$~10 (Original)

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

\+ CS(COMM) 159/2022

ADOBE, INC ..... Plaintiff

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

Versus

NAMASE PATEL AND OTHERS ..... Defendants

Through: Mr. Azhar Qayum Adv for D-8
Mr. Harish Vaidyanathan Shankar, CGSC with Mr. Srish Kumar Mishra, Mr. Sagar Mehlawat and Mr. Alexander Mathai Paikaday, Advs. for D-11

**CORAM:**
**HON'BLE MR. JUSTICE C.HARI SHANKAR**

**JUDGMENT(ORAL)**

**% 29.11.2022**

**1.** The plaintiff, which was founded in 1982, is the second largest US based personal software company, and claims to have annual turnover in the region of US dollars five billion. It has a global presence and disseminates various products and services, used the world over under various trademarks, which are all licensed. The present suit concerns itself with 'ADOBE', 'SPARK'/'ADOBE SPARK' and 'PHOTOSHOP' trademarks, registered in favour of the plaintiff and, as per the plaint, infringed by Defendant 1 Namase Patel.

**2.** The plaintiff claims to have adopted the word marks 'ADOBE' as early as in 1986, and to have been using it, in respect of its products

and services, worldwide since then. The trademark is stated to have been derived from the 'Adobe Creek' in Los Altos, California, which flowed behind the houses of the founders of the plaintiff company. By order dated 30th May 2008 in CS(OS) 1784/2007, this Court has already recognized 'ADOBE' to be a well-known trademark within the meaning of Section 2(zg) of the Trademarks Act, 1999 ('the Trademarks Act'). By virtue thereof, and by operation of Section 29(4) of the Trademarks Act, the mark 'ADOBE' becomes entitled to a higher degree of protection.

**3.** The plaint asserts that the use of the mark 'ADOBE' was commenced in India, by the plaintiff, in 1993. The registration held by the plaintiff, for its marks 'ADOBE' and 'PHOTOSHOP' have been provided in a tabular form, thus, in para 11 of the plaint:

| Registration No. | Class | Application Date | Trade Mark |
|---|---|---|---|
| 480389 | 9 | 30/10/1987 | ADOBE |
| 480390 | 16 | 30/10/1987 | ADOBE |
| 2073538 | 42 | 23/12/2010 | ADOBE |
| 534978 | 9 | 10/08/1990 | PHOTOSHOP |
| 1742124 | 39 | 10/10/2008 | PHOTOSHOP |
| 1742125 | 42 | 10/10/2008 | PHOTOSHOP |

**4.** 'ADOBE' also forms part of the domain names www.adobe.com, www.adobe.net and www.adobe.in ('the adobe domain names', hereinafter) owned by the plaintiff.

**5.** The plaintiff also claims proprietorial rights in respect of the trademark 'SPARK'/'ADOBE SPARK' which, though not registered in India, was the name given by the plaintiff to its suite of mobile and web tools used to create visual content, which debuted on 19th May

2016.

**6.** Defendant 1 is alleged, in the plaint, to be infringing the plaintiff's 'ADOBE' mark by his domain names www.addobe.com and www.adobee.com. There can possibly be no dispute about the fact that the domain names www.addobe.com and www.adobee.com are confusingly similar to 'ADOBE' mark and, therefore, infringed the 'ADOBE' mark and the adobe domain names of the plaintiff within the meaning of Section 29 of the Trademarks Act.

**7.** The manner in which the 'PHOTOSHOP' and 'SPARK' marks of the plaintiff are being infringed and misused by Defendant 1 is set out in para 18 of the plaint, which reads thus:

> "18. That in the present case too, Defendant No.1 's bad faith is borne out by the fact that Defendant No.1 is using several hundred sub-domains within the impugned domains www.addobe.com and www.adobee.com which include well-known trademarks/ products of the Plaintiff such as "Photoshop" "Spark" and are being used for the purposes of infecting an unsuspecting user's computer with malware. ….."

