Civil Procedure, 1908 - plaintiff adopted the mark "INDIA TV" and registered owner of mark "INDIA TV'S MOST WANTED" and domain name "indiatvnews.com" - Defendant owner of the domain name "indiatvlive.com" registered in Arizona - plaintiff filed suit restraining Defendant from use of mark "INDIA" and "TV" in combination as a domain name - Held, Defendant company has global presence and website accessible in India as such Courts in India can exercise personal jurisdiction over Defendants - Convenience of both the parties to be seen - Further held, where a mark having geographical connotation has acquired secondary significance and distinction, may be granted protection in a passing off action (Hi Tech Pipes case) - Test of distinctiveness in case of generic and descriptive names - Mark "INDIA TV" would not immediately lead any person to connect the same with the specific business, i.e., a Hindi news channel - Defendants permitted to use the domain name "indiatvlive.com" with the disclaimer - Ex-parte interim Order modified to that extent

Ratio Decidendi:

"Generic as well as descriptive names may be granted protection where the same has assumed a secondary meaning which identifies it either with particular goods or services or as being from a particular source."

JUDGMENT**Sanjay Kishan Kaul, J.**

IA. Nos. 651/2007, 1366/2007 & 2611/2007

1. "Jurisdiction" as Oliver Wendall Holmes said, "whatever else or more it may mean, is jurisdiction, in its popular sense of authority to apply the law to the acts of men". Ordinarily jurisdiction is exercised over defendants residing or carrying on business or personally working for gain within the territorial jurisdiction of the court. With the growth of e-commerce and commercial activity over the world wide web, it has become possible for business to be conducted across the globe without actual presence in every place. The present case, inter alia, involves the question of jurisdiction in such a situation.
2. The plaintiff company runs a Hindi news channel "INDIA TV" which was launched in March 2004. It is stated that the channel is one of the leading Hindi news channels in India having popular programs such as 'Breaking News' and other programs such as India Beats, Jago India, Aap ki Adalat etc.
3. The plaintiff claims to have adopted the mark "INDIA TV" since 01.12.2002 and is stated to have been using the said mark continuously and extensively. It is stated that the plaintiff applied for the registration of the mark "India TV" in classes 38 and 41 on 22.01.2004 of which the mark applied for in class 38 was published in March 2006 and the mark in class 41 was published in February 2005. The claim of the plaintiff is on the use of the words 'India' and 'TV' as a combination and disclaimer on the separate use of the words has been published with the marks of the plaintiff published in the trademarks journal. It is claimed that no opposition to any of the advertisements has been received within the statutory period stipulated.
4. It is further stated that the plaintiff had also applied for the registration of the mark "INDIA TV's MOST WANTED", which is a popular program of the plaintiff's channel, on 22.06.2004 in class 38 and the same was registered on 29.10.2005 under the registration No. 1291703.
5. The mark "INDIA TV" is thus stated to be a well known mark having enormous reputation and fame and is stated to be exclusively identified with the plaintiff. The "INDIA TV" mark and logo written in a distinctive manner is claimed to be the original creation of the plaintiff.
6. Besides the news channel "INDIA TV", the plaintiff is stated to be the owner of the domain name "indiatvnews.com" which is stated to have been registered by the plaintiff on 18.11.2003. It is stated that its channel is made available for live viewing on the said website.
7. It is claimed that the plaintiff came across the website of defendant nos. 1 and 2- "indiatvlive.com" in January 2007 while carrying out an Internet search. The said website contains the words "INDIA TV" displayed prominently inside the sketch of a television. On search of the 'WHOIS' database of the registering authority, it was found that the same was registered through "GODADDY.COM" i. e. defendant No. 3.
8. The plaintiff avers that the mala fides of defendants 1 and 2 is confirmed by the fact that the names and contact addresses of the defendants are not mentioned in the "WHOIS" database. On a search on the site itself, it is claimed that on a reading of the terms and conditions of the subscription for the website "www.indiatvlive.com", it was found that "IBL" (India Broadcast Live) and "www.indiatvlive.com" were trademarks and service marks belonging to IBL. The plaintiff claims that on a further search, it came across

manupate press releases showing IBL to be a division of Defendant No. 2. It has also been claimed that on the site of the defendants itself, the plaintiff found that it is stated that IBL, LLC enjoys a strategic relationship with Archer Media Communications Incorporated (hereinafter referred to as Archer Media) and the development, technology integration and launch of the website "www.indiatvlive.com" has been funded by Archer Media.

9. The plaintiff avers that defendants nos. 1 and 2 have no rights or legitimate interest in respect of the impugned domain name and the registration of the domain name has been done with a view to commercially benefit from the mark of the plaintiff. A domain name acts as the address of a company on the Internet and is its web mark just like a trade or service mark and the plaintiff avers that by using of the plaintiffs mark within a sketch of a television on the homepage of defendant nos. 1 and 2, the said defendants are attempting to represent themselves as the plaintiff/representative of the plaintiff. It is alleged that the registration of the impugned domain name by the defendants 1 and 2 constitutes infringement, passing off and dilution of the plaintiff's mark besides unfair competition.

10. The plaintiff thus filed the present suit against the defendants for permanently restraining the defendants from the use of the mark "INDIA TV" either as a domain name or in any other manner whatsoever on its website links, electronic material etc, from offering services through the said domain name and restraining the defendants from transferring or alienating or in any manner dealing with the said domain name. The plaintiff has also prayed for a mandatory injunction directing the transfer of the said domain name to the plaintiff besides claiming damages and rendition of accounts.

11. The suit has been contested by Defendant No. 1 by filing a written statement. The stand taken in the written statement is that defendant No. 1 company has been in business since the year 2006 and has a global presence including in India. The impugned website "indiatvlive.com" was publicly launched on 17.08.2006 with another website of the defendant. It is claimed that the said defendant has expended huge amounts of time and money in launching, promoting and marketing the said website. Insofar as the mark "INDIA TV" is concerned, it is claimed that the said mark has not yet been registered by the Trademark Registry. It is also averred that the words "INDIA TV" do not possess the basic attributes of a trademark due to their inherent generic nature and that the mark is not capable of registration by virtue of the provisions of Section 9(1)(a), (b) and (c) of the Trademarks Act, 1999 (hereinafter referred to as the said Act) as the same is not capable of distinguishing the services of the proprietor, has reference to the nature, quality and geographical origin of the services and contains marks or indications which have become customary in the current language/bona fide established practice of the trade. It is further claimed that the domain name and logo used by defendant No. 1 is neither identical nor confusingly similar to the stylized mark of the plaintiff. The said defendant claims to have registered other domain names such as "chinatvlive.com", "irantvlive.com" etc. It is averred that the plaintiff has brought the present litigation only after signing an agreement with a rival IPTV (Internet Protocol Television) service provider "www.jumptv.com". It has also been pleaded that this court is a forum non conveniens for the purpose of entertaining the present suit.

12. None entered appearance on behalf of defendant No. 2 who was proceeded ex parte on 22.03.2007. Defendant No. 3 is a pro forma party.

13. The plaintiff has also filed is No. 651/2007 under Order 39 Rules 1 and 2 of the Code of Civil Procedure 1908 (hereinafter referred to as the said code) seeking an interim injunction inter alias restraining defendants 1 and 2 from the use of the mark "INDIATV" either as part of their domain name "indiatvlive.com" or in any other manner on their website, links, any other electronic or printed material etc, and restraining defendants 1 and 2 from operating any website under the said domain name and offering its services through the said web site either through subscription and otherwise; restraining the said defendants from transferring, alienating or in any other manner dealing with the domain name and for transfer the said domain name to the plaintiff.

14. On 19.01.2007, an ex parte ad interim injunction was granted restraining defendant Nos. 1 and 2, their directors, officers, agents, licensees, franchises and representatives from using any domain name containing the combination of words "INDIA TV" as also from transferring or alienating the said domain name to any person.

15. Defendant No. 1 thereafter filed is 1366/2007 under Order 39 Rule 4 of the said code for setting aside the ex parte ad interim injunction granted on 19.01.2007. The stand taken in the said application is that defendant No. 1 is a company formed and existing in the United States having no Indian presence. It is pleaded that the two promoters of defendant No. 1 company are a well known Indian journalist based overseas and the founder and promoter of Internet portals such as "www.SmasHits.com" and defendant No. 1 is in the process of filing trademarks and patents based on its unique proprietary combination. It is alleged that the plaintiff filed the present suit only after it entered into an agreement with a rival IPTV platform "www.jumptv.com". It is claimed that defendant No. 1 has already invested US \$ 1.2 million under various heads in respect of the said website. It is further averred that the mark "INDIA TV" is not capable of being registered as the words are of generic nature and have direct reference to the nature of business of the plaintiff. It is pleaded that there is no visual similarity between the marks of the plaintiff and defendant No. 1. Defendant No. 1 has also averred that there has been delay on the part of the plaintiff in filing the present suit. The website of defendant No. 1 is stated to have been launched at separate public functions in Los Angeles and Delhi while the plaintiff, which claims to be a premier news channel, states, that it has come across the website only in January 2007.

manupatra
16. Insofar as the aforementioned applications are concerned, the submissions of learned Counsel for the plaintiff were heard which were concluded on 21.02.2007 where after the matter was listed for the submissions of the learned Counsel for defendant No. 1. On 03.03.2007, is 2611/2007 was filed by the plaintiff under the provisions of Order 39 Rules 1 and 2 of the said code seeking an injunction against defendant No. 1 from proceeding with the action instituted by it in the Arizona District Courts against the plaintiff in respect of 'reverse domain name hijacking' seeking a declaration of non-infringement of the plaintiffs mark by defendant No. 1. Summons in the said suit are stated to have been received by the plaintiff on 20.02.2007. The plaintiff has also averred in the said application are that the on typing "indiatvlive.com" the website finally displayed is the website of defendant No. 1 showing the actual IP address instead of "indiatvlive.com" which is contrary to the interim orders granted on 19.01.2007.

17. It is further averred in the application that defendant No. 1 had filed the action in the Arizona Courts on 20.02.2007 and the factum of filing of the same has not been disclosed by the defendant either orally or in writing before this court although the written statement in the present suit was filed after the institution of the said action. It is claimed that the action is unwarranted and has been attracted on the basis that the Registering Authority i.e. Defendant No. 3 is located in Arizona though the said authority has no role to play insofar as the merits of the matter are concerned. The plaintiff has thus prayed for an injunction against proceeding with the action in the Arizona courts as the suit in this court was instituted prior to the Arizona suit and the arguments on the injunction applications in this court were being heard on a day to day basis. It has also been averred that different views by both courts would cause irreparable injury to both the plaintiff and defendant No. 1 and would be against the interest of justice.

18. The said application has been resisted by defendant No. 1 who has taken the stand that this court is not a court of competent jurisdiction not being the appropriate forum/ forum convenience. It is averred that all the defendants in the present case are American entities not amenable to the personal jurisdiction of the court. It is stated that the defendants do not reside or work for gain in India and that the promoters of defendant No. 1 are both permanent residents of the US. Defendant No. 1 is a Delaware Corporation. That the registrar of domain names "godaddy.com" which is the authority which has to ultimately enforce any court order in respect of the impugned domain name is based in Arizona and thus the District Court at Arizona is the forum convenience to decide the present dispute. The plaintiff has also pleaded that the District Court at Arizona has personal jurisdiction over defendant No. 3 as well as defendant No. 1. It is further claimed that the domain name registration of defendant No. 1 was placed under registrar lock and upon suspension of the domain name, defendant No. 1 had no option but to file a complaint under the relevant US Statute being the Anti cyber squatting Consumer Protection Act, 1999.

19. Insofar as the aspect of the identity of defendant No. 1 is concerned, the stand taken is that defendant No. 1 is not obligated to disclose its identity or publicly provide its contact details. It is claimed that defendant No. 1 opted for a private registration of the impugned domain name which is an option commonly available to all domain name registrants. It is also averred that signing of an affidavit by an administrative staff of a law firm on behalf of its client is not barred under law. Defendant No. 1 has also alleged that the plaintiff has been changing its corporate name in each of the pleadings filed and that the plaintiff has misrepresented that its mark "INDIA TV" has been registered. It has further been averred that while the plaintiff has been asserting that the sale of the impugned domain name by defendant No. 1 would put the plaintiff in a disadvantageous position, even after filing of the suit, the domain name "www.indiatv.com" was on sale.

