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* IN THE HIGH COURT OF DELHI AT NEW DELHI

Date of Decision: 01st March, 2023

+ CS(COMM) 592/2018 & I.As. 18693-18694/2011, 15489/2012, 16551/2012.

GOOGLE LLC.....Plaintiff

Through: Ms. Tanya Varma and Ms. Coral Shah,
Advocates.

versus

GOOGLE ENTERPRISES PVT TLD & ORS Defendants

Through: Defendants proceeded ex-parte *vide*
order dated 02nd July, 2013.

CORAM:

HON'BLE MR. JUSTICE SANJEEV NARULA

JUDGMENT

SANJEEV NARULA, J. (Oral):

I.A. No. 4124/2023 (for amendment of the plaint)

1. Present application seeks to introduce amendments in the plaint, noted hereinafter :-

(i) Change in name of Plaintiff from Google Inc. to Google LLC, which was in fact allowed *vide* order dated 15th December 2022 and to this effect, an amended memo of parties is already on record.

(ii) Additional prayer against Department of Telecommunications [hereinafter '*DoT*'] to permanently block Defendants' domain names, as listed in paragraph 37(iv) of the amended plaint, which form part of the subject matter of the suit.

(iii) Change in constituted attorney of Plaintiff from Mr. Rahul Sethi to Mr. Vishal Vig, whose power of attorney is already on record.

2. Given that above changes are formal in nature, the present application is allowed. Amended plaint accompanying the application, is taken on record.

3. Disposed of.

CS (COMM) 592/2018

4. Plaintiff, a multinational technology company, is the registered proprietor of the mark “GOOGLE” and variations thereof, under several classes such as Classes 16, 42, 35, and 9.


5. The Plaintiff is adversely effected by the Defendants' actions of misusing the aforementioned mark and falsely claiming an association with the Plaintiff to deceitfully mislead the public. As a result, the Plaintiff seeks a permanent injunction to restrain infringement of their marks and passing off, in addition to submission of accounts, damages, delivery up, and other remedies.

PLAINTIFF'S CASE

6. The Plaintiff conceived and adopted the mark “GOOGLE” in 1997, both as a trademark and in its corporate name. Plaintiff is widely recognised for its internet-search engine viz. “www.google.com” [*hereinafter* “**Plaintiff's website**”] which, along with its country specific domains (including “www.google.co.in”, the Indian domain) receives over a hundred million unique visitors every month and reaches more than 150 countries worldwide. Plaintiff also provides a range of products and internet-based services which *inter alia* relate to advertising, news, navigation/maps, email, office productivity services, video-sharing. In addition, Plaintiff has established offices and R&D centres across India to provide its products and

services, and develop locally relevant products. Plaintiff's products and services, including its website, bear the mark "GOOGLE" and variations



thereof, including “”, details of registration of such marks are provided at page 2 to 8 of the documents filed along with the plaint and Ex. PW1/3 [hereinafter collectively referred to as “*Plaintiff's mark(s)*”]. Given the ubiquity of the internet and digital services around the world and India, Plaintiff's marks have built tremendous goodwill and reputation over a span of more than two decades. Around the world, the “GOOGLE” mark and its variations are associated with Plaintiff's products and services. Plaintiff generated revenue of more than USD 29 million in 2010 and has expended heavily towards sales and promotions of its products, details of which are enumerated at page 17 of the amended plaint.


7. Plaintiff's mark “GOOGLE” has acquired a high degree of inherent distinctiveness; has been used extensively over a long period of time spanning a wide geographical area; has been given tremendous publicity and attained immense popularity; it is well recognised by members of the trade and public. Trademark Registry has also included the mark “GOOGLE” in its list of well-known trademarks in terms of Section 2(zg) of the Trade Marks Act 1999 [hereinafter “*the Act*”]. This Court in CS(OS) 317/2011 restrained a party from using the mark “GOOGLE” even in relation to different goods i.e., iodised salt.¹

8. Defendant No. 1, is engaged in the business of trading, consultancy for allied activities etc. and is registered under the corporate name “Google

¹ Google Inc. v. M/s Jagnath Chem Food Pvt. Ltd., decided on 05th July, 2011.



