

2011 SCC OnLine Del 2660 : (2011) 181 DLT 716 : (2011) 47
PTC 1

In the High Court of Delhi

(Before Manmohan Singh, J.)

Mr. Arun Jaitley Plaintiff

Ms Pratibha M. Singh, Adv. with Mr. Sudeep Chatterjee and Mr. Sudeep
Bhandari, Advs.

Versus

Network Solutions Private Limited & Ors. Defendants

Mr C.M. Lall, Adv. with Ms. Ekta Sarin and Ms. Nancy Roy, Adv. for
defendant Nos. 1-2.

CS (OS) 1745/2009 & I.A. No. 11943/2009 & 17485/2010

Decided on July 4, 2011

MANMOHAN SINGH, J.: — The plaintiff Mr. Arun Jaitley has filed the
present suit for permanent injunction restraining the defendants from
misuse and immediate transfer of domain name WWW. ARUNJAITLEY.
COM.

2. The name of defendant No. 1 Network Solutions Private Limited was
deleted vide order dated 15.04.2009. Amended memo of parties is
already filed on record and defendant Nos. 2 to 4 have been numbered
as defendant Nos. 1, 2 and 3 respectively. Mr C.M. Lall is appearing on
behalf of defendant Nos. 1 and 2 as per amended memo of parties.
The defendant No. 3 namely Portfolio Brains LLC was proceeded ex-
parte vide order dated 06.01.2010.

3. When the suit along with interim application was listed, the court

passed the interim order in favour of the plaintiff. The operative portion of the interim order passed is as under:

"It is directed that till the next date of hearing the Defendant No. 3, Portfolio Brains LLC or its principal officers, servants, agents or anyone who may be acting for and for and on its behalf, shall not in any manner advertise the domain name [arunjaitley.com](https://www.arunjaitley.com), use the said domain name for auction purposes or for any other purpose. Defendant No. 3 is restrained from transferring, alienating or offering for sale the said domain name "[arunjaitley.com](https://www.arunjaitley.com)" to any third party and from creating any third party interest in the said domain name 'arunjaitley.com'. Defendant No. 3 is directed to maintain status quo in relation to the said domain name. This is subject to the Plaintiff complying with the requirements of Order XXXIX Rule 3 CPC within one week."

4. The matter was listed before the court on 25.04.2011 for consideration of I.A. No. 11943/2009 (Order 39 Rule 1&2 read with Section 151 CPC) and I.A. No. 17485/2010 (Order 1 Rule 1 CPC). Both the parties have given their consent if the main suit along with these applications be also decided.

5. Before considering these pending applications, I feel it is necessary to refer the facts which reads as under:

(i) The plaintiff is a prominent leader of the Bhartiya Janata Party which is currently the largest opposition party in India and is the leader of Opposition in the Rajya Sabha. The plaintiff has been a Member of Parliament for the last ten years. He was a prominent leader of a movement against corruption launched in the year 1973 by Late Shri Jai Prakash Narayan. He was the Convenor of the National Committee for Students and Youth Organization appointed by Late Shri Jai Prakash Narayan.

(ii) The plaintiff was a delegate on behalf of the Government of

India to the United Nations General Assembly session in June, 1998 where the Declaration on laws relating to Drugs and Money Laundering was approved. The plaintiff was appointed as the Minister of State for Information and Broadcasting (Independent Charge) in 1999. In the year 2000, the plaintiff was also appointed as the Minister of State for Disinvestment to give effect to the policy of disinvestments under the World Trade Organization (WTO) regime and was also given the additional charge of the Ministry of Law, Justice and Company Affairs and was elevated to rank of a Cabinet Minister on 7th November, 2000 with the Law, Justice & Company Affairs under his charge and also given the charge of the Ministry of Shipping.

(iii) Thereafter the plaintiff demitted the office to join the Bhartiya Janta Party as its Secretary General and also as its national spokesman in the year 2001. In the year 2003, the plaintiff again became the Union Cabinet Minister as the Minister of Commerce & Industry and Law & Justice before rejoining the Bhartiya Janata Party as its General Secretary.

(iv) The name "ARUN JAITLEY" being the personal name of the plaintiff, immediately gets associated with the plaintiff and no one else. The plaintiff's name carries enormous goodwill and reputation and is exclusively associated with the plaintiff. the plaintiff is a household name not only in India but also globally for the last more than 35 years. In the public perception, whenever the name of Mr. Arun Jaitley is mentioned, it is immediately identified and related with him and no one else.

6. The plaintiff wanted to book the domain www.arunjaitley.com. Since it was not becoming possible to register through the website of the defendants, a letter dated 16.07.2009 was addressed to the defendant No. 2 namely Network Solutions, LLC (previously defendant No. 3) through email by the counsel for the plaintiff. That on 17th July, 2009 a

reply was received that the said domain was already taken. It was also asked the plaintiff to make an offer for purchasing the said domain through its Certified Offer Service. When the plaintiff visited the website of the defendant No. 3 he found that the said domain was "Pending Deletion" as it had not been renewed by the previous owner.

7. The counsel for plaintiff again wrote an email dated 23rd July, 2009 to the defendants wherein, the plaintiff requested the defendants to transfer the said domain in the plaintiff's name as the said domain was pending deletion and had not been renewed by any person.

8. The defendant No. 2 vide an email dated 25th July, 2009 reverted back by stating that the matter was escalated to the Executive Department for review and that someone would be contacting them. Later on an email dated 27th July 2009 was received by the counsel for the plaintiff from Mr. Jeffrey Visgaitis, Executive Support of the defendant No. 2, wherein the plaintiff was asked to either wait for the domain to be deleted for non-payment or make a certified offer for purchasing the domain.

