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IN THE HIGH COURT OF DELHI AT NEW DELHI

CORAM: JUSTICE PRATHIBA M. SINGH

CS (COMM) 159/2022; 11.03.2022

ADOBE, INC versus NAMASE PATEL AND OTHERS

Plaintiff Through: Ms. Shwetasree Majumder, Ms. Tanya Varma and Mr. Prithvi Gulati, Advocates.

ORDER

1. This hearing has been done through hybrid mode. I.A.4003/2022 (for exemption)
2. Allowed, subject to all just exceptions. Application is disposed of. I.A. 4002/2022 (additional documents)
3. This is an application seeking leave to file additional documents under the Commercial Courts, Commercial Division and Commercial Appellate Division of High Courts Act, 2015 (hereinafter, 'Commercial Courts Act').
4. The Plaintiff, if it wishes to file additional documents at a later stage, shall do so strictly as per the provisions of the Commercial Courts Act.
5. Application is disposed of.

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6. Let the plaint be registered as a suit.
7. Issue summons to the Defendants through all modes, upon filing of process fee. Mr. Harish Vaidyanathan, Id. CGSC, accepts notice on behalf of DoT/Defendant No.11.
8. The summons to the Defendants shall indicate that a written statement to the plaint shall be positively filed within 30 days from the date of receipt of summons. Along with the written statement, Defendants shall also file an affidavit of admission/denial of the documents of the Plaintiff, without which the written statement shall not be taken on record.
9. Liberty is given to the Plaintiff to file a replication within 15 days of the receipt of the written statement(s). Along with the replication, if any, filed by the Plaintiff, an affidavit of admission/denial of documents of the Defendants, be filed by the Plaintiff, without which the replication shall not be taken on record. If any of the parties wish to seek inspection of any documents, the same shall be sought and given within the timelines.
10. List before the Joint Registrar for marking of exhibits on 12th July, 2022. It is made clear that any party unjustifiably denying documents would be liable to be burdened with costs.

11. List before Court on 11th May, 2022.

I.A.4001/2022 (u/O XXXIX Rules 1 & 2 CPC)

12. The present suit has been filed by the Plaintiff - Adobe, Inc. - seeking permanent injunction restraining infringement of the Plaintiff's trademark, passing off, dissemination of confidential information, unfair trade practices, transfer of domain names, rendition of accounts and damages against Defendant No.1 - Namase Patel, who has registered the domain names www.addobe.com and www.adobee.com (hereinafter "Infringing Domains"). The case of the Plaintiff is that the mark 'ADOBE' was coined sometime in 1980 and has been used internationally by it in respect of computer software and other IT related services. The trademark 'ADOBE' is a registered trademark in India as well as in several foreign countries. The earliest registered trademark of the Plaintiff in India dates back to 1987, registered in class 9.

13. The case of the Plaintiff is that Defendant No.1, who goes by the name Namase Patel with the email address: namasepatel@yahoo.co.in has registered the Infringing Domains and has engaged in completely illegal conduct for the last several years. The submission of Ms. Majumdar, Id. Counsel appearing for the Plaintiff, is that Defendant No.1 is a habitual registrant of variations of well-known trademarks and there are several orders, which have been passed against him under the proceedings by the Arbitral Forum under the ICANN's Uniform Domain-Name Dispute Resolution Policy (hereinafter "UDRP"). She submits that though the Infringing Domains were registered way back in 2004, the Plaintiff discovered the said usage of the Infringing Domains only when some emails, which were meant for circulation within the Plaintiff-company, were found to have been received by the Defendants due to a spelling error made by the sender of the emails. The forensic audit, which was conducted when the emails did not bounce back to the sender, revealed that Defendant No.1 has availed of hosting of Infringing Domains on an infrastructure platform owned by WWW.ABOVE.COM/Defendant No.13 (hereinafter "Above.com"), which is itself an IT infrastructure company.

