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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

Date of Decision: 18th April, 2022

+ **CS (COMM) 205/2020 & CCP(O) 25/2020 & I. As. 4967/2020,
4753-54/2021**

GOVERNMENT E MARKETPLACE Plaintiff

Through: Mr. Shailendra Sharma, Advocate.
(M:9810267976)

Mr. Rajeev K. Virmani, Senior
Advocate, Amicus Curiae with Mr.
Mohit Dang and Ms. Niharika,
Advocates. (M:8697002497)

versus

UNILEX CONSULTANTS & ORS. Defendants

Through:

Ms. Monika Arora and Mr. Yogesh
Panwar, Advocates for D-15.
(M:8383876215)

Ms. Shweta Sahu, Advocate for D-16.
(M:7738741586)

CORAM:

JUSTICE PRATHIBA M. SINGH

Prathiba M. Singh, J. (Oral)

1. This hearing has been done through hybrid mode.

CS (COMM) 205/2020 & I.As. 4967/2020, 4753-54/2021

2. The present suit has been filed by the Plaintiff – The Government E Marketplace (*hereinafter* “*GeM*”), which is a National Public Procurement portal and end to end online marketplace from where both Central and State Government Ministries /Departments, CPSUs and SPSUs effect the procurement of goods and services. The mark used by the Plaintiff is ‘*GeM*’

along with the logo, which is depicted below:



3. The case of the Plaintiff in the present suit is that there are several parties, who are either registering ‘GeM’ in respect of procurement of goods and services as a domain name or using the term ‘GeM’ as a URL extension of their usual websites. Some of the parties are providing services to enable businesses to register on the ‘GeM’ portal. Therefore, the Plaintiff is aggrieved by the fact that the Defendants seemed to be claiming to the public at large, that they are associated with the Plaintiff, thereby misrepresenting their status *qua* the Plaintiff and also adversely impacting the Plaintiff’s brand equity and goodwill. In the present case, the following URLs have been impugned:

1. <https://www.unilexconsultants.com/registrations/GEM-Registration/>
2. <https://charteredmunshi.com/gem-registration>
3. <https://complykart.com/service/GEM-Registration>
4. <https://www.digitalsanjay.com/gem-registration-govemment-e-marketplace/>
5. <https://gemgov.in/>
6. <http://www.legalbrothers.in/service/gem-registration/>
7. <http://www.maanof.co.in/gem-registration.html>
8. <https://prospectdigital.in/gem-government-e-marketplace-registration-consultant/>
9. <https://www.e-startupindia.com/gem-registration.html>
10. <https://registrationseva.com/gem-registration-in-india/>

11. <https://www.legalsalaah.com/gem-registration.html>
12. <https://gem-registration.org/>
13. <https://apkpure.com/>
14. <https://www.ezzus.com/services/gems-portal-registration>

4. In the present suit, various persons who are using the objectionable domain names/URL extensions have been impleaded as Defendant Nos.1 to 11. Defendant Nos.12 to 14 are registered by John Does, whose whereabouts are not known. Defendant No.15 is the Ministry of Electronics and Information Technology (*hereinafter* “MEITY”). Defendant Nos.16 to 18 are the Registrars of various domain names/URLs, wherein the objectionable term ‘GeM’ has been used. Defendant No.19 is a company where Defendant No.2 is a shareholder and director. Various orders have been passed from time to time in this matter. A brief background of the decrees passed against various Defendants is captured hereinbelow.

5. Initially, vide order dated 1st July, 2020, an *ad interim* injunction was passed in this matter, directing suspension of the impugned domain names in the following terms:

“9. I am, for the moment, persuaded by the arguments advanced by Mr. Sharma that if interim relief, as sought for, is not granted, it would jeopardise not only the interest of the plaintiff, but of the users at large, and thus, impact, inter alia, public interest as well.

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11. Accordingly, till the next date of hearing, the Registrars of the domain names concerning defendant Nos.1 to 14 shall suspend the domain names of defendant Nos. 1 to 14.

