

Adobe Systems Incorporated Vs. Sh. Rohit Rathi and anr.

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Court : Delhi

Decided On : May-30-2008

Reported in : 152(2008)DLT646; 2008(104)DRJ208; LC2008(3)380; 2008(37)PTC523(Del)

Judge : Badar Durrez Ahmed, J.

Appeal No. : CS (OS) 1784 /2007

Appellant : Adobe Systems Incorporated

Respondent : Sh. Rohit Rathi and anr.

Advocate for Def. : None

Advocate for Pet/Ap. : Pravin Anand and; Munish Mehra, Advs

Judgement :

Badar Durrez Ahmed, J.

1. The plaintiff, inter alia, seeks a decree of permanent injunction restraining the defendants from using the domain name www.adobeinc.org or using any other business or domain name containing the trademark 'ADOBE' or any other deceptively similar variant of the said trademark on the internet or otherwise so as to amount to infringement of the plaintiff's registered trademark. A permanent injunction restraining the defendants from passing off their goods, services,

business or domain name as that of the plaintiff has also been sought. The plaintiff has also prayed for a mandatory injunction directing the defendant No. 1 and the defendant No. 2 to transfer the domain name www.adobeinc.org to the plaintiff as well as to render all assistance to the plaintiff in bringing about the said transfer. A decree for damages of Rs 20 lakhs has also been sought Along with costs.

2. On 28.09.2007, this Court directed the issuance of summons in the suit, returnable on 19.02.2008. The summons had been served on defendant No. 2 both through registered AD post as well as dasti. This is recorded in the order dated 19.02.2008. However, insofar as the defendant No. 1 was concerned, the only address which was available to the plaintiff was the e-mail address which had been revealed to the plaintiff upon conducting a WHOIS search on the internet. The e-mail address of the defendant No. 1, as revealed is, - rht_rathi@yahoo.com. In the said order dated 19.02.2008, it is further recorded that the physical address given in the WHOIS search is apparently fictitious and incomplete. The mobile telephone number also appeared to be incomplete inasmuch as it comprised of only seven digits, whereas mobile telephone numbers are of ten digits.

3. On 22.02.2008, the learned Counsel for the plaintiff submitted that the summons had been sent to the defendant No. 1 on the aforesaid e-mail address. An affidavit of Mr Gurjot Singh, who is the Head of the IT Department in the plaintiff's lawyers firm, was filed. The affidavit indicated that the summons had been sent through e-mail to the defendant No. 1. A copy of the print out taken from Tata Communications (the e-mail service provider) also indicated that the message had been successfully relayed to rht_rathi@yahoo.com. Consequently, this Court concluded that the defendant No. 1 had been duly served with the summons. By virtue of the said order dated 22.02.2008, since neither of the defendants had entered appearance despite service of summons, they were directed to be proceeded against ex parte. The plaintiff was required to file its affidavits by way of evidence. The plaintiff has filed the affidavit of Mr Anand Banerjee (PW-1) by way of evidence. The said affidavit is marked as Exhibit PW-1/A. Mr Anand Banerjee (PW-1) is the constituted attorney of the plaintiff. A notorised copy of the letter of authority issued in his favor by the plaintiff has been filed.

4. The plaintiff has also filed several documents which have been exhibited as Exhibits P-1 to P-9. The averments made in the plaint have been fully supported by the evidence affidavit of PW-1. It is stated that the plaintiff is a company incorporated in USA. The plaintiff was founded in 1982 and is a software company involved in producing innovative digital imaging software, design and documents technology platform for consumers, creative professionals and enterprises. It has also been stated that the plaintiff employs more than 3700 people around the world and holds more than 250 patents. The plaintiff's popular software applications include ADOBE PHOTOSHOP, ADOBE PAGE MAKER, ADOBE ILLUSTRATOR and ADOBE PREMIER. PW-1 has also stated that the plaintiff, in an effort to give creative design professionals a complete design environment, provides a platform in the form of ADOBE CREATIVE SUITE which combines the best available digital imaging, vector graphics, web publishing, page layout and PDF creation software. The plaintiff carries on business in India including Delhi, through its authorised distributors who offer the whole range of the plaintiff's products. The plaintiff has also established its subsidiary in India - Adobe Systems India Pvt. Ltd, in 1998.

5. The said witness has also stated in his affidavit that the plaintiff is known by its corporate and house name ADOBE which is also its flagship and primary trademark for most of its products. It is stated that the trademark ADOBE has become a well-known mark and is exclusively identified and recognised by the purchasing public as relating to software products of the plaintiff and no other. The plaintiff also has trademark registrations in India in respect of the mark ADOBE and ADOBE ILLUSTRATOR by virtue of registrations in Class-9 bearing registration Nos. 480389 (Exhibit P-3) and 473999 (Exhibit P-4) respectively. It is stated that the mark ADOBE enjoys trans-border reputation and is well-known and recognised in India and that the degree of association of the mark with the plaintiff is so intense that the use of the mark ADOBE or of any other deceptively similar mark by any party unrelated to the plaintiff would be looked upon and understood as having been used by the plaintiff. It is submitted that the mark has become synonymous with the plaintiff company.