20. Besides, the plaintiff has also filed CCP 22/2007 pleading that despite the ad interim injunction granted vide order dated 19.01.2007, this only change made by defendant No. 1 was that when "indiatvlive.com" was typed in the address bar, the impugned website itself was displayed while in the address bar it was the actual IP address of the website that appeared instead of "indiatvlive.com". It is thus averred that this is a case of disobedience of the order dated 19.01.2007.

21. It may be noticed that insofar as is 2611/2007 is concerned, learned senior counsel for defendant No. 1 had on instructions stated on 05.03.2007 that the said defendant would not take any further steps to prosecute the action in the Arizona Court until the next date. On 25.04.2007, the said statement was confirmed until modification or variation.

22. Learned Counsels for the parties advanced their submissions in respect of all the aforementioned applications at length on various dates.

Anti Suit Injunction

23. The plaintiff has prayed for an anti-suit injunction restraining defendant No. 1 from proceeding with the suit filed by it against the plaintiff in the district courts at Arizona. The plaintiff claims that the subject matter in the two suits is the same and avers that different views of the two courts in the suits would cause irreparable injury to the plaintiff as well as defendant No. 1. Defendant No. 1, on the other hand has claimed that this court has no personal jurisdiction over the defendants and is not the forum convenience for hearing the present matter.

24. Insofar as the principles governing granting of anti-suit injunction are concerned, it would be useful to refer to the judgment of the Apex Court in Modi Entertainment Network and Anr. v. W.S.G. Cricket Pte. Ltd.

10. The courts in India like the courts in England are courts of both law and equity. The principles governing grant of injunction - an equitable relief - by a court will also govern grant of anti-suit injunction which is but a species of injunction. When a court restrains a party to a suit/proceeding before it from instituting or prosecuting a case in another court including a foreign court, it is called anti-suit injunction. It is a common ground that the courts in India have power to issue anti-suit injunction to a party over whom it has personal jurisdiction, in an appropriate case. This is because courts of equity exercise jurisdiction in personam. However, having regard to the rule of comity, this power will be exercised sparingly because such an injunction though directed against a person, in effect causes interference in the exercise of jurisdiction by another court.

...

24. From the above discussion the following principles emerge:

(1) In exercising discretion to grant an anti-suit injunction the court must be satisfied of the following aspects:

(a) the defendant, against whom injunction is sought, is amenable to the personal jurisdiction of the court;

(b) if the injunction is declined, the ends of justice will be defeated and injustice will be perpetuated; and

(c) the principle of comity - respect for the court in which the commencement or continuance of action/proceeding is sought to be restrained - must be borne in mind.

(2) In a case where more forums than one are available, the court in exercise of its discretion to grant anti-suit injunction will examine as to which is the appropriate forum (forum convenience) having regard to the convenience of the parties and may grant anti-suit injunction in regard to proceedings which are oppressive or vexatious or in a forum non-convenience.

...

(7) The burden of establishing that the forum of choice is a forum non-convenience or the proceedings therein are oppressive or vexatious would be on the party so contending to aver and prove the same.

25. In the judgment of the House of Lords in *Airbus Industries GIE v. Patel and Ors.* [1998] 2 All ER 257, it was observed inter alia that in England, jurisdiction is founded on the presence of the defendant within the jurisdiction, and in certain specified (but widely drawn) circumstances, in a power to serve the defendant with process outside the jurisdiction. But the potential excesses of common law jurisdictions are generally curtailed by the adoption of the principle of forum non convenience. It was also observed that as a general rule, before an anti-suit injunction could be granted by an English Court to restrain a person from pursuing proceedings in a foreign jurisdiction, comity required that the English Forum should have sufficient interest or a connection with the matter in question to justify the indirect interference with the foreign court which such injunction entailed.

26. Thus, in considering whether an anti suit injunction is to be granted or not, as held in *Modi Entertainment Network and Anr.* (supra), the court is to inquire whether the defendant is amenable to the personal jurisdiction of the court, whether the ends of justice would be defeated by refusal to grant the injunction and where there are more than one forums available, and which is the forum convenience for bringing the action in question having regard to the convenience of the parties and other factors. The court has also to bear in mind the principle of comity.

Personal Jurisdiction over defendants

27. Defendant No. 1 has taken the stand that neither of the defendants reside or work for gain in India; the promoters of defendant No. 1 are both permanent residents of the United States and Defendant No. 1 is a Delaware State Corporation formed under the laws of the United States and thus, this court does not have personal jurisdiction over the defendants.

28. Learned senior counsel for defendant No. 1 submitted that personal jurisdiction is the power which a court has over a person as opposed to jurisdiction over property etc. In this behalf, reference was made to Black's Law Dictionary (6th Ed.), page 790, 1144. Learned senior counsel emphasized the distinction between 'in personam' and 'in personam jurisdiction'. The expressions 'personal jurisdiction', 'in personam' and 'in personam jurisdiction' are defined as under:

In personam. Against the person. Action seeking judgment against a person involving his personal rights and based on jurisdiction of his person, as distinguished from a judgment against property (i.e. in rem). Type of jurisdiction or power which a court may acquire over the defendant himself in contrast to jurisdiction over his property. See also In personam jurisdiction; In rem; Jurisdiction in personam.

In personam jurisdiction. Power which a court has over the defendant himself in contrast to the court's power over the defendant's interest in property (quasi in rem) or power over the property itself (in rem). A court which lacks personal jurisdiction is without power to issue an in personam judgment. *Pennoyer v. Neff* 95 U.S. 714 :24 L.Ed. 565. See also In rem; Jurisdiction in personam.

Personal Jurisdiction. The power of a court over the person of a defendant in contrast to the jurisdiction of a court over a defendant's property or his interest therein; in personam as opposed to in rem jurisdiction. See In personam jurisdiction.

29. Learned senior counsel drew the attention of this court to the legal position as regards personal jurisdiction in the United States. A reference was made to an article entitled "Personal Jurisdiction (United States)" from wikipedia (http://en.wikipedia.org/wiki/personal_jurisdiction). It has been observed therein that personal jurisdiction as distinguished from subject matter jurisdiction is the power of the court to require a party (usually the defendant) or a witness to come before the court. States have enacted 'long arm' statutes by which courts can exercise jurisdiction over a business entity or individual located outside the state if for example such entity or individual regularly does business in the state or transacted business with the plaintiff in the state. Personal jurisdiction over non-residents is however limited by the constitutional requirements of due process. A defendant not served with process within the state in which the court sits must have sufficient level of business or personal contacts within the state so that the defendant can reasonably be expected to be sued there. As regards Internet activity, it has been noted that courts are still working out how this applies to law suits regarding Internet activity and business though some courts appear to be in agreement that the passive posting of a website is not enough to establish widespread jurisdiction wherever someone wants to sue the web author over its contents. The 'purposeful availment test' has been used whether a company can be sued in a specific jurisdiction in the case of Internet companies. Courts specifically look at three factors- (1) availment of a company to another jurisdiction (2) whether the act was done in another jurisdiction and (3) whether the jurisdiction is reasonable for the defendant to be expected to defend himself there.

30. Learned senior counsel submitted that the tests usually applied by American Courts for the exercise of personal jurisdiction over non-resident defendants are (a) existence of sufficient minimum contacts with the forum state (b) claim asserted must arise out of the contact (c) exercise of jurisdiction must be reasonable and (d) effect test. In *Cybersell Inc v. Cybersell Inc and Ors.* Case No. 96-17087 D.C. No. CV-96-0089-EHC, the US court of Appeals for the 9th Circuit observed that a three part test is used to determine whether personal jurisdiction can be exercised by the district court. The relevant paragraph is as under:

We use a three-part to determine whether a district court may exercise specific jurisdiction over a nonresident defendant:

(1) The non resident defendant must do some act or consummate some transaction with the forum or perform some act by which he purposefully avails himself of the privilege of conducting activities in the forum, thereby invoking the benefits and protections; (2) the claim must be one which arises out of or results from the defendant's forum-related activities; and (3) exercise of jurisdiction must be reasonable.

Ballard v. Savage 65 F.3d 1495, 1498 (9th Cir. 1995) (citations omitted).

31. Learned senior counsel contended that mere maintenance of a homepage by defendant No. 1 which is accessible in India is not sufficient to confer jurisdiction on this court particularly where there is no evidence to show that defendant No. 1 specifically targeted audiences in India. In this behalf, reliance was placed on the judgment in *GTE Media Services Incorporated v. Bell South Corporation et al.* 199 F. 3d 1343 where, the US Court of Appeals, District of Columbia Circuit observed that to establish personal jurisdiction over a non-resident, a court must engage in a two part inquiry; the court must first examine whether jurisdiction is applicable under a state's 'long arm' statute and then determine whether a finding of jurisdiction satisfies the constitutional requirement of due process. It was held that that personal jurisdiction over non residents in the District of Columbia could not be based solely on the ability of District residents to access the defendants' websites as this would not by itself show any persistent course of conduct by the defendants in the District within the meaning of the Sub-section of the District Long Arm statute pertaining to causing tortious injury in the District. It was observed that the plaintiff must show sufficient minimum contacts between the defendant and the forum establishing that the maintenance of the suit does not offend the notions of fair play and justice.

32. In *Cybersell Inc* case (supra) the question was whether the alleged infringing use of a service mark on a homepage on the WWW suffices for personal jurisdiction in the state where the holder of the mark has its

manupat principal place of business. In this case Cybersell Florida was alleged to have infringed the mark of Cybersell Arizona which advertised for commercial services over the Internet. It was observed inter alia, that no court has ever held that an Internet advertisement alone is sufficient to subject the advertiser to jurisdiction in the plaintiff's home state. It was found that Cybersell, Florida conducted no commercial activity over the Internet in Arizona and did nothing to encourage people in Arizona to access its site and there is no evidence that any part of its business was sought to be achieved in Arizona. The interactivity of the web page was limited to receiving the browsers name and expression of interest – signing up for the service was not an option nor did anyone in Arizona do so. It was held that as Cybersell, Florida engaged in no commercial activity and had no contacts via the Internet or otherwise in Arizona, it lacked sufficient minimum contacts with Arizona for personal jurisdiction to be asserted over it over there. The court referred to the judgment in Zippo Mfg Co v. Zippo Dot Com, Inc 952 Supp 1119 (W.D. Pa. 1997) wherein it was observed that “the likelihood that personal jurisdiction can be constitutionally exercised is directly proportionate to the nature and quality of commercial activity that an entity conducts over the Internet”.

33. Again, in Rothschild Berry Farm v. Serendipity Group LLC No. C-3-99-281 a food seller had sued its competitor for infringement of trademark. The defendant filed a motion to dismiss the suit or transfer the venue. It was observed that the defendant's maintenance of an Internet website which customers in Ohio could utilize to order its products, was insufficient without more to subject to the court's personal jurisdiction for the purpose of an Ohio resident's infringement suit. The seller had not sold products to customers in Ohio or solicited such sales through catalogues distributed within that state or advertisements appearing in publications that had been circulated in Ohio.

34. In Panavision International LP v. Dennis Toppen; Network Solutions Inc D.C. Case No. CV-96-03284-DDP. Appeal No. 97-55467 it was observed that simply registering someone else's trademark as a domain name and posting a website on the Internet is not sufficient to subject a party domiciled in one state to jurisdiction in another. As noticed in Cybersell case (supra) there must be something more to demonstrate that the defendant directed his activity towards the forum state.

35. Learned senior counsel submitted that where the personal jurisdiction of the court is challenged by the defendant, the burden lies on the plaintiff to come forward with sufficient facts to establish that the jurisdiction is proper. In support of this contention, learned Counsel placed reliance on the judgment in Berthold Types Limited v. European Mikrograf Corporation 102 F. Supp. 2d. 928 where the defendants argued in their motion to dismiss that Illinois does not have personal jurisdiction over them but the plaintiff claimed that the defendants are subject to personal jurisdiction based on the Illinois 'long arm' statute. It was observed that the plaintiff has the burden of demonstrating that personal jurisdiction exists.