14. Therefore, Ms. Majumdar submits that in view of Defendant No.1 having availed of the services of Above.com, the emails have been received by Defendant No.1 by utilizing a feature called catch-all configuration wherein all the emails, which may have been sent with a spelling error of the Plaintiff's domain name i.e., "...@addobe.com" or "...@adobee.com", is received by Defendant No.1's mailbox. It is because of this configuration, which was revealed in a forensic audit as per the affidavit of Mr. John Scott Evans, Director, IP & Marketing and Assistant Secretary for Adobe Inc. that Plaintiff learnt of the Defendant and the extent of the illegality being perpetuated by him. The relevant paragraphs of the affidavit are set out herein below:

"3. It has come to Adobe's attention that a thirdparty domain owner sits in possession of addobe.com and adobee.com.

4. Forensic investigation has revealed that these domains have been configured with the brands of Adobe products, such as Adobe Photoshop and Adobe Spark.

5. In particular, forensic investigation has discovered that addobe.com has been configured with over 400 subdomains which match many used by adobe.com. A subdomain is a configuration that prepends a name to the front of a domain. As an example, addobe.com has been configured with photoshop.addobe.com according to the domain history provided to Adobe by respected threat intelligence providers that monitor for these types of potentially infringing behaviors.

6. Adobe has learned that addobe.com is hosted on Above.com infrastructure with an email catch-all to obtain any email sent to the domain, a configuration used to capture any and all email sent to addobe.com regardless of what is placed in front of the "@" symbol in the email.

7. Adobe's investigation has revealed that, as a result of this email catch-all configuration, emails intended for Adobe recipients, but which include an inadvertent typo in the intended recipients' email address, have instead been received and collected by this non-Adobe email catch-all. Due to the email catch-all configuration, these messages sent in error would not have generated a bounce-back or send failure message in the same manner as the sender would have been expected for messages sent to an invalid email address."

15. Ms. Majumdar, Id. Counsel, also relies upon various orders passed by the US National Arbitration Forum (hereinafter "NAF") and WIPO Arbitration and Mediation Centre, wherein directions have been given for transfer/locking of the domain names illegally registered by Defendant No.1.

16. Defendant No.1 has registered the impugned domain names www.addobe.com and www.adobee.com. The said domain names are infringing variants of the Plaintiff's trade mark ADOBE. A list of domains names, which have been registered by Defendant No.1, has been placed on record, shows that Defendant No.1 has in the past, registered, variations of several well-known trademarks including Under Armour, Christian Dior, AirFrance, Japan Airways, etc.

17. The Court has perused the list of domain names of Defendant No.1, as also the various orders passed by the NAF and other arbitral institutions, which clearly show that the Defendant No.1 seems to be a habitual cyber squatter engaged in registering various domain names. Such registration of well-known trademarks as domain names constitutes bad faith registrations under Paragraph 4(a)(iii) of the UDRP. As held in **Satyam Infoway Ltd. v. Sifynet Solutions Pvt. Ltd., 2004 (6) SCC 145**, by the Supreme Court, cyber-squatting cannot be encouraged and is clearly contrary to law. The relevant extract of the said judgment is as under:

“While registration with such Registrars may not have the same consequences as registration under the Trademark Act, 1999 nevertheless it at least evidences recognised user of a mark. Besides 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”. 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 Final Report of WIPO dt. 30.4.1999 rights; and
- (ii) the domain name owner/registant 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.

Rule 4(b) has listed by way of illustration the following four circumstances as evidence of registration and use of a domain name in bad faith.

- (i) circumstances indicating that the domain name owner/ registant has registered or the domain name owner/registant 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/registant 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/registant 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/registant 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/registant web site or location or of a product or service on its web site or location.’

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These rules indicate that the disputes may be broadly categorised as : (a) disputes between trademark owners and domain name owners and (b) between domain name owners inter se. What is important for the purposes of the present appeal is the

protection given to intellectual property in domain names. A prior registrant can protect its domain name against subsequent registrants. Confusing similarity in domain names may be a ground for complaint and similarity is to be decided on the possibility of deception amongst potential customers. The defences available to a complainant are also substantially similar to those available to an action for passing off under trademark law.