Enterprises Private Limited” per the records of the Registrar of Companies, Kanpur [hereinafter “**ROC**”]. Defendant No. 1 applied for registration of

marks viz. “GOOGLE ENTERPRISES”, “” and “

” in classes 35 and 42 bearing application Nos. 2195139, 2193370, and 2193371 dated 20th August, 2011 [hereinafter “**Trademark Registration Applications**”]. In September, 2011, on gaining knowledge of Defendant No. 1’s corporate name, and the filing of Trademark Registration Applications, Plaintiff sent a cease and desist letter dated 19th September, 2011 [hereinafter “**Cease and Desist Letter**”]. In response thereto, Defendant No. 1 agreed to withdraw its Trademark Registration Applications but refused to amend its corporate name.

9. In October, 2011, Plaintiff learned from queries received from customers, that a concocted collaboration was announced between Plaintiff’s supposed India entity and “Tata Communications” for a joint venture, i.e., Defendant No. 2-E-Kutir Technology & Extension Management (P) Ltd., a Knowledge Process Outsourcing (KPO) unit with the website “www.ekutirindia.com” [hereinafter “**KPO unit**”], as also an “E-Card” service, providing a bouquet of technology services which would include Plaintiff’s services. Said announcement was publicised by way of a brochure and news articles, which have been filed along with the plaint. Neither Plaintiff nor Plaintiff’s India entity entered into such a collaboration. Defendant misrepresented the public into believing that on depositing certain amounts of money in Defendant No. 1’s bank accounts, they would secure a job with the aforesaid KPO unit.

10. On further enquiries, Plaintiff learned that Defendant No. 1 also operates websites i.e., “www.getjobdesk.com” and “www.gkpo.co.in”. Defendant No. 1’s name and address as provided in the “WHOIS” records of the domain “www.gkpo.co.in”, is identical to Defendant No. 2’s address mentioned in the memo of parties. Plaintiff also discovered another website “www.googlekpo.com” which redirects to “www.ekutirindia.com” (for the said KPO unit), registered under the name of Mr. Chander Shekhar, the Defendant No. 3, who is Director of Defendants No. 1 and 2. On the websites “www.gkpo.co.in” and “www.ekutirindia.com”, Defendants used the marks

“” and “”, respectively [hereinafter “*impugned marks*”]. In view of the above facts, it is evident that Defendants No. 1 to 3 were acting in collusion with each other in furtherance of their unlawful activities. They have misrepresented their association with Plaintiff, by misusing Plaintiff’s “GOOGLE” trademark on their websites.

INTERIM ORDERS AND EX-PARTE EVIDENCE

11. Plaintiff secured an *ex parte ad interim* injunction in its favour on 25th November, 2011 against Defendants, relevant portion whereof is as under:

“Hence, defendants No. 1 and 2 are restrained, till further orders from selling/ offering, promoting, advertising or marketing any product or service under the name GOOGLE or Google Enterprises (Pvt.) Ltd. They are also restrained from using GOOGLE as part of the corporate name of defendant no. 1 w.e.f. 12th December, 2011.

This order will operate from the time it is served upon defendants along with suit summon and notice of the application. The plaintiff is directed to take dasti process and get the defendants served at his own responsibility within one week. Registry is directed to give dasti process to the plaintiff within three days”

12. Thereafter, despite summons, Defendants continued their infringing

activities. This came to light when Plaintiff was served with a legal notice dated 08th June 2012, by a number of parties residing in Bhopal, who believed that Defendant No. 1 was associated with the Plaintiff and said notice further revealed that Defendant No. 2 and 3 committed misappropriation of funds to the extent of Rs.11,89,500/-. Pursuant to this, Plaintiff initiated contempt proceedings against them which are currently pending. Plaintiff also filed an FIR bearing no. 643/12 on 10th August, 2012 against the Defendants, at Police Station, Sector-20, Noida.

13. Defendant No. 1 has not appeared before Court and despite grant of multiple opportunities, failed to file a written statement or affidavit of admission/ denial. Defendants No. 2 and 3 have however filed their written statements on 30th March, 2012, but, subsequently, they too stopped contesting the matter and have failed to file an affidavit of admission/ denial of Plaintiff's documents. Defendant No. 2 and 3's counsels withdrew their vakalatnama as they stopped receiving instructions as recorded in order dated 17th April, 2020. Thereafter, Defendants No. 1 to 3 were proceeded *ex-parte* in terms of order dated 02nd July, 2013. Plaintiff has led *ex-parte* evidence by way of affidavit Ex. PW1/A and exhibited documents Ex. PW-1/1 to Ex. PW-1/14.

DEFENDANT'S CONTENTIONS

14. In the written statement, Defendants No. 2 and 3 pray that the present suit should be dismissed on the following grounds:

14.1 In terms of Order XXIX Rule 1 and 2 of CPC, 1908, the competent person to sign and verify pleadings on behalf of a corporation is a secretary, director, and principal officer of said corporation. Present suit has not been

instituted or signed by any such competent person on behalf of Plaintiff-company, or a power of attorney holder on their behalf.