36. Insofar as the aspect of this court having personal jurisdiction over defendants 1 and 2 is concerned, learned Counsel for the plaintiff referred to the judgment in Compuserve Inc. v. Patterson 89 F. 3d 1257 6th Cir. 1996. It was observed in this case that personal jurisdiction may be either general or specific depending on the nature of contacts in a given case. It was observed that in this case the plaintiff sought to establish specific personal jurisdiction over the defendant. The court observed that the crucial federal constitutional inquiry in such a case is whether given the facts of the case, the non resident defendant has sufficient contacts with the forum state that the district courts exercise of jurisdiction would comport with 'traditional notions of fair play and substantial justice'. The three tests observed to be repeatedly employed by courts to make such a determination are:

- a. the defendant must purposefully avail himself of acting in the forum state or causing a consequence in the forum state
- b. the cause of action must arise from the defendants activities there
- c. the acts of the defendant or consequences caused by the defendant must have a substantial enough connection with the forum to make exercise of jurisdiction over the defendant reasonable.

In this case the defendant had claimed to have never visited Ohio but had placed items of 'shareware' on Compuserve's system for others to use and purchase. It was found that the defendant frequently contacted Ohio to sell his computer software over compuserve's Ohio based system and 'sent' his goods to compuserve in Ohio for their ultimate sale. Compuserve in effect acted as the defendant's distributor albeit electronically and not physically. It was thus found that the defendant had sufficient minimum contacts with Ohio to support the exercise of jurisdiction over him.

37. A reference was also made to the ninth circuit opinion in Panavision International LP case (supra) wherein one of the issues involved was of the application of existing rules of personal jurisdiction to conduct that took place in part in cyberspace. In this case again, the court again observed that a three part test is applied to determine if a district court may exercise specific jurisdiction.

- a. The non resident defendant must do some act or consummate some transaction with the forum or perform some act by which he purposefully avails himself of the privilege of conducting activities in the forum, thereby invoking the benefits and protections of its laws.

b. The claim must be one that arises out of or results from the defendant's forum related activities

c. Exercise of jurisdiction must be reasonable

It was found that the defendant's registration of the plaintiff's trademark as his own domain names on the Internet had the effect of injuring the plaintiff in California and but for his conduct the injury would not have occurred. The claims of the plaintiff were held to have arisen out of the defendant's California related activities. It was thus found that the district court properly exercised personal jurisdiction over the defendant.

38. Learned Counsel for the plaintiff contended that defendant No. 1 has more than sufficient minimum contacts in India for personal jurisdiction to be exercised by this court. It was contended that the plaintiff has enormous goodwill and reputation in India and the goodwill of the plaintiff is being damaged in India. Also, the mark has been diluted in India. Learned Counsel further submitted that the website of defendant No. 1 is an active one which permits subscribers from India to subscribe to its services. In this behalf, learned Counsel referred to the "subscribe" section of the impugned website which provides a form for subscription to services provided by defendant No. 1's website. The options under the head 'Country' include 'India'. The website can not only be accessed from but also subscribed to from Delhi and it is thus contended that defendant No. 1 is carrying on business for profit or gain from India.

39. Learned Counsel contended that defendant No. 2 is the controlling authority of defendant No. 1 and has its office in India as per the information given on its own website.

40. Reference was also made to the "Live Channels" section of the website of defendant No. 1 to show that the TV channels offered on subscription by defendant No. 1's website are Indian TV channels and contended that the target audience for the same is the Indian public. It was also pointed out that the web page for "PIO TV", one of the channels being shown by defendant No. 1 on its website, states "Live feed 24/7 directly from India". The stand taken in the written statement is also that the website "indiatvlive.com" became the very first IPTV delivery system of Indian content from India.

41. Learned Counsel referred to the written statement filed by defendant No. 1. The said written statement shows that the promoters of defendant No. 1 are of Indian origin. Para 3 of the written statement states that the website "indiatvlive.com" was launched at New Delhi on 17.08.2006. Learned Counsel thus contended that the defendant has sufficient minimum contacts with Delhi and thus this court can exercise jurisdiction in the present matter.

42. Learned Counsel for the plaintiff relied on the judgment of learned single judge of this court in *Casio India Co. Ltd v. Ashita Tele Systems Pvt. Ltd* MANU/DE/0739/2003 : 106(2003)DLT554 to advance the proposition that the fact that the website of the defendant can be accessed from Delhi is sufficient to invoke the territorial jurisdiction of this court in the light of the judicial principles enunciated. The Court in this case had referred inter alia to the judgment of the High Court of Australia in *Dow Jones & Co. Inc. v. Gutnic* (2002) HCA 56 wherein it was held that due to the ubiquity, universality and utility of the features of the Internet and World Wide Web, any matter associated with it possesses global jurisdiction.

43. Learned Counsel further also placed reliance on the judgment of the High Court of New Zealand in *New Zealand Post Ltd. v. Leng* 45 IPR 263. This was a case involving the domain name nzpost.com. It was found that there was a likelihood of misleading or deceiving with the activities of New Zealand Post and its activities. It was observed that either deliberately or by happenstance, the defendant's domain name was appropriating NZ post's goodwill at least in New Zealand.

44. Learned Counsel referred to the provisions of Section 20 of the said code to contend that this court has jurisdiction in the present matter. The said provision reads as under:

20. Other suits to be instituted where defendants reside or cause of action arises.

Subject to the limitations aforesaid, every suit shall be instituted in Court within the local limits of whose jurisdiction-

(a) the defendant, or each of the defendants where there are more than one, at the time of the commencement of the suit, actually and voluntarily resides, or carries on business, or personally works for gain; or

(b) any of the defendants, where there are more than one, at the time of the commencement of the suit actually and voluntarily resides, or carries on business, or personally works for gain, provided that in such case either the leave of the Court is given, or the defendants who do not reside, or carry on business, or personally work for gain, as aforesaid, acquiesce in such institution; or

(c) the cause of action, wholly or in part, arises.

[Explanation].-A corporation shall be deemed to carry on business at its sole or principal office in [India] or, in respect of any cause of action arising at any place where it has also a subordinate office, at such place.

...

45. In order for the grant of an anti-suit injunction, one of the conditions is the amenability of the defendant to the personal jurisdiction of the court. The position in the United States, in this behalf, as enunciated in the judgments referred to by the learned Counsels for the parties, is to inquire firstly, whether jurisdiction can be exercised under the 'long arm' statute of the state and secondly, whether the finding of jurisdiction satisfies the constitutional requirements of due process. American Courts basically apply a three part test to determine whether specific personal jurisdiction can be exercised over non-resident defendants. These include an act or transaction within the forum state by which the defendant purposefully avails himself of the privilege of conducting activities within the forum; claim/cause of action arising out of the defendant's forum related activities and whether the acts of the defendant or its consequences have a substantial enough connection with the forum to make the exercise of jurisdiction over the defendant reasonable [Cybersell Inc. case (supra); Panavision International LP case (supra)]. Besides, whether the defendant's conduct had an effect in the forum state (an effects test) would also be seen [Panavision International LP case (supra)].

46. As regards the exercise of personal jurisdiction in cases involving Internet activities, the position appears to be that mere 'passive' posting of a website does not give jurisdiction to the court within whose jurisdiction, the complainant company is present. Thus, personal jurisdiction cannot be exercised over non-residents merely because their website is accessible within the jurisdiction of the court. There has to be something more to indicate purposeful direction of activity to the forum state in a substantial way. In Cybersell Inc. case (supra) limited interactivity of the website restricted to received browser's name and expression of interest but not signing up for the services provided was not considered to be sufficient for the exercise of jurisdiction.

47. Insofar as the position in this country is concerned, there is no 'long arm' statute as such which deals with jurisdiction as regards non-resident defendants. Thus, it would have to be seen whether the defendant's activities have a sufficient connection with the forum state (India); whether the cause of action arises out of the defendant's activities within the forum and whether the exercise of jurisdiction would be reasonable.

48. I am in agreement with the proposition that the mere fact that a website is accessible in a particular place may not itself be sufficient for the courts of that place to exercise personal jurisdiction over the owners of the website. However, where the website is not merely 'passive' but is interactive permitting the browsers to not only access the contents thereof but also subscribe to the services provided by the owners/operators, the position would be different. However, as noticed in the judgment in CyberSell Inc. case (supra), even where a website is interactive, the level of interactivity would be relevant and limited interactivity may also not be sufficient for a court to exercise jurisdiction. In Panavision International LP case (supra), it was found that the registration of the plaintiff's mark as a domain name by the defendant had the effect of injuring the plaintiff in California and Therefore the court had jurisdiction. In Compuserve case (supra) again it was found that the defendant had contacted Ohio to sell his computer software's on the plaintiffs Ohio based systems and sent his goods to Ohio further for their ultimate sale and thus those courts had jurisdiction.

49. In the present case, the website "indiatvlive.com" of defendant No. 1 is not wholly of a 'passive' character. It has a specific section for subscription to its services and the options (provided on the website itself) for the countries whose residents can subscribe to the services include India. The services provided by defendant No. 1 can thus be subscribed to and availed of in Delhi (India) i.e. within the jurisdiction of this court. It may also be noticed that an article entitled "Archer Entertainment Joins India Minister for Overseas Affairs in Launching [indiatvlive.com](http://in-sys-con.com/read/243792.htm)" (<http://in-sys-con.com/read/243792.htm>; http://www.archeremc.com/Media_Center/Company_News/?sp=20060705 quotes IBL CEO Abhesh Verma as saying that "The platform provides us the extremely lucrative opportunity to reach both inside and outside of India. Overseas Indians represent the most affluent ethnic consumers of any expatriate group. Within India, we will target a whopping 500 million consumer class with a steadily rising broadband connectivity." Another article "Archer launches IPTV Platform for Indian content in the US" (<http://us.indiatelevision.com/headlines/y2k6/july/july45.htm>) again filed by defendant No. 1 contains a similar statement. This indicates that defendant No. 1 intended to target expatriate Indians as well as Indians within the country. Further the stand taken by defendant No. 1 in its written statement is that defendant No. 1 company has a global presence including in India. Defendant No. 1 also claims to be the first IPTV delivery system of Indian content from India. The website of defendant No. 1 was launched in India as well as in Los Angeles. Thus, defendant No. 1 company has sufficient connection with India.

50. The plaintiff's channel being primarily an Indian news channel intended for Indian audiences, any damage alleged to have been caused or alleged to be likely to arise to the goodwill, reputation etc of the plaintiff would be in India. Further, the alleged damage that may have arisen or may be likely to arise to the plaintiff would be as a consequence of the fact that the impugned website is accessible in India and the services provided can be availed of in India.

51. The result of the aforesaid is that the defendant is carrying on activities within the jurisdiction of this court;

manupatra has a sufficient contacts with the jurisdiction of the court and the claim of the plaintiff has arisen as a consequence of the activities of defendant No. 1 within the jurisdiction of this court. This court can thus exercise personal jurisdiction over the defendants.

Forum convenience

52. The second aspect to be considered in determining whether an anti-suit injunction can be granted is which of the available forums is the forum convenience for the dispute at hand. It is the stand of defendant No. 1 that this Court is not the forum convenience for dealing with the present case. It is the case of defendant No. 1 that the said defendant is entirely based in the United States and thus it is the District Court at Arizona, which is the convenience forum to be approached for claiming reliefs.

53. Learned senior counsel for defendant No. 1 placed reliance on the judgment of the House of Lords in *Spiliada Maritime Corporation v. Cansulex Ltd.* [1986] 3 All E.R. 844 in which the Court on consideration of various authorities summarized the principles applicable insofar as granting of stay on the ground of forum non convenience is concerned. Broadly, the principles are as under:

i. The basic principle is that a stay will be granted on the ground of forum non convenience where the court is satisfied that there is some other available forum having competent jurisdiction where the case may be tried more suitably for the interest of all the parties and the ends of justice.

ii. The burden of proof in general rests on the defendant to persuade the court to grant a stay and once the court is satisfied that there is another available forum, which is prima facie the appropriate forum for the trial of the action the burden will then shift to the plaintiff to show special circumstances by reason of which justice requires that the trial should nevertheless take place in the forum state.

iii. In considering whether there is some other forum which is appropriate for the trial of the action, it is pertinent to ask whether the fact that the plaintiff has ex hypothesi founded jurisdiction as of right in accordance with the law of this country, which of itself gives the plaintiff an advantage in the sense that the English Court will not likely disturb jurisdiction so established. The position appears to be such in the United States also where the court hesitates to disturb the plaintiff's choice of forum and will not do so unless the balance of factors is strongly in favor of the defendant. The burden on the defendant is to show that the forum state is not the natural or appropriate forum for the trial and to establish that there is another available forum which is clearly or distinctly more appropriate than the English forum.

iv. Where the question is whether there exists a more appropriate forum, the court will look at factors, which point in the direction of the other forum. The court must also look at connecting factors, such as those affecting convenience or expense as also factors such as the law governing the relevant transactions.

v. If the court concludes that there is no other available forum which is clearly more appropriate for grant of stay, it will ordinarily refuse the stay.

vi. If, however, the court concludes that there is some other forum, which prima facie is more appropriate for the trial of the action ordinarily a stay will be granted unless there are circumstances by reason of which justice requires that a stay should nevertheless not be granted. In this enquiry, all the circumstances of the case are to be considered which include circumstances which go beyond those taken into account while considering factors connected with other jurisdictions. For instance, where it is established objectively by cogent evidence that the plaintiff will not obtain justice in the forum jurisdiction.