9. The domain www.arunjaitley.com according to the WHOIS report had expired on 12th June, 2009. Further according to the Domain Deletion Policy of the defendants, the domain ought to have been deleted after the expiration of 35 days as per the Policy. It is argued that even after the expiration of the said 35 days, the domain continued to be under the Pending Deletion status and the same was not transferred as referred by the plaintiff. The domain name www.arunjaitley.com being a Global Top Level Domain name, the defendants are bound by the Uniform Dispute Resolution Policy (UDRP). The validity and binding nature of UDRP has been discussed and affirmed by the Hon'ble Supreme Court in *Satyam Infoway Ltd. v. Sifynet Solutions Pvt. Ltd.*, (2004) 6 SCC 145. Further the defendants are also bound by the Domain Deletion Policy of ICANN wherein any expired domain is bound to be deleted within 45 days. Domain

Deletion Policy of ICANN is also filed by the plaintiff and the same is available at page 23 of the documents.

10. The contention of the plaintiff is that the defendants with mala fide intentions did not delete the said domain and not transferred the same to the plaintiff as they had asked the plaintiff to purchase the domain through their Certified Offer Service. The Certified Offer Service of the defendants is nothing but an auction service wherein the person who bids the maximum amount would be entitled for the domain name. The cost for booking a domain for one year is \$35. However, the minimum bid amount for Certified Offer Service is over \$100. Further there is no guarantee that the domain name would be transferred to the bidder. Further the price assessment to procure the domain name www.arunjaitley.com according to the website of the defendants is ranging from \$11,725 to \$14,475. Certified offer for the domain www.arunjaitley.com of the defendant No. 1 and 2 is available on record. Thus according to the counsel it is clear that the intention of the defendants was to have a monetary gain by collecting sums of money for the domain name.

11. It is informed by the counsel that the defendant No. 2 thereafter transferred the said domain to the defendant No. 3 which is an auction site for domain names. The defendant No. 3 company acquires domains and auctions them to the general public. Thus it is obvious that the defendants are colluding with each other in order to make money on the domain name and not permitting the bona fide use of the same by the plaintiff as the defendant Nos. 1 and 2, in spite of having knowledge transferred the domain name to the defendant No. 3 for its commercial gains which is a mere auction site. It is further submitted that even on 27th August, 2009, the domain was shown as "PENDING DELETE" But it was thereafter transferred on the same day i.e. 27th August, 2009 to the defendant No. 3 after 85 days. By an interim order passed on 15.09.2009, the court restrained defendant No. 3 from transferring, alienating or offering for sale the said domain

name www.arunjaitley.com to any third party and from creating any third party interest in the said domain name www.arunjaitley.com. The defendant No. 3 was also directed to maintain status quo in relation to the domain name.

12. It is alleged that the Registrars of the domain names including Network Solutions, Veri Sign, Portfolia Brains LLC, etc. are all operating under the ICANN and all these Registrars are in collusion with each other and it is being done deliberately in order to defeat rights of bona fide holders in a domain name.

13. Further the transfer was done without the notice or knowledge of the plaintiff who was expecting a positive reply in view of the letter dated 27th July, 2009 and thus the transfer is made to Portfolio Brains LLC the defendant No. 3 contrary to their own rules and in order to violate the orders of the court and keep the rightful person in dark, though all these Registrars are bound under the UDRP Policy. Violation of the UDRP Policy in fact is to be construed very strictly by the ICANN.

14. The right to file the written statement on behalf of the defendant Nos. 1 and 2 was closed vide order dated 23.04.2010. No written statement was filed by defendant No. 3. Mr. Lall appearing on behalf of defendant Nos. 1 and 2, on instructions, made the statement before the court on 23.04.2010 that he would have no difficulty if the domain name is transferred in the name of plaintiff. Mr. Lall made another statement on 15.12.2010 that the defendant Nos. 1 and 2 are no longer the Registrar of the said domain name and the defendant Nos. 1 and 2 have not allowed the auction or transfer of the said domain name. In view of statement made by Mr. Lall, time was granted to the plaintiff to implead the new Registrar and to initiate proceedings against them. It appears from record that no such application was filed by the plaintiff to implead the new Registrar and to initiate proceedings against them except the oral submissions made by the learned counsel for the plaintiff.

15. Later on, the defendant Nos. 1 and 2 filed the application under Order 1 Rule 10 read with Section 151 CPC being I.A. No. 17485/2010 for deletion of the name of defendant Nos. 1 and 2 from the array of parties. The said application along with the interim application was filed by the plaintiff before the court. Both the applications were heard. Learned counsel appearing on behalf of the parties have raised no objection if the suit itself is decided. This court has allowed the consent given by them to determine the entire matter even otherwise since none of the parties has filed the written statement, this court can pronounce the judgment by involving the provision of order 8 Rule 10 CPC.

16. In the application the defendant Nos. 1 and 2 have tried to explain their stand. The explanation given by them is that the defendant Nos. 1 and 2 have been wrongly added in the array of parties as proforma parties by the plaintiff when the said defendants are not the Registrar of the domain name in question. They are neither the Registrar nor the Registrants of the domain name in question and therefore cannot assist the court in effectively adjudicating the present dispute. In the application the details of general practice is also given.