11.1 The Registrars of domain names, who have been arrayed as parties, are shown as defendant Nos.16 to 18 in the memo of parties.

11.2 Defendant No. 16 to 18 will comply the directions issued hereinabove, immediately, upon receipt of a copy of the order passed today.”

6. Thereafter, on 17th July, 2020, vide two applications being filed on behalf Defendant Nos.9 & 10, the said Defendants agreed not to include the URL extension ‘gem.registration.html’ or any other deceptively similar URL extension, as part of their domain names. The said order reads as under:

“3.1 Furthermore, learned counsel says that he is instructed to make a statement on behalf of his clients i.e. defendant nos. 9 and 10 that they would not include the extension URL i.e. "gem.registration.html" or any other deceptively similar extension URL as part of their domain names.

3.2 In other words, Mr. Rishi says that during the pendency of the instant suit, defendant nos. 9 and 10 will not project to the public at large that they are, in any way, associated with the plaintiff.”

7. On 21st July, 2020, the initial injunction order dated 1st July, 2020 was put in abeyance only *qua* Defendant Nos.9 & 10, in order to enable Defendant Nos.9 & 10 to deactivate and disable the hyperlink/extension URL i.e., ‘gem.registration.html’. However, the interim order dated 1st July, 2020 *qua* the other Defendants was continued. It was thereafter, confirmed on 27th July, 2020 that the extension URL/hyperlink has been disabled/blocked by Defendant Nos.9 & 10. Accordingly, vide order dated 27th July, 2020, the decree *qua* Defendant Nos.9 & 10, was passed in the following terms:

“5.1 However, by itself, the services offered by

entities which do not involve infringement or passing off of plaintiffs trademark as their own, cannot be found fault with.

6. That being said, based on Mr. Rishi's statement, I am inclined to decree the suit qua defendant nos. 9 and 10.

6.1 It is ordered accordingly.

7. Defendant nos. 9 and 10 are permanently enjoined from using the plaintiffs trademark or trade name i.e. GeM/Government e-Marketplace in any manner whatsoever including as a part of its website or domain name so that no impression is created that they are, in any manner, associated with the plaintiff.

8. However, it is made clear that defendant nos. 9 and 10 will be free to carry on the business of enabling registration qua the plaintiffs web portal for a fee or otherwise, albeit without giving an impression that they are, in any way, associated with or connected with the plaintiff.

9. Thus, the instant suit against defendant nos. 9 and 10 is disposed of in the aforementioned terms.

10. A decree will be drawn up accordingly.”

8. Thus, in respect of Defendant Nos.9 & 10, the suit was disposed of.

9. On the same date, Defendant No.1 undertook by **I.A. No.6123/2020**, that even prior to the passing of the order dated 1st July, 2020, it had permanently removed the extension URL <https://www.unilexcohsultants.com/registrations/GEM-Registrations/> and the said position would continue in the future as well. Accordingly, the suit was also decreed *qua* Defendant No.1, vide order dated 27th July, 2020 in the following terms:

“19. Accordingly, the captioned application and suit is disposed of qua defendant no. 1 with the following directions:

(i) Defendant no. 1 will not use the extension URL, which is set forth in paragraph 3 of the captioned application or any other deceptively similar extension URL as a part of its domain name.

(ii) Furthermore, defendant no. 1 will not project to the public at large that it is, in any way, associated or connected with the plaintiff.

(iii) In view of the undertaking given by defendant no. 1 to this Court, interim order dated 01.07.2020 shall stand vacated insofar as the said defendant concerned.

(iv) A decree will be drawn up in the aforementioned terms in respect of defendant no. 1.”

10. Thereafter, on 24th August, 2020, qua Defendant No.6, the following directions were issued:

“8. Thus, with the consent of Mr. Mehrotra, the following directions are issued:

(i) Defendant no. 6 is permanently enjoined from using the plaintiff’s trademark or trade name i.e. GeM/Government e-Marketplace in any manner whatsoever including as a part of its Website or domain name so that no impression, whatsoever is created that it is, in any manner, associated with the plaintiff.

