



IN THE COURT OF XVIII ADDL.CITY CIVIL JUDGE,  
AT BENGALURU CITY [CCH.NO.10]

Dated this day the 28<sup>th</sup> October 2021

PRESENT

Sri. SADANANDA NAGAPPA NAIK, B.A.L., LL.B.  
XVIII Addl.City Civil Judge.

O.S.No.2280/2019

Plaintiffs

1. Milaap Social Ventures India  
Private Ltd.  
A Company registered under the  
Companies Act, having its regd.office  
at No.549, 14<sup>th</sup> Cross, 26<sup>th</sup> Main,  
J.P.Nagar 1<sup>st</sup> Phase,  
Bengaluru – 560 078  
Reptd.by its authorised signatory &  
Director Mr.Mayukh Choudhary.

2. Milaap Social Ventures Pte Ltd.  
A Company registered under the  
Laws of Singapore, Having its office  
at No.79, Ayer Rajah Crescent,  
Block 79, Singapore 139955.  
Reptd. By its authorised signatory  
Mr.Mayukh Choudhary.

**[By Sri.Karan Joseph, Advocate]**

/VS/

Defendants:

1. Google India Private Limited,  
A Company registered under the  
Companies Act, having its regd.office  
at No.3, RMZ Infinity – Tower E,  
Old Madras Road 4<sup>th</sup> & 5<sup>th</sup> Floors,  
Bengaluru – 560 016.  
Reptd.by its Managing Directorate

2. Impact Guru Technology Ventures  
Private Limited,  
A Company registered under the  
Companies Act, having its regd.office  
at No.B-401, Pramukh Plaza,  
Cardinal Gracias Road,  
Andheri East, Bandra Suburban.  
Mumbai 400 099  
Also having its office in Bengaluru  
Reptd. By its Managing Director.  
[By Sri.S.G.P.,Adv. For D1.  
Sri.A.G.V., adv., for D2

ORDERS ON I.A.No.1, 2, 4, 6 & 8

The plaintiff filed I.A.No.1 Under Order 39 Rules 1 and 2 r/w Sec.151 of CPC prays to pass an order of temporary injunction restraining the defendant No.1, its agents, servants and all other persons claiming through or under it from displaying the defendant No. 2 website or diverting traffic to the defendant No. 2 website through the usage of AdWords, keyword, meta tag or in any other

manner whatsoever when the plaintiffs' mark 'MILAAP' is searched for or any of its websites including Google.com/Google.co.in, pending disposal of the suit.

2. The plaintiff filed I.A.No.2 Under Order 39 Rules 1 and 2 r/w Sec.151 of CPC prays to pass an order of temporary injunction restraining the defendant No. 2, its agents, servants and all other persons claiming through or under it from using the plaintiff's name and mark 'MILAAP' for any online or offline activity including in the form of AdWords, keyword, meta tag or in any other manner whatsoever, including on any online search engine such as that of the defendant No.1 pending disposal of the suit.

3. The above applications are enclosed with affidavit of authorised signatory of the plaintiffs wherein it is stated that the plaintiff is incorporated in Bengaluru and Plaintiffs are primarily engaged in the business of facilitating crowdfunding in India across all sectors and classes of persons for charitable purposes such as healthcare, education, sports, disaster relief and other personal causes with great ease. Each charitable purpose is known as crowdfunding campaign which relies solely

on contributions made by the public through the plaintiffs' website. The campaigns are dependent on the reputation, goodwill and trust earned by the plaintiffs to fund their social welfare projects. The plaintiffs were the first in India to introduce the concept of an online crowdfunding platform. The 1<sup>st</sup> plaintiff is the subsidiary of plaintiff No. 2.

4. It is further contended that the plaintiffs' mark and trade name 'MILAAP' has been continually in use in India ever since 2010. The word 'MILAAP', its name and style has been coined by the plaintiffs and is an invented word. The plaintiff is also the owner of the domain name [www.milaap.org](http://www.milaap.org). The plaintiffs applied for registration of its mark and trade name 'MILAAP' under Classes 9 and 36 on 06.12.2016. The plaintiffs have also registered the trademark 'MILAAP' in Singapore and the United States. The plaintiffs receive contributions made by public through the website and registered domain name [www.milaap.org](http://www.milaap.org). Plaintiff's mark has been in continuous use in several countries since its first use in 2010 and boasts of a dominant presence in the niche field of crowdfunding. It has gained considerable goodwill and reputation in the industry. Customers and various

stakeholders of the service industry therefore associate the mark MILAAP exclusively with the plaintiffs. The plaintiff's page on the social network website [www.facebook.com](http://www.facebook.com) has over 12 lakh likes and followers. Plaintiffs have acquired commonlaw rights in respect of the mark and tradename MILAAP. They have also applied for registration of its tradename MILAAP before the trademark registry.

5. It is further contended that the defendants have been deliberately, unfairly and illegally misusing the plaintiffs' mark 'MILAAP' to divert traffic to the website of the defendant No. 2 [www.impactguru.com](http://www.impactguru.com). When a user searches for the plaintiffs' mark 'MILAAP' on Google, the very first entry that appears is that defendant No. 2 and its website. The title to the defendants' website is the plaintiff's mark 'MILAAP'. The use of the name 'MILAAP' by the defendant is amounting to blatant passing off the trade name and mark 'MILAAP'. It is further contended that the 2<sup>nd</sup> defendant is a younger company having been incorporated only in 2015, is using the mark MILAAP with the sole intention of using the same as a bait to generate traffic and direct and misappropriate users who are searching for the plaintiffs services or the MILAAP website on Google. It is further contended that the

plaintiffs and 2<sup>nd</sup> defendant are operate in the same crowdfunding space, as such, there is a grave likelihood of deception and confusion in the minds of customers, business partners, employees and general public. The plaintiffs are prior user and adopter of the mark MILAAP. The 1<sup>st</sup> defendant has facilitated the infringement by the 2<sup>nd</sup> defendant by permitting the plaintiff's mark MILAAP to be used in the Adtitle as an Adtext of their advertisement. The 2<sup>nd</sup> defendant fully intends to continue its blatant misuse of the plaintiffs name and mark, leading to further confusion among customers, and cause the plaintiffs to suffer grave losses and also result in dilution of the plaintiffs' mark. It is further contended that they have made out a prima facie case for grant of injunction as sought and balance of convenience lies in their favour. No hardship or loss will be caused to the defendants, if temporary injunction is granted. Hence, prayed to allow the applications.

6. The 2<sup>nd</sup> defendant has filed memo to adopt the written statement averments as objection to I.A.No.1 & 2. It is the contention of the defendant no.2 that it is engaged in the business of providing financial crowdsourcing services for specific individual and social causes. The principle objective is to leverage technology

and the internet to enable those in pressing need for money, to raise charitable donations from donors across the globe for either personal needs, social causes or creative projects. The 2<sup>nd</sup> defendant is honestly adopted and began using the mark 'Impact Guru' in the year 2015, running its web based crowdsourcing platform <http://www.impactguru.com>. The 2<sup>nd</sup> defendant has leveraged enormous creativity and intellectual labour to develop systems to prevent fraud through its websites, thus making its platform reliable and trust worthy for people to both collect charitable donations and for people to make charitable donations. In the year 2018, along 2<sup>nd</sup> defendant's crowdsourcing platform enabled more than 12,000 life saving surgeries. The 2<sup>nd</sup> defendant with its global partners, global giving and fundnel, has also raised an amount in the region of Rs.50 crores since its inception across the Asian continent. On account of significant success of the defendant No.2's platform, there is a positive impact on the lives of many individuals, and they have been covered by the press extensively. Their website as on date has 400,000 visitors a month. The defendant No.2's quality of services fulfill the objective of ensuring people having a reliable method of making charitable donations.

7. It is further contended that 2<sup>nd</sup> defendant's use of the 1<sup>st</sup> defendant adword service is perfectly lawful and does not in any manner amount to misuse of the trademark of the plaintiffs. 1<sup>st</sup> defendant operates an internet search engine under the name and style of Google. The search engine will display the sites which appear best to correspond to those words, in decreasing order for relevance. Such search results are referred to as natural results of the search.

8. It is further contended that the 1<sup>st</sup> defendant also offers a paid referencing service called 'AdWords'. The AdWord service enables a business owner, to reserve one or more key words used by internet users to search for websites on the 1<sup>st</sup> defendant's search engine. The Adword sponsor's perspective, once the keywords have been reserved using the 1<sup>st</sup> defendant's automated AdWord platform, the AdWord sponser selects the keywords, drafts the commercial message and also creates the link on the advertisement to lead users to their website. The 1<sup>st</sup> defendant uses a pricing model whereby AdWord Sponsors have to pay for every time a user clicks the sponsored ad resulting in a user being directed to the Adword Sponsor's website. The 2<sup>nd</sup>



defendant's website does not contain even a single reference or representation that can remotely be interpreted or construed as 2<sup>nd</sup> defendant passing itself off as the plaintiffs. The 2<sup>nd</sup> defendant has made every effort to prominently showcase its trademark 'Impact Guru' on the website and also explain to users, the source of the crowdsourcing services available on the website [http:// www.impactguru.com](http://www.impactguru.com). The 2<sup>nd</sup> defendant is neither capable nor actually causing detriment to any of the functions of the plaintiffs' alleged mark 'Milaap'. The plaintiffs are not entitled for any remedies against the 2<sup>nd</sup> defendant. Hence, prays to dismiss the applications.

9. The defendant No.2 has filed I.A.No.4 under order 39 Rule 4 R/w Sec.151 CPC praying to vacate the exparte order of injunction dated 12.4.2019 in the above case.

10. The above application is enclosed with affidavit of chief product officer of the 2<sup>nd</sup> defendant wherein he has reproduced the averments of its written statement. It is further contended that they have filed caveat No.109719 and they have been served copy of the plaint

entered appearance on 22.3.2019 and the case was adjourned to 3.4.2019 for filing the written statement. On 3.4.2019, they have filed the written statement and filed memo to adopt the written statement averments as objections to Interlocutory applications filed by the plaintiff. During the hearing on 5.4.2019, they have also advanced its arguments against the grant of injunctions prayed by the plaintiffs. In view of the 2<sup>nd</sup> defendant having filed a caveat, its written statement and statement of objections and also having advanced its arguments against the grant of injunction, the order granting ex parte ad-interim order infavour of plaintiffs in I.A.No.1 is not sustainable in law and on facts. Hence, the impugned order is liable to be vacated. It is further contended that the plaintiffs have not made out prima facie case and the balance of convenience lies in favour of the defendant No.2. If the ex parte order of temporary injunction is not vacated the defendant No.2 will be put to hardship and injury. Hence, prayed to vacate the ex parte order of ad interim injunction by allowing the application.

11. The defendant No.1 has filed I.A.NO.6 under Order 39 Rule 4 R/w Sec.151 CPC praying to

modify/vacate the exparte order dtd.12.4.2019 passed against them in the above case.

12. The above application is enclosed with affidavit of authorised signatory of 1<sup>st</sup> defendant wherein it is contended that the order passed is without jurisdiction and deserves to be vacated. The suit is a commercial dispute within the meaning of the Commercial Courts Act, 2015 and this court does not have jurisdiction to entertain the suit. The plaintiffs have mischaracterized and misrepresented the manner in which the Google Search Engine functions, the Google Ads program operates, and the function performed by Keywords, Keywords as used in the Google Ads program do not perform any trademark function nor do they have commercial relevance by 1<sup>st</sup> defendant, as falsely represented by the plaintiffs. None of the acts performed by the 1<sup>st</sup> defendant amounts to infringement of the plaintiff's alleged trademark rights or passing off, as they are not using the plaintiff's trademark in the course of the trade. The impugned order causes severe prejudice to the 1<sup>st</sup> defendant to the advertisers such as 2<sup>nd</sup> defendant participating in the Google Ads program, and potentially impacts the utility of a search engine as a

means to disseminate information and to enhance user choice. Plaintiffs have materially misrepresented the court that 1<sup>st</sup> defendant permits the 2<sup>nd</sup> defendants to use the plaintiff's trademark MILAAP in the uniform resources locator to divert traffic to its own website. The particular signifier “q=\_\_\_\_\_” is dynamic and shall change upon the search query of each user. Therefore, plaintiff has failed to demonstrate a prima facie case in its favour to indicate any malafides on the part of the defendants.

13. It is further contended that the Google Search is an internet-based search service provided on the websites [www.google.com/www.google.co.in](http://www.google.com/www.google.co.in) using which 3<sup>rd</sup> party data and websites existing on the internet can be searched for by any internet user. An internet user can type its search query, which may consist of a single word or many words at the same time within a box known as the search box. In response to a query entered by a user in the search box, the search algorithm matches the search query with the webpages that have been indexed and displays results that are relevant to the search query. The Google Ads Program is a search-based advertising service on which an advertiser can create and

display an online advertisement for its website. The advertiser can avail of this service by selecting a search term or phrase and providing the 'text' of the advertisement ("Ad") that may be displayed when the keyword is searched by a user.

14. It is further contended that the Google Ads Program is owned, controlled and managed by Google LLC, a company incorporated under the laws of USA, located at 1600 Amphitheatre Parkway, Mountain View, CA 94043. USA and all policies relevant to the said program are formulated and administered by it. The 1<sup>st</sup> defendant is a subsidiary of Google LLC and has been appointed as a non-exclusive reseller of the online advertising space on Google Ads in India. The 1<sup>st</sup> defendant does not act as an agent and instead functions on a principal-to-principal relationship with the Google LLC. The plaintiffs are seeking to extend its trademark rights beyond the scope of its registrations.

15. It is further contended that the MILAAP is a word of common usage in Hindi language which means 'to meet' and has been used since time memorial and has also been used in Hindu Mythology. The word MILAAP

having a clear dictionary meaning does not have the characteristic of an 'invented word' and the plaintiff has therefore, misrepresented the court on the word MILAAP being an invented word. The word MILAAP is devoid of any distinct character and nothing to the contrary has been prima facie proved by the plaintiffs. The statement regarding alleged use claim of 2010 made in the plaint is contrary to the statement made by the 2<sup>nd</sup> plaintiff in their response dtd.2.6.2017 to the examination report issued by the trademark registry. The plaintiffs are attempting to exercise a monopoly over a dictionary word which is used or registered by an extraordinary number of 3<sup>rd</sup> parties but have suppressed these publicly available records of 3<sup>rd</sup> party rights. No violation of trademark laws by incorporating trademarked terms as key word. The users do not get confused by the display of the ads. The Google's Ads practices are as per industry norms, are honest and they benefit consumers.