17. The plaintiff opposed this application and filed the reply. The main reply to the application is that the Registrars of the domain names including Network Solutions, Veri Sign, Portfolio Brains LLC, etc. are all operating under the ICANN. When the plaintiff had already put Network Solutions LLC on notice in this matter, they ought not to have transferred the domain name. This transfer was not within the knowledge of the plaintiff. The transfer made to Portfolio Brains LLC was contrary to their own rules. Despite there being an order of injunction as on date by this court, repeated transfers continue to take place. This is clear that these Registrars keep floating new companies under new names, operating from the same address. The Registrar and Registrant of the domain www.arunjaitley.com is the same entity. It is submitted that the defendant No. 3 i.e. M/s Oversee Domain

Management, LLC which is controlled by M/s Oversee.net. The Registrar of the domain www.arunjaitley.com is DOMAINPARKBLOCK which is also controlled by M/s Oversee.net. Internet printouts from Network-tools.com showing that www.arunjaitley.com, DOMAINPARKBLOCK & M/s Oversee Domain Management, LLC are controlled by M/s Oversee.net. The fact that the Domain name is being squatted upon with mala fide intent is further evident of an intention to monetarily earn from the same.

18. Ms Pratibha M. Singh argued that instead of deletion of Network Solutions, LLC from the array of defendants, the Court should direct ICANN, which is the supervisory authority, to take appropriate action against Network Solutions LLC for acting contrary to their own Policy and ICANN Policy and also action to be taken against Portfolio Brains LLC for transferring the Domain name during the pendency of suit and despite the order of injunction having been informed to them.

19. On merit, learned counsel Ms. Pratibha M Singh appearing on behalf of the plaintiff has made her submissions which can be enumerated as under:

a) Ms. Singh firstly submitted that the name Arun Jaitley is the rare combination of two words and the same is protectable under the provisions of the trade mark Act. Furthermore, she submitted that the fame and the achievements of Mr. Jaitley adds value to such personal name which does merely remain a personal name but becomes a source indicator which identifies the persona of the eminent politician, advocate, leader who is world renown. She submitted that the right to use the name Arun Jaitley vests with the plaintiff and does not accrue to anyone else.

b) Secondly, Ms. Singh submitted by placing reliance on the domain name policy particularly Rule 4(a) and 4(b) and submits that the domain name Arunjaitley.com has been registered in the bad faith and sufficiently qualifies the tests of determining the

domain name to be called as registered in bad faith. She submitted that there is no just reason behind the English entity to retain the domain involving the personal name and after putting to notice, the defendants more specifically defendant no. 3 is not even transferring the domain name which makes it completely in bad faith as per the requirement of Rule 4(a) (iii).

Further, the defendant is intending to trade with the domain name arunjaitley.com by putting the same on website and asking Mr. Jaitley to pay huge sum of the money which itself means that there is unfair attempt on the part of the defendant to indulge into cyber squatting against which the domain name policy is made. She submitted that the present case is squarely a case involving cyber squatting.

- c) Thirdly, Ms. Singh argued that the conduct of the defendants is malafide as the defendant no. 1 and 2 went on to alienate or part with the domain name immediately upon putting to the notice on 16th July 2009 by the plaintiff. Learned counsel for the plaintiff contended that the defendant no. 1 and 2 ought to have cooperated with that of the plaintiffs in order to enable the plaintiff to retrieve the domain rather than to keep the deletion of the domain name in abeyance and ultimately parting with them to third party which is defendant no. 3.

Likewise, the learned counsel for the plaintiff vehemently contended that the conduct of the defendant No. 3 is equally bad and dishonest one. This is due to the reason that the defendant no. 3 has also parted with the domain after this court passed an injunction order dated 15.04.2009. The said domain name is now assigned to another entity namely M/s Oversee Domain Management LLC and also the registrar is also changed which is some Domainparkblock. The said new assignee as well as the defendant no. 3 operates from the same address. Further, the new registrar as well as the assignee is controlled by the entity

namely Oversee.net. As per the counsel for the plaintiff, all this leads to only one conclusion which is that the said acts are done consciously only to earn monetary gains so that the domain name may be sold at the high price rather than to return to the legitimate owner. Thus, the defendants may be dealt with appropriately so that they may not further frustrate the claims of the plaintiffs.

d) Learned counsel for the plaintiff further submitted that the domain name protection is amply given by the courts as that of the trade mark. Even if the word domain name is not mentioned in the definition of the mark under the trade marks, the judicial opinion is well settled that the domain names are to be given the protection under the law of passing off under the common law remedy. Learned counsel for the plaintiff relied upon the dicta of *Satyam Infoway Ltd. v. Sifynet Solutions Pvt. Ltd.*, (2004) 6 SCC 145 in support of her contention. Further the learned counsel relied upon certain decisions of ICANN Panel to contend that the personal names are given protection under the regime of the domain name.

20. Learned counsel finally submitted that the defendant no. 3 has not filed the written statement and is also not appearing before this court despite service but is assigning the domain name even after the orders of the court. The defendant no. 1 and 2 are seeking wash their hands off by way of putting the stand that the domain registrar is different and they are not the incharge of the domain name and infact they were aware and put to notice by the plaintiff counsel by way of notice dated 16th july 2009. Thus, the court may disallow the application seeking striking of the names of the defendant no. 1 and 2 from the array of the parties as the said defendants were involved in the part of the transaction of transfer of domain name one way or the other. Therefore the suit may be decreed in terms of the prayers with the direction to ICANN to immediately transfer the domain name to the

plaintiff.