(ii) Interim order dated 01.07.2020 shall stand vacated qua defendant no. 6. Defendant no. 17 i.e. the Registrar of the domain name of defendant no. 6 will act accordingly.

(iii) Defendant no. 6 will disable the extension URL/hyperlink concerning the plaintiffs GeM portal from its domain name i.e. www.Legalbrothers.in.

9. The suit qua defendant no. 6 is disposed of in the aforementioned terms. A decree vis-a-vis defendant no. 6 will be drawn-up accordingly.

11. On 2nd September, 2020, ld. Counsel for the Defendant No.2 made a statement that it has no objection if the suit is decreed *qua* Defendant No.2. Accordingly, an undertaking was recorded in terms of paragraphs 6 & 7 of the affidavit dated 20th August, 2020 as under:

“4. It is in this context that defendant no. 2 has made the following assertions in paragraph 6 & 7 of the affidavit dated 20.08.2020.

“6.I state that I do not wish to provide the service of registration to the Government E-Marketplace portal (or any related services through the impugned URL/Extension <https://charteredmunshi.com/gem-registration> either currently or any time in the future. Thus, I undertake, to not use the said URL/ Extension at any time in the future.

7. I say that pursuant to the aforesaid removal of the URL/Extension from the website of Chartered Munshi, the claim of the Plaintiff against the Defendant No.2 stands satisfied in its entirety. Hence, I being named Defendant No.2 in the present matter have no objection if a decree is passed in the aforesaid terms by this Hon'ble Court.””

12. Accordingly, a decree was passed on 10th September, 2020 against Defendant No.2 and Defendant No.19-the company where Defendant No.2 is a director and shareholder, in terms of paragraphs 6 & 7 of the affidavit extracted above. It was also directed as under:

“4. Accordingly, as prayed, a decree is passed against defendant no. 2 in terms of paragraphs 6

and 7 of the affidavit dated 20.08.2020 filed by him.

4.1 The decree shall bind, as indicated hereinabove by Ms. Dutt, not only defendant no. 2 but also defendant no. 19 i.e. Draft Notion Services Pvt. Ltd.

4.2 Since a direction has already been issued on 02.09.2020 that an affidavit will be filed, in that regard, by defendant no. 19 i.e. Draft Notion Services Pvt. Ltd., that direction, for the sake of completion of record, shall also be complied with by the said defendant.

4.3 The affidavit will be filed by defendant no. 19 i.e. Draft Notion Services Pvt. Ltd. within 10 days from today. A copy of the same will be furnished to Mr. Abhinav Sharma via e-mail.

5. A decree will be drawn-up qua defendant no. 2 in the aforementioned terms.”

13. Defendant No.16 was also directed to lift the suspension qua Defendant No.2's domain name in terms of the above order.

14. As per paragraph 8 of the said order dated 10th September, 2020, the suit was decreed against Defendant No.11 as well. The same reads as under:

“8. The suit is decreed against defendant no. 11 in terms of assertions made in paragraph 6 to 8 of the affidavits dated 04.09.2020 filed by the partners of defendant no. 11 i.e., Mr. Abhishek Kumar and Mr. Surinder Kumar.”

15. Thereafter, on 11th September, 2020, the suit was decreed qua Defendant No.3. The relevant portion of the order is extracted herein below:

“5. To be noted, I.A. No. 8038/2020 has been

listed for the first time today. It is in this application that the applicant/defendant no. 3 has prayed that a decree be passed against him in terms of the order dated 27.07.2020.