54. Learned senior counsel referred to the judgment of the Supreme Court in *Kusum Ingots & Alloys Limited v. Union of India and Anr.* MANU/SC/0430/2004 : 2004(186)ELT3(SC) to advance the proposition that even if a small part of the cause of action arises within the territorial jurisdiction of the High Court, the same by itself may not be considered to be a determinative factor compelling the High Court to decide the matter on merits. In appropriate cases, the Court may refuse to exercise its discretionary jurisdiction by invoking the doctrine of forum convenience.

55. In *ONGC v. Utpal Kumar Basu and Ors.* MANU/SC/0759/1994 : (1994)4SCC711, it was held that the mere fact that the petitioner company which had its registered office at Calcutta and read in a Calcutta newspaper ONGC's advertisement inviting tenders at Delhi for works to be executed in Gujarat and in response thereto the petitioner sent its tenders to the Delhi address from Calcutta and made representations from Calcutta against the non-consideration of its offer would not constitute an integral part of the cause of action. In determining the objection of the lack of territorial jurisdiction, the court must take into consideration all the facts pleaded in support of the cause of action albeit without embarking upon an enquiry as to the correctness or otherwise of the said fact. In other words, the question of territorial jurisdiction must be decided on the facts pleaded in the petition.

manupatra 56. It was thus contended that the District court of Arizona by reason inter alias of having personal jurisdiction over defendant No. 1 as also the registering authority being defendant No. 3 would be the forum convenience in the present matter.

57. Learned Counsel for the plaintiff on the other hand contended that this court is the most convenience forum for the parties. Learned Counsel for the plaintiff averred that the cause of action has arisen in India. Further the defendant has enough links with India for this Court to exercise jurisdiction while the plaintiff has an office only in India and does not have offices anywhere else in the world. Learned Counsel contended that in determining the convenience forum for a suit, the court must consider the point of view of the plaintiff as well as the defendant. Learned Counsel for the plaintiff referred to the provisions of Section 134 of the said Act which reads as under:

134. Suit for infringement, etc., to be instituted before district Court.- (1) No suit -

(a) for the infringement of a registered trade mark, or

(b) relating to any right in a registered trade mark, or

(c) for passing off arising out of the use by the defendant of any trade mark which is identical with or deceptively similar to the plaintiff's trade mark, whether registered or unregistered.

Shall be instituted in any court inferior to a District Court having jurisdiction to try the suit.

(2) For the purpose of Clauses (a) and (b) of Sub-section (1), a "District Court having jurisdiction" shall, notwithstanding anything contained in the Code of Civil Procedure, 1908 (5 of 1908) or any other law for the time being in force, include a District Court within the local limits of whose jurisdiction, at the time of the institution of the suit or other proceeding, the person instituting the suit or proceeding, or where there are more than one such person any of them, actually and voluntarily resides or carries on business or personally works for gain.

Explanation.- For the purpose of Sub-section (2), "person" includes the registered proprietor and the registered user.

58. Learned Counsel for the plaintiff referred to the judgment of learned single judge of this court in *Surbhi Kumar v. Nitin Kumar and Ors.* CS(OS) 2047/2006 decided on 12.03.2007 wherein in the interim application filed, the relief prayed for was restraining the defendant from proceeding with the divorce petition filed before the Superior Court of the State of California, County of San Diego, USA pending disposal of the suit. The plaintiff had initially participated in the proceedings in California and thereafter filed a suit in India. It was found that the plaintiff had only a dependent visa and had could not effectively represent herself in the US as she had no residence in the US. The defendant on the other hand was an Indian citizen having a permanent residence in India and thus it would be simpler for him to contest the proceedings in India. It was found that the balance of convenience was in favor of the plaintiff and the defendant was restrained from proceeding further in the Superior Court of California, County of San Diego till the disposal of the suit.

59. A perusal of the aforesaid shows that the legal position as regards forum non convenience is that a stay on the ground of forum non convenience would be granted where a court is satisfied that there is another available forum having jurisdiction. Also the plaintiff's choice of forum is usually not disturbed unless the balance of convenience is strongly in favor of the defendant. In determining whether a more appropriate forum exists, connecting factors, such as those effecting the convenience of parties, expenses involved and the law governing the relevant transactions are to be looked into. The mere fact that a part of the cause of action has arisen within the jurisdiction of the court may itself not be considered to be a determinative factor compelling the court to decide the matter on merits. In determining which of the available forums is the forum convenience in a given matter, the convenience of all the parties had to be seen.

60. Insofar as Section 134 of the said Act relied on by the plaintiff is concerned, it is only a suit with regard to the infringement of a registered trademark or relating to any right in a registered trademark which can be filed in the District court within the local limits of whose jurisdiction, at the time of institution of the suit or proceeding the person instituting the suit or proceeding actually resides or personally works for gain. In the present matter it is not disputed that the mark of the plaintiff "IndiaTV" is not registered. It is only the mark "India TV's Most Wanted" of the plaintiff that is registered. The present suit is in respect of the mark "INDIATV" which is not registered and thus this provision does not really support the case of the plaintiff.

61. In the present matter, the defendant 1 and 2, as noticed hereinabove, are amenable to the jurisdiction of this Court and have sufficient contacts with the jurisdiction of this court. Defendant No. 1 as per its written statement is based in Delaware(USA) and defendant No. 2 as per the website print outs placed on record has offices in Los Angeles, China and Delhi (India). It may be noticed that the website of defendant No. 2 no more displays the address in India. Thus, even defendants 1 & 2 are not based in Arizona where the subsequent suit has been filed by defendant No. 1. The plaintiff company is based entirely in India with its offices at New Delhi. Thus, neither the plaintiff nor defendants 1 & 2 have any connection with Arizona. It is only defendant

manupatra No. 3, the Registrar of Domain Names, which is a proforma party, which has its offices at Arizona. Moreover, the claim of the plaintiff has arisen as a result of the fact that the impugned website is accessible in India and any injury alleged to have been caused to the goodwill and reputation of the plaintiff would be in India.

62. It may be noticed that the fact of filing of the suit in Arizona District Court was not disclosed by defendant No. 1 in this Court either in its written statement or in the reply to the application under Order 39 Rules 1 & 2 CPC (IA No. 651/2007) although the said suit was filed prior to filing of the written statement and reply. This fact was also not disclosed during submissions made before the court until the filing of the application under Order 39 rules 1 and 2 of the said code by the plaintiff praying for the grant of an anti-suit injunction.

63. The suit of the plaintiff was filed in this court on 18.01.2007 and this court is the forum of choice of the plaintiff and is the court of competent jurisdiction to adjudicate the matter in dispute. The balance of convenience is not so strongly in favor of the defendants as to warrant the stay of the present proceedings.

64. The aforesaid shows that it is this court and not the district court in Arizona that is the forum convenience in the present matter.

Connection between Defendant Nos. 1 and 2

65. Learned Counsel pointed out the WHOIS search results in respect of the website of defendant No. 1 to show that the domain name has been obtained by proxy Inc and information pertaining to the owner etc of the said domain name has not been given. It was further pointed out that the website of defendant No. 1 in the section entitled "About Us" (as on 16.01.2007) to contend that the website is promoted by Archer Media. The relevant paragraph is as under:

...

IBL, LLC enjoys a strategic relationship with Los Angeles based Archer Entertainment Media Communications Incorporated (OTC: ACRM). Archer (www.archeremc.com) has funded the development, technology integration and launch of www.indiatvlive.com and People of India Origin TV Channel.

66. In this behalf, learned Counsel also relied on an article entitled "India Broadcast Live launches five more channels" appearing on "www.digitalmediasia.com" (as on 16.01.2007) to contend that India Broadcast Live i. e. defendant No. 1 is really a division of Archer Media and that the channels carried by the website of defendant No. 1 are directly from India. The relevant paragraph is as under:

India Broadcast Live (IBL), a division of Archer Entertainment Media Communications, has added 5 additional channels bringing the total to 10 live, steaming channels on its platform. India Broadcast Live debuted what is called first Indian IPTV platform India TV Live on 17 August with five channels. This service carries these 10 channels directly from India, in real time, and delivers them worldwide via broadband, to any web enabled device- PCs, Laptops, PDA's and Cell Phones.

The company claims that India TV Live does not directly compete with broadcast, satellite and cable television, but is expected to become an additional platform to provide on the go news, information pertaining to business and investment and entertain.

...

67. Learned Counsel referred to the website of Archer Media, where, in the section entitled "About Us", it has been stated inter alia that Archer Media is a vertically integrated global entertainment and media company and its interests are exclusively focused in China, India and the United States. The website of Archer Media in the section entitled "Contact US" provides addresses in China, India and the United States and the Address provided for India is Shama Broadcast Contents and Services Pvt. Ltd , D-47 Gulmohar Park Delhi. Learned Counsel pointed out that the address herein is the same as the address of Sh. K. N. Gupta, who has signed the written statement filed by defendant No. 1. The plaintiff has thus contended that defendant No. 1 is a division of defendant No. 2.

68. It may be noticed that in the article entitled "Archer Entertainment Joins India Minister of Overseas Affairs in Launching [indiatvlive.com](http://www.indiatvlive.com)" as also other articles including "Archer Launches IPTV Platform for Indian Content overseas" (<http://us.indiantelelevision.com/headlines/y2k6/july/july45.htm>) filed by defendant No. 1 with the application under order 39 Rule 4 of the said code mention that [indiatvlive.com](http://www.indiatvlive.com)'s content and marketing partners include Shama Broadcast & Content Service India Pvt. Ltd. and Creative Content Services India Pvt. Ltd., owned and operated by Mr. Kedar Nath Gupta.

69. In the affidavit filed by Mr. K.N. Gupta, on behalf of defendant No. 1, the stand taken is that defendant No. 2 is a venture capital company, which has loaned funds to defendant No. 1 in early 2006 and defendant No. 1 has no relationship of being a division, affiliate or partner of defendant No. 2. It is also claimed that a letter was sent on 30.10.2006 by defendant No. 1 through its corporate counsel to defendant No. 2 demanding that the

manupatra said defendant ceases and desists from publishing any statements implying that it owns defendant No. 1 or regarding the operations of defendant No. 1. The letter has been acknowledged and compliance with the demands made therein have been expressed by defendant No. 2 in its E-mail dated 7.11.2006. Insofar as the address given for the parties is concerned, it is stated that the address of D-47, Gulmohar Park, New Delhi is neither the correct address of defendant No. 1 nor of defendant No. 2. However, there is no specific Explanation forthcoming regarding the fact of the said address being mentioned on the website of defendant No. 2 except the stand that defendant No. 2 has misrepresented its relationship with defendant No. 1.

70. The plaintiff in its reply has averred that defendant No. 1's plea is malafide. The earlier statement in the section 'About us' on the website of defendant No. 1 has been amended as under:

India Broadcast Live, INC, is a vertically integrated global entertainment and media company engaged in the production, acquisition, delivery, distribution and exhibition of digital content through various platforms including the Internet, IPTV, Video-On-Demand (VOD), Pay-Per-View (PPV) and other electronic means and methods currently available and those in the future.

IBL, INC, has created a digital infrastructure leveraging existing Internet assets and resources providing a secure, complete, end-to-end digital solution positioned to capture the global audience. IBL, INC members have extensive experience in content production, aggregation, acquisition, distribution and delivery of entertainment product in addition to talent management and studio administration. IBL currently operates this Web site.

71. Learned Counsel for the plaintiff contended that all available public documents show the relationship between defendants 1 & 2. It is alleged that the fact that these documents find mention in the letter dated 30.10.2006 indicates an attempt to create evidence to escape liability. The fact that defendant No. 1 shares a strategic relationship with defendant No. 2 was mentioned on the website of defendant No. 1 itself and not only of defendant No. 2.