21. Per contra, Mr. Chander Lall, learned counsel for the defendant no. 1 and defendant no. 2 has resisted the claims of the plaintiff qua defendant no. 1 and 2 by making his submissions which are as under:

- a) Firstly, Mr. Lall contended that the defendant no. 1 and 2 were not the registrar of the said domain name and the domain name in question was supposed to expire on 12th June 2009 and thereafter there is a procedure which is prescribed for the deletion of the domain name after the expiry. The said procedure has been explained by Mr. Lall involving following steps:
- On 21st June 2009, the defendant no. 1 sent the delete command to Verisign for deletion which was the 39th day after expiry of the term of the domain name.
 - However, as a general trade practice, Verisign continues to keep the domain name associated with the most recent registrar on record until it deletes the name from its records. In the present case, Verisign did not delete the domain name until August 27th 2009 when it was apparently registered by the current registrant.
 - The name of the defendants in the whois data kept appearing since they remained the registrar on record at the registry despite communicating the deletion to the registry.
 - Further, it was informed that there is a procedure for deleted domain name when it is deleted by the registrar which goes into redemption grace period for 30 days.
 - After the redemption grace period, the verisign again waits for 5 more calendar days which means that the domain goes for pending delete mode.
 - In the present case, the database continued to display the name

of the defendant despite the fact that the defendant had sent the delete command.

Thus, Mr. Lall submitted that thereafter the control of the domain name after the deletion command by the defendant vests with Verisign which has not deleted the same timely and the domain was available to another registrant for consideration. Due to all these reasons, the defendant no. 1 and 2 even though intending to cooperate with the plaintiff were left helpless so far as the retrieval of the domain to the plaintiff is concerned.

Consequently, the defendant no. 1 and 2 were right in advising the plaintiff to pursue his remedies with the appropriate forum.

- b) Secondly Mr. Lall submitted that there is no malafides which can be attributed to the defendant no. 1 and 2 as the said defendants as and when they were informed about the plaintiffs rights wrote to the plaintiff that they will cooperate with him. Further, the said defendants have infact informed the plaintiff the information available with them and thereafter asked the plaintiff to go for their remedies. The defendant is one of the leading companies in getting the domain name registered is not anyway connected with any interest of the person in the said domain name. The defendants being not even necessary or proper parties ought to be deleted from the array of the parties.
- c) Mr. Lall further argued that the defendant no. 1 and 2 has no relation whatsoever with defendant no. 3 who is in ownership of the domain name. Neither the defendant no. 1 and 2 are currently the registrar in the said domain name arunjaitley.com nor there is anything on record to establish any nexus of the defendant no. 1 and 2 with that of defendant no 3. Hence, the defendant no. 1 and 2 may be dropped from the case and the court may deal with the defendant as the court may deem fit.
- d) Had the defendants not issued the delete command, they would

have been required to pay the renewal charge for the impugned domain, which is not the case at present since the delete command was issued within the stipulated time. The defendants were never charged for the additional registration renewal fee since they deleted the name. The domain name was, therefore, available to the public and the new registrant was able to register it on August 27, 2009.

e) Therefore, when the plaintiff wrote to the defendants, since he is not the registrant of the domain name, the said defendants could not help him except for fairly advising to file a civil action against the registrant of the domain name at that time, or file a UDRP complaint. The impugned domain name, therefore, was not with the defendants to transfer it to the plaintiff when the plaintiff wrote to them in 16th September, 2009. As per Mr. Lall, only the current Registrar can transfer the impugned domain to the plaintiff and without direction to the Registrar, this court cannot effectively adjudicate the present controversy between the parties.

22. Under these circumstances, Mr. Lall says that the court should therefore allow his application under order 1 rule 10 CPC by striking of the names of the defendant no. 1 and 2 from the array of the parties.

23. At this stage, let me now discuss the law relating to protection of domain names which is worth noting. The domain name is usually an address given to the website so that the person intending to visit the same may visit the website of the identified person.

a) This function of giving names to the addresses of the website has undergone magnificent change whereby the companies, firms, eminent individuals have been able to name the web addresses after their own names and/or trade mark. This performs dual functions, firstly, the domain name does not merely remain as an address but rather performs the function of a trade mark as the

prospective customers or other known persons visit the webpage and are able to immediately connect with the source and identify the same with the particular company or the individual.

- b) Secondly, so far as individual persons or eminent personalities/popular companies are concerned, their identity is established in the virtual world of internet. In other words, the popularity or the fame of any individual or the company will be no different on the computer (or internet) than the reality.
- c) Therefore, it becomes incumbent to protect the domain names so that the identified names of companies and individuals which are distinct at the market place may not go at the hands of individuals who are nowhere concerned with those names and have obtained them just because they are better conversant with the computer techniques and usage of the internet. To simplify, in order to prevent the cyber squatting or trafficking or trading in domain names or the marks, the trade mark law has been stretched to the extent that it may cover the field of internet and domain names may be protected just like the trade marks.

24. The trade mark law protects names from its inception. Rather, the specific provision which trade mark Act 1999 has in relation to trade name was not earlier present in the Trade & Merchandise Marks Act 1958. Even in earlier trade mark act of 1958, the names were given ample protection on the principles of passing off. It would be appropriate at this stage to reiterate the basic principle of passing off law under which the names were protected which has been articulated by Narayanan in his book:

“25. 104 Law of passing off applicable to trade names - Apart from a trade mark in the strict sense of term, a trader may use a name to indicate his business or goods. The definition of a mark includes a name. A trade name can therefore serve the purpose of a trade mark. Where the business is such that no sale of any goods is

involved, it is carried on invariably under a trading name or style. Individuals, firms or companies rendering certain professional services comes under this category. The law is that no man is entitled to carry on his business in such a way as to represent that if it is business of another or is in any way connected with the business of another. The general principles of the law applicable to cases where a person uses a name or intends to use a name which is like to deceive and thereby divert the business of the plaintiff to the defendant or cause confusion between two businesses are analogous to the principles which are applicable to ordinary cases of passing off relating to sale of goods.” (Emphasis supplied)

25. Likewise, the definition of trade mark includes the name being an inclusive definition was also extended to include domain names. This was done so as to give ample protection to domain names as the domain names was not included as a specific subject under the trade mark law regime. Therefore, the recourse was taken by expansive interpretation of the definition of the trade mark which is sought to include domain names so that the law of passing off may sufficiently subsume the same.