5.1 The sum and substance of the assertions made/by the applicant/defendant no. 3 is captured in paragraphs 5 to 8 of the application. For the sake of convenience, the same are extracted herewith:

"5. It is respectfully submitted that Applicant's website is presently disabled and thus, he could not be able to have the access to disable the hyperlink/ extension URL of the Plaintiffs portal. Hence, this application seeking to vacate the interim order dated 01.07.2020 against the Applicant/Defendant No. 3 so that the Applicant/ Defendant No. 3 would be in position to disable the hyperlink/extension URL, i.e. www.complykart.com/GeM-Registration at his own. It is humbly submitted that once the Applicant disables/deactivate the hyperlink/ extension URL of the Plaintiffs portal, there remains no grievances to the Plaintiff the Defendant No.16 i.e. GoDaddy.com shall also have no role to play qua the domain name of the Applicant/ Defendant No. 3.

6. That the Applicant/Defendant No. 3 undertake before his Hon'ble Court to disable the hyper link/ extension URL from his domain name i.e. "complykart.com", once the domain of the Applicant is enabled, which is disabled pursuant to directions by this Hon 'ble Court:

7. The Applicant/ Defendant No. 3 further

undertakes that after disabling the hyperlink/extension URL, the Applicant/Defendant No. 3 shall not include the same or any other deceptively similar extension URL/ hyperlink as part of his domain name and shall not project in his domain/ website representing any association with the Plaintiff. The Applicant/ Defendant No. 3 has also filed a separate affidavit to this effect.

8. That this Hon'ble Court by way of order dated 27.07.2020 in the instant suit has been pleased to pass decree against Defendant Nos. 9 and 10 whereby this Hon'ble Court has held:

"That being said, based on Mr. Rishi 's statement, I am inclined to decree the suit qua defendant nos. 9 and 10. 6.1. It is ordered accordingly.

7. Defendant nos. 9 and 10 are permanently enjoined from using the plaintiffs trademark or trade name i.e. GeM/Government e-Marketplace in any manner whatsoever including as a part of its website or domain name so that no impression is created that they are, in any manner, associated with the plaintiff.

8. However, it is made clear that defendant nos. 9 and 10 will be free to carry on the business of enabling registration qua the plaintiffs web portal for a fee or otherwise, albeit without giving an impression that they are, in any way, associated with or connected with the plaintiff. 9. Thus, the instant suit against defendant nos. 9 and 10 is disposed of in the aforementioned terms. 10. A decree will be drawn up accordingly.

11. The captioned applications are, consequently, disposed of. 12: I must also record that the Registrar of the domain names of defendant nos. 9 and 10 i.e. defendant no.16/GoDaddy.com LLC has complied with the directions contained in order dated 21.07.2020, which enabled the said defendants to take steps to which reference is made in the said order and in the order passed today. 13. Thus, the interim order dated 01.07.2020 shall stand vacated qua defendant nos. 9 and 10."

5.2 Accordingly, issue notice in IA. No. 8038/2020. Mr. Sharma accepts service on behalf of the plaintiff.

5.3 Mr. Sharma says that he does not wish to file a reply to IA. No. 8038/2020 as he would have no objection if the suit is decreed in terms of the averments made by applicant/defendant no. 3 in paragraph nos. 6 to 8 of the said application.

6. Accordingly, interim order dated 01.07.2020 shall stand vacated qua the applicant/defendant no. 3.

6.1 The applicant/defendant no. 3 is permanently enjoined from using the plaintiffs trademark or trade name i.e. GeM/Government e-Marketplace in any manner whatsoever including as a part of his website or domain name so that no impression is created that he is, in any manner, associated with the plaintiff.

6.3 It is, however, made clear that the applicant/defendant no. 3 will be free to carry on the business of enabling registration qua the plaintiff's web portal for a fee or otherwise, albeit

without giving an impression that he is, in any way, associated with or connected with the plaintiff.

6.4 The Registrar of the domain name of applicant/defendant no. 3 i.e. defendant no. 16 will lift the suspension placed on the said domain name.”