**8.** Defendant 1 is also alleged to be using the "catch-all" e-mail service provided by Above.com. A catch-all e-mail service is stated to be a service provided by which the person availing the services of the provider would acquire access to all e-mails, which may misspell the domain of the e-mail ID, which follows after "@". In other words, as is explained by Ms. Majumder, by using the said service, Defendant 1 was ensuring that if, while attempting to communicate with, hypothetically, a person having the e-mail ID xyz@adobe.com, the person communicating misspelled the second part of e-mail ID and, therefore, sent a mail to xyz@addobe.com or xyz@adobee.com , despite no such e-mail ID actually being in existence, the e-mail

would be directed to e-mail ID of Defendant 1. Thus, submits Ms. Majumder, Defendant 1 using the aforesaid unwholesome service provided by Above.com, was securing access to various confidential e-mails including e-mails relating to her client. As the e-mail would stand delivered to the inbox of Defendant 1, the person sending the e-mail would not bounce back to the sender, who would be under the impression that the e-mail stood delivered to the correct recipient.

**9.** In these circumstances, the plaint alleges that Defendant 1 was infringing the plaintiff's 'ADOBE' mark and also infringing, in the process, in an infringing fashion, the 'PHOTOSHOP' and 'SPARK' marks of the plaintiff. The confusing similarity between the www.addobe.com and www.adobee.com marks of Defendant 1, with the "Adobe" mark of the plaintiff, it is alleged, has also resulted in the Defendant 1 passing off his services as those of the plaintiff.

**10.** Defendants 2 to 10 are Internet Service Providers (ISPs), which provide gateways to enable access to the impugned domains owned by Defendant 1 and have been impleaded by the plaintiff to ensure effective implementation of the reliefs granted by the Court in the present proceedings.

**11.** Defendant 11 is the Department of Telecommunications.

**12.** Defendant 12, Sea Wasp LLC, is the Domain Registrar of the impugned domains of Defendant 1. Defendant 13 is Above.com.

**13.** Predicated on the above facts and allegations, the plaint seeks (i) a decree of permanent injunction, restraining Defendant 1,

his employees, servants, agents, representatives and others associated with him from registering any domain names which incorporate 'ADOBE' or any similar variant thereof as would amount to infringement of the trademarks of the plaintiff,

(ii) a direction to Defendant 11 to issue a notification to internet and telecom service providers to ensure blocking of access to the websites www.addobe.com and www.adobee.com,

(iii) a direction to Defendant 12 to transfer the said domain names to the plaintiff,

(iv) an order restraining Defendant 1 from disclosing any confidential material received by him and relating to the plaintiff to any third party,

(v) a direction to Defendant 13 www.above.com to disable the catch-all e-mail service being provided to Defendant 1 in respect of the impugned domains www.addobe.com and www.adobee.com, apart from a direction for rendition of accounts and damages to the tune of ₹ 2,00,01,000/-.

**14.** I may note, here that, though the relief at (i) above, as worded in the plaint, sought an injunction against defendant, from applying for registration of any domain name having 'ADOBE' as part thereof. Ms. Majumder, during arguments, restricts the prayer to a direction to Defendant 1 not to seek to register any domain name which would use the 'ADOBE' registered trademark of the Plaintiff in a manner as would infringe it.

**15.** In support of the assertions in the plaint, the plaintiff has placed on record an affidavit of Mr. John Scott Evans, who is the Director, IP & Marketing and Assistant Secretary for Adobe Inc., USA. The

affidavit deposes on oath that forensic investigation reveals that the domains www.addobe.com and www.adobee.com have been configured with the brands of 'ADOBE' products, such as 'PHOTOSHOP' and 'ADOBE SPARK'. In this context, one may reproduce paras 4 to 7 of the affidavit, thus:

> "4. Forensic investigation has revealed that these domains have been configured with the brands of Adobe products, such as Adobe Photoshop and Adobe Spark.
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> 5. In particular, forensic investigation has discovered that addobe.com has been configured with over 400 subdomains which match many used by adobe.com. A sub domain is a configuration that prepends a name to the front of a domain. As an example, addobe.com has been configured with photoshop.addobe.com according to the domain history provided to Adobe by respected threat intelligence providers that monitor for these types of potentially infringing behaviors
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> 6. Adobe has learned that addobe.com is hosted on Above.com infrastructure with an email catch-all to obtain any email sent to the domain, a configuration used to capture any and all email sent to addobe.com regardless of what is placed in front of the"@" symbol in the email.
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> 7. Adobe's investigation has revealed that, as a result of this email catch-all configuration, emails intended for Adobe recipients, but which include an Adobe's investigation has revealed that, as a result of this email catch-all configuration, emails intended for Adobe recipients, but which include an inadvertent typo in the intended recipients' email address, have instead been received and collected by this non-Adobe email catch-all. Due to the email catch-all configuration, these messages sent in error would not have generated a bounce-back or send failure message in the same manner as the sender would have been expected for messages sent to an invalid email address."