26. The interplay between the trade mark act as well as the domain names on the basis of the trade mark includes name and in turn the domain name was for first witnessed by this court in the case of *Yahoo Inc v. Akash Arora*, 1999 PTC (19) 201 wherein this court accorded protection of domain names after going through the objects of the trade mark law as well as the definition of the trade mark.

27. Further, the same proposition was laid down by the Bombay High Court in *Rediff Communication Ltd. v. Cyberbooth*, AIR 2000 Bom 27 wherein the court has held that the domain names are worthy of the protection under the passing off regime.

28. Finally, the Hon'ble Supreme Court in the case of *Satyam Infoway*

Ltd. v. Sifynet Solutions Pvt. Ltd., (2004) 6 SCC 145 has extensively discussed the law on the subject and also discussed the place of the domain names under the law of passing off. Some of the paragraphs of Apex court's decision are worth noting which can be reproduced herein after:

"7. A "trade mark" has been defined in section 2 (zb) of the Trade Marks Act, 1999 (hereafter referred to as 'the Act') as meaning:

"trade mark' means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours".

8. Therefore a distinctive mark in respect of goods or services is a 'Trade mark'.

9. A "mark" has been defined in Section 2(m) as including "a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof" and a 'name' includes any abbreviation of a name (s. 2k).

10. "Goods" have been defined in Section 2(j) as meaning "anything" which is the subject of trade or manufacture, and "Services" has been defined in section 2 (z) as meaning:

"service of any description which is made available to potential users and includes the provision of services in connection with business of any industrial or commercial matters such as banking, communication, education, financing, insurance, chit funds, real estate, transport, storage, material treatment, processing, supply of electrical or other energy, boarding, lodging, entertainment, amusement, construction, repair, conveying of news or information and advertising."

11. Analysing and cumulatively paraphrasing the relevant parts of

the aforesaid definitions, the question which is apposite is whether a domain name can be said to be a word or name which is capable of distinguishing the subject of trade or service made available to potential users of the internet?

12. 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 (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 trademarks containing the same name can comfortably co-exist 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 an affirmative.

13. The next question is would the principles of trade mark law and in particular those relating to passing off apply? An action for passing off, as the phrase "passing off" itself suggests, is to restrain the defendant from passing off its goods or services to the public as that of the plaintiff's. It is an action not only to preserve the reputation of the plaintiff but also to safeguard the public. The defendant must have sold its goods or offered its services in a manner which has deceived or would be likely to deceive the public into thinking that the defendant's goods or services are the plaintiff's. The action is normally available to the owner of a distinctive trademark and the person who, if the word or name is an invented one, invents and uses it. If two trade rivals claim to have individually invented the same mark, then the trader who is able to establish prior user will succeed. The question is, as has been aptly put, who gets these first? It is not essential for the plaintiff to prove long user to establish reputation in a passing off action. It would depend upon the volume of sales and extent of advertisement.

14. The second element that must be established by a plaintiff in a passing off action is misrepresentation by the defendant to the public. The word misrepresentation does not mean that the plaintiff has to prove any malafide intention on the part of the defendant. Of course, if the misrepresentation is intentional, it might lead to an inference that the reputation of the plaintiff is such that it is worth the defendant's while to cash in on it. An innocent misrepresentation would be relevant only on the question of the ultimate relief which would be granted to plaintiff. *CADBURY SCEHWEPPES v. PUB SQUASH*, 1981 rpc 429, *ERVEN WARNINK v. TOWNEND*, 1980 RPC 31 What has to be established is the likelihood of confusion in the minds of the public, (the word "public"

being understood to mean actual or potential customers or users) that the goods or services offered by the defendant are the goods or the services of the plaintiff. In assessing the likelihood of such confusion the courts must allow for the "imperfect recollection of a person of ordinary memory" *ARISTOC v. RYSTA*, 1945 AC 68

15. The third element of a passing off action is loss or the likelihood of it.

16. The use of the same or similar domain name may lead to a diversion of users which could result from such users mistakenly accessing one domain name instead of another. This may occur in e-commerce with its rapid progress and instant (and theoretically limitless) accessibility to users and potential customers and particularly so in areas of specific overlap. Ordinary consumers/users seeking to locate the functions available under one domain name may be confused if they accidentally arrived at a different but similar web site which offers no such services. Such users could well conclude that the first domain name owner had misrepresented its goods or services through its promotional activities and the first domain owner would thereby lose their custom. It is apparent therefore that a domain name may have all the characteristics of a trademark and could found an action for passing off."

29. From the above discussion, it is clear that the domain names are protected under the law of passing off with a personal name being no exception. Rather it would not be out of place to say that the entitlement to use one's own name stands on a higher footing than the entitlement to use the trade mark. This is so due to the reason that the right to use one's own name is a personal right as against the right to use a trade mark which is merely a commercial right. This can be discerned after carefully analyzing the scheme of the trade mark law wherein Section 35 of the Trade Marks Act 1999 provides right to use the personal name as a valid defence or an exception to the

infringement of the mark.