72. It may also be noticed that the articles filed by defendant No. 1 along with is 1366/2007 also support the contention of the plaintiff that there is some connection between defendants 1 and 2. In the article entitled "Archer Entertainment Joins India Minister of Overseas affairs in launching indiatvlive.com" (<http://in.syscon.com/read/243792.htm>), defendant No. 1 has been described as an Archer supported company. The article also quotes Munish Gupta, the COO of Archer Entertainment (also a promoter of defendant No. 1) as stating that teaming up with Abhesh Verma (the other promoter of defendant No. 1), Archer was able to put together a state of the art digital platform to broadcast Indian Channels from India. The relevant paragraph is as under:

Teaming up with Abhesh, Archer was able to put together a state-of-the-art digital technology platform to broadcast the top channels from India. We will deliver channels real time and live from one of the fastest growing and dynamic countries in the world but also guarantee terrific consumer experience in terms of quality. This is the first time that the world will watch news and events as they unfold in India on any device connected by high speed Internet. This is just the beginning of what Archer and <http://www.indiatvlive.com/> intend to deliver.

73. Another article "Archer launches Indian IPTV Platform for Expats" (<http://www.iptvnews.com/content/view/742/64/>) states that LA based Archer Entertainment Media Communications Incorporated conceived and developed India TV live after investing \$ 1.5 million. It quotes Paul Ebeling, Chairman of Archer Entertainment Media Communications Inc as saying that Archers relationship with IBL is a strategic one as well as an investor. Also, in an article "Archer Entertainment Media to Gain Revenue From Advertising as India Broadcast Live launches Ten Channels" (<http://www.prnewswire.com/cgi-bin/stories.pl?ACCT=109&StorY=/www/story/09-11-200...>) filed by the plaintiff again, defendant No. 1 has been described as a division of Archer Media.

74. Insofar as the aspect of the connection between defendant No. 1 and 2 concerned, the material relied on by learned Counsel for the plaintiff prima facie shows that there is a connection between defendants 1 and 2. The website of defendant No. 1 itself at the time of the filing of the suit stated that the development, technology integration etc of the impugned website was funded by Archer Media. Also, the contact address provided by Archer Media for India is the address of the authorized signatory of defendant No. 1. This along with the articles relied upon by the plaintiff and filed by defendant No. 1 along with its application under Order 39 Rule 4 shows a connection between defendants 1 and 2.

75. It may however be noticed as pointed out by learned Counsel for the plaintiff that subsequently the "About Us" section of the website of defendant No. 1 was amended and Archer Media is no more mentioned therein. The website of defendant No. 2 has also been amended subsequently and the contact address for India has been omitted. It cannot be disputed that there was a connection between defendants 1 and 2. The copies of emails filed with the affidavit of Sh. K.N. Gupta merely show that defendant No. 1 demanded that defendant 2 cease and desist from making any statement that it is the owner of defendant No. 1 or as to the operations of defendant No. 1. These emails do not clearly show that there has been any severance of ties between

manupatra defendants 1 and 2 and when such severance if any took place. There is no other material on record which shows severance of ties between defendants 1 and 2. There is no material on record which shows the nature of the relationship between defendants 1 and 2 besides the affidavit of Sh. K.N. Gupta in which the stand taken is that defendant No. 2 is a venture capital company, which has loaned funds to defendant No. 1. This aspect can thus really be decided only after trial where evidence is led in this behalf.

REMEDY UNDER UDRP:

76. Defendant No. 1, in its written statement has averred that the remedy provided by ICANN would be an equally efficacious and appropriate remedy and the plaintiff has approached this court mala fide instead of approaching ICANN.

77. Learned Counsel for the plaintiff submitted that domain name disputes are governed by the Uniform Domain Name Dispute Resolution Policy (for short UDRP). It is noted in the policy that the same has been adopted by all accredited domain name registrars for domain names ending in '.com', '.net' and '.org' besides certain managers of country code domains including ".nu", ".tv" and ".ws". Para 3 of the said policy deals with "cancellations, transfers and changes". Para 3 (b) of the same stipulates as under

3. Cancellations, Transfers and Changes We cancel, transfer or otherwise make changes to domain name registrations under the following circumstances:

(b) our receipt of an order from a court or an arbitral tribunal, in each case of competent jurisdiction, requiring such action.

78. Learned Counsel further submitted that the only remedies available to a complainant in case of a proceeding before an administrative panel provided for under the UDRP shall be limited to cancellation of the domain name or transfer of the domain name registration to the complainant. It was thus submitted that the Panel provided for in the policy can only provide for cancellation or transfer of the impugned domain name and not damages or rendition of accounts as has been prayed for by the plaintiff in the present suit.

79. In this behalf it may be useful to reproduce some provisions of paragraph 4 of the UDRP. The same are as under:

4. Mandatory Administrative Proceeding.

This Paragraph sets forth the type of disputes for which you are required to submit to a mandatory administrative proceeding. These proceedings will be conducted before one of the administrative-dispute-resolution service providers listed at

"www.icann.org/udrp/approved-providers.htm" (each, a "Provider").

a. Applicable Disputes. You are required to submit to a mandatory administrative proceeding in the event that a third party (a "complainant") asserts to the applicable Provider, in compliance with the Rules of Procedure, that

(i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

(ii) you have no rights or legitimate interests in respect of the domain name; and

(iii) your domain name has been registered and is being used in bad faith.

In the administrative proceeding, the complainant must prove that each of these three elements are present.

...

(i) Remedies. The remedies available to a complainant pursuant to any proceeding before an Administrative Panel shall be limited to requiring the cancellation of your domain name or the transfer of your domain name registration to the complainant.

80. Learned Counsel for the plaintiff placed reliance on the judgment of the learned single Judge of this Court in Citi Corporation and Anr. v. Todi Investors and Anr. 2006 (33) PTC 631 in support of the proposition that online resolution does not offer a complete alternative to passing off actions. In this case, the Court considered that the '.IN' Domain Name Dispute Resolution Policy (INDRP) for inquiring whether the remedies provided therein are adequate and sufficient. It was observed that the remedies available under the INDRP are limited to requiring the cancellation of the registrants domain name. The scope of the suit where the relief claimed is for infringement of trademark and passing off is far greater than the disputes that could be adjudicated by the Tribunal. The Court further noticed that the INDRP was not a statutory remedy and the

manupatra arbitrator provided for under that policy is not a Judge/Judicial Officer. Section 134 of the said Act empowers a District Court to deal with suits for infringement of trademark or passing off.

81. The remedy provided in the UDRP of the ICANN is restricted to cancellation, transfer or changes in domain names and not for actions for passing off or damages. This is apparent from para 4(i) of the UDRP. Para 3(b) of the UDRP shows that such cancellation, transfer or change can also be made pursuant to an order of a court of competent jurisdiction requiring such an action. Para 4 (k) of the said policy clearly provides that the mandatory administrative proceeding does not prevent either party to the dispute from submitting the dispute to a court of competent jurisdiction for independent resolution before the commencement of such proceeding or after the conclusion thereof. The judgment in Citi Corporation and Anr. case (supra) is to the effect that the reliefs in a suit for passing off are wider than the mere cancellation or transfer of a domain name, which is envisaged in the UDRP. The plaintiff in the present suit has prayed for include a permanent injunction restraining defendants 1 and 2 from operating any website under the impugned domain name and damages besides the transfer of the said domain name to the plaintiff. I am thus of the view that the present suit filed by the plaintiff is the most appropriate remedy in the light of the reliefs that have been claimed therein.

Injunction from using the domain name "indiatvlive.com"

Domain names dealt with differently

82. Learned Counsel for the plaintiff contended that the Internet is to be dealt with differently and separately from trademarks used in the ordinary course and that the concept of honest concurrent user which is applicable to trademarks would not be applicable to domain names. In this behalf, learned Counsel placed reliance on the judgment of the Apex Court in Satyam Infoway Ltd. v. Sifynet Solutions Pvt. Ltd (2004) 28 PTC 566. It was observed in this case that a domain name is used as a business identifier to identify and distinguish the business itself or its goods and services and to specify its corresponding online Internet location. The court observed at para 11 as under:

The original role of a domain name was no doubt to provide an address for computers on the internet. But the internet has developed from a mere means of communication to a mode of carrying on commercial activity. With the increase of commercial activity on the internet, a domain name is also used as a business identifier. Therefore, the domain name not only serves as an address for internet communication but also identifies the specific internet site. In the commercial field, each domain-name owner provides information/services which are associated with such domain name. Thus a domain name may pertain to provision of services within the meaning of Section 2(1)(z). A domain name is easy to remember and use, and is chosen as an instrument of commercial enterprise not only because it facilitates the ability of consumers to navigate the internet to find websites they are looking for, but also at the same time, serves to identify and distinguish the business itself, or its goods or services, and to specify its corresponding online internet location. Consequently a domain name as an address must, of necessity, be peculiar and unique and where a domain name is used in connection with a business, the value of maintaining an exclusive identity becomes critical.

As more and more commercial enterprises trade or advertise their presence on the web, domain names have become more and more valuable and the potential for dispute is high. Whereas a large number of trade marks containing the same name can comfortably coexist because they are associated with different products, belong to business in different jurisdictions, etc., the distinctive nature of the domain name providing global exclusivity is much sought after. The fact that many consumers searching for a particular site are likely, in the first place, to try and guess its domain name has further enhanced this value.

The answer to the question posed in the preceding paragraph is Therefore in the affirmative.

83. It was thus contended by learned Counsel for the plaintiff that the use of a same or similar domain name to that of the plaintiff would mislead consumers. As defendant No. 1's website is a subscription site, it was submitted that the same is being used to earn revenue and the defendants are attempting to ride piggyback on the goodwill of the plaintiff.

84. There is no doubt that with the development of e commerce, domain names have gained greater importance and have become business identifiers. It is also not disputed that on the Internet, no two domain names can be identical unlike in the case of trademarks where even two identical marks can co-exist.

85. Insofar as the aspect of revenue being earned by the defendants from the impugned website, at this stage there is no material on record which shows the revenues from the impugned website either totally or from India. This aspect would thus have to be considered after evidence is led in this regard.

Geographical Name

86. Learned senior counsel for defendant No. 1 submitted that a geographical name cannot be registered as

manupatra a trademark. In support of his submission, learned senior counsel referred to the judgment of a division bench of the Calcutta High Court in *Imperial Tobacco Co. of India Ltd. v. The Registrar of Trademarks and Anr.* MANU/WB/0109/1977 : AIR1977Cal413 which involved the trademark 'SIMLA' in respect of manufactured tobacco (cigarettes). Some relevant observations in respect of the registration of geographical names as trademarks are as under:

25. A geographical name according to its ordinary signification is such mark inherently or otherwise incapable of registration subject to such minor exceptions in regard to other aspects as noticed in judicial decisions referred hereinafter. In *Corpus Jurisdiction Vol. 63 (1933 Edn.)*, in Chapter of Trade Marks etc. Article 53 (pp. 356-7) it is stated:

Geographical terms and words in common use to designate a locality, a country, or a section of country cannot be monopolised as trade marks; but a geographical name not used in geographical sense to denote place of origin, but used in an arbitrary or fanciful way to indicate origin or ownership regardless of location, may be sustained as a valid trade mark.

According to Section 9 Sub-section (1) Clause (d) of our Act, a trade mark for registration in 'A' part of the Register must contain one or more words having no direct reference to the character or quality of the goods and not being according to its ordinary signification, a geographical name.

...

34. As we have seen, the mark 'Simla' is a geographical name and the snow-clad hills in outline in the mark indicates its use in ordinary or geographical signification, so that the mark is neither a fancy or invented word nor one with a secondary meaning. As has been observed in *Karly's Treatise (10th Edition)*:

8.51. A word is not debarred from registration under Section 9(1)(e) as a distinctive word merely because it is geographical and so cannot be registered under Section 9(1)(d). Some geographical names can be inherently adapted to distinguish the goods of particular traders, but only if it can be predicated that they are such names as it would never occur to any other trader in such goods to use. At the other extreme, the name of a major industrial area of city will be totally unregistrable in respect of almost any goods. In between come the marks calling for more or less evidence that they are distinctive in fact....It may tip the balance that the applicant can show that he has a natural or legal monopoly of the production of goods concerned in the place concerned; but that alone will not make a geographical name registrable without substantial evidence of distinctiveness.