16. It is further contended that the impugned order causes severe prejudice to 1<sup>st</sup> defendant to advertisers participating in the Google Ads program who are not even parties to the present suit, and potentially impacts the utility of a search engine as means to

disseminate information and to enhance user choice. If the exparte temporary injunction is continued the 1<sup>st</sup> defendant will be put to great hardship. Hence, prayed to vacate the exparte ad-interim injunction by allowing I.A.No.6.

17. The defendant No.1 has also filed rejoinder statement of objections filed by the plaintiffs to I.A.No.6.

18. The defendant No.1 has also filed memo to adopt the affidavit averments of I.A.No.6, as objections to I.A.No.1 & 2.

19. Percontra, the plaintiff has filed objection to IA.No.4 & 6 wherein they have reiterated the affidavit averments of I.A.No.1 & 2 and prayed to dismiss the application.

20. Further contended that the interim order passed in I.A.No.1 pertains to the 1<sup>st</sup> defendant and not the 2<sup>nd</sup> defendant, as such, the 2<sup>nd</sup> defendant does not have any locus to seek vacation of the interim order passed against the 1<sup>st</sup> defendant. The 2<sup>nd</sup> defendant has neither stated in detailed below how it is aggrieved by the

interim order nor has it made out any grounds for vacating the interim order.

21. Further in the objection to I.A.No.6, it is further contended that the application is replete with mistruths and deliberate misleading statements, seemingly concocted with the intent of pressing forth arguments that have no basis in fact or law and to disguise the fact that the 1<sup>st</sup> defendant has willfully disobeyed the interim order. The 1<sup>st</sup> defendant has approached the court with unclean hands and not entitled to any relief. The 1<sup>st</sup> defendant continues to violate the spirit of the interim order by continuing to divert traffic from users searching for MILAAP to the 2<sup>nd</sup> defendant's website as on 27.7.2019. The software deployed by the 1<sup>st</sup> defendant recognises that a user who searches for MILAAP is actually searching for MILAAP and automatically includes the search results that would have arisen had the user searched for MILAAP. Before displaying the results of such a search, 1<sup>st</sup> defendant's website shows an advertisement for IMPACTGURU in an attempt to continue diverting traffic to the 2<sup>nd</sup> defendant's website. These actions of 1<sup>st</sup> defendant constitute a conscious, willful and devious violation of the interim



order. The plaintiffs have suffered losses on account of the 1<sup>st</sup> defendant's actions. On the above grounds, prayed to dismiss I.A.NO.4 & 6.

22. The plaintiff filed IA.No.8 under order 6 rule 17 R/w Sec.151 CPC praying to permit the plaintiffs to amend the plaint.

23. The above application is enclosed with affidavit of authorised person wherein it is contended that at the time of filing the suit, the application of the plaintiffs for registration of trademark MILAAP was pending before trademark registry. After filing of the suit, the trademark registry registered their trademark under No.3428351 dtd.6.11.2019 in favour of the plaintiff No.2. The amendment sought for is only to incorporate the factum of registration of their trademark and consequent reliefs. The trial has not commenced. The application is necessary for determining real questions in controversy between the parties. Hence, prayed to allow the application.

24. The above application is opposed on behalf of 1<sup>st</sup> defendant wherein it is contended that they have filed the written statement and interim application under

order 39 Rule 4 CPC. The application is filed only to convert the suit for infringement from passing off and same is not maintainable. Admittedly, as on the date of institution of suit and occurrence of cause of action for filing the suit, 2<sup>nd</sup> plaintiff application for registration of trademark MILAAP was pending. Therefore, an action for infringement of trademark would not have been maintainable. An action of infringement will not lie before the actual date on which the trademark is registered. The proposed amendment changes the very nature of the suit and introduces new cause of action. The application is filed at belated stage. The proposed amendment to the reliefs in the suit will convert the suit into another of different and inconsistent character and the application deserves to be dismissed. The infringement proceedings can only arise from the actual date of registration of the trademark. There being no registration of trademark as on the date of the institution of the suit, the plaintiffs are not entitled to sue for damages for infringement of their trademark. On the above grounds, prayed to dismiss the application.

25. Heard the arguments on both sides and perused the contentions made out. The counsel for the plaintiffs has relied on the following decisions:

1. Judgment of Hon'ble High Court of Delhi in C.S.(O.S.) No.2623/2014 between Columbia Sportswear Company Vs. Harish Footwear & Another
2. (2004) 3 SCC 90 – Midas Hygiene Industries (P) Ltd & Anr. Vs. Sudhir Bhatia & Ors.
3. 2018 SCC Online Del.12215 – Christian Louboutin Sas Vs.Nakul Bajaj & Ors.
4. (2002) 3 SCC 65 – Laxmikant Vs.Patel Vs. Chetanbhai Shan & Anr
5. (2012) 5 LW 1(Mad) – Consim Info Pvt. Ltd. Vs. Google India Pvt. Ltd.
6. Judgment of Hon'ble High Court of Bombay in Suit (L) No.622/2014 between People Interactive (I) Pvt.Ltd.Vs. Gaurav Jerry.
7. Judgment of Hon'ble High Court of Delhi in CS(OS) 784/2013 between World Wrestling Entertainment Inc.Vs. Savio Fernandes.
8. AIR 2019 Mad 133 – Matrimony Com Ltd.Vs.Thodu Needa Telugu Matrimony.
9. (2019) 2 ICC 872 – Microsoft Corprn. Vs. Rajesh Duseja & Ors.
10. Judgment of Hon'ble Supreme Court in SLP © 22081/2016 – Google India Pvt.Ltd. Vs. Blueberry Books & Ors.

11. Judgment of Hon'ble High Court of Punjab & Haryana in CR.No.7034/2012 (O & M) -Google India Pvt. Ltd. Vs. M/s. Shree Krishna International & Ors.
12. 2017- SCC Online Del.11885 – Cable News Network, Inc. Vs.Rm.Anshu Jain & Anr.
13. ILR (2009) II DELHI 193 – Mattel Inc. & Ors. Vs. Mr.Jayant Agarwalla & Ors.
14. Judgment of Hon'ble High Court of Delhi in CS(COMM) 1200/2018 – Mohalla Tech Pvt. Ltd. Vs.Bytedance Inc. & Ors.
15. Orders of Hon'ble High Court of Delhi in CS(OS)594/2013 – HSIL Ltd. Vs. Omkara Infoweb Pvt. Ltd.& Ors.
16. Orders of Hon'ble High Court of Delhi in CS(COMM) 66/2019- IBIBO Group Pvt. Ltd. Vs. Happy Easy Go India Pvt. Ltd & Ors.
17. Orders of Hon'ble High Court of Delhi in CS(COMM) 889/2018- Make My Trip (India) Pvt.Ltd. Vs., Make My Travel (India) Pvt.Ltd.
18. Orders of Hon'ble High Court of Delhi in CS(COMM) 416/2017 Matrix Cellular(International) Services Ltd. Vs. TSIM communication Services Pvt.Ltd.
19. 2014 SCC Online Del 6573 – Banyan Tree Holding P Ltd. Vs.Jamshyad Sethna & Anr.
20. (2013) 198 DLT 407 (DB) Flight Center Travels Pvt. Ltd. Vs. Flight Centre Ltd. & Anr.

21. 2002(25) PTC 184 (DB) – Usha International & Anr. Vs. Usha Television Ltd.
22. 2009(109) DRJ 607 – Vatika Resorts Pvt.Ltd. Vs. Vatika Grand
23. 2018 (73) PTC 388(DEL) – Columbia Sportswear Company Vs. Harish Footwear & Ors.
- 24.(2012) 129 DRJ1- Anchor Health and Beauty Care Pvt. Ltd. Vs. Kausik.
- 25.(2006) 6 SCC 498 – Baldev Singh & Ors. Vs. Manohar Singh & Ors.
26. (2018) LIC of India Vs. Sanjeev Builders (P) Ltd.
- 27.(2000) 1 SCC 712 – B.K.Narayana Pillai Vs. Parameswaran Pillai.
28. 011 SCC Online Mad 780 – Thalappakatti Naidu Ananda Vilas Biriyani Hotel Vs.Thalapakattu Biriyani & Fast Food.
29. 2010(42) PTC 480(Karn) Presteege Property Developers & Ors. Vs. Prestige Estates Projects Pvt.Ltd.
30. (2001) 3 CTC 652 – Premier Distilleries Pvt. Ltd. Vs.Sushi Distilleries.

The counsel for the defendant No.1 has relied on the following decisions:

1. (2016) FCA 255- Veda Advantage Ltd. Vs. Malouf Group Enterprises Pty.Ltd.

2. (2004) EWCA (Civ) 159 of Supreme Court of Judicature Court of Appeal (Civil Division) London – Reed Executive Plc & Anr. Vs. Reed Business Information Ltd.& Ors.
3. 307 F.Supp.3d 260 United States District Court for the Southern District of New York – Alzheimer's Disease & Related Disorders Assn. Vs. Alzheimer's Found of Am., Inc.
4. (2016) ZACSCA 74 (Supreme Court of Appeal South Africa) – Cochrane Steel Products (Pty) Ltd. Vs. M.Systems Group(Pty) Ltd & Anr.
5. (2010) A.J.No.7172 (Quebec Superior Court) Chocolat Lmontagne Inc.Vs. Humeur Groupe Conseil Inc.
- 6.2008 (38) PTC 185 (Del) Warner Bros. Entertainment Inc.& Anr. Vs. Harinder Kohli & Ors.
7. 2019 SCC Online Bom 1612 – Aegon Life Insurance Co. Ltd. Vs. Aviva Life Insurance Co.India Ltd.
8. 217 BCCA 41 Courtof Appeals British Columbia Canada – Vancouver Community CollegeVs. Vancouver Career College (Burnaby)
- 9.2010 BCSC 765 – Supreme Court of British Columbia Vancouver, Canada – Private Career Training Vs. Vancouver Career College (Burnaby) Inc.
10. 2010(114) DRJ 296(DB)- Rajveer Food Marketing (I) Pvt. Ltd. Vs. Amrit Banaspati Company Ltd.

11. 2011 SCC Online Mad 780 – Thalappakatti Naidu Ananda Vilas Biryani Hotel Vs.Thalapakattu Biryani & Fast Food.
12. 2010(42) PTC 480(Karn) Presteege Property Developers & Ors. Vs. Prestige Estates Projects Pvt.Ltd.
13. (2001) 3 CTC 652 – Premier Distilleries Pvt. Ltd. Vs.Sushi Distilleries.
14. MANU/TN/3919/2016-Maya Appliances (P) Ltd. Vs. Urooj Ahmed Lords Enterprises (India)
15. (2009) 10 SCC 84 – Revajeetu Builders & Developer Vs. Narayanaswamy & Sons.
- 16.(2006) 12 SCC 19 – State of A.P. Vs. Pioneer Builders.
17. 1967 SCC Online AP 136 – Chilakuru Chenchurami Reddy Vs. Kanupuru Chenchuram Reddy.
18. MANU/SC/0016/1979 – Meenakshisundaram Chettiar Vs. Venkatachalam Chettiar.
19. MANU/DE/0158/1986 – Commercial Aviation & Travel Co.(Inc) & Ors. Vs. Vimla Panna Lal.
20. MANU/SC/0367/2019 – Raghvendra Sharan Singh Vs. Ram Prasanna Singh(Dead) y Lrs.
21. MANU/SC/0403/2005 – N.V.Srinivasa Murthy & Ors. Vs. Mariyamma (Dead) by Proposed Lrs. & Ors.
22. MANU/SC/0034/1977- T.Arvindam Vs. T.V.Satyapal & Ors.

23. MANU/DE/3110/2009 – Ravindra Kishore sinha Vs. Manjula Bhushan
24. MANU/MH/0206/2013 – Ketankumar M.Sharma Vs. Vasantkumar Meganlal Patel.
25. MANU/UP/0794/1998 – Umesh Chandra Saxena & Ors. Vs. Administrator General & Ors.
26. (2008) 10 SCC 479 – K.Narayanan Vs. S.Murali
27. 2010 SCC Online Cal.134 – Three-N-Products Pvt.Ltd. Vs. Emami Ltd.
28. MANU/TN/0237/1978 – Nestle's Products (India) Ltd. Vs. P.Thankaraja & Ors.
29. MANU/DE/0011/2018 – Three N Products Pvt. Ltd. Vs. Kairali Exports & Ors.
30. AIR 1992 DEL 197 – Seemax Construction (P) Ltd. Vs. State Bank of India
31. ILR (2001) 2 Del 690 – Rohit Dhawan Vs. G.K.Malhotra.
32. (1994) 1 SCC 1 -S.P.Chengalvaraya Naidu Vs. Jagannath.
- 33.(2012) 11 SCC 57 - Badami Vs.Bhali.

The counsel for the defendant No.2 has relied on the following decisions:



1. 2017 SCC Online Bom.394 – Cello Household Products Vs. Modware India.
2. 2010(6) CTC 813 – Consim Info Pvt. Ltd. Vs. Google India Pvt.Ltd.
3. 2013 SCC Online Bom 1168 – Salim Khan & Anr.Vs. Sumeet Prakash Mehra & Others.
4. 2020 SCC Online Bom.989 – Plex Inc. Vs. Zee Entertainment Enterprises Ltd.
5. Orders of Hon'ble High Court of Delhi in CS(COMM) 260/2019 – Policybazar Insurance Web Aggregator & Anr.Vs. Acko General Insurance Ltd. & Ors.

I have considered the the arguments advanced by both counsels and the rulings relied by the plaintiff with utmost reverence.

26. The points that arise for my consideration are as follows:

- (1) Whether the plaintiffs have made out a prima facie case for grant of ad-interim temporary injunction as prayed in I.A.No.1 & 2?
- (2) Whether the plaintiffs prove that the balance of convenience lies in their favour?
- (3) Whether the plaintiffs will be put to irreparable loss and hardship if an order of an-interim injunction is not granted?

- (4) Whether the defendant No.1 & 2 had made out grounds to vacate exparte temporary injunction as prayed in IA.No.4 & 6?
- (5) Whether the plaintiffs have made out grounds to allow I.A.No.8?
- (6) What order?