6. It is stated by PW-1 that the plaintiff does extensive business on the internet. The websites owned by the plaintiff and their domain names incorporate the plaintiff's mark 'ADOBE' and other allied marks. For example, it is stated that the plaintiff's domain names include:

www.adobe.com;

www.adobemagazine.com; and

www.adobeindia.com.

7. The said witness has affirmed that in August, 2007, the plaintiff discovered that the domain name www.adobeinc.org had been registered by defendant No. 1 through defendant No. 2 (the registering authority) without any authorisation or permission from the plaintiff. It is then that the plaintiff learnt that the defendant No. 1, through the website www.adobeinc.org, was carrying on deceptive commercial activities relating to the plaintiff's products and was using the deceptive and confusing name 'Adobe Inc' as its trading style on the internet. The printouts from the defendant No. 1's website www.adobeinc.org have been filed as Exhibit P-7. The original computer printout of the WHOIS search showing the details of the registration of the defendant No. 1 has been filed as Exhibit P-8. The same reveals that the domain name was created on 25.01.2007. The Sponsoring Registrar has been indicated to be Direct Internet Solutions (defendant No. 2). The registrant's name has been given as 'Rohit' and his e-mail address has been given as rht_rathi@yahoo.com.

8. PW-1 has stated that the defendants and, in particular, the defendant No. 1, have no affiliation or association with the plaintiff and have no legitimate interest in or right to the mark 'ADOBE' or the domain name www.adobeinc.org which incorporates the plaintiffs registered mark ADOBE. It has also been stated that the adoption of the said domain name by the defendants is a clear and mala fide attempt to ride on the popularity of the plaintiff's trademark ADOBE and gain more business and unjustly enrich themselves. It is stated that the inclusion of the mark 'ADOBE' in the domain name Along with the suffix 'inc', which stands for incorporated, has been designed to indicate to the consumers on the internet and

the plaintiff's customers that the said website - www.adobeinc.org - has some affiliation or association with the plaintiff.

9. It is also stated that over the internet, users are accustomed to reaching the websites of well-known brands by keying in the specific words which identify those brands. Consequently, when a user keys in the plaintiff's mark ADOBE, the search engines would return all web pages which include the said word in the domain names. In this way, a person trying to misappropriate the goodwill and reputation of another's trademark can misdirect traffic intended for that person to his website, by incorporating the trademark in the domain name of his website.

10. Since the averments made in the plaint are fully supported by the affidavit (Exhibit PW-1/A) of PW-1 and the supporting documents (Exhibits P-1 to P-9) as also because the same stands uncontroverted, the case of the plaintiff stands proved. The defendant No. 1 has no right over the mark 'ADOBE' which is the registered trademark of the plaintiff. The defendant No. 1 does not manufacture or trade in any product under the name 'ADOBE', nor could he legitimately do so. But, the defendant No. 1 has got the domain name 'www.adobeinc.org' registered in his name. The domain name registration in the name of the defendant No. 1 is clearly unauthorized as the plaintiff has not franchised, licenced or authorised the defendant No. 1 to use the mark 'ADOBE'. The plaintiff is the proprietor of the registered trademark 'ADOBE'. The plaintiff has spent a lot of time, money and effort in developing and marketing its products under the said mark. It is also the registered owner of several domain names which include the mark 'ADOBE'. The plaintiff has a legitimate interest in protecting its mark 'ADOBE' which is well-known world over. On the other hand, the defendant No. 1 does not have any legitimate claim to the mark 'ADOBE'.

11. In these circumstances, the plaintiff has become entitled to the injunctions as prayed for in the prayers contained in para 31 (a), (b) and (c) of the plaint.

12. While the plaintiff is also entitled to a decree for damages, the plaintiff has not led any evidence to indicate the extent of damages caused to the plaintiff by the defendants. However, the learned Counsel for the plaintiff submitted that as decided by this Court in various earlier decisions, punitive damages could be

awarded in such a case. He referred to the following decisions:

1. Time Incorporated v. Lokesh Srivastava and Anr. 2005 (30) PTC 3;
2. Himalaya Drug Company v. Sumit 2006 (32) PTC 112 ;
3. Times Internet Ltd. v. Just Flowers and Anr. 2007 (X) AD (Delhi) 302.

13. Upon considering the pleadings, the evidence and the arguments advanced by the learned Counsel for the plaintiff, the suit is decreed in terms of prayers (a), (b) and (c) as contained in paragraph 31 of the plaint. Insofar as the prayer for damages is concerned, following the principles laid down in the aforesaid decisions, I award punitive damages of Rs 5 lakhs in favor of the plaintiff and against the defendant No. 1.

The suit is decreed accordingly with costs. The formal decree be drawn up.