Though Clause (d) of Section 9(1) which refers to geographical name in ordinary signification relates to registration in Part A of the register, the distinctiveness of the trade mark which makes it capable of distinguishing the applicant's goods, as required in Clause (b) of Section 9(5) in respect of registration in Part B of the register, it is a vital and essential element for the purpose. Such distinctiveness is not possible for any geographical name in its ordinary or geographical signification. Though the rule has been relaxed in respect of small and insignificant place or where there is no geographical significance of the mark, if the geographical name propounded for registration is the name of an important country or a large district, county or city of commercial importance or has a geographical signification, the mark will be refused registration notwithstanding evidence of long and extensive use....

87. Learned senior counsel drew the attention of this court to the decision in *Liverpool Electric Cable Co Ltd's case (1929) 46 RPC 99* referred to in *Imperial Tobacco Co case (supra)* in which registration was sought for the trademark 'Liverpool' in both parts A and B of the trademark register. It was held that the name of an important commercial centre as Liverpool, even though it may in fact be distinctive of the goods in respect of which it is sought to register is not registrable.

88. In the *Matter of Sir Titus Salt, Bart., Sons and Co. s' Application XI. (1894) 26 RPC 518*, the mark sought to be registered by the applicants was 'Eboline' for silk piece goods. It was observed that 'Eboline' is the name of an Italian town and the mere addition of the common English Termination 'ne' is not sufficient to make this word an invented word. What the Act requires is that the word should be an invented word in fact and not merely in the belief of the person claiming to register it as a trademark. It was further held that the prohibition extends to a noun substantive, the adjective as well as to the name of a place to which an ordinary English suffix has been added so as to impart to it an adjectival form. The object of the legislature was observed to be of preventing a trader from acquiring a monopoly in the name of a place, and thereby suggesting that the goods had a local origin or local connection, which in fact it may not have.

89. It was thus contended that the plaintiff cannot claim exclusive use over the word 'INDIA'.

manupatra 90. Learned Counsel for the plaintiff submitted that though the mark 'INDIA TV' consists of the word 'India' which has a geographical connotation in the context of news channels, 'INDIA TV' as a combination is distinctive and is, thus, entitled to protection. Distinctiveness of such a mark can be recognized and protected even at the prima facie stage.

91. Learned Counsel referred to the judgment of this Court in *Hi-Tech Pipes Ltd. v. Asian Mills Pvt. Ltd.* MANU/DE/8065/2006. The plaintiff company was in the business of manufacturing and selling steel pipes etc. under the mark 'GUJRAT' while the defendant was selling 'MS ERW' pipes under the mark 'GUJARAT'. It was observed that the important aspect to be considered is whether the word 'Gujarat' has acquired secondary significance and has distinctiveness in respect of the steel pipes produced by the plaintiff. It was further observed that both the marks 'Gujrat' and 'Gujarat' are similar if not identical and the only issue is whether the plaintiff can abrogate to itself the use of the said trademark for its steel pipes or preclude the defendant from using the same in respect of the same product on the ground that such sale is an attempt by the defendant to pass off its goods as that of the plaintiff since by consistent prior use, the mark is associated with the product of the plaintiff. It was observed that similar protection was granted in respect of the mark 'CHAMBAL' in *Geepee Ceval Protiens & Investment Private Limited v. Saroj Oil Industry* MANU/DE/0761/2003. The Court referred to the judgment of the learned single Judge of the Gujarat High Court in *Bharat Tiles and Marble Private Ltd. v. Bharat Tiles Manufacturing Co.* 1978 GLR 518 wherein it was held that merely because a trade name is geographically descriptive, it does not imply that an action for passing off cannot be maintained provided the plaintiff is able to establish the requisite grounds of deceit by use of similar name.

92. Learned Counsel for the plaintiff submitted that geographical names have been granted protection in a number of other cases, such as, the mark 'BHARAT' in *Bharat Tiles and Marble Private Ltd.* case (supra) and 'HINDUSTAN' in respect of radiators in *Hindustan Radiators Co. v. Hindustan Radiators Limited* 1987 PTC 73 and 'CHAMBAL' in *Geepee Ceval Protiens & Investment Private Limited* case (supra).

93. The legal position as set out in the various judgments referred to by learned Counsels for the parties is that ordinarily geographical names are incapable of registration as trademarks. The rule has however been relaxed in respect of small and insignificant places or where there is no geographical significance of the mark. (*Imperial Tobacco Company of India* case (supra)). Even if the name may be distinctive of the goods in respect of which it is sought to be registered, registration of a geographical name may be refused, as was the case in *Liverpool Electric Cable Co Ltd.* case (supra). The addition of an ordinary English suffix to a geographical name may not be sufficient to permit registration of the word as a trademark (*Sir Titus Salt, Bart Sons and Co's Application* case [supra]).

94. It must however be borne in mind that, the present action as was the case in *Hi Tech pipes* case (supra), is really in the nature of an action for passing off and what is being sought is not the registration of the impugned mark. It is not the case that a geographical mark cannot be granted protection in an action for passing off (*Bharat Tiles and Marbles Private Ltd's* case [supra]). Where a mark having a geographical connotation has acquired secondary significance and distinction, such a mark may be granted protection in a passing off action (*Hi Tech Pipes* case [supra]).

95. Thus, what has to be seen is whether the plaintiff's mark which is comprised partly of a geographical name 'India' has acquired any secondary significance or distinction and is thereby entitled to protection. The plaintiff claims that its mark is distinctive and a unique combination which has been used for the first time by the plaintiff. No other TV channel adopted the said mark till the plaintiff in the year 2004. It is also the claim of the plaintiff that being a 24 hour 365 days channel by its very nature the reputation and goodwill of the plaintiff is unparalleled compared to any other trademark. The plaintiff's contention is that being a TV channel which is viewed and heard by consumers in different parts of the country and on which the logo of the plaintiff is continuously displayed there is no need for the plaintiff to show the amount of investment etc. made in advertising as is necessary in the case of FMCG or like products and services.

96. The plaintiff's channel is stated to be amongst the top three news channels of the country. In this behalf, learned Counsel placed reliance on TAM People meter system ratings for the breaking news band (week 44, 2006) wherein the plaintiff's channel has been rated among the top Hindi news channels in the said segment. Similar ratings of the TAM People meter system carried out in Hindi speaking markets have been placed on record in respect of other programs of the plaintiff's channel. The plaintiff has also placed on record certain other ratings of the TAM People meter system which rates the channel among the top three Hindi news channels in India. The plaintiff has also placed reliance on articles/clippings regarding the launch of the plaintiff's channel.

97. Learned senior counsel for defendant No. 1 drew the attention of the Court to the application for registration of the plaintiff's mark 'INDIA TV' which is dated 22.1.2004 while the channel of the plaintiff was launched only in March 2004. Learned senior counsel, thus, contended that since the registration was sought even prior to the launch of the plaintiff's channel, the plaintiff cannot claim that they achieved distinctiveness at that stage. It was further contended that it is claimed in paragraph 6 of the plaint that the plaintiff started using the mark since 1.12.2002, there is no evidence on record in support of the same. There is also no plea regarding how the mark acquired distinctiveness prior to the date of the application. In the case of *Hi-Tech Pipes* case (supra) referred to by the plaintiff, registration was applied for nine years after the first use of the

98. As noted earlier the plaintiff in the present action is not seeking registration of the mark. Thus, the court is not to determine whether or not the mark is capable of registration and has to only look into the aspect whether the mark has acquired a secondary significance which entitles it to protection in an action for passing off. Any objections as regards registration would have to be raised by the said defendants in the relevant proceedings.

99. The TAM ratings for the years 2006- 2007 on which reliance has been placed by learned Counsel for the plaintiff prima facie does indicate that the channel of the plaintiff is rated among the top Hindi news channels in various time bands. The other articles etc placed on record by the plaintiff are with regard to the proposed launch of the plaintiff's channel "INDIA TV" and show that the same is being promoted by Sh. Rajat Sharma, a well known journalist. It is not disputed that the channel of the plaintiff was launched in March 2004 and has been continuously in operation in then. Prima facie, the material placed on record does indicate the popularity of the plaintiff's channel. However as evidence is still to be led, a conclusive finding in this regard can be reached after trial.

100. Further, in the present case, as the plaintiff is seeking directions with regard to the domain name "Indiatvlive.com" owned by defendant No. 1 which contains the suffix "Live" along with the mark of the plaintiff "India TV", it would have to be determined whether the suffix "live" in the domain name of defendant No. 1 is sufficiently distinguishes the domain name from the mark of the plaintiff.

101. It may be noticed that the impugned website does not carry the logo of the plaintiff or any other mark which would mislead persons browsing to believe that the same is that of the plaintiff. The objection of the plaintiff is only as regards the use of the mark as part of the domain name of the defendant. While the words indiatvlive do appear on the website of the plaintiff, the same merely provides a link to the website of "jumptv.com" which site broadcasts the plaintiff's channel as also other television channels from various countries on subscription. The plaintiff's website provides information about the plaintiff's channel and programs as also news updates etc.

102. As evidence is still to be led, at this stage, extra precautions would have to be taken so as to distinguish the website of defendant No. 1. It cannot be lost sight of that on the Internet the options available for domain names are limited since no two identical domain names can coexist, and thus, the plaintiff cannot really be permitted to claim exclusive rights over the name "indiatv" used in any combination with any prefix or suffix whatsoever. Learned senior counsel for the defendant proposed that this may be done by displaying a disclaimer prominently on the website of defendant No. 1 which would clearly show that the said website has no connection with the plaintiff company or the plaintiff's channel. In support of this contention reliance was placed on the judgment of the Apex Court in West inn Hospitality Services Ltd. v. Ceasar Park Hotels & Resorts Inc 1999 (19) PTC 430 wherein the petitioner was permitted to use the word 'Westinn' as part of its corporate name with the rider that the letterheads, advertisements etc of the petitioner company would contain the words- "NO CONNECTION WHATSOEVER WITH WESTINN HOTELS AND RESORTS". It is thus contended that use of the mark as part of a corporate name can be permitted if it is used with a disclaimer clearly showing that there is no connection with the mark of the complainant.

103. Learned Counsel for the plaintiff on the other hand, in this regard referred to the judgment of the Supreme Court in Registrar of Trademarks v. Chandra Rakhit Ltd. MANU/SC/0052/1955 : [1955]2SCR252 in which it was observed that "if the proprietor has acquired any right by long user of those parts or matters in connection with goods manufactured or sold by him or otherwise in relation to his trade, he may, on proof of the necessary facts, prevent an infringement of his rights by a passing off action or a prosecution under the Indian Penal Code. Disclaimer does not in any way affect those rights.

104. Learned Counsel for the plaintiff contended that initial confusion between the marks of the parties may cause the potential purchaser to preclude the services/goods of the complainant/opposed in making his decision. In this behalf learned Counsel referred to McCarthy on Trademarks and Unfair Competition (3rd Edition Volume 3). The relevant extract is as under:

[b] Initial Interest Confusion

Infringement can be based upon confusion that creates initial customer interest, even though no actual sale is finally completed as a result of the confusion. For example, the likelihood that a potential purchaser of a specialised computer program may be drawn to the junior user, thinking it was the senior user, is actionable "confusion" even if over the course of several months of the purchasing decision-making process, the buyer's confusion is dissipated. Such a senior user who is the opposer may suffer injury "if a potential purchaser is initially confused between the parties' respective marks in that opposer may be precluded from further consideration by the potential purchaser in reaching his or her buying decision.

The analogy to trademark initial interest confusion is a jobseeker who misrepresents educational background on a resume, obtains an interview and at the interview explains that the inflated resume claim is a mistake or a "typo." The misrepresentation has enabled the job-seeking to

obtain a coveted interview, a clear advantage over others with the same background who honestly stated their educational achievements on their resumes. In such a situation, it is not possible to say that the misrepresentation caused no competitive damage.

105. I am inclined to accept the contention of the learned senior counsel for defendant No. 1 that at least at the interim stage, the said defendant may be permitted to operate its website with the disclaimer which clearly shows that the same has no connection with the plaintiff company. Such a disclaimer if appropriately placed on the impugned website would convey to the browsers that the website has no connection with the plaintiff company or services provided by them. Once the person browsing is aware of the fact that there is no connection between the impugned website and the plaintiff company, if he chooses to subscribe to the services being provided by defendant No. 1 he would not be doing so under any misconception or confusion. As the person visiting the impugned website would immediately become aware that the impugned website is not the website of the plaintiff, if he still consciously chooses to subscribe to the services, he cannot really be prevented from doing so.