27. My answer to the above points are as follows:

- Point No.1 : In the negative  
Point No.2 : In the negative  
Point No.3 : In the negative  
Point No.4 : In the affirmative  
Point No.5 : In the negative  
Point No.6 : As per final order,

For the following reasons:

### REASONS

28. Point No.1 to 5:- It is the contention of the plaintiffs that the plaintiff is incorporated in Bengaluru and Plaintiffs are primarily engaged in the business of facilitating crowdfunding in India across all sectors and classes of persons for charitable purposes. Each charitable purpose is known as crowdfunding campaign which relies solely on contributions made by the public through the plaintiffs' website. The campaigns are dependent on the reputation, goodwill and trust earned by the plaintiffs to fund their social welfare projects. The plaintiffs were the first in India to introduce the concept

of an online crowdfunding platform. The 1<sup>st</sup> plaintiff is the subsidiary of plaintiff No. 2.

29. It is further contended that the plaintiffs' mark and trade name 'MILAAP' has been continually in use in India ever since 2010. The word 'MILAAP', its name and style has been coined by the plaintiffs and is an invented word. The plaintiff is also the owner of the domain name [www.milaap.org](http://www.milaap.org). The plaintiffs applied for registration of its mark and trade name 'MILAAP' under Classes 9 and 36 on 06.12.2016. The plaintiffs have also registered the trademark 'MILAAP' in Singapore and the United States. The plaintiffs receive contributions made by public through the website and registered domain name [www.milaap.org](http://www.milaap.org). Plaintiff's mark has been in continuous use in several countries since its first use in 2010 and boasts of a dominant presence in the niche field of crowdfunding. It has gained considerable goodwill and reputation in the industry. Customers and various stakeholders of the service industry therefore associate the mark MILAAP exclusively with the plaintiffs. The plaintiff's page on the social network website [www.facebook.com](http://www.facebook.com) has over 12 lakh likes and followers. Plaintiffs have acquired commonlaw rights in respect of

the mark and tradename MILAAP. They have also applied for registration of its tradename MILAAP before the trademark registry.

30. It is further contended that the defendants have been deliberately, unfairly and illegally misusing the plaintiffs' mark 'MILAAP' to divert traffic to the website of the defendant No. 2 [www.impactguru.com](http://www.impactguru.com). When a user searches for the plaintiffs' mark 'MILAAP' on Google, the very first entry that appears is that defendant No. 2 and its website. The title to the defendant's website is the plaintiff's mark 'MILAAP'. The use of the name 'MILAAP' by the defendant is amounting to blatant passing off the trade name and mark 'MILAAP'. It is further contended that the 2<sup>nd</sup> defendant is a younger company having been incorporated only in 2015, is using the mark MILAAP with the sole intention of using the same as a bait to generate traffic and direct and misappropriate users who are searching for the plaintiffs services or the MILAAP website on Google. It is further contended that the plaintiffs and 2<sup>nd</sup> defendant are operate in the same crowdfunding space, as such, there is a grave likelihood of deception and confusion in the minds of customers, business partners, employees and general public. The plaintiffs are prior user and adopter of the mark MILAAP.

The 1<sup>st</sup> defendant has facilitated the infringement by the 2<sup>nd</sup> defendant by permitting the plaintiff's mark MILAAP to be used in the Adtitle as an Adtext of their advertisement. The 2<sup>nd</sup> defendant fully intends to continue its blatant misuse of the plaintiffs name and mark, leading to further confusion among customers, and cause the plaintiffs to suffer grave losses and also result in dilution of the plaintiffs' mark.

31. Further contended that the interim order passed in I.A.No.1 pertains to the 1<sup>st</sup> defendant and not the 2<sup>nd</sup> defendant, as such, the 2<sup>nd</sup> defendant does not have any locus to seek vacation of the interim order passed against the 1<sup>st</sup> defendant. The 2<sup>nd</sup> defendant has neither stated in detailed below how it is aggrieved by the interim order nor has it made out any grounds for vacating the interim order.

32. Further in the objection to I.A.No.6, it is further contended that the application is replete with mistruths and deliberate misleading statements, seemingly concocted with the intent of pressing forth arguments that have no basis in fact or law and to disguise the fact that the 1<sup>st</sup> defendant has willfully disobeyed the interim order. The 1<sup>st</sup> defendant has approached the court with

unclean hands and not entitled to any relief. The 1<sup>st</sup> defendant continues to violate the spirit of the interim order by continuing to divert traffic from users searching for MILAAP to the 2<sup>nd</sup> defendant's website as on 27.7.2019. The software displayed by the 1<sup>st</sup> defendant recognises that a user who searches for MILAAP is actually searching for MILAAP and automatically includes the search results that would have arisen had the user searched for MILAAP. Before displaying the results of such a search, 1<sup>st</sup> defendant's website shows an advertisement for IMPACTGURU in an attempt to continue diverting traffic to the 2<sup>nd</sup> defendant's website. These actions of 1<sup>st</sup> defendant constitute a conscious, willful and devious violation of the interim order. The plaintiffs have suffered losses on account of the 1<sup>st</sup> defendant's actions. On the above grounds, prayed to dismiss I.A.NO.4 & 6.

33. On the other hand, it is the contention of the defendant No.1 that the order passed is without jurisdiction and deserves to be vacated. The plaintiffs have mischaracterized and misrepresented the manner in which the Google Search Engine functions, the Google Ads program operates, and the function performed by Keywords, Keywords as used in the Google Ads program

do not perform any trademark function nor do they have commercial relevance by 1<sup>st</sup> defendant, as falsely represented by the plaintiffs. None of the acts performed by the 1<sup>st</sup> defendant amounts to infringement of the plaintiff's alleged trademark rights or passing off, as they are not using the plaintiff's trademark in the course of the trade. The impugned order causes severe prejudice to the 1<sup>st</sup> defendant to the advertisers such as 2<sup>nd</sup> defendant participating in the Google Ads program, and potentially impacts the utility of a search engine as a means to disseminate information and to enhance user choice. Plaintiffs have materially misrepresented the court that 1<sup>st</sup> defendant permits the 2<sup>nd</sup> defendants to use the plaintiff's trademark MILAAP in the uniform resources locator to divert traffic to its own website. The particular signifier "q=\_\_\_\_\_" is dynamic and shall change upon the search query of each user. Therefore, plaintiff has failed to demonstrate a prima facie case in its favour to indicate any malafides on the part of the defendants.

34. It is further contended that the Google Search is an internet-based search service provided on the websites [www.google.com/www.google.co.in](http://www.google.com/www.google.co.in) using which

3<sup>rd</sup> party data and websites existing on the internet can be searched for by any internet user. An internet user can type its search query, which may consist of a single word or many words at the same time within a box known as the search box. In response to a query entered by a user in the search box, the search algorithm matches the search query with the webpages that have been indexed and displays results that are relevant to the search query. The Google Ads Program is a search-based advertising service on which an advertiser can create and display an online advertisement for its website. The advertiser can avail of this service by selecting a search term or phrase and providing the 'text' of the advertisement ("Ad") that may be displayed when the keyword is searched by a user.

35. It is further contended that the Google Ads Program is owned, controlled and managed by Google LLC, a company incorporated under the laws of USA. All policies relevant to the said program are formulated and administered by it. The 1<sup>st</sup> defendant is a subsidiary of Google LLC and has been appointed as a non-exclusive reseller of the online advertising space on Google Ads in India. The 1<sup>st</sup> defendant does not act as an agent and



instead functions on a principal-to-principal relationship with the Google LLC. The plaintiffs are seeking to extend its trademark rights beyond the scope of its registrations.

36. It is further contended that the MILAAP is a word of common usage in Hindi language which means 'to meet' and has been used since time memorial and has also been used in Hindu Mythology. The word MILAAP having a clear dictionary meaning does not have the characteristic of an 'invented word' and the plaintiff has therefore, misrepresented the court on the word MILAAP being an invented word. The word MILAAP is devoid of any distinct character and nothing to the contrary has been prima facie proved by the plaintiffs. The statement regarding alleged use claim of 2010 made in the plaint is contrary to the statement made by the 2<sup>nd</sup> plaintiff in their response dtd.2.6.2017 to the examination report issued by the trademark registry. The plaintiffs are attempting to exercise a monopoly over a dictionary word which is used or registered by an extraordinary number of 3<sup>rd</sup> parties but have suppressed these publicly available records of 3<sup>rd</sup> party rights. No violation of trademark laws by incorporating trademarked terms as key word. The users do not get confused by the display

of the ads. The Google's Ads practices are as per industry norms, are honest and they benefit consumers.

37. It is further contended that the impugned order causes severe prejudice to 1<sup>st</sup> defendant to advertisers participating in the Google Ads program who are not even parties to the present suit, and potentially impacts the utility of a search engine as means to disseminate information and to enhance user choice. If the exparte temporary injunction is continued the 1<sup>st</sup> defendant will be put to great hardship. Hence, prayed to vacate the exparte ad-interim injunction by allowing I.A.No.6.

38. Percontra, it is the contention of the defendant no.2 that it is engaged in the business of providing financial crowdsourcing services for specific individual and social causes. The principle objective is to leverage technology and the internet to enable those in pressing need for money, to raise charitable donations from donors across the globe for either personal needs, social causes or creative projects. The 2<sup>nd</sup> defendant is honestly adopted and began using the mark 'Impact Guru' in the year 2015, running its web based crowdsourcing platform <http://www.impactguru.com>. The 2<sup>nd</sup> defendant has leveraged enormous creativity and intellectual labour

to develop systems to prevent fraud through its websites, thus making its platform reliable and trust worthy for people to both collect charitable donations and for people to make charitable donations. In the year 2018, along 2<sup>nd</sup> defendant's crowdsourcing platform enabled more than 12,000 life saving surgeries. The 2<sup>nd</sup> defendant with its global partners, global giving and fundnel, has also raised an amount in the region of Rs.50 crores since its inception across the Asian continent. On account of significant success of the defendant No.2's platform, there is a positive impact on the lives of many individuals and they have been covered by the press extensively. Their website as on date has 400,000 visitors a month. The defendant No.2's quality of services fulfill the objective of ensuring people having a reliable method of making charitable donations.

39. It is further contended that 2<sup>nd</sup> defendant's use of the 1<sup>st</sup> defendant adword service is perfectly lawful and does not in any manner amount to misuse of the trademark of the plaintiffs. 1<sup>st</sup> defendant operates an internet search engine under the name and style of Google. The search engine will display the sites which appear best to correspond to those words, in decreasing

order for relevance. Such search results are referred to as natural results of the search.

40. It is further contended that the 1<sup>st</sup> defendant also offers a paid referencing service called 'AdWords'. The AdWord service enables a business owner, to reserve one or more key words used by internet users to search for websites on the 1<sup>st</sup> defendant's search engine. The Adword sponsor's perspective, once the keywords have been reserved using the 1<sup>st</sup> defendant's automated AdWord platform, the AdWord sponser selects the keywords, drafts the commercial message and also creates the link on the advertisement to lead users to their website. The 1<sup>st</sup> defendant uses a pricing model whereby AdWord Sponsors have to pay for every time a user clicks the sponsored ad resulting in a user being directed to the Adword Sponsor's website. The 2<sup>nd</sup> defendant's website does not contain even a single reference or representation that can remotely be interpreted or construed as 2<sup>nd</sup> defendant passing itself off as the plaintiffs. The 2<sup>nd</sup> defendant has made every effort to prominently showcase its trademark 'Impact Guru' on the website and also explain to users, the source of the crowdsourcing services available on the

website [http:// www.impactguru.com](http://www.impactguru.com). The 2<sup>nd</sup> defendant is neither capable nor actually causing detriment to any of the functions of the plaintiffs' alleged mark 'Milaap'. The plaintiffs are not entitled for any remedies against the 2<sup>nd</sup> defendant. Hence, prays to dismiss the applications.

41. It is further contended by the 2<sup>nd</sup> defendant that It is further contended that they have filed caveat No.109719 and they have been served copy of the plaint entered appearance on 22.3.2019 and the case was adjourned to 3.4.2019 for filing the written statement. On 3.4.2019 they have filed the written statement and filed memo to adopt the written statement averments as objections to Interlocutory applications filed by the plaintiff. During the hearing on 5.4.2019, they have also advanced its arguments against the grant of injunctions prayed by the plaintiffs. In view of the 2<sup>nd</sup> defendant having filed a caveat, its written statement and statement of objections and also having advanced its arguments against the grant of injunction, the order granting ex parte ad-interim order infavour of plaintiffs in I.A.No.1 is not sustainable in law and on facts. Hence, the impugned order is liable to be vacated. It is further

contended that the plaintiffs have not made out prima facie case and the balance of convenience lies in favour of the defendant. If the ex parte order of temporary injunction is not vacated the defendant will be put to hardship and injury. Hence, prayed to vacate the ex parte order of ad interim injunction by allowing the application.

42. The learned counsel for the plaintiffs Sri.Karan Joseph, has argued that plaintiffs have started the business on 11.7.2012 as per document No.1. Defendant No.2 has started the business on 29.1.2015. Plaintiffs are in the news for many years as it is a crowdfunding company. Plaintiff is the market leader in crowdfunding. As on 26.01.2019, the plaintiff had over 1.21 Million monthly visits to its website. That on 6.12.2016, the plaintiffs have filed for registration of trademark application and the same was allowed during the pendency of the present suit on 6.11.2019. When the trade mark application is allowed, it will relate back to the date of application. It is argued that in a competent proceedings, the subsequent events could be of course be taken into consideration. The plaintiffs are the owner of the word mark MILAAP and it is also registered in Singapore and many other countries. In order to take

advantage of plaintiffs popularity, the 2<sup>nd</sup> defendant began illegally using the plaintiffs trademark MILAAP. In fact, if some one searched a MILAAP in 1<sup>st</sup> defendant's website it will give the first result as 2<sup>nd</sup> defendant. In order to ensure 2<sup>nd</sup> defendant to coming first result, defendant No.2 to bids on the word MILAAP and Google sells the word MILAAP to Defendant No.2. As a consideration of such arrangement, Impact guru diverts traffic to its own website on the strengths of plaintiffs trademark. This is causing confusion among the customers of the plaintiff. If some one wants to donate money to the plaintiff's beneficiaries, they are forcefully drawn to the website of the 2<sup>nd</sup> defendant by the 1<sup>st</sup> defendant. Further, 2<sup>nd</sup> defendant's website is also bearing the key word MILAAP. It is argued that if the defendants were not deriving commercial benefit why they do want to use the trademark of plaintiff and there is no reason for bidding or selling or otherwise utilizing it. It is argued that the use for the purpose of the act is not restricted to merely printed or other visual representation of the mark, but rather in relation to the goods and services in any manner. The use of trademark in advertising clearly falls within the ambit of use. Sec. 29(7) to (9) Trademark act prohibits Unauthorized

advertisement. The defendants are well aware that they are not authorised by the plaintiffs to use the mark. Defendant No.2 make a payment to 1<sup>st</sup> defendant for the word. Such arrangement is not a honest trade practice under Sec.29(8) of TM Act. There is no delay in filing the present suit. Defendant No.1 cannot escape from the liability contending that Adword service is provided by foreign Google entities. Google cannot escape for the liability contending that it is an intermediary which is exempt under IT Act. It is argued that Google plays an active role in identifying, suggesting and selling keywords through Adword program. The plaintiffs have also got issued notice to the defendants and they have also received reply from the defendants. On these grounds, prayed to grant the temporary injunction and to allow amendment application.