30. A necessary corollary which follows is that the right to use a personal name is superior than that of the commercial right of using the trade mark and thus the entitlement to use it as a trade mark or domain name vests with the person having its personal name. Afortiori it can be conveniently stated that the name which besides being a personal name is also distinctive due to its inherent distinctiveness and also by virtue of the popularity of the person specific also fulfils the criterion of trade mark.

31. In the present case it is clear from a visit to the WHOIS that;

- (i) There is no natural person who claims rights in the domain name www.arunjaitley.com;
- (ii) There is no corporate entity claiming rights in the same except unknown Registering authorities;

32. Therefore, the entitlement to restrain the use of the popular or well known personal names accrues to a person on both the counts, first on the satisfaction of the principles of well known marks envisaged under the trade mark law and second in view of his personal right and entitlement to use his personal name. However, there is no absolute right to use personal name and whenever there are common names or common surnames, or names of the sect which cannot attain distinctiveness, the right and entitlement to use the same varies and tests become different as in those cases no exclusivity can be maintained by a single person and equal rights subsist to each of the persons using the common names unless high degree of distinctive character is established. The said principles can be hold to be good for the purposes for deciding the cases involving personal names which can also qualify the tests of the trade mark.

33. I find that the name of Mr. Arun Jaitley falls in the category wherein it besides being a personal name has attained distinctive

indicia of its own. Therefore, the said name due its peculiar nature/distinctive character coupled with the gained popularity in several fields whether being in politics, or in advocacy, or in part of emergency protest, or as leader or as debator has become well known personal name/mark under the trade mark law which enures him the benefit to refrain others from using this name unjustifiably in addition to his personal right to sue them for the misuse of his name.

34. This international regulation was effected through WIPO and ICANN. India is one of the States of the world which are members of WIPO. WIPO was established for promoting the protection, dissemination and use of intellectual property in all over the world. Services provided by WIPO to its member states include the provision of a forum for the development and implementation of intellectual property policies internationally through treaties. The setting up not only of a system of registration of domain names with accredited Registrars but also the evolution of the Uniform Domain Name Disputes Resolution Policy (UDNDR Policy) by ICANN on 24th October 1999. As far as registration is concerned, it is provided on a first come first serve basis.

35. The procedure of registration with such registrars is not the same as under the Trade Marks Act, 1999, but the principles apply to the same are to some extent similar as trademark protection. The UDNDR Policy is instructive as to the kind of rights which a domain name owner may have upon registration with ICANN accredited Registrars. In Rule 2 of the Policy, prior to application for registration of a domain name, the applicant is required to determine whether the domain name for which registration is sought "infringes or violates someone else's rights".

36. A person may complain before administration-dispute-resolution service providers listed by ICANN under Rule 4(a) that:

- i) a domain name is identical or confusingly similar to a trademark

or service mark in which the complainant has rights; and

- ii) the domain name owner/registrant has no right or legitimate interest in respect of the domain name; and iii) a domain name has been registered and is being used in bad faith.

37. Rule 4(b) of the policy provides that for the purpose of paragraph 4(a)(iii) the following four circumstances, in particular but without limitation if found by the panel to be present as evidence of registration and use of a domain name in bad faith:

- (i) circumstances indicating that the domain name owner/registrant has registered or the domain name owner/registrant has acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name; or
- (ii) the domain name owner/registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that it has engaged in a pattern of such conduct; or
- (iii) the domain name owner/registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the domain name owner/registrant has intentionally attempted to attract, for commercial gain internet users, to its web site or other on-line location, by creating a likelihood of confusion with the complainants mark as to the source, sponsorship, affiliation, or endorsement of the domain name owner/registrant web site or location or of a product or service on its web site or location."

38. Rule 4 (k) provides that the proceedings under the UDNDR Policy would not prevent either the domain name owner/registrant or the complainant from submitting the dispute to a court of competent jurisdiction for independent resolution, either before proceeding under ICANN's policy or after such proceeding is concluded.

39. The defences available to such a complaint have been particularized "but without limitation", in Rule 4 (c) as follows:

- (i) before any notice to the domain name owner/registrant, the use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with bona fide offering of goods or services; or
- (ii) the domain name owner/registrant (as an individual, business, or other organization) has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the domain name owner/registrant is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue",

40. In the present case, as I have already come to the conclusion that the name ARUN JAITLEY is a well known name, the use of the same without any reason by the defendants as a domain name and keeping in possession the said domain without sufficient cause is violative of the ICANN policy and can be safely held to be a bad faith registration.

41. Further the conduct of the defendants have been reprehensible from the beginning of the dispute. The Defendant no. 1 and 2 although are seeking to justify the same by stating that the said defendants were not in control of the domain name at the time when they were informed as the domain name has already gone into deletion mode but the movements in the matter after the issuance of legal notice dated

16.7.2009 from defendants side raises a reasonable level of doubts and concerns. It has been realized that the said domain name is passed to defendant no. 3 and thereafter the plaintiff is advised by the defendants to go for online auction wherein the said domain name is available at the astronomical rates of \$11,725 to \$14,475 USD.

42. Pursuant to filing the present suit and passing off the interim orders, the defendant no. 3 has not put in appearance but rather chosen to part with the said domain by purporting to transfer.