106. As far as the creation of initial confusion is concerned any such confusion that may initially arise would be dissipated as soon as the browser visits the website as a disclaimer would be clearly displayed therein. It is not that there would be any time gap between accessing the website and discovering that the same is not that of the plaintiff. The impugned website does not carry the logo of the plaintiff or any other misleading information. Thus, defendant No. 1 may be permitted to continue operating the website with a disclaimer.

Descriptive names

107. Insofar as the plea of defendant No. 1 that the mark of the plaintiff 'INDIATV' is descriptive, learned Counsel for the plaintiff submitted that even descriptive words that have acquired distinctiveness and significance to be associated with the business of the company whose mark it is would be entitled to protection. In support of her plea, learned Counsel referred to the judgment of the Supreme Court in *Godfrey Phillips India Ltd. v. Girnar Food and Beverages (P) Ltd* 2005 (30) PTC 1 in which the trademark involved was "SUPER CUP" in respect of tea. It was held that a descriptive trademark may be entitled to protection if it has assumed a secondary meaning which identifies it with a particular product or as being from a particular source.

108. Reliance was also placed on the judgment of a learned single judge (as he then was) of this court in *Info Edge (India) Pvt. Ltd. and Anr. v. Shailesh Gupta and Anr.* 2002 (24) PTC 255 (Del). The case was with regard to the domain name "naukri.com". The defendants had registered a similar domain name "naukari.com". It was observed that it is a well settled legal position that when a defendant does business under a name sufficiently close to the name under which the plaintiff is trading and the name has acquired a reputation, the public at large is likely to be deceived and misled that the defendant's business is the business of the plaintiff or is a branch or department of the plaintiff. It was also observed that it is a well settled law that the distinction between the generic word and descriptive word is very thin and such word could also assume a secondary meaning by its long user by a person who establishes his reputation in the market. The court also noted that even if the word in question is generic, yet, if it is found by the court that such mark has attained distinctiveness and is associated with the business of the plaintiff for a considerable time and thereafter the defendant adopts a similar word as one of his marks to induce innocent Internet users to come to his website, the same establishes dishonest intention and bad faith, the court would grant injunction to protect the business of the plaintiff. The defendant had contended in this case that there were other websites with almost similar names against which the plaintiff had not proceeded for similar reliefs. The court found that there is neither any occasion or immediate necessity for the plaintiff to proceed against those domain names as the same were either non functional or non relatable to the plaintiffs business. It was held that the plaintiff cannot be denied relief and an injunction only because it has not proceeded against other similar names. Further it was noted that if two contesting parties are involved in the same area or similar line of business, there is grave and immense possibility for confusion and deception.

109. Learned Counsel further contended that even if words are descriptive in nature, if they are identified with the business of the plaintiff, protection may be given to combination though individually the words may not be permitted to be monopolized. In *Living Media India Ltd. v. Jitender v. Jain and Anr.* 2002 (25) PTC 61 (Del), the plaintiff was the producer of a news program under the name and style of "AAJ TAK" while the defendants had adopted the name *Khabarein* "AAJ TAK" in respect of newspapers. The mark used by the defendant was found to be the exact reproduction of the mark of the plaintiff. In this case, learned single judge of this court observed that that while the words 'aaj' and 'tak' may be individually descriptive and dictionary words and may not be monopolized by any person but their combination does provide protection as a trademark if it has been in long, prior and continuous user in relation to particular goods manufactured or sold by a particular person and by virtue of such user, the mark gets identified with such person. It is so irrespective of the fact whether such combination is descriptive in nature and even has a dictionary meaning. In such a case, any person can use any of the two words as their trade mark or mark but has to be prohibited from using the words as a combination.

110. Learned senior counsel for defendant No. 1 referred to the provisions of the Section 9 of the said Act to contend that registration of the mark of the plaintiffs can be refused on use of descriptive words which

111. Further, reference was also made to the judgment of learned single judge of the Kerala High Court in *Bhartiya Coffee Workers Catering Service (P) Ltd. v. Indian Coffee Workers Cooperative Society Ltd.* MANU/KE/0490/1999 : AIR1999Ker169 . The plaintiff society was running "Indian Coffee Houses" right from their inception and brought an action against the defendants who also named their establishment 'Indian Coffee House'. The court noted that the only infringement set up by the plaintiff is that the defendant has also used the name Indian Coffee House for its catering establishments and there is no case that the set of words has come to be associated with a particular product manufactured or marketed by the plaintiff. The court further observed that while it may be true that the India Coffee House run by the plaintiff might have earned a name and goodwill due to the services rendered by them in their catering establishments, that itself would not enable the plaintiff to prevent any other owner of the establishment from running the establishment under the said name. The name was a generic name being used by all cooperative societies of ex employees of the Coffee Board who function independently of each other. It was sought to be emphasized by learned senior counsel that despite usage for a number of years, due to the nature of the name, the mark of the plaintiffs in that case could not be protected.

112. In *Online India Capital Co. Pvt. Ltd and Anr. v. Dimension Corporate* (2000) VAD (Del) 860, the plaintiff company was running the website "www.mutualfundsindia.com" while the defendant had created a similar website "www.mutualfundindia.com". The contention was that "mutual fund" is a generic term and no monopoly can be claimed in relation thereto by any person. It was observed that the expression "mutual funds" forming part of the plaintiff's domain name is the description of the services being offered by the plaintiff. The material placed on record failed to show that the said expression had acquired a secondary meaning which is a precondition for grant of protection to a descriptive name. It was thus held that no prima facie case was made out for the grant of interim injunction prayed for by the plaintiff.

113. In this behalf reference was also made to the judgment of a learned single judge of this court in *Manish Vij and Ors v. Indra Chugh and Ors.* AIR 2002 Del 243 which was again a case concerning similar domain names. The plaintiff was the proprietor of a website dealing with second hand goods on the Internet under the domain name "www.kabadibazaar.com". The defendants owned a similar domain name "www.kabaribazaar.com", the only distinction being the use of the letter 'r' instead of letter 'd' in the word 'KABARI/KABADI'. It was observed that a trademark is descriptive if it imparts information directly which may concern some characteristic or ingredient of the product. The term "kabari bazaar" is descriptive and requires no imagination to connect the same with second hand goods. It was further observed that it is true that descriptive words can be used at times as trademarks where they acquire distinctiveness and signify that particular goods are manufactured or services rendered by a particular person, it may be said that the mark has acquired a secondary meaning. This can be demonstrated by proving advertisements, promotions and sales. It was found that there was no such material to show that the website of the plaintiff had acquired such a secondary meaning.

114. In *Digital City, Inc v. Smalldomain* Case No. D2000-1283, the complainant before the WIPO Administrative Panel alleged that the domain name of the respondent being "digitalcitymap.com" was confusingly similar to the 'digital city' mark of the complainant. The argument of the respondent was that the addition of the word "map" rendered the name different from the marks of the plaintiff. It was observed by the panel that consumers are not likely to be confused where (1) a domain name comprises a mark and a suffix; (2) where the mark is essentially generic within the online world and has not acquired such distinctiveness as to merit broader protection and (3) where the suffix or the domain name as a whole does not relate specifically to the business of the complainant. The nature of business of the parties was also taken into account. The complainant was in the business of providing city information and not maps as the respondent. The domain name was held not to be confusingly similar.

115. Learned senior counsel further contented that the word "INDIA" is common to the trade of communication and is used extensively by numerous domain name owners and publications as part of the trade names used and the plaintiff cannot claim a monopoly over the use of the word "INDIA". In this behalf learned senior counsel referred to judgment in *J.R. Kapoor v. Micronix India* MANU/SC/1166/1994 : 1994(3)SCALE732 wherein the mark of the appellant was 'MICROTEL' while that of the respondent was 'MICRONIX'. The court observed that the word 'MICRO' is being descriptive of the micro technologies used for the production of many electronic goods which daily come into the market no one can claim monopoly over the use of the said word. Anyone producing a product with the use of microchip technology would be justified in using the said word as a prefix to its trade name. Similarly, in *Kewal Krishan Kumar v. Kaushal Roller Flour Mills Pvt. Ltd.* PTC (suppl.) (1) 217 (Del.) learned single Judge of this Court (as he then was) observed with regard to the word 'SHAKTI' which formed part of both plaintiff's and defendant's trademark that prima facie it appears that the term 'SHAKTI' is commonly used in business parlance as would appear from the few pages of the telephone directory produced in the present case and the word 'MAHASHAKTI' is descriptive in nature. The words 'SHAKTI BHOG' are also descriptive. The Court referred to the case of *F. Hoffmann La. Roche & Co. Ltd. v. Geoffery Manners & Co.* AIR 1997 SC 2062 where it was held that where two words have a common suffix, the uncommon prefix of the words is a natural mark of distinction.

116. Learned Counsel for the plaintiff drew the attention of this Court to the print outs taken from the website

manupatra of the US Patent & Trademark Office, which show that defendant No. 1 has filed applications for the registration of the marks 'INDIABROADCASTLIVE' and 'INDIATVLIVE' in the United States. The applications have been filed only on 11.5.2007. Learned Counsel thus contended that while on the one hand defendant No. 1 is averring that the mark of the plaintiff is incapable of being registered on the ground of it having a geographical name as also on the ground of it being descriptive of the nature of the plaintiff's business, on the other hand, defendant No. 1 itself has applied for registration thereof. The plaintiff has sought to contend that in such a case it does not lie in the mouth of defendant No. 1 to raise the plea of the mark being descriptive. In support of her contention learned Counsel has relied upon the judgment of the learned single Judge of this Court (as he then was) in Automatic Electric Limited v. R.K. Dhawan and Anr. (1999) (19) PTC 81. The marks involved in this matter were 'DIMMER DOT' and 'DIMMER STAT'. It was found that the defendants had got their mark 'DIMMER DOT' registered in Australia and as the defendant itself sought to claim trade and proprietary rights and monopoly in the mark 'DIMMER DOT' it does not lie in their mouth to say that 'DIMMER' is a generic expression.

117. Learned Counsel for the plaintiff submitted that in the judgment of Office Cleaning Services Limited case (supra) relied upon by defendant No. 1 while it has been recognised that descriptive words are entitled to protection, if they acquire secondary meaning, it has also been held that the distinction between the names 'Office Cleaning Services' and 'Office Cleaning Association' is sufficient to distinguish the two names. It was averred that the said judgment has been diluted to a great extent even in England and in a number of authorities such as Computer Vision v. Computer Vision 1975 RPC 171 and Berkeley Hotel Co. Ltd. v. Berkely International (Mayfair) Limited and Anr. 1971 FSR 300 descriptive names has been protected despite applying the dictum in Office Cleaning Services Limited case (supra).

118. In Berkeley Hotel Co. Ltd. case (supra), the plaintiffs were the owners of a first class hotel by the name of Berkeley Hotel in Berkeley Street, prior to its demolition and were in the process of constructing another hotel by the same name at a new site. The defendants had also started a hotel in Berkeley Street by the name of Berkely International. While it was contended that the name Berkeley being a geographical name the court should accept small differences to avoid confusion, it was held that although the name has a geographical element, the same is primarily distinctive of a particular hotel entity. It was further observed that it is intended to say that the plaintiff company has obtained such a monopoly in the word Berkeley as to prevent its use in any combination of words for a hotel in Berkeley Square or Berkeley Street however, the word Berkeley with this particular suffix (International) is likely to cause confusion.

119. In Computer Vision case (supra) it was observed that even if the words 'Computer Vision' can be regarded as ordinary descriptive words, the question still arises as to whether the defendants trade name has been sufficiently distinguished and differentiated from the plaintiff's mark. Also as regards the contention of the defendants that the plaintiff was 'Computer Vision Corporation' while the defendants were 'Computer Vision Limited', it was observed that the word 'limited' is more often than mark dropped in referring to a company 'colloquially' and the very existence of that difference is likely to lead people to think that the defendant is an English subsidiary of the plaintiff or is in some other way connected with them.

120. Learned Counsel thus contended that the judgments in Online India Capital Co. Pvt. Ltd case (supra) & Manish Vij and Ors case (supra) followed the judgment in Office Cleaning Services Limited case (supra), which has been diluted to a great extent and thus cannot be followed.