43. Percontra, the learned Senior Counsel Sri.Sajjan Poovaiah appearing for the defendant No.1 has argued that plaintiffs and 2<sup>nd</sup> defendant are involved in crowd funding business. However, 1<sup>st</sup> defendant is a search engine and do not involved in the similar business as of the plaintiffs and 2<sup>nd</sup> defendant. It is argued that it is the contention of the plaintiffs that if some one



searches for MILAAP in 1<sup>st</sup> defendant's search engine, plaintiffs' name only should be shown and others name should not be shown. The word MILAAP has got dictionary meaning. The word MILAAP is to mean 'come together'. In fact, defendant no.1 is not a competitor to the plaintiffs business. Infact, plaintiffs and 2<sup>nd</sup> defendant are competitors. It is the contention of the plaintiffs that 1<sup>st</sup> defendant has faciliated Addtitle and Addtext. In fact, the practice of Addtitle and Addtext is followed since the old period. In earlier dates, during the international sports, if some company used display major soft drinks name, major soft drinks competitors name also get displayed by its competitors. If major sports shoes company name used to get displayed, their competitor name also used to get displayed. In fact, if some one advertises their businesses in the 2<sup>nd</sup> page of the newspaper, the competitor may want to advertise their brand in the first page itself. These advertisements will not in any way infringes any one's copyright or trademark. It is the contention of the plaintiffs that whenever some one searches for the name MILAAP, their name should come on the top and not the 2<sup>nd</sup> defendant's name. Infact MILAAP is not a coined word. It has a

dictionary meaning. The same is valid under the Trademarks Act.

44. Referring to Sec.2(2)(b) of Trademarks Act, it is argued that in order to attract infringement of trademark such trademark must have been used by the defendants. In the present case, there is no visual representation made by the 1<sup>st</sup> defendant. Such use must be always refer to printed or visual representation of the mark. There is no visual or printed representation of the mark by the defendant No.1. Further, Sec.29 (1) of the Act, provides that if the trademark is used in the course of trade in such manner, that would become infringement. In the present case, there is no use of the trademark of the plaintiffs by the 1<sup>st</sup> defendant. Further Sec.29(9) of the Act, refers to spoken or visual term. In fact, 1<sup>st</sup> defendant is not running a charity show. 1<sup>st</sup> defendant is only an indexing tool. It is just like a library/catalogue having 1.3 crores books. If somebody searches for key word, it would come up with particular result. In fact, 2<sup>nd</sup> defendant is using the key word MILAAP to trigger the result for IMPACT GURU. 2<sup>Nd</sup> defendant is not using the MILAAP in a digital or sound form. Only triggering a search do not amount to infringement of trademark. In

fact, as per Sec.29 (2) and 29(4) of Trademark Act, in order to attract passing off or infringement goods should be identical and similar. In the present case, if the plaintiffs are crowdfunding, 1<sup>st</sup> defendant is a search engine. There is no identity or similarity. The real dispute is between the plaintiffs and 2<sup>nd</sup> defendant. If the plaintiffs are injuncting 2<sup>nd</sup> defendant, then injuncting 1<sup>st</sup> defendant do not arise for consideration. 1<sup>st</sup> defendant is not a necessary party in the suit. It is argued that even on perusal of the plaintiffs' document, entire text result of 2<sup>nd</sup> defendant do not contain the word MILAAP. It is further argued that meta tags are neither used by Google in the organic search results nor are part of sponsored links/Ad section. Trademark policy for Google ads do not restrict trademarks as keywords. Exparte orders are obtained by suppressing material facts that plaintiff are users of Google Ads programme and they also bidding for adwords. Plaintiff is bidding for 'GofundMe' mark which is another crowd funding website. Google has complied the interim order dated 12.4.2019. Bidding on keywords to trigger Ads based on such keywords do not amount to use of trademark. Federal courts of Australia in Veda Advantage (supra) has held that use a of a Trademark as a keyword which is invisible to the customer do not

amount to use a trademark. Supreme court of London in Red Executive Plc., has observed that an invisible use of such sort may not be use at all. The Newzeland court in NZ Fintech held that an advertiser is not using the keyword as badge of origin for its goods and services and therefore do not amounts to use as a trademark. It is further argued that there is no case of infringement of trademark under any part of Sec.29 of Trademarks Act. Also relied on Google France SARL supra to contend that use of a trademark by search engine is not use or use in the course of trade or in relation to goods. Further argued that plaintiffs failed to establish ingredients of passing off in relation to the trademark of MILAAP. There is no likelihood of confusion. On these grounds, prayed to dismiss the applications of the plaintiffs and vacate the interim order.

45. On the amendment application, it is argued that once the trademark application is allowed, that will generally relates back to the date of application. Even if during the pendency of the suit, if the amendment application is allowed, the same will relates back to the date of filing of the suit. In the present case, plaintiffs were an unregistered owner of the MILAAP at the time of

filing the suit. If the amendment is allowed, it will make the suit one for infringement of the trademark. The same leads to change in cause of action. The same is not permissible under the Trademarks Act. Whether there is a infringement or passing off, it is a matter of trial. If the amendment is allowed, same will cause hardship to the 1<sup>st</sup> defendant as there is no cause of action for infringement suit as on the date of filing the suit. Even if it is assumed that the present suit is for infringement, there is no infringement of the trademark by the defendant no.1. Infact the courts in US, UK, South Africa have categorically held that just by triggering results the same would not amount to infringement of trademark. On these grounds, prayed to dismiss the amendment application.

46. In the above circumstances, whether the plaintiffs have made out a grounds for grant of temporary injunction and allow the amendment or defendant has made out ground to vacate ad interim injunction, we may refer to relevant provisions and case laws on the subject. The relevant provisions and the case laws are extracted hereunder:

**Civil Procedure Code 1908**

**Order-XXXIX, Rule-1.** Cases in which temporary injunction may be granted.- Where in any Suit it is proved by affidavit or otherwise—

- (a) that any property in dispute in a suit is in danger of being wasted, damaged or alienated by any party to the suit, or wrongfully sold in execution of a decree, or
- (b) that the defendant threatens, or intends, to remove or dispose of his property with a view to defrauding his creditors,
- (c) that the defendant threatens to dispossess the plaintiff or otherwise cause injury to the plaintiff in relation to any property in dispute in the suit, the court may by Order grant a temporary injunction to restrain such act, or make such other Order for the purpose of staying and preventing the wasting, damaging, alienation, sale, removal or disposition of the property or dispossession of the plaintiff, or otherwise causing injury to the plaintiff in relation to any property in dispute in the suit] as the court thinks fit, until the disposal of the suit or until further orders.

**Order-XXXIX, Rule-2.** Injunction to restrain repetition or continuance of breach.-

- (1) In any suit for restraining the defendant from committing a breach of contract or other injury of any kind, whether compensation is claimed in the suit or not, the plaintiff may, at any time after the commencement of the suit, and either before or after judgment, apply to the court for a temporary injunction to restrain the defendant from committing the breach of

contract or injury complained of, or any breach of contract or injury of a like kind arising out of the same contract or relating to the same property or right.

(2) The court may by Order grant such injunction, on such terms, as to the duration of the injunction, keeping an account, giving security, or otherwise, as the court thinks fit.

### **Order XXXIX Rule 3**

Before granting injunction, Court to direct notice to opposite party:

The Court shall in all cases, except where it appears that the object of granting the injunction would be defeated by the delay, before granting an injunction, direct notice of the application for the same to be give to the opposite party:

Provided that, where it is proposed to grant an injunction without giving notice of the application to the opposite party, the Court shall record the reasons for its opinion that the object of granting the injunction would be defeated by delay, and require the applicant- (a) to deliver to the opposite party, or to send to him by registered post, immediately after the order granting the injunction has been made, a copy of the application for injunction together with-

- (i) a copy of the affidavit filed in support of the application;
- (ii) a copy of the plaint; and

(iii) copies of documents all which the applicant relies, and

(b) to file. on the day on which such injunction is granted or on the day immediately following, that day, an affidavit stating that the copies aforesaid have been so delivered or sent.

**Order XXXIX Rule 4** Order for injunction may be discharged, varied or set aside"

Any order for an injunction may be discharged, or varied, or set aside by the Court, on an application thereto by any party dissatisfied with such order :

Provided that if in an application for temporary injunction or in any affidavit supporting such application a party has knowingly made a false or misleading statement in relation to a material particular and the injunction was granted without giving notice to the opposite party, the Court shall vacate the injunction unless, for reasons to be recorded, it considers that it is not necessary so to do in the interests of justice :

Provided further that where an order for injunction has been passed after giving to a party an opportunity of being heard, the order shall not be discharged, varied or set aside on the application of that party except where such discharge, variation or setting aside has been necessitated by a change in the circumstances, or unless the Court is satisfied that the order has caused undue hardship to that party.



### **The Specific Relief Act, 1963**

Sec.36.Preventive relief how granted.—Preventive relief is granted at the discretion of the court by injunction, temporary or perpetual.

Sec.37 Temporary and perpetual injunctions.—

(1) Temporary injunctions are such as are to continue until a specified time, or until the further order of the court, and they may be granted at any stage of a suit, and are regulated by the Code of Civil Procedure, 1908 (5 of 1908).

(2)A perpetual injunction can only be granted by the decree made at the hearing and upon the merits of the suit; the defendant is thereby perpetually enjoined from the assertion of a right, or from the commission of an act, which would be contrary to the rights of the plaintiff.

### **Trademark Act 1999**

2. Definitions and interpretation.—

(b) “assignment” means an assignment in writing by act of the parties concerned;

(zc) “transmission” means transmission by operation of law, devolution on the personal representative of a deceased person and any other mode of transfer, not being assignment;  
Sec.2(1)(m)

(m) “mark” includes a device, brand, heading, label, ticket, name, signature, word, letter,

numeral, shape of goods, packaging or combination of colours or any combination thereof;

Sec. 2.(2)(b)

(b) to the use of a mark shall be construed as a reference to the use of printed or other visual representation of the mark;

Sec. 2.(2)(c) to the use of a mark,—

(i) in relation to goods, shall be construed as a reference to the use of the mark upon, or in any physical or in any other relation whatsoever, to such goods;

(ii) in relation to services, shall be construed as a reference to the use of the mark as or as part of any statement about the availability, provision or performance of such services;

Sec. 28. Rights conferred by registration.-

(1) Subject to the other provisions of this Act, the registration of a trade mark shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or service in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act.

(2) The exclusive right to the use of a trade mark given under sub-section (1) shall be subject to any conditions and limitations to which the registration is subject.

(3) Where two or more persons are registered proprietors of trade marks, which are identical with or nearly resemble each other, the exclusive right to the use of any of those trade marks shall not (except so far as their respective rights are subject to any conditions or limitations entered on the register) be deemed to have been acquired by any one of those persons as against any other of those persons merely by registration of the trade marks but each of those persons have otherwise the same rights as against other persons (not being registered proprietor).

#### Section 29 in The Trade Marks Act, 1999

29. Infringement of registered trade marks.—

(1) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.

(2) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of—

(a) its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark; or

- (b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark; or
- (c) its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark, is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.

(3) In any case falling under clause (c) of subsection (2), the court shall presume that it is likely to cause confusion on the part of the public.

(4) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which—

- (a) is identical with or similar to the registered trade mark; and
- (b) is used in relation to goods or services which are not similar to those for which the trade mark is registered; and
- (c) the registered trade mark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trade mark.

(5) A registered trade mark is infringed by a person if he uses such registered trade mark, as his trade name or part of his trade name, or name of his business concern or part of the name, of his business concern dealing in

goods or services in respect of which the trade mark is registered.

(6) For the purposes of this section, a person uses a registered mark, if, in particular, he—

- (a) affixes it to goods or the packaging thereof;
- (b) offers or exposes goods for sale, puts them on the market, or stocks them for those purposes under the registered trade mark, or offers or supplies services under the registered trade mark;
- (c) imports or exports goods under the mark; or
- (d) uses the registered trade mark on business papers or in advertising.

(7) A registered trade mark is infringed by a person who applies such registered trade mark to a material intended to be used for labelling or packaging goods, as a business paper, or for advertising goods or services, provided such person, when he applied the mark, knew or had reason to believe that the application of the mark was not duly authorised by the proprietor or a licensee.

(8) A registered trade mark is infringed by any advertising of that trade mark if such advertising—

- (a) takes unfair advantage of and is contrary to honest practices in industrial or commercial matters; or
- (b) is detrimental to its distinctive character; or
- (c) is against the reputation of the trade mark.

(9) Where the distinctive elements of a registered trade mark consist of or include

words, the trade mark may be infringed by the spoken use of those words as well as by their visual representation and reference in this section to the use of a mark shall be construed accordingly.

Sec. 134. Suit for infringement, etc., to be instituted before District Court.—

(1) No suit—

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

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

(c) for passing off arising out of the use by the defendant of any trade mark which is identical with or deceptively similar to the plaintiff's trade mark, whether registered or unregistered, shall be instituted in any court inferior to a District Court having jurisdiction to try the suit.

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

the registered proprietor and the registered user.

Sec.135. Relief in suits for infringement or for passing off.—

(1) The relief which a court may grant in any suit for infringement or for passing off referred to in section 134 includes injunction (subject to such terms, if any, as the court thinks fit) and at the option of the plaintiff, either damages or an account of profits, together with or without any order for the delivery-up of the infringing labels and marks for destruction or erasure.

(2) The order of injunction under sub-section (1) may include an ex parte injunction or any interlocutory order for any of the following matters, namely:—

(a) for discovery of documents;

(b) preserving of infringing goods, documents or other evidence which are related to the subject-matter of the suit;

(c) restraining the defendant from disposing of or dealing with his assets in a manner which may adversely affect plaintiff's ability to recover damages, costs or other pecuniary remedies which may be finally awarded to the plaintiff.