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. As far as India is concerned, there is no legislation which explicitly refers to dispute resolution in connection with domain names. But although the operation of the Trade Marks Act, 1999 itself is not extra territorial and may not allow for adequate protection of domain names, this does not mean that domain names are not to be legally protected to the extent possible under the laws relating to passing off.

18. This Court is also convinced that the availing of a catch-all configuration being hosted on WWW.ABOVE.COM, is conduct which is meant to cause harm to the Plaintiff. Defendant No.1 is also stated to be using the subdomains 'photoshop.adobe.com' and 'spark.adobee.com', whereas 'SPARK' and 'PHOTOSHOP' are both products of the Plaintiff.

19. Under such circumstances, the Plaintiff has made out a prima facie case in its favour for grant of ex-parte injunction. Defendant Nos.2 to 10 are internet service providers (hereinafter "ISPs"). The Registrar of the Infringing Domains is M/s. SEA WASP LLC/Defendant No.12, which is also a company whose home page has been blocked by the DoT under the Information Technology Act, 2000. The illegality committed by Defendant No.1 is, thus, evident upon a perusal of the averments in the plaint and the documents.

20. Accordingly, the following directions are issued:

(1) Defendant No.1 and anyone else acting on his behalf, is restrained from using the Infringing Domains being www.addobe.com and www.adobee.com and further from registering any domain name, which incorporates the Plaintiff's trademark 'ADOBE' or 'PHOTOSHOP' or 'SPARK' or any other variants thereof.

(2) Defendant No.1 shall be served on the email address namasepatel@yahoo.co.in. The declared address of Defendant No.1 is 1415, Mahatma Gandhi Road, MHADA, Mumbai, Maharashtra-400066, which is stated to be a false address as there is a mismatch between the address and pincode. Accordingly, directions are also issued to the Cyber Cell, Mumbai Police to conduct an investigation and place on record a status report as to the following:

(i) The individual(s), who has registered the Infringing Domains www.addobe.com and www.adobee.com.

(ii) The individual, who is using the email id namasepatel@yahoo.co.in.

(3) The Mumbai Police is permitted to use the services of any other police authority in other cities, if the need so arises. Copy of the present order be served upon the Commissioner of Police, Mumbai at the email address cp.mumbai@mahapolice.gov.in for filing of the status report. Ld. Counsel for the Plaintiff to do the necessary follow-up, if required.

(4) The ISPs i.e., Defendant Nos.2 to 10 are directed to block the Infringing Domains i.e., www.addobe.com and www.adobee.com, immediately.

(5) Defendant No.11 is directed to issue instructions for blocking of the Infringing Domains i.e., www.addobe.com and www.adobee.com, immediately.

(6) Defendant No.12 shall disclose to the Court the contact details of the person, who has registered the Infringing Domains www.addobe.com and www.adobee.com. The said Infringing Domains i.e., www.addobe.com and www.adobee.com, shall be blocked immediately and status quo shall be maintained till the next date of hearing. No transfer shall be permitted of the said domain names.

(7) Defendant No.13, WWW.ABOVE.COM which is hosting Defendant No.1's email/domains on its catch-all email configuration, shall suspend the said services qua Defendant No.1 and shall also disclose to this Court the contact details of the person, who is using the email address namasepatel@yahoo.co.in or any other persons who have availed of catch-all email configuration services from WWW.ABOVE.COM.

21. Compliance of Order XXXIX Rule 3 CPC be made within five working days. Reply to the application be filed within 4 weeks from service of the present order along with the paper book.

22. List the application before Court on 11th May, 2022. Order be uploaded forthwith.

23. The digitally signed copy of this order, duly uploaded on the official website of the Delhi High Court, www.delhihighcourt.nic.in, shall be treated as the certified copy of the order for the purpose of ensuring compliance. No physical copy of orders shall be insisted by any authority/entity or litigant.