121. Learned Counsel sought to distinguish the judgment in Manish Vij and Ors case supra by submitting that in that case the adoption of the domain name by the plaintiff was recent i. e. the suit was filed within about one year of the adoption of the domain name which is not the case in the present matter. It was also submitted that while in the case of "kadbazaar.com" no imagination is required to connect the same with its contents. However, in the present case, the mark is a unique combination of the words "INDIA" and "TV" which can relate to any television channel and does not convey that the same is a news channel or a Hindi news channel.

122. Insofar as descriptive names are concerned, the position as in the case of the geographical names is that a descriptive mark may be granted protection where the same has assumed a secondary meaning which identifies it either with particular goods or services or as being from a particular source. This is the position as held in Godfrey Phillips India Ltd. case (supra) & Info Edge (I) Pvt. Ltd. case (supra). Also as held in the Living Media India Limited case (supra) protection can be given to individually descriptive words when used as a combination where such combination by reason of long, prior and continuous user in relation to the particular goods or services get identified with the goods/services/source.

123. In Online India Capital Co. Pvt. Ltd case (supra) & Manish Vij and Ors case (supra) protection was not granted to domain names comprising generic words, which were descriptive of the services being provided by the concerned parties. It may, however, be noticed that in both these cases it has been observed that there was absence of material or the material placed on record was insufficient to show that the marks had acquired any secondary meaning which is a 'precondition' for granting protection to descriptive names. Bhartiya Coffee Workers Catering Service Pvt. Ltd. case (supra) was again concerned with the descriptive mark but the same was being used by all co-operative societies of former employees of the Coffee Board and thus could not be identified with the particular service provider as such.

124. Learned senior counsel for defendant No. 1 has contended that by the addition of a suffix 'LIVE' the mark

manupatra of the said defendant has been rendered different from the plaintiff as was the case in Digital City Inc. case (supra). Learned Counsel for the plaintiff, however, contended that in the judgments in Computer Vision case (supra) and Berkeley Hotel Co. Ltd. case (supra) protection is granted even where the infringing marks contained different suffixes. However it may be noticed that in Berkeley Hotel Co. case (supra) it was the particular suffix involved in that case that was held to be likely to cause confusion. It was specifically observed that it is not the intention to say that the word BERKELEY could not be used for a hotel in any combination. Similarly in Computer Vision case (supra) it was found that the suffix 'Limited' is most likely to be dropped in referring to the company colloquially and the existence of that particular difference was likely to cause confusion.

125. The judgment of learned single Judge in Automatic Electric Limited case (supra) is to the effect that where the defendants themselves have got the mark registered and claimed proprietary rights therein they cannot claim that the mark consists of a generic expression. Thus, as applications have been filed on behalf of defendant No. 1 for the registration of the marks "INDIABROADCASTLIVE" and "INDIATVLIVE", defendant No. 1 cannot really claim that the marks are incapable of registration.

126. Be that as it may, the mark of the plaintiff "INDIA TV" is comprised of ordinary descriptive words. The plaintiff is claiming rights over the words in that particular combination. The mark "INDIA TV", does not as contended by learned Counsel for the plaintiff, by itself indicate that the same is a Hindi news channel. The mark would prima facie show a connection with Indian television which is the general nature of the business being carried out by the plaintiff but would not immediately lead any person to connect the same with the specific business i. e. a Hindi news channel.

127. As noted hereinabove, the ratings etc placed on record in respect of the plaintiff's channel prima facie do show that the same is among the popular Hindi news channels. However, evidence is still to be led in this behalf. It has also to be seen whether the suffix, 'live' can sufficiently distinguish the website of the defendant from the plaintiff's mark.

128. As observed earlier, at the interim stage, it would suffice to display prominently on the website of defendant No. 1, a disclaimer which shows that the same has no connection with the plaintiff's channel.

Agreement with Jump TV:

129. Defendant No. 1 in its reply has taken the stand that the present suit is at the behest of 'Jump TV' with whom the plaintiff entered into an agreement and which is a competitor of defendant No. 1 in the IPTV (Internet Protocol Television) segment.

130. Learned Counsel for the plaintiff in this regard submitted that the contention of defendant No. 1 is baseless as the Agreement entered into between the plaintiff and JUMP TV is dated 8th August 2006 and was thus entered into prior to the launch of the website of defendant No. 2. Thus, it cannot be contended that the suit has been initiated merely because of the agreement with the competitor.

131. The portions of the agreement with "JUMP TV" filed by learned Counsel for the plaintiff shows that the agreement with "JUMP TV" was entered into on 08.08.2006. There is no dispute that the website of defendant No. 1 was launched on 17th August 2006. Thus, the agreement entered into with JUMP TV was prior to the launch of the website of defendant No. 1. However the website was inaugurated in Anaheim, California on 29.06.2006 as per the articles placed on record by defendant No. 1.

132. No evidence has really been placed on record at this stage which indicates that the plaintiff was aware of the launch of the impugned website of defendant No. 1. prior to January 2007. The material placed on record at this stage is insufficient to establish whether the present suit is a consequence of the Agreement entered into with JUMP TV. This aspect would thus be decided after trial.

Delay

133. Learned senior counsel for defendant No. 1 submitted that the plaintiff is guilty of undue and unexplained delay in approaching this court for relief. The website of defendant No. 1 was launched in June 2006 while the present suit was instituted only in January 2007 and there is no Explanation for not approaching the court sooner.

134. Reference was made to the judgment of a division bench of this court in B.L. and Co. and Ors. v. Pfizer Products Incl. 2001 PTC 797 (Del) wherein it was observed that in a passing off action, while delay in filing of the suit may not be fatal, it is one of the important and relevant considerations before granting an ex parte or interlocutory injunction. It was found that the respondents knew about the launch of the products of the appellant but waited till the appellant developed for one year before the action was brought. In fact even after commencement of manufacture, the action was not brought for nearly five months. It was observed that the factor of delay alone should have been sufficient to deny the respondents an ex parte restraint.

135. In The Gillette Co. and Ors. v. A.K. Stationery and Ors. 2001 PTC 513 (Del) learned single judge of this court, as regards the aspect of delay observed as under:

As regards the delay in institution of the suit and its effect for the purpose of grant of ex parte restraint, the settled legal position is that while the delay in institution of a suit for an action for passing off may not be fatal, it is one of the important and relevant considerations before granting an ex parte/interlocutory injunction. Reference in this regard is invited to the 'THE LAW OF PASSING OFF' by Christopher Wadlow. Learned Author while dealing with the motions of interlocutory relevance has observed as under:

Delay in applying for interlocutory relief is a very serious matter. As a rule of thumb, delay of up to about a month, or perhaps six weeks, generally has no adverse effect on an inter parties application and delay of up to twice that period need not be fatal if it can be explained and the plaintiff's case is otherwise strong. On an ex parte application even delay of a few days can be critical. Unjustified delay of more than a few months is almost always fatal to the plaintiff's case, even though delay of this order has no effect on the plaintiff's rights at trial. Unlike many of the issues which can arise on motion, the existence of delay does not normally admit of much argument. Delay, if present, is therefore a short, safe and simple basis for refusing relief. This means that applications for interlocutory injunctions in which there is significant delay are unlikely even to get as far as a hearing, and those that do are quite likely to be refused without going into the merits or the balance of convenience.

136. Learned Counsel for the plaintiff submitted in this behalf that there is only one article on record from the print media being a news clipping from the Financial Express dated 21.08.2006 which mentions that the website of defendant No. 1 will be launched. The other articles regarding the launch of defendant No. 1's website are from various sources on the Internet. It is thus contended that the plaintiff could not have been expected to know of the launch of defendant No. 1's website around August 2006 when it was launched.

137. Learned Counsel referred to the judgment of the Apex Court in *Midas Hygiene Industries P. Ltd. and Anr. v. Sudhir Bhatia and Ors.* MANU/SC/0186/2004 : 2004(28)PTC121(SC) in support of the proposition that in cases of infringement either of trademark or of copyright normally an injunction must follow. Mere delay in bringing action is not sufficient to defeat grant of injunction in such cases. The grant of injunction also becomes necessary if it prima facie appears that the adoption of the mark was dishonest. Learned Counsel also placed reliance on the judgment in *Hindustan Pencil Private Limited v. India Stationery Product Co.* 1989 (9) PTC 61 (Del) wherein it was observed that delay by itself is not a sufficient defense to an action for interim injunction, but delay coupled with prejudice caused to the defendant would amount to 'laches'. It is the magnitude of the product of delay and prejudice which must be weighed, not the magnitude of solely the quantum of delay or prejudice alone. For example, in one case, a long delay coupled with even a slight amount of prejudice may suffice to prove an adequate defense of laches. Yet, in another case, a short delay coupled with a great amount of resulting prejudice to defendant may also suffice for laches. Judicial opinion has been consistent in holding that if the defendant acts fraudulently with the knowledge that he is violating the plaintiff's rights then in that case, even if there is an inordinate delay on the part of the plaintiff in taking action against the defendant, the relief of injunction is not denied.

138. It was thus submitted that merely delay in bringing an action is not sufficient for the refusal of an injunction and even if there was a delay by the plaintiff in initiating the action, the same is not of more than three-four months which cannot be said to be excessive.

139. Insofar as the aforesaid aspect is concerned, there is no dispute in the proposition that delay is an important factor to be taken into account while considering an application for the grant of an interim injunction as noticed in the judgments in *B.L. and Company and The Gillette Co.* cases (supra). It however may be noticed that in the case of *B.L. and co.* (supra), the fact of the launch of the defendant's product was within the knowledge of the respondent/plaintiff for about a year before the action was brought.

140. In the present matter the plea of the plaintiff is that they came to know of the defendant's website only in January 2007. The press clippings, articles etc placed on record by defendant No. 1 regarding the launch of their website as pointed out by learned Counsel for the plaintiff are mostly from different websites and the only article from the print media is a small clipping. I am in agreement with the contention of learned Counsel for the plaintiff that the plaintiff could not have been expected to know about the launch of defendant No. 1's website from these materials alone.

141. There is no other material on record at this stage to show that the plaintiff was aware of the launch of the website of defendant No. 1 prior to January 2007 when it is claimed that the plaintiff came to know of the website of defendant No. 1 and when the present suit has been filed. Thus, it cannot prima facie be said that there was excessive delay on the part of the plaintiff in bringing the present action for passing off.

Conclusion

142. The result is that 2611/2007 stands allowed and defendant No. 1 is restrained from proceeding with

143. Insofar as is Nos. 651/2007 and 1366/2007 are concerned, the order dated 19.01.2007 is modified and defendants are permitted to use the domain name "INDIATVLIVE.COM" with the disclaimer "This website has no connection, affiliation or association whatsoever with India TV, the Indian Hindi news and Current Affairs television channel" which should appear prominently next to its logo "Indiatvlive".

144. Defendant No. 1 is also directed to file six monthly statement of revenue earned from the impugned website in India.

145. is Nos. 651/2007 and 1366/2006 thus stand disposed of.

146. Needless to say, the observations herein are prima facie in nature and will not affect the final disposal of the suit.

CCPO 22/2007

147. The plaintiffs stand in this regard is basically that even after the grant of the ex parte ad interim injunction, the website of defendant No. 1 could still be opened on typing the impugned domain name in the address bar although what would be displayed in the address bar was the IP address of the website and not the impugned domain name.

148. The position was thereafter rectified and on typing the impugned domain name, the person browsing is redirected to "indiabroadcastlive.com" which is the another domain name of defendant No. 1.

149. In its reply to the petition, the respondents have tendered an unconditional apology for any breach or non compliance of the orders.

150. The respondents have also explained that as the interim order on 19.01.2007 restrained them from using the domain name "INDIATV" or any other domain name with the combination of the words "INDIATV" they removed the domain name from their website and replaced the same with the IP address of the said website and also displayed a disclaimer that the website had no connection with the plaintiff's channel "India TV". The respondents have also submitted that the interim order on 19.01.2007 was granted till the next date of hearing which was 07.02.2007 and the same was not directed to be continued till 15.02.2007.

151. The respondents have further pointed out that thereafter they discontinued use of the impugned domain name and shifted the website to another domain name being "indiabroadcastlive.com". When the impugned domain name is typed in the address bar, a redirection notice appears which states that the website is not operational due to interim orders passed and persons visiting the said website are automatically redirected to "indiabroadcastlive.com". Thus, the respondents have rectified the position.

152. In view of the aforesaid, I do not deem it appropriate to proceed further with the petition and the petition stands disposed of.