(3) Notwithstanding anything contained in sub-section (1), the court shall not grant relief by way of damages (other than nominal damages) or on account of profits in any case-

(a) where in a suit for infringement of a trade mark, the infringement complained of is in relation to a certification trade mark or collective mark; or

(b) where in a suit for infringement the defendant satisfies the court—

(i) that at the time he commenced to use the trade mark complained of in the suit, he was unaware and had no reasonable ground for believing that the trade mark of the plaintiff was on the register or that the plaintiff was a registered user using by way of permitted use; and

(ii) that when he became aware of the existence and nature of the plaintiff's right in the trade mark, he forthwith ceased to use the trade mark in relation to goods or services in respect of which it was registered; or

(c) where in a suit for passing off, the defendant satisfies the court—

(i) that at the time he commenced to use the trade mark complained of in the suit he was unaware and had no reasonable ground for believing that the trade mark of the plaintiff was in use; and

(ii) that when he became aware of the existence and nature of the plaintiff's trade mark he forthwith ceased to use the trade mark complained of.

### **Article 20 of The Constitution Of India 1949:**

20. Protection in respect of conviction for offences:



(1) No person shall be convicted of any offence except for violation of the law in force at the time of the commission of the act charged as an offence, nor be subjected to a penalty greater than that which might have been inflicted under the law in force at the time of the commission of the offence

(2) No person shall be prosecuted and punished for the same offence more than once

(3) No person accused of any offence shall be compelled to be a witness against himself.

In Reed Executive Plc & Another Vs. Reed Business Information Ltd & Others reported in [2004] EWCA Civ 159 the Supreme Court of Judicature Court of Appeal (Civil Division), London held as under:

140. I am unable to agree with this. The banner itself referred only to totaljobs – there was no visible appearance of the word Reed at all. Whether the use as a reserved word can fairly be regarded as “use in the course of trade” or not (as to which I express no opinion), I cannot see that causing the unarguably inoffensive-in-itself banner to appear on a search under the name “Reed” or “Reed jobs” can amount to an Art.5.1(b) infringement. The web-using member of the public knows that all sorts of banners appear when he or she does a search and they are or may be triggered by something in the search. He or she also knows that searches produce fuzzy results – results with much rubbish thrown in. The idea that a search under the

name Reed would make anyone think there was a trade connection between a totaljobs banner making no reference to the word “Reed” and Reed Employment is fanciful. No likelihood of confusion was established.

141. That is not to say, of course, that if anyone actually clicked through (and few did) and found an infringing use, there could not be infringement. Whether there was or not would depend solely on the site content, not the banner.

150. Accordingly I hold that there was no infringement by the use of the “Reed Business Information” metatags.

Further held:

The metatag use did not amount to trade mark infringement as causing a website to appear in a search result does not without more suggest a connection with another trader. Invisible use does not convey a message to anyone.

In Veda Advantage Limited Vs. Malouf Group Enterprises Pty Limited reported in [2016] FCA 255. Federal Court of Australia has held that

61 A sponsored link appears in hypertext accompanied by a yellow tag in which the word “Ad” appears in white. Clicking on the link takes the searcher to the advertiser’s website. A person who has conducted a search and chosen to examine the link in an advertisement can always click on the “back” button on his or

her browser and return to the original search results.

127 But the proposition that using words which are invisible and inaudible, indeed imperceptible, to consumers is using them as a trade mark makes no sense. How could the keywords be understood to be used to distinguish the services of one trader from those of another when the keywords are indiscernible? How could it appear to consumers that, by Malouf's designation of the Veda keywords to Google, the words are used to denote a connection in the course of trade between Malouf's services and the services provided by another trader, or to distinguish its services from the services of others, when the consumers have not seen or otherwise perceived the keywords?

128 Moreover, in a case where the consumer does not merely search for "veda", but enters a term or phrase which includes the word "veda", how would the consumer know that the trade mark was being used at all? If the consumer searches for "veda credit report", for example, and the search returns a Malouf advertisement, a consumer who understands how the AdWords program operates might imagine that the keyword generating the advertisement was "veda". But equally the consumer might imagine that the keyword or words were "credit report". As the keyword is invisible, the consumer cannot know. The fact that use need not be in physical relation to the services does not address the question at hand. In any case, I

doubt very much whether the Parliament had in mind a metaphysical relationship, no matter how expansive the concept of use was intended to be.

220 I respectfully agree. Although sponsored links on Google no longer display the words “sponsored links” as they did at the time of the events in *ACCC v Trading Post*, the yellow “ad” box that now appears sends the same message to the user with equal, if not greater, clarity. I discuss this matter further below at 233.

233 Malouf further submitted that the ordinary or reasonable member of the class would infer from the yellow “ad boxes” appearing on a results page that those entries are links for which businesses seeking to promote their goods or services made payments to Google. This submission should also be accepted. Veda countered that there was no evidence to support it, but any ordinary or reasonable person would appreciate that advertisements must be paid for and, knowing that Google is a commercial enterprise, he or she would also appreciate that the payments would be made to Google.

In *Intercity Group (NZ) Limited Vs. Nakedbus NZ Limited* reported in [2014] NZHC 124 the High Court of New Zealand held as under:

[85] The position in relation to the use by Nakedbus of the keywords is entirely different to a use on packaging or other communications to the public. The use of the

keyword was by Nakedbus when it purchased that keyword prior to the placement of its advertisement, and then by Google when, through its search engine, it provided for the Nakedbus advertisement to appear when a consumer keyed “intercity” into a computer. In such a situation, the use of the keyword by Nakedbus and indeed Google was not seen by the consumer at all. As Mr Harris observed, these actions were invisible to everyone except Google and the advertiser. If the “use” could not be seen by the consumer it could not be “taken as” anything, let alone “taken as being used as a trade mark”.

It is further held that:

Nakedbus’s purchase of the keywords was “use in the course of trade” in terms of Section 89(1) of the Trade Marks Act 2002, but did not amount to trade mark infringement.

NZ Fintech Ltd. T/A Moola V Credit Co-Corporation Financial Solutions Pty Ltd. T/A Wallet Wizard reported in [2019] NZHC 654 High Court of New Zealand held as under:

Para 12: The purchase of Google Adwords has become a very common and well-known method of advertising on the internet. While details of Google’s algorithms remain confidential to Google, the way Google Adwords work is generally outlined by Google for advertisers (and consumers) and has been

discussed in previous trade mark cases concerning their use in New Zealand and elsewhere. Although the parties filed a number of affidavits setting out how Adwords work, there was little dispute. The only real dispute is as to the level of consumer understanding.

Para 13: Google Adwords is an advertising service run by Google. The service was launched in 2000 but has expanded significantly in recent years. Google's principal source of revenue is advertising and the main way it provides advertising services is through Adwords. The service has recently been rebranded as Google Ads but, like the witnesses, I refer to Adwords for convenience. Adwords allow advertisers to bid on keywords made up of single words or phrases to influence when and where their advertisement is displayed when the chosen keyword is used as a search term by a person carrying out a search on the Google search engine.

Para 14: When people search on the internet using the Google search engine, the search results include both organic search results that the relevant Google algorithm considers are most likely to be relevant to what the person is searching for, and also paid search results designated in the results with the icon AD. These paid results are the product of the purchase of Google Adwords.

In Warner Bros. Entertainment Inc. and Anr. Vs. Harinder Kohli and Ors reported in 155 (2008) DLT 56 held as under:

(29) It is the settled position both in law and in equity that a deliberate suppression of material facts, viewed singularly or coupled with blatantly false assertions, so far as the grant of equitable relief of injunction is concerned, is fatal. The plaintiffs in the instant action have attempted to lightly brush off their intentional non-disclosure by feigning oversight, contending that they had nothing to gain from the aforesaid non-disclosure. What has been lost sight of is that it is a cardinal principle of law that a person who seeks the equitable relief of injunction must come to the Court with clean hands. In Udai chand vs. Shankar Lal and Ors. AIR 1978 SC 765, it was held by the Hon'ble supreme Court that the Court would be justified in revoking the leave to appeal if the same was obtained by making mis-statement of a material fact which was of decisive importance in the case. It was held that a party who approaches the court invoking the exercise of its overriding discretions must come with clean hands. If there appears on his part any attempt to over reach or mislead the court by false or untrue statements or by withholding true information which would have a bearing on the question of exercise of discretion, the Court would be justified in refusing to exercise the discretion or, if the discretion has been exercised, in revoking the leave to appeal granted even at

the time of hearing of the appeal. Again, in the cases of Satish Khosla vs. Eli Lilly ranbaxy Limited 1998 I AD (Delhi) 927 and Anand Swarup vs. Municipal Corporation of Delhi 36 (1998) DLT 304, this Court reiterated the legal principle that a person approaching the Court must disclose all relevant facts if he seeks an injunction. In a recent decision of this Court in the case of Micolube India ltd. vs. Maggon Auto Centre and Anr. 150 (2008) DLT 458, it was again held that the plaintiff cannot be let off by accepting its plea of feigned ignorance.

Apart from the above, after careful consideration, I am of the view that even assuming there is any structural or phonetic similarity in the words “Harry Potter” and “Hari Puttar”, what has to be borne in mind is that the Harry Potter films are targeted to meet the entertainment needs of an elite and exclusive audience — the cognoscenti — an audience able to discern the difference between a film based on a Harry Potter book on the one hand and a film which is a Punjabi comedy on the other, the chief protagonist of which is Hariprasad Dhoonda. It is not the case of a consumer good or product, which stands on an entirely different footing. Necessarily, the yardstick must also differ, bearing in mind the fact that a consumer product such as a soap or even a pharmaceutical product may be purchased by an unwary purchaser or even an illiterate one, but the possibility of an unlettered audience viewing a HARRY POTTER movie are remote, to say the least. To put it differently, an illiterate or semi-literate movie viewer, in case he



ventures to see a film by the name of Hari Puttar, would never be able to relate the same with a Harry Potter film or book. Conversely, an educated person who has pored over or even browsed through a book on Harry Potter or viewed a Harry Potter film, is not likely to be misled. Such a person must be taken to be astute enough to know the difference between a Harry Potter film and a film entitled Hari Puttar, for, in my view, the cognoscenti, the intellectuals and even the pseudo-intellectuals presumably know the difference between chalk and cheese or at any rate must be presumed to know the same.

Further held :

An illiterate or semi-literate movie viewer, would never be able to relate 'HARI PUTTAR' with a Harry Potter film or book. Conversely, an educated person, is not likely to be misled.

In Aegon Life Insurance Company Ltd vs Aviva Life Insurance Company reported in 2019 SCC Online Bombay 1612 High court of Bombay held as under:

Para 97 I have already observed that the unique characteristic of the subject goods is that they can only be purchased online from the websites of the parties herein and the websites of policy aggregators. Obviously since the policies are only available online, the mode of purchase is through the internet.

Para 102 I therefore hold that considering the nature of the rival marks, rival products, the

class of purchasers who are likely to buy these products and the mode of purchasing these products, there is no question of any confusion or deception between the rival trade marks. Particularly, considering the nature of the goods and the manner in which insurance policies are purchased, there is no possibility of persons who are buying insurance policies online after analysis and considering the pros and cons, getting confused.

In *Network Automation Inc Vs. Advanced Systems Concepts Inc* reported in 638 F.3d 1137 the United States Court of Appeals, Ninth Circuit held as under:

Internal page 15: We have recently acknowledged that the default degree of consumer care is becoming more heightened as the novelty of the Internet evaporates and online commerce becomes commonplace. In *Toyota Motor Sales v. Tabari*, 610 F.3d 1171 (9th Cir.2010), we vacated a preliminary injunction that prohibited a pair of automobile brokers from using Toyota's "Lexus" mark in their domain names.<sup>5</sup> We determined that it was unlikely that a reasonably prudent consumer would be confused into believing that a domain name that included a product name would necessarily have a formal affiliation with the maker of the product, as "[consumers who use the internet for shopping are generally quite sophisticated about such matters.

Internal page 16: In the keyword advertising context the “likelihood of confusion will ultimately turn on what the consumer saw on the screen and reasonably believed, given the context.”

The appearance of the advertisements and their surrounding context on the user's screen are similarly important here. The district court correctly examined the text of Network's sponsored links, concluding that the advertisements did not clearly identify their source. However, the district court did not consider the surrounding context. In *Playboy*, we also found it important that Netscape's search engine did not clearly segregate the sponsored advertisements from the objective results. 354 F.3d at 1030. Here, even if Network has not clearly identified itself in the text of its ads, Google and Bing have partitioned their search results pages so that the advertisements appear in separately labeled sections for “sponsored” links. The labeling and appearance of the advertisements as they appear on the results page includes more than the text of the advertisement, and must be considered as a whole.

In *Alzheimer's Disease & Related Disorders Ass'n, Inc. vs Alzheimer's Found. of Am., Inc.* reported in 307 F. Supp.3d 260 US District court for the southern district of New York held as under:

Internal page 16: Virtually no court has held that, on its own, a defendant's purchase of a

plaintiff's mark as a keyword term is sufficient for liability.

Internal Page 17: The Court's analysis is not mechanical, but remains focused on the ultimate question of whether consumers are likely to be confused as a result of the allegedly infringing conduct.

Internal page 27: Google and Bing both label sponsored advertising results with the word "ad" next to the listing, and Bing previously displayed the ads on a sidebar, separated from the organic results. The presence of this "ad" signifier heightens consumers care and attention in clicking on the links, and further diminishes the likelihood of initial interest confusion.

In *Cosmetic Warriors Ltd & Another Vs. Amazon Co.U.K. Ltd., and Another* reported in 2014 EWHC 181 (CH) High Court of England and Wales Chancery Division held as under:

43. This class is illustrated by the example in paragraph 9 above. In particular, I am concerned with the situation of this advertisement appearing as a result of Amazon bidding on a keyword containing the word 'lush'. I am not concerned with a case in which exactly the same ad might appear as a result of Amazon having bid on a key word comprising 'bath bomb'. In such a situation the ad would appear in response to the entry by a consumer of 'lush cosmetics bath bomb',

but this would not be due to any use by Amazon of the sign Lush.

46. Moreover, the evidence establishes that Lush are brand conscious and have made great efforts to build up a reputation in the Lush name. In my judgment average consumers would expect an advertisement for Lush products to include some reference to the Lush mark, some indicia which would distinguish that ad from the ads of others which he might expect to see on the results page of a Google search.

48. It will be recalled that in the example pleaded and referred to in paragraphs 9 and 10 above, there was an ad for a third party as well as one for Amazon. In my judgment the presence of such other ads makes the position even clearer. The average consumer could not reasonably fail to appreciate that the Amazon ad was just another ad from a supplier offering similar products to those requested by the internet searcher. My conclusion on this part of the case does not, however, depend on the presence of this other ad.