43. The Registrar and Registrant of the domain name www.arunjaitley.com is the same entity or is a group company. It is submitted that the defendant No. 3 i.e. M/s Portfolio Brains LLC has been taken over by M/s Oversee Domain Management, LLC which is controlled by M/s Oversee.net. The Registrar of the domain www.arunjaitley.com is DOMAINPARKBLOCK which is also controlled by M/s Oversee.net. Internet printouts from Network-tools.com showing that www.arunjaitley.com, DOMAINPARKBLOCK & M/s Oversee Domain Management, LLC are controlled by M/s Oversee.net are already on record. They all operate from the same address i.e., 515 South Flower Street, Suite 4400, Los Angeles, CA 90071, United States.

44. All these events speak for themselves that the sole intention of the defendants if not of defendant no. 1 and 2 but offcourse of defendant no. 3 is to fetch money in consideration of sale of domain name and the said defendant no. 3 is no where interested in keeping the domain name but at the same time depriving the legitimate owner to use the same unjustifiably. Thus, the said defendant no. 3 is a cyber squatter who is indulging into the trafficking in the domain name and is also keeping the domain name in bad faith which is violative Rule 4 (a) and (b) of ICANN Policy.

45. I am not totally convinced by the submissions of Mr. Lall who has rather tried to complicate the simple issue by meticulously describing the procedure involved in deletion of the domain name. The sum and

substance of the matter is that the defendant no. 1 and defendant no. 2 are not able to explain properly as to how the domain name which was initially under their control upto 21st July 2009 and which continued to show their name in database as controlling registrar upto 27th July 2009 suddenly go out of control solely because the domain was supposed to expire due to non payment of the renewal fee. The defendant no. 1 and 2 have not able to show any provision under the ICANN policy for deletion of name which reveals that the registrar of the domain name changes when it is put into deletion. Merely because there is an intermediary or facilitator like Verisign to delete the domain names. All the burden of parting with the domain name cannot be shifted to Verisign.

46. This can be further seen by looking at the events more carefully. The domain was supposed to expire on 12th June 2009. The plaintiff wrote to the defendants on 16th July 2009 for immediately transfer the domain to the plaintiff. The defendant's then replied the same on 17th July 2009 calling upon the plaintiff to make an offer for purchase of the said domain name. As per the defendant's own version defendant did take an action of deletion upto 21st July 2009. In the meantime, the defendants continued to gave assurances to the plaintiff that the matter was taken to the executive department for review upto 25th July 2009.

47. All these events and happening reveal reasonable doubts if not malafides on the part of the defendant no. 1 and 2. Firstly, how and why the defendants were so much diligent in asking the plaintiff to go for purchase of the registered domain name at certified offer service in its reply dated 17th July 2009 and on the contrary the very same defendants negligibly awaited for more than 5 days to go for delete command despite the legal notice dated 16th July 2009 and even after more than 30 days after the expiry of the domain name on 12th June

2009.

48. After the defendants have asked about the purchase of the domain name from its service which sells registered domain name, it becomes evident that till the time defendants were put to notice, the domain was already in the control of the said defendants. The defendants were also put to notice about the rights of the plaintiff, the defendants if were reasonable ought to have immediately moved for deletion and would have facilitated the plaintiff to retrieve the domain name back either by fresh registration or at nominal price. But on the contrary, the defendants awaited the plaintiff for either to move for online service which offers to make a bid starting from 100 USD to 25000 USD and when the plaintiff did not do so, the defendants have accorded to them went for deletion which parted with the domain name to other registrant.

49. Furthermore, it is difficult to believe entire version of the defendants as truth. This is so because after the domain name went for deletion, the only reason it was said to be transferred is due to involvement one Verisign which can be said to be facilitator for deletion. It is also told that as a trade practice, the domain vests with Verisign until completely deleted. Firstly, This cannot be sole reason for parting with the domain name from one registrar to another. Secondly, Verisign is not before the court to explain its stand, one cannot assume any such trade practice and also the untimely deletion by the verisign which has lead to transfer as per the defendants. It is very easy to shift burdens due to involvement of third party in its absence. Thirdly and most importantly, the name of the defendants appeared as registrar on the records of Who is database as per their own admissions uptil the next transfer on 27th July 2009. Then there is no reason why this court should believe the defendants (1 and 2) that the domain name went out of their control solely because the defendants are saying in the absence of the any formal proof and more so when even Verisign is not before the court.

50. There is certainly either not a full explanation of the events or there is a missing link in the chain of events which raises reasonable suspicion upon the defendant no. 1 and 2 with respect to progression of events in the matter. Nevertheless, as the domain name is now available with the defendant no. 3, this court deems fit to direct the defendant no. 1 and defendant no. 2 to act more fairly and transparently and cooperate with the legitimate proprietors in getting their domain names in future.

51. One more thing which is matter of concern in the cases involving the well known marks or popular personal names to be registered as a domain names is that when the domain policy is aimed at curbing the bad faith adoption as well as to prevent the use of the domain names for trafficking. Sufficient powers can be assumed considering the policy and its aims by the registrars to enquire into while registering the domain name as to whether any particular popular personal name or the well known name of the company is actually belonging to the applicant or not.

52. Cyber squatting is a crime against the laws and regulations of cyber law. The registering, or using a domain name with mala fide intent to make profit belonging to someone else. The cyber squatter then offers to sell the domain to the person or company who owns a trademark contained within the name at an inflated price. Cyber squatters ask for prices far more than that at which they purchased it. Some cyber squatters put up derogatory remarks about the person to buy the domain from them to compel the innocent person without any fault. The World Intellectual Organization (WIPO) has noticed about the increase in the number of cyber squatting (abusive registration of trademarks as domain names) cases filed but still no stern action is being taken against them or even no amendment is made in law in order to curb illegal activities of these persons.