16. Thus, *qua* Defendant No.3, Defendant No.16 was directed to lift the suspension of domain name.

17. Vide order dated 9th October, 2020, Defendant No.5 was proceeded *ex-parte*. It was also recorded that though appearance had not been entered on behalf of Defendant Nos.17 and 18, they were Domain Name Registrars who had otherwise complied with the directions of the Court, so the only contesting Defendant left was Defendant No.5. Accordingly, the Defendant Nos.5, 12 to 14 were directed to be served by publication. On 9th October, 2020, Defendant Nos.4, 7 & 8 agreed to suffer a decree as well and they were permitted to file applications/undertakings in this regard. Defendant No.4 had submitted that it had filed the application and the same was likely to come up for hearing. The said application being ***I.A.4753/2021*** has now been filed along with ***I.A.4754/2021*** seeking condonation of delay of 81 days in removing objections and re-filing ***I.A.4753/2021***. In the application seeking vacation of injunction, Defendant No.4 has stated as under:

“That Defendant No. 4 only provided information on GeM registration process, documents required for a GeM registration, benefits of GeM registration etc., as a description guide under the knowledge section of his blog/website www.digitalsanjay.com for the benefit of the readers who visited the above mentioned

blog/website. The said blog/ website has no payment gateway and Defendant No. 4 has never made any undue profits from the use of the Plaintiff's trade mark.

5. That Defendant No.4 has never claimed or used the Plaintiff's mark and has no intention of doing so ever. The Defendant No.4 has never claimed in its website or to any clientele that it is duly authorized agent of Plaintiff or sought to create any association with the Plaintiff.

6. That the Defendant No. 4 has not indulged in any sort of malpractice so as to deceive any person and has no connection with any kind of monetary consideration received from any person/customer as alleged by the Plaintiff.

7. That the Defendant No. 4 has never undertaken and will not undertake any such activity which may remotely intend passing off of the Plaintiff's mark or mislead anyone by portraying its website as that of the Plaintiff's website.

8. That the Defendant No.4 further undertakes that it will not include the extension URL <https://www.digitalsanjay.com/gemregistration-government-e-mrketplace/> or any other deceptively similar URL bearing the Plaintiff's trade mark as a part of its domain names and further project to public at large that Defendant No.4 is, in any way, associated with the Plaintiff."

18. The prayers in the said application read as under:

"It is, therefore, most respectfully prayed that this Hon'ble Court may graciously be pleased to:-

a) vacate the order dated 1st July, 2020 insofar as it has directed the Registrar of the Defendant No. 4 i.e. Defendant No. 16 to suspend domain services of the answering Defendant;

b) pass such other order(s) or further order(s) as this Hon'ble Court may deem fit and proper in the facts and circumstances of the case; and

c) the Defendant No.4 has no objection if a decree is passed in terms of this undertaking without the imposition of any damages and/ or costs against Defendant No. 4.
It is prayed accordingly.”

19. Notice was issued in **I.A.4753/2021** vide order dated 5th April, 2021. However, none has appeared for Defendant No.4 since then. None appears for Defendant No.4, 7 &8 today either. It is noticed however that, Defendant No.8 in its replication has also taken a similar stand. The same reads as under:

“5. That the humble applicant/ defendant no. 8 submits that the content on the web page of www.prospectdigital.in referring about GEM on the site was uploaded on 19,11.2019 and no clientele walked in or consulted for registration on GEM portal nor any fees been charged or mentioned in the content nor claimed at any point of time to be associated with plaintiff GEM by any means.

6. That, the humble defendant no. 8 submits and undertakes that since the injunction order the domain used is been blocked by the registrar and further had not been and will not claim to be associated with the plaintiff/GEM and will make necessary changes in the website depicting the above. It further undertakes that they will not include the extension URL <http://prospectdigital.in/gem-government-e-marketplace-registrationconsultant> or any other deceptively similar URL as part of their domain name.

7. That the humble answering defendant submits that in the absence of any document or irregularity reaching to the conclusion with regard to

misrepresentation, harm cause to goodwill, mark created any confusion amongst public or deceptive similar domain name is unjustifiable, hence the injunction order passed on 01.07.2020 to be discharged against the defendant no. 8.