In *Chocolat Lamontagne inc vs Humeur Group Conseil Inc* reported in 2010 QJ No.7172 Quebec Superior Court held as under:

Para 99 The defendant in no way acquired the exclusive use of the keywords that it had purchased from Google, which are available to anyone.

Para 100 In an economy of open competition, information meant to provide an alternative to other business cannot be prohibited.

Para 123 The sponsored link to the Humeur website at the very top of the page of search results obtained after entering the words Chocolaterie Lamontagne in Google does not give rise to any confusion. The information clearly indicates an alternative to the type of business operated by the plaintiff.

Para 124 If a Web user accepts the defendant's offer to go to its site, there is nothing to suggest any association whatsoever between the parties, except that the Web user can find out what Humeur is all about.

Para 125 In the Court's opinion, the use of Google AdWords, as the defendant did, to bill itself as the plaintiff's competitor to Web users looking for the plaintiff's site does not constitute unfair competition or passing off, which would lay the blame on it and warrant awarding damages to the plaintiff.

Para 126 When such an offer does not contain anything unfair, the Web user makes a free choice, and the advertiser cannot be held liable for having created the opportunity to be reached, as in the case before us.

Para 127 In the Court's view, the general principles of competition in the country do not preclude offering Web users looking for information the opportunity to find other information about a company competing with the one being searched.

In *Cochrane Steel Products (Pty) Ltd v M-Systems Group (Pty) Ltd and Another* reported in [2016] ZASCA 74 the South Africa: Supreme Court of Appeal held as under:

[12] The critical question to be answered in a keyword bidding case is whether the Google advertisement which appears in response to the search using the keyword does not enable normally informed and reasonably observant internet users, or enables them only with difficulty, to ascertain whether the goods or services referred to in the Google advertisement originate from the proprietor of the trade mark (whose mark has been used as a keyword) or an undertaking economically connected to it or, on the contrary, originate from a third party. Put differently, the question is whether the advertisement itself gives rise to the likelihood of confusion; and not whether or not the bidding by one competitor on the trade mark of another is itself unlawful.

[14] The facts here are strikingly similar to the second class of complaints in *Cosmetic Warriors* (above). Having searched for Clearvu in one form or another, the consumer is confronted (on such limited evidence as is before us) with advertisements for a multiplicity of suppliers. The natural search results are also not limited to goods and services provided by the appellant. No reasonable consumer will consider, even momentarily, having searched for Clearvu (or some derivative of it), that every result obtained relates to the appellant's products or services. Consumers will assume,

as all internet users do, that they will have to separate the wheat from the chaff in deciding which hyperlinks appearing as a result of their search should be clicked. That presumably will cause irritation and perhaps even annoyance but it does provide the consumer with alternatives thereby fostering competition. Sorting the wheat from the chaff insofar as Google advertisements are concerned is by no means difficult. The advertisements are clearly marked as such and appear in different areas of the screen. What is more is that advertisements are clearly distinguished from the natural search results. That cannot be lost on the average consumer, who would immediately notice that these are advertisements rather than the natural results of their search. Thus if the advertisement contains no reference to the appellant the consumer ought reasonably to conclude that the result is not related to the appellant or its products or services. But even if the consumer went one step further and clicked on M-Systems' website its branding would have left the consumer in no reasonable doubt as to the identity of the trader whose services were on offer.

NZ Fintech Ltd. T/A Moola Vs.Credit Corporation Financial Solutions Pty.Ltd.T/A Wallet Wizard reported in[2019] NZHC 654 the High Court of New Zealand declined to grant interim relief to the plaintiff holding that plaintiff is also involved in similar bidding process.



In *Banyan Tree Holding (P) Limited vs Jamshyad Sethna And Anr.*, reported in 2014 SCC Online Del 6573. In this case trademark Banyan was not registered in the name of plaintiff as on date of filing the suit. Amendment was allowed when the trademark is registered during the pendency of the suit.

In the case of *Savitri Minda vs. Minda Industries*, reported in 1997 PTC 257, this Court allowed the amendment of the plaint under Order VI Rule 17 CPC observing that the courts should be liberal in the matter of allowing amendment unless serious injustice or irreparable loss is caused to the other side. It was also observed that the Courts exist to decide the rights of the parties and not to punish them for the mistake they make in the conduct of their cases.

In *Sinhal Metal Industries Pvt. Ltd. vs. Royal Enterprises*, reported in 1998 PTC 128 amendment of plaint under Order VI Rule 17 was allowed in a suit for passing off, when the registration of mark was obtained during pendency of the suit. It was held that refusal of amendment is likely to lead to multiplicity of proceedings.

In the case of Laxmi & Co. Vs. Dr. Anant R. Deshpande and Anr. Reported in AIR 1973 SC 171 it was held as under :

"Where, subsequent to the institution of the suit events happen which give the plaintiff a new cause of action for the relief claimed or the right to a new or additional relief he will, as a general rule, be allowed to amend the plaint by moulding it in an appropriate manner."

15. Ordinarily under Order VI Rule 17 CPC, all amendments ought to be allowed which satisfy two conditions (a) of not causing injustice to the other side and (b) of being necessary for the purpose of determining the real question in controversy between the parties.

In the case of Rajesh Kumar Aggarwal and Ors. Vs. K.K. Modi and Ors. Reported in AIR 2006 SC 1647, it was held as under:

"19. While considering whether an application for amendment should or should not be allowed, the Court should not go into the correctness or falsity of the case in the amendment. Likewise, it should not record a finding on the merits of the amendment and the merits of the amendment sought to be incorporated by way of amendment are not to be adjudged at the stage of allowing the prayer for amendment....."

In the case of State of A.P. v. Pioneer Builders, reported in (2006) 12 SCC 119, at page 127, it was observed as under :

"21. Principles governing amendment of pleadings are well settled. Order 6 Rule 17 CPC deals with the amendment of pleadings and provides that the court may at any stage of the proceedings allow either party to alter or amend pleadings in such a manner and on such terms as may be just and all such amendments shall be made as may be necessary for the purpose of determining the real questions in controversy between the parties. It is trite that though an amendment cannot be claimed as a matter of right under all circumstances, yet the power to allow the amendment is wide and can be exercised at any stage of the proceedings in the interest of justice. It is equally well settled that unless serious injustice or irreparable loss is likely to be caused to the other side, the court should adopt liberal approach and not a hypertechnical approach, particularly in a case where the other side can be compensated with costs. Dominant object to allow the amendment in the pleadings liberally is to avoid multiplicity of proceedings.

In the case of Usha International vs. Usha Television Limited, reported in 2002 (25) PTC 184 (Del) (DB), it was held that the rule of amendment of pleadings has to be governed on the basic rule of justice, equity

and good conscience. When this principle is applied, the amendment as prayed has to be allowed. It was further observed that the main consideration for allowing the application is to avoid multiplicity of proceedings which means saving of previous judicial time and saving of avoidable expenses for the litigants.

Further held as under:

Para 14. We have heard the learned counsel for the appellants and carefully perused the judgments cited at the Bar. In our opinion, the law relating to infringement and passing off are fundamentally similar. The supervening event of registration of trade mark under the Trade and Merchandise Marks Act, 1958 is a fact which can be taken note of on that basis the application for amendment deserves to be allowed.

Para 15. The rule of amendment of pleadings has to be governed on the basic rule of justice, equity and good conscience. When this principle is applied, the amendment as prayed has to be allowed. We are satisfied that the alternative plea that is sought to be raised by the appellant is the amendment application is only by way of expatiating his rights which he has secured by a statute. Apart from this, the main consideration for allowing the application is to avoid multiplicity of proceedings which means saving of precious judicial time and saving of avoidable expenses for the litigants.

In Flight Center Travels Pvt. Ltd. vs Flight Centre Limited & Anr. Reported in (2013) 198 DLT 407 (DB) held

Para 35: Learned counsels for both the parties sought to emphasise the aforesaid aspect in the context of the nature of a suit for passing off and that of infringement of trademark. Learned counsel for the appellant, as noticed above, has canvassed that the aspect of application for registration of trademark already formed a part of the original plaint. It is only the subsequent development of registration which was brought in through the process of amendment which only fortified the case of the appellant, thereby effecting the degree of proof in view of the provisions of Section 29(3) of the TM Act raising a presumption in favour of the appellant. We find force in the contention of the learned counsel for the appellant, especially when there was really no change in the nature of relief in the suit post the amendment. In species the relief sought essentially was for an injunction against the respondents to restrain the respondents from using the mark —FLIGHT CENTER. This relief did not undergo any change because of the amendment. The only aspect incorporated is the factum of registration of the trademark and the consequent relief in respect thereof. No additional relief qua damages or other amounts has been inserted and no relief in that behalf was granted.

38. It is in the aforesaid context that the plea of the appellant becomes significant that the cause of actions are substantially the same in the two actions, but that it would be in the nature of an alternative relief. The original suit as laid by the appellant clearly set out the reputation of the trademark/service mark that they had a right in, in view of

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\_ Usha International & Anr. case (supra) and they pleaded that the mark should be protected for which application for registration was pending. The subsequent registration of the mark was only a fact which fortified the case of the appellant further, and in our view the aforesaid facts & circumstances, such an amendment did not necessitate fresh summons and notices to be issued to the respondents. In fact, the respondents were not unaware of the application having been filed by the appellant for registration of its mark in view of what was set out in the plaint, yet they chose to abandon their defence; did not oppose the registration of the mark; did not file any proceedings for cancellation of the mark and, in fact, were seeking registration of their mark FLIGHT SHOP. Once the mark of the appellants was registered, the respondents cannot claim not to have knowledge of the same. This was not a fact which they were ignorant of, or could not have come to know without being put to notice of the amendment application or the amended plaint. The amendment is really in the nature of additional mode of relief and it was not substantive in

nature [Hari Ram Keer case (supra)]. In the present case, however, it is based on passing off and registration of the mark post amendment.

In Vatika Resorts Pvt. Ltd. vs Vatika Grand reported in 2009 (109) DRJ 607 held as under:

6. In the present case, it is an undisputed fact that the plaintiff has filed the suit for permanent injunction, passing off etc. seeking the injunction from using the mark Vatika against the defendant. The trade mark Vatika on the date of filing of the suit was not registered/assigned in favour of the plaintiff. The said trade mark was registered and assigned in favour of the plaintiff during the pendency of the suit. It is also a matter of fact that the evidence in the matter is yet to commence and it is also well established law that while considering the amendment, the merit of the case is immaterial.

17. In the case of Usha International vs. Usha Television Limited, reported in 2002 (25) PTC 184 (Del)(DB) it was held that the rule of amendment of pleadings has to be governed on the basic rule of justice, equity and good conscience. When this principle is applied, the amendment as prayed has to be allowed. We are satisfied that the alternative plea that is sought to be raised by the appellant in the amendment application is only by way of expatiating his rights which he has secured by

a statute. Apart from this, the main consideration for allowing the application is to avoid multiplicity of proceedings which means saving of previous judicial time and saving of avoidable expenses for the litigants.

18. The contention of the defendant that the suit for infringement on the basis of registration in Class 16 for infringement of trade mark is not maintainable has no force as at this stage the court is not deciding any issue or defence raised by defendant on merits of the case. In case the suit for infringement is not maintainable as alleged by the defendant, even if the amendment is allowed it will have to be considered in accordance with law at the final stage. Similarly, the contention of the defendant that the registration has been obtained by the plaintiff from the back door as the plaintiff himself has not obtained the registration has no force as the plaintiff has claimed the ownership of the registered trademark which has been assigned in its favour. Also, the plea of the defendant that the original registration was obtained by the plaintiff through its sister concern in order to defeat the rights of the defendants has no force as in case the defendant is the earlier user of the mark in question, the right of the defendant is otherwise protected under Section 33 of the Trade and Merchandise Marks Act, 1958 and if even the amendment is allowed, in my opinion, there would not be any change in the nature of matter as cause of action in infringement and passing off actions are substantially the same in law. The decision cited by the defendant in the case of Godej



Sara Lee vs. Karam Chand Appliances 2007 (35) PTC 341 therefore, does not help the case of the defendant in view of the decision given by the Division Bench of this court in the case reported in 2002 (25) PTC 184 Delhi (supra) on the similar facts.

19. In view of my above discussion, amendment sought by the plaintiff is allowed as no prejudice is caused to the defendants in any manner. I am of the considered view that the proposed amendment is necessary for the purpose of determining the real matter in controversy between the parties. Amended plaint be filed within two weeks from today. The defendant is granted four weeks thereafter to file the written statement.

In Columbia Sportswear Company vs Harish Footwear & Anr reported in 2018 (73) PTC 388(Del) held as under:

4 Defense of defendant No. 2 is two fold. His first submission is that his user of trade mark "COLUMBIA" is honest and he is the prior adopter and continuously and extensively using this mark in relation to his goods since 1995. The defendant has also applied for a trade mark application under No. 1126256 which was wrongly shown as abandoned. A writ petition (W.P. (C) No.5866/2013) had been filed in the High Court which was disposed of on 16.07.2014. The status of the said TM application of defendant No. 2 was shown to be „pending“ and not „abandoned“. This information was in fact uploaded by the Trade

Mark Authorities but this factum has been suppressed by the plaintiff; he has obtained an ex-parte injunction giving an impression to the Court that the TM application of defendant No. 2 has been abandoned whereas this is not the correct position. The plaintiff is guilty of concealment of material facts. The additional submission on this score is that the plaintiff in para 40 of his plaint has detailed its registrations which are in his favour but he has failed to disclose that there is disclaimer qua three of the aforementioned registrations. This also amounts to an active concealment. Having approached the Court with unclean hands, he is not entitled to any discretionary relief. Details of the disclaimer attached to the aforementioned three applications have been detailed. In fact in rejoinder this position has not been disputed. It is not in dispute that out of six registrations which are in favour of the plaintiff, three have a disclaimer attached to them. The additional defence adopted by defendant No. 2 is that the plaintiff has no trans-border reputation as has been contended by him; he has failed to establish this. It is pointed out that there is not a single document of the plaintiff to show his presence in India; no sale figures have also been filed. It is denied that the plaintiff is selling shoes under the trade name „COLUMBIA“ in India. It is denied that the plaintiff has a subsidiary Company by the name of M/s Columbia Sportswear India Sourcing Pvt Ltd having its office at Bangalore. Qua the status of the defendant, it is pointed out that the defendant has been in active business for the sale of

shoes since the year 1995. He cannot be injuncted from carrying out its business. The plaintiff has failed to make out a prima-facie case.