53. The WIPO in the case of *www. Airtel com. Between Bharti Airtel*

Limited v. Ramandeep singh - Case No. D2010-0524 decided by WIPO,
the following remarks were made:

“4.1 As a preliminary matter, it is necessary to comment upon the Registrar's actions in this matter. In short the Registrar has not behaved in a manner that one would expect from a reputable provider of registrar services

4.5 If registrars are permitted to behave in such a fashion with impunity they undermine the operation and integrity of the Policy.

4.7 Accordingly, the Panel invites the Center to bring a copy of this decision to the attention to take such investigation and action in relation to the Registrar as it considers appropriate.”

54. In the digital world, one cannot be expected to be so much negligent or un prompt unless there are motives behind the movements. This can also certainly not expected from the domain registrar who deals in domain name and also knows the value of minutes and seconds in which the domain names are being transferred. Once the defendants were put to notice and informed about the rights of the plaintiffs on 16th July 2009 by the plaintiff. The defendants ought not to have waited for long to set a good deal by advising the plaintiff to go for online auctioning but to immediately check the status of the domain name which was expired as it was expired on 12th June 2009 (a month back) and on the next day ought to have gone for the deletion. The inaction of the defendants is sufficient to attach motives to the defendants conduct.

55. The use of the domain policy in the current manner wherein first there is a wrongful grant of the domain name to some person and misuse thereof and thereafter leading to the legitimate proprietor rushing to the court to get back his own personal name only due to less level of scrutiny or no checks at the first instance is a matter of harassment. There should be sufficient preliminary enquiry before

registering the domain name as to whether the domain in question is personal name of the applicant or his near relative by disclosing an identity of a person.

56. The anomalous situations like the present one would continue to arise wherein names of the popular personalities like Mr. Arun Jaitley is being registered by foreigner who have no concern with the domain name in question. Can some individual from Asian country get the domain name registered of renowned politician in USA and is it possible to get it registered so easily as registered in the present case. I am sure that no domain Registrars will let this happen and nor the Government there will allow this to be misused.

57. Let us now take the example at the present case, the plaintiff is an Indian citizen. He is well-known senior advocate and politician. He is the member of Parliament and is the leader of opposition in the Rajya Sabha and was the Union Minister in the various Ministries. Arun Jaitley being the personal name which cannot be associated with anyone.

58. If that is so, the domain registrars cannot remain only an office receiving the domain applications without applying their mind on the aims and objects of the domain name policy operating worldwide. The domain registrars should act circumspectly at the first instance itself so that the domain litigation can be curbed to the maximum. This can be done by merely calling upon the applicants to disclose their identity or sufficient connection or the nexus with the domain name in question.

59. This is all necessary to implement the domain name policy at all stages from registration uptill seeking cancellation in the litigation. It cannot be assumed that the role of applying the domain name policy only vests with the court and the UDRP panel. The registrars can equally recite these rules to realize the objects behind the same so as not to act mindlessly granting domain names to strangers to the

businesses or to the traffickers. Only then, we can have the effective implementation of objects of the domain names policy. Thus, as per rules, Registrars must follow some norms in granting the domain names so as to prevent harassments and litigations to the best they can.

60. As regards the defendant no. 3 no doubt the conduct of the defendant is beyond doubt as one of the traffickers in the domain name. The said defendant was put to service and had failed to appear and was accordingly set down *ex parte*. As the records of the proceedings show that the defendant has not merely willfully absent himself from the court but has also indulged into the overt act of parting with the domain name despite the injunction and now the current assignee as well as the registrar is operated by the same entity. All these event further establish that the defendants acts are dishonest and malafide.

61. It is now almost well settled by this court starting from *Time Incorporated v. Lokesh Srivastava*, 2005 (30) PTC 3 that the court should make its endeavours to deprecate the dishonesty especially to discourage the law breakers who have also willfully absent themselves from the court. This has been done by the courts by awarding punitive damages which has its genesis from American concept of punitive damages which is akin to the penalty or having penal effect in the damage jurisprudence. The said damages are discretionary but are awarded in the cases where the court find that the defendants conduct are *ex facie* dishonest.

62. The present case according to me warrants the grant of punitive damages so that the trafficking in the domain names can be discouraged. This is due to the reason that the defendant no. 3 besides being absenting himself is also transferring the domain name from time to time to other entities. Therefore, the defendant no. 3 and its agents or entities operating at the same address or persons connected there to with defendant no. 3, its entities and assignee are liable to

pay the punitive damages to the tune of Rs. 5 lakhs to the plaintiff for causing hardship and harassment and mental torture to the plaintiff in getting back the domain name.

63. Accordingly, the defendant no. 3, its entities operating at the addresses namely portfolio Brains LLC, M/s Oversee.net are permanently restrained from using, promoting, advertisement or retaining or parting with the said domain name namely Arunjaitley.com and further restrained from adopting, using the mark, name in any of the extensions of the domain name in cyberspace wherein the name ARUN JAITLEY forms one of the feature. The said defendant no. 3 and its entities are directed to transfer the said domain name to the plaintiff with immediate effect. The necessary governing body under the ICANN rules is also directed to block this domain name and immediately transfer this domain name to the plaintiff and requisite charges and formalities. The defendant no. 1 and 2 shall make serious efforts and co-operate in transforming the impugned domain name in favour of the plaintiff.

64. The application of defendant No. 1 and 2 being IA no 17485/2010 accordingly stands disposed of.

65. Suit of the plaintiff is decreed in terms of para 43 A and B of the plaint. Let the decree be drawn accordingly. The plaintiff is also entitled for the costs.

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