8. That the humble defendant no. 8 had a prima facie case on merit & is most likely to succeed before the Hon'ble Court. The balance of convenience also lies in Defendants favour. That no prejudice will be caused to the plaintiff if its rights are protected.”

20. On 23rd March, 2021, **CCP (O) 25/2020** was filed in view of the conduct of the Defendant No.3 – Mr. Kamalesh Mishra. On the said date Mr. R.K. Virmani, Id. Senior Counsel was appointed as *amicus curiae* in the contempt petition.

21. The grievance of the Plaintiff in the present suit is that various persons are using the GeM logo and the GeM mark. It is clear from the perusal of the pleadings and documents on record that ‘GeM’ is the name of the portal which is used by the government for its procurement activities. No person would be entitled to use the said mark or logo thereof in any manner as to represent themselves as being connected with or affiliated to or sponsored by the Plaintiff. However, some of the Defendants are persons, who seem to be providing services and helping third party businesses to set up their GeM accounts. This Court is clearly of the opinion that such provision of services would not be contrary to law but showing an affiliation, sponsorship or connection with the Plaintiff would be contrary to law. A number of Defendants, as set out above, have suffered a decree in this matter. The remaining Defendants are Defendant Nos.4, 5, 7 & 8. They are stated to be using the term ‘GeM’ as an extension to their existing

domain names, which are also using the terms: ‘gem-registration-government-e-marketplace’, ‘gem-registration’, ‘gemgov.in’, ‘gem-registration.html’, ‘gem-government-e-marketplace-registration-consultant’.

22. The use of such names or URLs is bound to give the impression to an unknown person, as though the Defendant-persons/entities are connected with the Plaintiff’s GeM Portal. Thus, such persons cannot be allowed to use the domain name ‘gemgov.in’ or the URL extensions with their existing domain names, as specified above. However, if they wish to use the term ‘GeM’ for the purposes of mere information, or in order to describe the Plaintiff’s services/portal, they would be entitled to do so, without causing any misrepresentation, as the same would be in consonance with Section 30 of the Trademarks Act, 1999 (*hereinafter “Trademarks Act”*). Section 30(2) of the Trademarks Act reads as under:

“(2) A registered trade mark is not infringed where—

(a) the use in relation to goods or services indicates the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services or other characteristics of goods or services;

(b) a trade mark is registered subject to any conditions or limitations, the use of the trade mark in any manner in relation to goods to be sold or otherwise traded in, in any place, or in relation to goods to be exported to any market or in relation to services for use or available or acceptance in any place or country outside India or in any other circumstances, to which, having regard to those conditions or limitations, the registration does not extend;

(c) the use by a person of a trade mark—

(i) in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark if, as to those goods or a bulk or which they form

part, the registered proprietor or the registered user conforming to the permitted use has applied the trade mark and has not subsequently removed or obliterated it, or has at any time expressly or impliedly consented to the use of the trade mark; or

(ii) in relation to services to which the proprietor of such mark or of a registered user conforming to the permitted use has applied the mark, where the purpose and effect of the use of the mark is to indicate, in accordance with the fact, that those services have been performed by the proprietor or a registered user of the mark;

(d) the use of a trade mark by a person in relation to goods adapted to form part of, or to be accessory to, other goods or services in relation to which the trade mark has been used without infringement of the right given by registration under this Act or might for the time being be so used, if the use of the trade mark is reasonably necessary in order to indicate that the goods or services are so adapted, and neither the purpose nor the effect of the use of the trade mark is to indicate, otherwise than in accordance with the fact, a connection in the course of trade between any person and the goods or services, as the case may be;

(e) the use of a registered trade mark, being one of two or more trade marks registered under this Act which are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration under this Act.”