7 Arguments have been refuted by Mr. S.K. Bansal, Advocate appearing for defendant No. 2. He has reiterated the averments which have been taken in his defence. It is pointed out that a party who approaches the Court with unclean hands is not entitled to any discretionary relief. There being an active concealment on the part of the plaintiff, no interim order could have been granted in his favour. To support his submission reliance has been placed upon (2013) 11 SCC 531 Bhaskar Laxman Jadhav & Others Vs. Karamveer Kakasaheb Wagh Education Society and Others. On the question of trans-border reputation of the plaintiff having travelled to India, it is pointed out that the Courts have time and again held that while dealing with an application for an interlocutory injunction, the rights of the plaintiff have to be protected against an injury but the corresponding need of the defendant to be protected against injury resulting from its having been prevented from exercising his legal rights has to be weighed in the scale of balance. To support this submission, reliance has been placed upon 2005 (30) PTC 471 (Del) QRG Enterprises and Anr Vs. Surendra Electricals and Others.

5. Having heard the learned counsel on both sides, this court finds no substance in the

objection thus taken. In *Rajveer Food Marketing (I) Pvt. Ltd. (supra)*, the amendment of the pleadings was mainly to bring on record certain material facts which had been earlier withheld, seemingly with no explanation offered for such omission. In the case at hand the issuance of the registration of the trademark on 13.03.2015 is a subsequent development. It may be that the application towards that end had been moved earlier on 27.07.2007, but that by itself is no reason why the applicant/plaintiff should not be allowed to plead the additional facts of yet another registration of his trademark. Similarity in the packaging, also constituting breach and giving rise to the cause of action has apparently come to light only upon the report of the local commissioner being submitted in this court. There is nothing on record to indicate that these facts were within the knowledge of the plaintiff and/or could have been pleaded earlier.

8. The case at hand is distinguishable from that of *Godrej Sara Lee Ltd.(supra)*. The cause of action remains the same. It is essentially the passing off the goods by the defendant using a trademark of which the plaintiff claims to be the owner. The principle that multiplicity of suits must be avoided has to be remembered. At this stage, the court cannot sit in judgment over the falsity or correctness of the facts sought to be additionally pleaded. The amendments are not likely to change the nature of the case. The supervening event of new registration of the trademark and another facet of the passing off with reference to the

packaging deserves to be allowed to be additionally pleaded.

9. The amendments proposed by the application are for complete and effectual determination of the controversy between the parties and, therefore, the application is allowed.

In Anchor Health And Beauty Care Pvt.Vs. V.Kaushik reported in AIR 2012 Del 62 held as under:

5. The application has been opposed by the defendants. They have taken a preliminary objection that the fundamental structure and cause of action is sought to be altered by making the proposed amendment, converting a non-confusion plaint into a confusion cause of action. It is also alleged that the limitation for infringement of trade mark expired in 2010 and, therefore, the proposed amendment, if allowed, would cause irreparable injury to the defendants. It is further stated that the defendants have already filed rectification proceedings, immediately on coming to know of the registration in favour of the plaintiff. Another ground on which the application has been opposed is that the plaintiff has not explained why the proposed amendment is sought to be made now, when the registration in its favour was granted on 26.08.2008.

11. In Revajeetu Builders And Developers (supra), the Supreme Court after reviewing the case law on amendment of pleadings, enunciated some basic principles which are to

be taken into consideration while allowing or rejecting an application for amendment of plaint. These basic principles read as under:-

"On critically analyzing both the English and Indian cases, some basic principles emerge which ought to be taken into consideration while allowing or rejecting the application for amendment.

(1) Whether the amendment sought is imperative for proper and effective adjudication of the case?

(2) Whether the application for amendment is bona fide or mala fide?

(3) The amendment should not cause such prejudice to the other side which cannot be compensated adequately in terms of money;

(4) Refusing amendment would in fact lead to injustice or lead to multiple litigation;

(5) Whether the proposed amendment constitutionally or fundamentally changes the nature and character of the case? and (6) As a general rule, the court should decline amendments if a fresh suit on the amended claims would be barred by limitation on the date of application.

12. Applying the aforesaid basic principles, I feel that though the plaintiff has been rather negligent since it did not seek amendment of the plaint soon after the trade mark was registered in its favour, this is not a case of fundamental change in the nature of the suit or the cause of action and since a fresh suit

based on infringement will also not be barred by limitation, there seems to be no justification for refusing the amendment, so long as the defendants can be compensated by way of costs. The trial is yet to commence and in fact the suit is at an initial stage since the issues have been framed and, therefore, there is no likelihood of any injustice or prejudice being caused to the defendants. On the other hand, if the proposed amendment is not allowed, it is likely to result in multiplicity of litigation on account of the plaintiff being compelled to file a fresh suit on the basis of infringement of its registered trade mark.

In Colgate Palmolive Company (supra), the suit of the plaintiffs was based on their design registration No.185480. The defendants, in their reply, had pleaded a prior registration No.185103. The plaintiff then came up with an application for amendment so as to incorporate the existence of four additional design registrations of variants of the toothbrush to which the toothbrush design before the Court was related, thereby seeking to alleged infringement even in respect of those four designs registrations. The amendment was refused on the ground that infringement of each registration of each design would rise to a separate cause of action which was to be specifically pleaded by the plaintiff. However, in the case before this Court, the case of the plaintiff even in the original plaint is based upon the expression "Allround" which is the mark registered in its favour during pendency of this suit. Therefore, the fundamental ground on which the suit is based would remain the

same even if the proposed amendment is allowed. Hence, strictly speaking, this is not a case of adding an additional cause of action, by way of the proposed amendment. Here, the plaintiff is seeking only to add an additional ground, to challenge the use of the impugned mark/expression by the defendants.

Privy Council in *Ma Shwe Mya v. Maung Mo Hnaung* reported in AIR 1922 P.C. 249 in which the Privy Council observed:

"All rules of courts are nothing but provisions intended to secure the proper administration of justice and it is, therefore, essential that they should be made to serve and be subordinate to that purpose, so that full powers of amendment must be enjoyed and should always be liberally exercised, but nonetheless no power has yet been given to enable one distinct cause of action to be substituted for another, nor to change by means of amendment, the subject-matter of the suit."

In *Baldev Singh & Ors. Etc Vs. Manohar Singh & Anr. Etc.*, reported in 2006 (6) SCC 498 held as under:

Para 7 - It is well settled by various decisions of this Court as well as the High Courts in India that Courts should be extremely liberal in granting the prayer for amendment of pleadings unless serious



injustice or irreparable loss is caused to the other side

Para 8.....Therefore, in view of the provisions made under Order 6 Rule 17 of the CPC it cannot be doubted that wide power and unfettered discretion has been conferred on the Court to allow amendment of the pleadings to a party in such manner and on such terms as it appears to the Court just and proper. While dealing with the prayer for amendment, it would also be necessary to keep in mind that the Court shall allow amendment of pleadings if it finds that delay in disposal of Suit can be avoided and that the suit can be disposed of expeditiously. By the Code of Civil Procedure (Amendment) Act, 2002 a proviso has been added to Order 6 Rule 17 which restricts the Courts from permitting an amendment to be allowed in the pleadings either of the parties, if at the time of filing an application for amendment, the trial has already commenced. However, Court may allow amendment if it is satisfied that in spite of due diligence, the party could not have raised the matter before the commencement of trial. So far as proviso to Order 6 Rule 17 of the Code of Civil Procedure is concerned, we shall deal with it later.

In Life Insurance Corp. Of India Vs. Sanjeev Builders Pvt Ltd 2018 (11) SCC 722 held as under:

16. As pointed out earlier, the application was filed after 27 years of filing of the suit. Of course, the power to allow the amendment of suit is wide and the court should not adopt

hyper technical approach. In considering amendment applications, court should adopt liberal approach and amendments are to be allowed to avoid multiplicity of litigations. We are conscious that mere delay is not a ground for rejecting the amendment. But in the rustic litigants; all the respondents are companies and the dispute between the parties is a commercial litigation. In such facts and circumstances, the amendment prayed in the Chamber Summons filed under Order XXII Rule 10 CPC ought not to have been allowed, as the same would cause serious prejudice to the appellant. In our view, the impugned order, allowing Chamber Summons No.187 of 2014 filed after 27 years of the suit would take away the substantial rights of defence accrued to the appellant and the same cannot be sustained.

In B.K-Narayana Pillai vs Pararneswaran Pillai & Anr 2000 (1) SCC 712 held as under:

**Para 3:** The-purpose and object of Order 6 Rule 17 CPC is to allow either party to alter or amend his pleadings in such manner and on such terms as may be just. The power to allow the amendment is wide and can be exercised at any stage of the proceedings in the interests of justice on the basis of guideline laid down by various High Courts and this Court. It is true that the amendment cannot be clawed as a matter of right and under all circumstances, But it is equally true that the courts while deciding such prayers should not adopt hypertechnical approach. Liberal approach

should be the general rule particularly in cases where the other side can be compensated with the costs. Technicalities of law should not be permitted to hamper the courts in the administration of justice between the parties. Amendments are allowed in the pleadings to avoid uncalled for multiplicity of litigation.

Para 4: "The general rule, no doubt, is that a party is not allowed by amendment to set up a new case or a new cause of action particularly when a suit or new case or cause of action is barred: *Weldon v Neale* (1887) 19 QBD 394. But it is also well recognised that where the amendment does not constitute the addition of a new cause of action or raise a different case, but amounts to no more than a different or additional approach to the same facts, the amendment will be allowed even after the expiry of the statutory period of limitation: See *Charan Das v. Amir Khan* reported in AIR 1921 PC 50 and LJ. *Leach and Company limited and another v. Jardine Skinner and Company* reported in 1957 SCR 433.

47. On perusal of the provisions and case laws as extracted supra, it is evident that the use of the mark refers to using the mark in a printed or visual form. Further, Sec.28 of the Act provides for rights conferred by the registration and Sec.29 provides for infringement of Trademark and provides that the registered trademark is infringed by a person who uses it in the course of trade.

Further, Sec. 134 provides for suit for infringement or passing off to be instituted before the court not inferior to that of District court and the registered proprietor of the mark can also file the suit for infringement before the court where he resides or carries out the business. Sec.135 of trademark Act provides for suit for infringement or passing off.

48. In Consim Info case(supra) relates to use of a keyword. In that case Google undertook that they would abide by the trademark policy and will not show the trademark in the Adtext. In People Interactive case(supra) the plaintiff was owner of the domain name Shadi.com and defendant started to sue Shadihishadi.com. It was held that same amounts to passing off, confusion and deception. In World Wrestling case (supra), the plaintiff was owner of the trademark wwe., having their many website domain name. Defendants started to sell products on line through ww.wrestlezoneindia.com., and wreslezone.co.in. In this case defendant's websites were embodied with plaintiff's registered trademark. It was held that the use of the pictorial representation of WWE will create confusion and deception in the mind of public. In matromony.com case (supra), if plaintiff was owner of tamilmatromany.com,

bengalimatromony.com, muslimmatromony.com, the defendant had started to use and started to divert web traffic to its reddytelugumatromony.com, vanjaratelugumatromony.com, and telugumatromony.org. The court decreed the suit of the plaintiff. In Microsoft corporation case (supra) and Google India Case (supra), defendant had filed an application under Order 1 rule 10 for deletion, the same was dismissed by the trial court. High Court has upheld the said order. In Cable News Network case (supra), if the plaintiff was owner of CNN.Com., defendant had adopted the domain name cnndigital.com, hence suit was decreed. In Mattel.Inc case (supra) relates to Board Game called Scrabble. Defendant had launched online version of a game under the mark Scrabulous. Hence temporary injunction was granted. In IBIBO Group Case (supra), the plaintiff was owner of domain name ibibo.com, and goibibo.com. Defendant was temporarily restrained to use Adword, Keyword of trademark ibibo and goibibo. On perusal of these decisions it is evident that if the defendant uses the identical or deceptively similar trademark in any of a trade name or in its domain name, the same amounts to passing off and infringement. In the present case, if the plaintiff is MILAAP.Com, defendant is Google.com and

defendant No.2 is ImpactGuru.com. Therefore, it cannot be said that the defendants are infringing and passing off of the plaintiff's trademark.

49. It is pertinent to note that there are divergent opinions with regard to use of a 3<sup>rd</sup> party trademark in the metatag. In Kapil Wadwa Vs.Samsung Electronics Company Ltd., reported in 194(2012) DLT 23 Hon'ble Delhi High Court has held that use of a 3<sup>rd</sup> party mark as a metatag is illegal as it enables the defendant to ride on the reputation of the plaintiff. In Group Field Communication Vs. West Coast Entertainment reported in 174 F.3d, 1036,1045(9<sup>th</sup> Circuit 1999) in this case the defendant was using the trademark Moviebuff of the plaintiff in its metatags. It was held that the same amounts to infringement as customers once enter website, they may no longer want to take the trouble of going back and looking for plaintiffs store. In North Am.Med.Corp.Vs. Axiom World Wide, Inc. reported in 522 F.3d. 1211, 1233(11<sup>th</sup> Circuit 2008) held that plaintiff's trademarks as metatags caused the google search to suggest that plaintiff's product and defendant's products had the same source. In Promatec Indus Ltd., Vs. Equi track Corp. reported in 300 F.3d.808 (7<sup>th</sup> Circuit 2002) the court granted injunction against the defendant for

using the plaintiff's trademark in a metatag. In *Accor Australia and New Zealand Hospitality Pvt. Ltd. Case* the plaintiff was owner of trademark 'HARBOUR LIGHTS'. Defendant used in its website sourcedata through metagags. Court held that enough to constitute infringement. In *Grotrian Vs. Steinway and sons* reported in 365 F.Supp. 707(1973) court observed that advertisement in the name of Steinway would mislead the customers that lets expensive Grotrian-Steinweg is atleast as good if not better than a steinweg. However, in *Reed Executive Plc case* (supra) it was held that metatag in the source code do not amounts to infringement.

50. In *Red Label Vacations Inc.Vs. 411 Travels Buys Ltd.* Reported 2015 FC 19 Federal Court of Canada has held that use of competitive trademarks in metatags in not an infringement of trademark or copyright. In the said case, it was not in dispute that metatags in the defendant's source code caused the defendant's website to be listed among the search results. However, there was no actual display of plaintiff's tradename or trademarks on the defendants' website. As the latter was clearly labelled with defendants own trademark. In *Tansocan Vs. Eurotex case*, Netherlands court has held that

metatags are visible to website visitors hence, not an infringement of trademark. On perusal of these decisions with respect to metatags, it shows that there are divergent opinions by courts of various countries. In the present case, whether defendants are using the plaintiffs' trademark in source codes of their website is yet to be determined during the full-fledged trial. Therefore, at this stage, it cannot be believed that the defendants are using the trademarks of plaintiffs in their websites as contended by the plaintiffs.