**16.** The plaintiff has also placed on record the orders passed by the National Arbitration Forum and the WIPO Arbitration and Mediation Center, which reveal that Defendant 1 Namase Patel is habitually involved in cyber squatting and infringing of domain names of various entities. The order passed by the National Arbitration Forum deals with infringement, by Defendant 1, of the domain names

www.underarmour.com and the orders of the WIPO Arbitration and Mediation Centre confirms infringement, by Defendant 1, by use of (i) the domain name 'theharrtford.com', of the marks 'HARTFORD', 'THE HARTFORD' and other such marks which included the word 'HARTFORD', owned by The Hartford Fire Insurance Company, and (ii) the domain name www.dior.com, registered in favour of Christian Dior Couture. Other similar orders have also been placed on record.

**17.** These orders clearly indicate that Defendant 1 is an inveterate cyber squatter, whose main sphere of activities involves infringing well-known domain names by using deceptively similar domain names and thereafter indulging in further misuse and infringing activities.

**18.** A list of the domain names owned by Defendant 1 has also been provided with the plaint.

**19.** In these circumstances, following the judgment of the Supreme Court in ***Satyam Infoway Ltd. v. Siffynet Solutions Pvt. Ltd***[1]**,** this Court *vide* order dated 11th March 2022, issued the following directions:

> "(1) Defendant No.l and anyone else acting on his behalf, is restrained from using the Infringing Domains being www.addobe.com and www.adobee.com and further from registering any domain name, which incorporates the Plaintiffs trademark 'ADOBE' or 'PHOTOSHOP' or 'SPARK' or any other variants thereof.
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> (2) Defendant No.l shall be served on the email address namasepatel@yahoo.co.in. The declared address of Defendant No.l is 1415, Mahatma Gandhi Road, MHADA, Mumbai, Maharashtra-400066, which is stated to be a false address as there is a mismatch between the address and pincode. Accordingly, directions are also

[1] **2004 6 SCC 145**

issued to the Cyber Cell, Mumbai Police to conduct an investigation and place on record a status report as to the following:

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

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

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

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

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

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

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

**20.** Defendant 1 has been absent from these proceedings ever since issuance of summons. It has been impossible to trace him. Efforts have also been made through the Cyber Cell of the Mumbai Police, which has also filed a status report indicating that it is not possible to trace Defendant 1, though the e-mail ID of Defendant 1 continues to remain in use. As Defendant 1 has never been appearing in these

proceedings, Defendants 1, 12 and 13 have all been proceeded *ex parte* in the present matter.

**21.** Directions issued in para 20 of the order dated 11th March 2022, passed by this Court, stands complied with. The infringing domains www.addobe.com and www.adobee.com have been blocked. Defendant 13 Above.com has not responded in the present proceedings. The Cyber Cell's report of the Mumbai Police indicates that the last known IP address of Defendant 1 is in the US.

**22.** Inasmuch as, for the present, infringing activities of Defendant 1, with which the plaintiff is aggrieved, have been brought to a halt, nothing further survives for adjudication in the present matter.

**23.** Accordingly, the suit stands decreed in the following terms:

(i) Defendant 1 as well as his employees, servants, agents, representatives and other associated with him shall stand permanently restrained from registering any domain names which incorporate or otherwise use the plaintiff's trademark 'ADOBE', 'PHOTOSHOP' or 'SPARK' in a manner which would infringe the plaintiff's registered trademarks or would otherwise infringe the said trademark.

(ii) Access to the websites www.addobe.com and www.adobee.com shall remain blocked.

(iii) Defendant 12 is directed to transfer the domain names www.addobe.com and www.adobee.com to the plaintiff, so as to avoid their misuse after expiry of their term.

(iv) There shall also be a decree of permanent injunction restraining Defendant 1 from disclosing any confidential material received by him relating to the plaintiff to any third party.

(v) Additionally, the plaintiff shall also be entitled to the quantum of the damages claimed in the suit of ₹ 2,00,01,000/-. These damages are intended to be deterrent in nature given the nature of activities of Defendant-1 and the fact that he stands recognized, even in foreign jurisdictions, as being an inveterate and habitual cyber-squatter and domain name infringer.

**24.** The suit stands decreed accordingly. The Registry is directed to draw up a decree-sheet in the above terms.

**C.HARI SHANKAR, J**

**NOVEMBER 29, 2022**
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