23. A Division Bench of this Court in ***Hawkins Cookers Limited v. Murugan Enterprises, [RFA (OS) No.09/2008, dated 13th April, 2012]***, in the context of trademarks being used for provision of identifiable goods, laid down the principles of the manner of use of a trademark in a *bonafide* manner while denoting the quality or characteristics of a particular good or service. The relevant observations are as under:

“9. Sub-section (2) of Section 30, legislates on the subject, when a registered trademark would not be infringed, and of the various situations contemplated, vide clause (d) of sub-section (2) of Section 30, is the situation where the manufacturer of goods which form part of or are an accessory to other goods for which a trademark exists is entitled to indicate that the accessory goods are adaptable to some other goods and it is reasonably necessary to so indicate. In such a situation, reference to the registered trademark of another person would not be actionable.

10. Now, at the heart of the matter in dispute in the instant appeal is: When would it be a case of the use of the trademark being reasonably necessary in order to indicate that the goods are so adapted?

11. The answer has to be found in the meaning of the two words “reasonably necessary”.

12. Of the various meanings of the word “necessary”, one meaning is “inherent in the situation”. Of the various meanings of the word “reasonable” one meaning is “just”.

13. Thus, the twin word “reasonably necessary” would mean that inherent in the situation it would be just; and in the context of Clause (d) of sub-section (2) of Section 30 of the Act, it would mean that where the goods which are claimed to be adaptable to some other goods would entitle the manufacturers of the goods which are adaptable to so indicate by reference to the trademark of the other goods provided it is just to so do and this would mean that the goods claimed to be adaptable are specifically manufactured to be used as a part of the other goods alone. This will not apply where the goods are capable of adaptable use to all goods manufactured by different manufacturers to

which they are adaptable. In said circumstance to indicate on the goods that they are adaptable only to the goods of only one manufacturer would be a clear violation of the trademark of the said manufacturer and Section 30 (2) (d) would not come into aid.

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20...It also needs to be highlighted that it has escaped the attention of the Learned Single Judge that while writing /Suitable for Hawkins Pressure Cookers', the Respondent has given undue prominence to the word 'Hawkins' by printing it in a distinct red colour and the remaining words of the sentence are printed in black."

24. Pertinently, in *McCarthy on Trademarks and Unfair Competition*, 3 *J. McCarthy on Trademarks* §23.10, on nominative fair use, it is observed as under:

"A use of another's trademark to identify, not the defendant's goods or services, but the plaintiff's goods or services, is not an infringement so long as there is no likelihood of confusion. This can be dubbed a non-confusing "nominative use" in that it names the real owner of the mark..."

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In the *New Kids* case, the Ninth Circuit said that:

[W]here the defendant uses a trademark to describe the plaintiff's product, rather than its own, we hold that a commercial user is entitled to a nominative fair use defense provided he meets the following three requirements. **First, the product or services in question must be one not readily identifiable without use of the trademark; second, only so much of the mark or marks may be used as is reasonably necessary to identify the product or service; and third, the user must do**

nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder.

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...That is, where the unauthorized use does not imply sponsorship or endorsement, the trademark owner cannot prevent the use.

...Also, a New Kids nominative fair use defense was found where a former Playboy Playmate used the Playboy marks to indicate her title on her personal website and in the website metatags.

But where the junior user exceeds the three requirements of “nominative fair use,” infringement will be found. For example, a court found that defendant’s book about the Godzilla fictional film character exceeded a “legitimate referential purpose” and created a likelihood of confusion as to sponsorship or endorsement by the trademark owner. Similarly it was held that an auto polish company could not claim a nominative fair use when it made prominent use in an advertisement of a PORSCHE auto.”

25. Accordingly, it is the settled position that nominative fair use is permissible in so far as the use is such that it does not depict sponsorship by the trademark owner and the use is “reasonably necessary”. Therefore, in the present case, the following directions are passed:

- (i) The suit is, accordingly, decreed to the effect that a permanent injunction shall operate against Defendant Nos.4, 5, 7 & 8, i.e., that they would not use the mark ‘GeM’ or the ‘GeM’ logo, either as part of a domain name or extension on their URL or as a mark or name in a manner so as to create confusion/deception in the mind of the public that they are affiliated with, sponsored by or connected to the Plaintiff. This would, however, not

prevent the said Defendants from using the term 'GeM' to refer to the Plaintiff and to refer to the services the Defendants are providing with respect to the Plaintiff's GeM portal, as a means of information to the general public in a descriptive manner. The decree shall be drawn up in the above terms *qua* Defendant Nos.4, 5, 7 & 8.