14.2 Plaintiff is accompanied by an improper affidavit, whereof Plaintiff has failed to specify the paragraphs in the plaint which are based on its own knowledge and those verified upon legal advice so received.

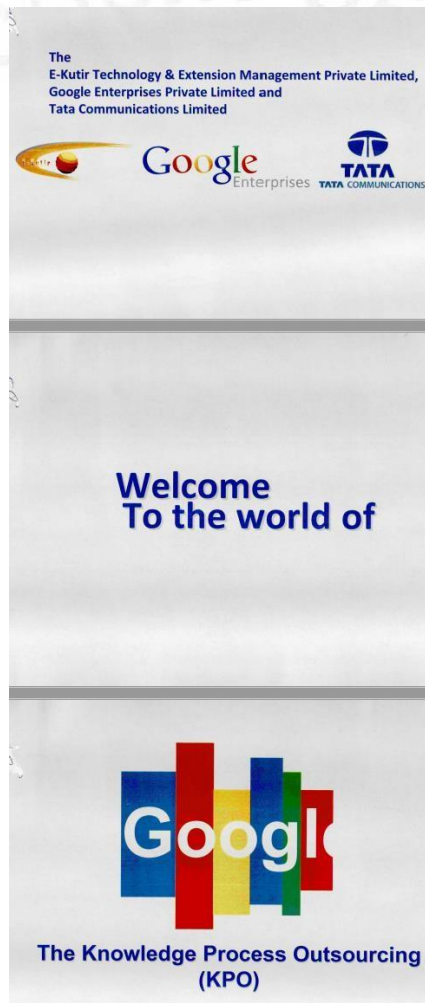
14.3 Cause of action lies against a corporate entity for its illegal actions, if any, and not against its director. Thus, arraying Defendant No. 3 as a party, who is only a director of Defendant No. 2, is misconceived in terms of Order I Rule 9 and 10, CPC, 1908. That apart, the entire claim has been made out against Defendants No. 1 and 2, and not Defendant No. 3.

14.4 Given that one of the prayers is to restrain Defendant No. 1 from using "GOOGLE" in its tradename, the present suit is barred by non-joinder of a necessary and property party, i.e., ROC, whose consent is required for any change in corporate name of an entity.

ANALYSIS

15. Defendant No. 1 could not be served by ordinary modes on account of having left the address available on record, accordingly substituted service was done by way of publication in "*Rashtriya Sahara*", New Delhi dated 08th October, 2012 as recorded in order dated 30th November, 2012. Despite this, Defendant No. 1 has failed to file a written statement and the statutory period of 120 days for the same also stands closed. None of the Defendants have controverted Plaintiff's claims or led evidence to substantiate their submissions. No evidence has been produced to refute Plaintiff's allegations. On the basis of oral and documentary evidence produced by Plaintiff, it is established that Defendants have used Plaintiff's registered marks without

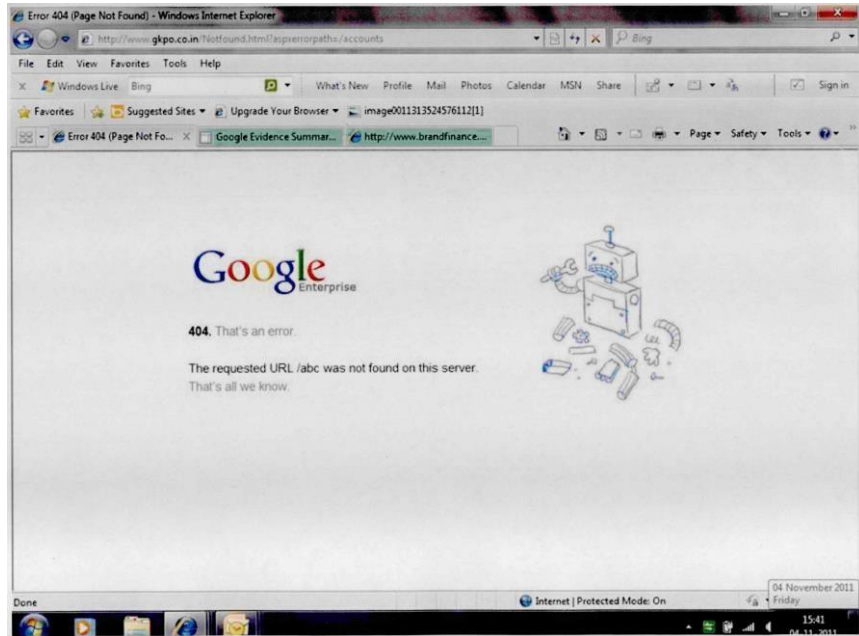
authorisation or consent. Defendants No. 1 and 2 have misrepresented to the public that they were partners of Plaintiff/ Plaintiff's India entity viz. "Google India" basis which Defendant No. 2 announced a fictitious KPO unit. The modus operandi of Defendants was to dupe members of the public into believing they would get a desk job on depositing money with Defendant No. 1 and be employed with an entity supposedly associated with Plaintiff, as is indicated from the KPO unit's brochure at Ex. PW1/11, an extract of which is reproduced below:



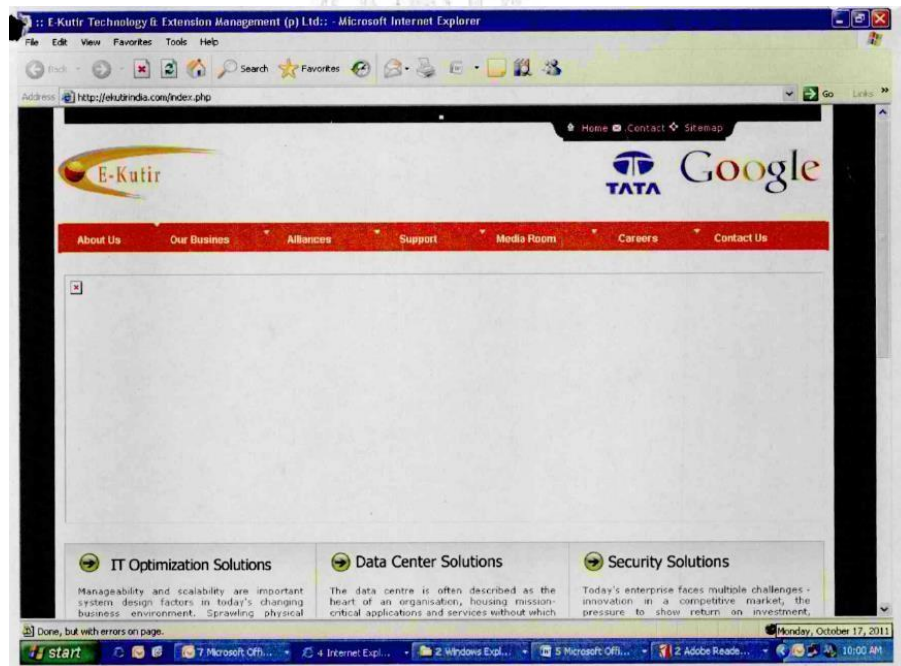
16. Defendants were unauthorizedly using the Plaintiff's marks on impugned websites, as made out from screenshots of such websites at Ex.

PW1/10, which are extracted as under:

- [Screenshot of www.gkpo.co.in](http://www.gkpo.co.in)

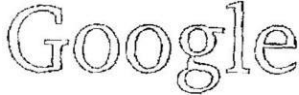





- [Screenshot of www.ekutirindia.com](http://www.ekutirindia.com)



17. Such was the level of deception and trickery, that individuals reached out to Plaintiff inquiring on their association with the Defendants on account

of the publicity of said KPO unit and impugned websites of Defendants; these communications have been filed as Ex. PW1/8. Comparison of Plaintiff's marks and marks adopted by Defendants on impugned websites is captured below—

<i>Plaintiff's mark(s)</i>	<i>Marks adopted by Defendants on its websites</i>
 [TM No. 1404168 in Class 42; TM No. 1404165 in Class 9]	 
	

18. The Court has also examined the defences raised by Defendant No. 2 and 3. Broadly, they seek dismissal of the present suit on technical grounds, with respect to competency, mis-joinder and non-joinder of parties. These contentions hold no merit and do not deal with allegations of infringement and passing off against Defendants. There is no specific denial to Plaintiff's assertions and thus, there is deemed admission of Plaintiff's allegations of infringement and passing off.

19. Plaintiff has valid and subsisting registrations for the mark "GOOGLE" and variations thereof. Said mark has also been declared a well-known mark with worldwide reputation on account of extensive use, numerous registrations of the mark "GOOGLE", by the Trademark Registry as well as

this Court. Plaintiff is surely entitled to statutory protection and grant of injunction for infringement.