51. Further, on perusal of Art. 20 of the Indian constitution it is evident that no person shall be subject to any liability or disability unless procedure established by law as on the date of commission of the Act. Further, rulings relied by the parties disclose that if the Google search results carry the registered trademarks for deceptive similar trademarks in 3<sup>rd</sup> party websites, the same amounts to infringement or passing off action. If the person use a domain name in which similar to registered trademark or deceptive similar, the same amounts to passing off or infringement. Key words or metatags used by 3<sup>rd</sup> parties which are invisible to consumers do not amount to passing off or infringement.



52. It is a settled principle of law that in order to attract passing off, the plaintiff shall prove that the defendant has made use of an identical/deceptively similar trademark in relation to identical goods from an identical trade channels. Therefore, identical/deceptive similar trademark, in relation to identical goods and identical trade channels are main criteria to attract requirements of passing off. In the present case, if the Plaintiffs are crowdfunding business, the defendant no.1 is the search engine. There is no deceptive similarity between Plaintiffs Trademark Milaap and Defendants Trademark Google. Both the plaintiffs business and trade channels are different. When the plaintiffs and defendant no.1 are into separate business, there is no reason for Confusion. Therefore, there is no cause for action of passing off against the Defendant no.1. Further, if the defendant no.2 who is using the defendant no.1 platform is restrained from using plaintiffs trademark through Defendant no.1, then it would suffice the case of the Plaintiffs.

53. With respect to action against the defendant no.2, it is not in dispute that plaintiffs and defendant no.2 are competitors and are involved in crowdfunding business. Therefore, plaintiffs and defendant no.2 are

having identical trade services and trade channels. However, merely because the Plaintiffs and defendant no.2 are having identical business and trade channels, that itself would not be sufficient to prove a passing off against 2<sup>nd</sup> defendants. Identically/deceptively similar Trademark by the defendant is the foremost criteria to be proved by the plaintiffs. In the present case, if the plaintiffs are a MILAAP, defendant no.2 is Impactguru. There is no deceptive similarity between two trademarks. Both are phonetically and visually are different. Hence, when the trademark itself will not qualify for 1<sup>st</sup> criteria of passing off, the rest of the criteria will not arise for consideration. However, it is not the case of the Plaintiffs that the use of Google or Impact guru is passing off the trademark of the Plaintiffs. It is the case of the plaintiffs that 2<sup>nd</sup> defendant is using the trademark of the Plaintiff in defendant no.1 search engine to divert the web traffic to Defendant no.2 website and the same amounts to Passing off. Whether diverting web traffic to 2<sup>nd</sup> defendant website amounts to passing off is also a matter of trial.

54. It is the contention of the defendant no.1 that the defendant no.1 is being the subsidiary of Google LLC, is not a proper and necessary party. On perusal of the document no.3 of WS of defendant no.1 Terms of

service of Google, it shows that Google Ads Program is owned, controlled and managed by the Google LLC which is incorporated in the USA. Defendant no.1 is a subsidiary of Google LLC. Therefore, Google LLC is a proper and necessary party to be impleaded in this case if there is any relief sought against them. Just because a Defendant no.1 is a subsidiary, it cannot be said that they are also liable for the action unless the plaintiffs shows that defendant no.1 is collecting the money and facilitating the Ad word program for its holding company.

55. Even if it is considered that defendant no.1 is the proper and necessary party, on perusal of document no.12 of the plaint 'Google Ads program', it shows that it is an advertising service on which any advertiser can create and display an online advertisement in relation to its website. When a user types a search term, the results that appear are "Sponsored Search results" which are displayed and labelled as Ad/ and organic search results are presented in an indexed manner. Every Ad has 3 visible components as Ad Title, URL and Ad Description. Ad title and Ad description which are collectively called as Adtext are created and controlled by an advertiser. On perusal of Document No.12 of the Plaint, it is clearly visible that AD is mentioned. Therefore, if a person

search for any name, it is easier to identify whether it is a sponsored AdText or organic results.

56. Even considering the reliefs against both the defendants, admittedly the plaintiffs and defendants website are not used by illiterates. It is generally used by the computer literates. Further, the websites of plaintiff and defendant No.2 are used by the persons who are having sufficient amount to contribute to the causes as shown/canvassed by the plaintiffs and 2nd defendant. In general, if a person is willing to donate some amount to Lord Ganesha, it is not likely that he would be donating the same amount to Lord Venkateshwara believing that it is Lord Ganesha. If a man searches for Bangalore to Delhi flight in 1<sup>st</sup> defendant's website and finds a result for Bangalore to Singapore flight, it is not likely that person will fly to Singapore instead of Delhi. In the present case, if the plaintiffs are Milaap, defendant No.2 is Impact Guru. Even if people search for Milaap and it gives the results for 2nd defendant website, as the most of the users are educated persons, it will not cause any confusion among the users that the Impact Guru is Milaap. Further, the services offered by the plaintiff and 2nd defendant are not over counter sales like fast moving consumer goods.

57. Further, admittedly on perusal of the plaint the present suit is not for infringement of copyright. Though Sec.29(8) provides that a registered trade mark is infringed by any advertising of that trade mark if such advertising takes unfair advantage of and is contrary to honest practices in industrial or commercial matters; or is detrimental to its distinctive character; or is against the reputation of the trade mark, the plaintiff cannot claim for temporary injunction on the basis of said provision as the plaintiff's trademark is unregistered as on the date of filing the suit.

58. It appears that Google has become part of life for many and used by many for quick information. Google do not charge anything for these searches and providing email and other services to the public. Further, in fact Google cannot survive just providing a charity service. If they need to provide some free services, it is inevitable for them to generate revenue by way of adwords and other programmes. In fact, Google appears to be just like an indexing tool or a catalogue. Whoever pays more amount, their services will be more highlighted. If X advertises in the Judicial Herald Newspaper in the 2nd page, and if Y being competitor of

X wants to advertise its service on the front page, just because Y services is shown in the front page, it do not mean that Y has infringed /passed off the trademark of X. Further, on perusal of the Google Trademark Policy, it shows that they are not permitting Adword programme users to include trademark of third party in their Adtext. Therefore, at this stage the version of the Google cannot be disbelieved.

59. In fact, if the plaintiffs want Google to show all the top 10 results as Milaap when some one searches for Milaap, there appears to be no impediment for the Google to provide such services on payment of requisite fees if their Adword program so provides. Such indexing may not amount to infringement or passing off of Trademark.

60. Further, records show that once the advertiser creates a google Ads Account, provides Ad title of Advertisement, Ad Text, Ad description, keywords relevant to its business and URLS of the website and whenever internet user types the said keyword, the same will get displayed on a Google Search Engine. These Keywords are different from Metatags. If a keyword is a word/Phrase that is provided by an advertiser to act as trigger for its website, a Metatag is embedded /included

in website source code by website developer. Even if it is considered that Google Sells or bids the keywords for a price, the advertiser will not acquire any proprietary rights over the keywords. No one can convey a better title than he himself has. Therefore, the same will not convey any title. Even if it is considered that the Google search results are giving result of the websites which are using the trademarks as metatags, there cannot be any infringement or passing off of Plaintiffs trademark as these websites will not display these metatags. In Google search these Metatags are visible only when internet user use the option of view source code to view the same and almost users never use such option as they are nothing to do with the same. It is settled principle of law as held by House of Lords, in Vickers Sons and Maxim Ltd. Vs. Evans(1910) AC 444 as quoted with approval by the Hon'ble Apex Court in Jamma Masjid, Mercara Vs. Kodimaniandra Deviah and Ors. AIR 1962 SC 847 and reiterated in Shiv Shakti Co-operative Housing Society Vs.Swaraj Developers, AIR 2003 SC 2434 and in a catena of decisions that the court cannot read anything into a statutory provision which is plain and unambiguous. On bare perusal of the Sec.2(2)(b) of Trademarks Act provides use of the mark shall be construed as reference

to the use of printed or other visual representation of the mark. Therefore, it makes it mandatory on the court to construe the use of the mark in a printed or visual representation of the mark. Unless the trademark statute provides that use of the mark shall include keywords and metatags in invisible form, it cannot be held that keywords and metatags in invisible form also amounts to infringement of trademark. In the present case, the records do not show whether the 1st defendant or 2nd defendant are using the plaintiff's mark in a visual or printed form. In fact, such results do not contain the trademark Milaap in the 2 defendant's website or Ad texts.

61. However, if the Google permits any 3<sup>rd</sup> party trademarks within Ad text or within website so as to display the competitors trademark, it can be said that Google is aiding the infringement or passing off of the Trademarks. Document no.12 of the plaintiff do not disclose that Ad text display the trademark of the Plaintiffs in Defendant no.2 website. Further, document no.12 of the plaint shows that when the Milapp is searched, the website of the Plaintiffs are also displayed. It is not the case of the plaintiffs that it is not showing



the website of the plaintiffs. When the Google display website of the defendant no.2 as well as the plaintiffs, there is no reason for confusion among the customers and they can always chose the website they are intended. Further, when Google gives such results, it is in a way beneficial to the consumers as they can opt for websites which charge less.

62. Further, it is a settled principle of law that a person who approaches the court shall approach the court with clean hands and shall have an unblemished background. He who seeks equity must do equity. On perusal of the page no4 of the Memo dated 27.8.2021 filed by the Defendant No.1, it shows that plaintiffs are actively bidding for the Trademark of one of its competitors 'Gofundme' as a keyword. When the plaintiffs themselves are involved in bidding process, they cannot contend that competitors infringe or pass of plaintiffs trademark.

63. Further, the moment, an advertiser subscribe to Ad program, they are bound by the terms and conditions of the same. The moment they access the Google Search engine, the access itself amounts to acceptance of the terms and conditions which are called

as Browse Wrap Agreement. They are also governed by the governing law contained in terms of use. Whether these governing Law Prohibits Adword programm is a matter of trial by a competent court.

64. Though the plaintiffs have relied on documents No. 1 to 20, ie., the company mater data extract from the website of the Ministry of Corporate Affairs of plaintiff No.1, defendant No.1 & 2, Web extracts confirming the 2<sup>nd</sup> defendant carries out commercial activities and operations and carried on business in Bangalore, Articles and press releases of the plaintiffs as well as media coverage in the newspapers and journals(Colly), Extract of plaintiff's application for registration of its mark before trademark registry, extract from the domain name registry and screen shorts of the plaintiff' website, Registration certificate of trademark MILAAP in Singapore and United States, Social media campaigns launched by the plaintiff, Newspaper coverage and list of awards won by the plaintiffs, Extract from Google.com confirming that appears first 2<sup>nd</sup> defendant's when user searches for the plaintiff's mark MILAAP, web extracts confirming the usage of the plaintiff's mark MILAAP as keyword by 2<sup>nd</sup> defendant, web extracts confirming the

usage of the plaintiff's mark MILAAP as keyword by Impact Guru Technology 2<sup>nd</sup> defendant, web extracts of the plaintiff's mark MILAAP keyword by the 2<sup>nd</sup> defendant, emails dtd.10.12.2019, 7.12.2018, 16.3.2017 & 17.3.2017, the relevant documents that arise only for consideration are document No.12 to 14. On perusal of document No.12, it shows that when MILAAP is searched on 1<sup>st</sup> defendant website, it is showing the first result of defendant No.2 and second result as plaintiff. However, the Adtext do not contain any trademark of the plaintiff. Therefore, when the consumers search for the plaintiffs' trademark it will give an option of either to go for plaintiff or defendant's website and there is no initial interest of confusion.

65. With regard to the amendment, admittedly the plaintiff was not the registered owner of the trademark on the date of filing the suit. Plaintiff has subsequently, registered the trademark Milaap. If the amendment is allowed, the same will relates back to the date of filing the suit and it may make the defendants liable for the infringement of the trademark as on the date of suit. Although, Art 20 of Indian constitution do not prohibit, expost facto laws with respect to civil liability, allowing the amendment would prejudice the interest of

defendants that it makes them liable for the acts which were not an infringement at the time of filing the suit. The Trademark Act 1999 itself clearly distinguish between the Infringement and passing off. If passing off itself provides for everything, then the registration of the Trademark becomes insignificant. The registration of the trademark itself provides for certain remedies and presumptions. If the registered proprietor has a statutory remedy, unregistered trademark owner has a common law remedy. Merely filing the trademark application, it does not guarantee the registration of the trademark by the trademark registry. If at all defendants are infringing the registered trademark of the plaintiffs, there is no bar for plaintiffs to file for separate suit for infringement of trademark based on the new cause of action. Just because the 2<sup>nd</sup> defendant has no objection to allow the amendment application, the same does not mean that it has to be allowed, unless plaintiff has made out grounds for allowing the amendment application. In the above circumstances, I answer the point no. 1 to 3 in the negative. Point no.4 in the affirmative and point no.5 in the negative.

66. **Point No.6** : In the result, I proceed to pass the following:

**ORDER**

I.A.No.1 & 2 under order 39 Rules 1 and 2 R/w Sec.151 of CPC and I.A.No.8 Under Order 6 rule 17 R/w Sec.151 CPC filed by the plaintiffs are hereby dismissed.

The I.A.No.4 & 6 under Order 39 Rule 4 r/w Sec.151 CPC filed by the defendant 2 & 1 respectively are hereby allowed.

[Dictated to the Judgment Writer directly on computer, computerised, and print out taken by him, corrected and then pronounced by me in open court, this day the 28<sup>th</sup> October 2021].

**(SADANANDA NAGAPPA NAIK)**  
XVIII ADDL. CITY CIVIL AND  
SESSIONS JUDGE, BENGALUR

Orders pronounced in the open court vide separate orders. The operative portion of the order reads thus;

ORDER

I.A.No.1 & 2 under order 39 Rules 1 and 2 R/w Sec.151 of CPC and I.A.No.8 Under Order 6 rule 17 R/w Sec.151 CPC filed by the plaintiffs are hereby dismissed.

The I.A.No.4 & 6 under Order 39 Rule 4 r/w Sec.151 CPC filed by the defendant 2 & 1 respectively are hereby allowed.

XVIII ADDL. CITY CIVIL AND  
SESSIONS JUDGE, BANGALORE