- (ii) Insofar as the Registrars of Domain Names are concerned, being Defendant Nos.16 to 18, the concerned Registrars shall (a) suspend/lock the domain names, which contain the term 'GeM' 'e-GeM' as listed in the amended memo of parties in this plaint, or if the term 'GeM' is in the domain name itself;

and

(b) lock the URLs, to the extent that any URL extension uses 'e-GeM', 'government e-marketplace' and such other references which are objectionable. This Court notes that on previous occasions also it has been submitted that the Registrar cannot block or delete the URL and only the party can do the same itself. Therefore, in so far as Defendant Nos.4,5,7 & 8 are concerned, the Registrars shall suspend/lock the domain names of Defendant Nos.4, 5, 7 & 8. However, if the said Defendants are willing to delete the said extensions, the suspension shall be revoked and the said Defendants would be permitted to delete the said objectionable URLs. Upon the objectionable URLs being removed or deleted, Defendant Nos.4, 5, 7 & 8 are permitted to use their own domain names, which are in no way connected to the Plaintiff. The decree sheet be drawn in the

above terms *qua* the Defendant Nos.16 to 18.

- (iii) Insofar as Defendant Nos.12 to 14 are concerned, they are John Does and they are using ‘gem-registration.org’, ‘apkpure.com’ & ‘gems-portal-registration.ezzus.com’. Accordingly, the said extensions/domain names shall be suspended/locked on the same terms as set out in point (ii) above. Insofar as Defendant No.13 is concerned, a perusal of the website’s screenshot shows that the said Defendant is also using the logo ‘GeM government e Marketplace’ and ‘GeM Seller’ on the website ‘apkpure.com’, as also the extension ‘in.gov.gem’. Accordingly, in respect of Defendants 12-14, decree in terms of the order at point (i) and (ii) above is passed.
- (iv) All the Registrars of Domain Names are directed to give effect to this order within two weeks. Decree sheet be drawn up in the above terms.

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26. Insofar as the present contempt petition is concerned, it is noticed that Defendant No.3 has already suffered a decree vide order dated 11th September, 2020. A perusal of the email shows that some intemperate and objectionable language has been used by the Defendant No.3. However, Mr. Virmani, *Id. Amicus Curiae*, submits that in one email the language is objectionable, however, thereafter, Defendant No.3 has appeared to have mended his conduct and has also suffered a decree. Considering that this was during the pandemic period, he submits that no action be taken and the contempt be disposed of.

27. Considering the submissions made and after perusal of the emails, this

Court notices that the said Defendant No.3 has written an email dated 8th July, 2020 wherein Defendant No.3 has made certain allegations, both against the counsels and has also not treated the order of the Court with deference.

28. Considering the conduct of Defendant No.3 and thereafter, it suffering a decree dated 11th September, 2020, the Court refrains from passing any orders. However, Defendant No.3 is however given a warning to ensure that any Court order which is passed is fully respected and given effect to and no intemperate language is used against counsels in the future. It is made clear that if there is any repetition of objectionable conduct by Defendant No.3, strict action would be liable to be taken.

29. Copy of this order be served upon Defendant No.3 through Id. Counsel appearing for Defendant No.3, Mr. Rajiv Dalal, as also through the SHO, PS, Janak Puri, so as to ensure that the present order is served upon Defendant No.3, for compliance.

30. With these observations, the present suit is decreed. All pending applications are disposed of in the above terms.

भारतमेव जयते

PRATHIBA M. SINGH
JUDGE

APRIL 18, 2022/dk/ms