20. A perusal of the documents and amended plaint indicates that Defendants have been dishonestly using Plaintiff's mark. The impugned marks displayed on Defendants websites, extracted above, are entirely



identical to Plaintiff's mark " apart from the addition of the word "Enterprise" in one instance . The word "GOOGLE" is depicted in a font and styling which is deceptively similar to Plaintiff's registered mark. Further, use of Plaintiff's registered word mark "GOOGLE" in the corporate name of Defendant No. 1 coupled with Defendants' use of Plaintiff's marks on their printed material/ brochures to represent was solely intended to dupe innocent members of the public. It is clear that Defendants No. 1 to 3 have been acting in collusion, insofar as the impugned websites are concerned, and as such continue to operate in complete disregard to Plaintiff's rights and the interim injunction operating against them. Defendants' evidently want to free-ride on Plaintiff's appeal in the global/ Indian market for unlawful monetary gain. Thus, they deliberately misrepresented to the trade and public that they are carrying out their business in partnership/ affiliation with Plaintiff, which was certainly not authorised or legitimate. Given the tremendous goodwill and worldwide reputation of Plaintiff's mark, Defendants use of the "GOOGLE" mark manifests bad faith with no justification. Such misrepresentation has also already led to confusion and deception among the public at large. Defendants, if not permanently restrained, are likely to cause further injury to the Plaintiff, given that their activities are severely harming the reputation and diluting the goodwill of Plaintiff's marks. The Court thus

holds that that Defendants are guilty of infringement and passing off.

21. Considering the foregoing, the Court is of the opinion that the present case is fit for passing a summary judgment under Order XIII-A of CPC as applicable to commercial disputes read with Rule 27 of Delhi High Court Intellectual Property Division Rules, 2022 [hereinafter “*IPD Rules*”].² In fact, in absence of defence by Defendant No. 1 Court is also entitled to invoke Order VIII Rule 10 of CPC to pass a judgment.

22. Plaintiff argues that it is entitled to the fullest extent of damages payable in law by way of compensatory damages for the loss of reputation in the eyes of customers as also punitive damages for Defendants’ deliberate illegal acts which amount to unjust enrichment at the Plaintiff’s expense, it notionally estimates that its losses would be at least Rs. 20,00,100/-. Coordinate Benches of this Court in *M/s General Electric Company v. Mr. Altamas Khan and Ors.*,³ and *Microsoft Corporation v. Yogesh Papat & Anr.*⁴ have granted compensatory damages based on assumptions of commercial gain. Thus, considering the overall facts and circumstances of the case, Defendants’ conduct invites the award of damages. In the opinion of the Court, taking a reasonable assessment and considering the nature of unlawful use of Plaintiff’s mark and misrepresentation by Defendants, Plaintiff is entitled to nominal damages.

RELIEFS

23. The present suit is accordingly decreed in favour of the Plaintiff and

² See: *Su-Kam Power Systems Ltd. v. Kunwer Sachdev*, 2019 SCC OnLine Del 10764, ¶¶ 90 and 92.

³ 2008 SCC OnLine Del 1794, ¶¶ 13 and 14.

⁴ 2005 SCC OnLine Del 216, ¶¶ 21.

against Defendants No. 1, 2, and 3 in terms of the prayers at paragraph no. 37 (i) and (ii) of the amended plaint.

24. In view of the above, damages of INR 10,00,000/- are awarded in favour of Plaintiff, payable jointly and severally by Defendants No. 1, 2 and 3 to Plaintiff.

25. Defendants are directed to hand over all printed matter, including stationery, brochures, bearing the mark/name "GOOGLE" to the authorized representative of the Plaintiff representative(s) for the purpose of destruction, in compliance with extant rules/ regulations.

26. DoT is directed to issue directions to all ISPs and telecom service providers directing them to block access to the website hosted on domain name – "www.googlekpo.com".

27. Plaintiff is also entitled to actual costs, in terms of the Commercial Courts Act, 2015 and Delhi High Court (Original Side) Rules, 2018 read with IPD Rules, recoverable jointly and severally, from Defendants No. 1, 2 and 3. Plaintiff shall file its bill of costs in terms of Rule 5 of Chapter XXIII of the Delhi High Court (Original Side) Rules, 2018 on or before 30th April, 2023. As and when the same is filed, the matter will be listed before the Taxing Officer for computation of costs.

28. Suit is decreed in above terms. Registry is directed to draw up the decree sheet.

29. Suit and pending applications are accordingly disposed of.

SANJEEV NARULA, J

MARCH 1, 2023/as

(Corrected and released on: 29th March, 2023)