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

Date of Decision: January, 30, 2015

+ CS(OS) 1226/2013

YAHOO INC

Through

..... Plaintiff

Mr.Pravin Anand,Mr. Dhruv
Anand & Ms. Udit M. Patro,
Advocates

versus

ABDUL RASHEED AND ORS

Through

..... Defendant

None.

CORAM:

HON'BLE MR. JUSTICE JAYANT NATH

JAYANT NATH, J.(Oral)

1. Arguments have been heard in this suit. The Defendants were served but as none appeared on behalf of the defendants they are proceeded ex parte vide Order dated 12.03.2014.

2. The present suit is filed by the Plaintiff for permanent injunction restraining the defendants, their agents etc. from manufacturing, selling, distributing etc. good or services in any manner using the mark 'YAHOO!' or any other deceptively similar mark amounting to infringement of the plaintiff's registered trademark.

3. It is the contention of the Plaintiff that 'YAHOO!' Inc. is a corporation organized and existing under the laws of State of Delaware, U.S.A and is the leading Global internet brand and communications, commerce and media

company. YAHOO! Inc. is an American multinational Internet corporation headquartered in Sunnyvale, California. It is the contention of the plaintiff that it is globally known for its Web portal, search engine Yahoo Search, and related services; media website as mentioned in Para 5 of the plaint and is one of the most popular sites accessed worldwide.

4. It is also contended by the Plaintiff that use of 'YAHOO!' mark is not restricted to its computer and Internet-related services, but also extends to clothing, sporting, goods, and books including collateral goods such as computer accessories. 'YAHOO!' is also associated with candies, chocolates and other eatables and pursuant to co-branding agreements with several companies.

5. It is the contention of the plaintiff that they were amongst the first to start a web directory and provide search services. It started in the year 1994 and in March, 1994 the said directory of websites was made available on Internet free of charge. It is the contention of the plaintiff that initially the directory was called "Jerry and David's Guide to the World Wide Web" and in June, 1994 the name was changed to 'YAHOO!'. The plaintiff states that since then the plaintiff has broadened its offerings to include wide variety of online services For example, e-mail, chat, instant messaging, message boards, sports scores, news, stock quotes, etc.

6. It is the contention of the plaintiff that their total revenues globally in the year 2006, 2007 and 2008 are \$6,425,679,000, \$6,969,274,000 and \$7,208,502,000 respectively.

7. It is contended by the Plaintiff that the plaintiff owns service mark and trademark registrations for the mark 'YAHOO!' and variations thereof in the

United States of America and throughout the world, including India. In India, the first application for registration of 'YAHOO!' trademark was made in the year 1997 under class 25. The details of registration of 'YAHOO' trademark under various classes are specified in Para 37 of the plaint.

8. It is the contention of the plaintiff that Defendant nos.1 & 2 are the owners and proprietors of Defendant no.3 concern by the name of 'YAHOO BEAUTY CARE AND HAIR STYLES' salon situated in Kerala. The plaintiff contends that towards the end of May, 2013, the Plaintiffs learnt about the infringing activities of the defendants involving use of the plaintiff's trademark "YAHOO" as part of their trade name "YAHOO BEAUTY CARE AND HAIR STYLES" salon.

9. The Plaintiff submits that the adoption of the trademark 'YAHOO' by the Defendants as part of their trading name specifically infringes upon the Plaintiff's Trademark 'YAHOO! LIFESTYLE' registered under Class 44. The said class includes hygienic and beauty care services. It is the contention of the plaintiff that the plaintiff is also in an overlapping area of business namely, providing information on beauty care services and therefore the Defendant's use would lead to immense confusion.

10. The plaintiff contends that the Defendant's trading name contains the plaintiff's trademark YAHOO which is a well known mark in India by virtue of Section 2(1) (zg) and 11(6) of the Trademarks Act, 1999. The plaintiff further contends that the Registrar of Trademarks has included the plaintiff's trademark YAHOO amongst the list of well known trademarks in India.

11. It is the contention of the Plaintiff that the infringing trademark being adopted by the Defendants 'YAHOO' is visually, phonetically and structurally

identical to the Trademark of the Plaintiff.

12. It is also submitted by the Plaintiff that the Defendants have illegally adopted and created a business of 'YAHOO BEAUTY CARE AND HAIR STYLES SALON' creating confusion and deception in the minds of the general public as the public is bound to assume association and nexus between the Defendant's business and the plaintiff's services.

13. The plaintiff states that the Defendant's adoption of the mark YAHOO as part of their trading name is detrimental to the distinctive character and repute of the plaintiff's registered trademark YAHOO! and it would cause irreparable injury to the plaintiff.

14. The plaintiff contends that any unauthorized use thereof or any other identical or similar mark by any trader would inevitably lead to erosion of distinctiveness of the registered trademark 'YAHOO!' which has been utilized and sold by the Plaintiff since 1994. It is also contended by the Plaintiff that the use of the impugned trademark 'YAHOO!' by the Defendants constituted act of misrepresentation and passing off Defendant's unauthorized business activity.

15. Col. J.K Sharma, Constituted Attorney of Yahoo! Inc. (the Plaintiff) has led evidence on behalf of the Plaintiff as PW1. He has stated that the well-known trademark 'YAHOO!' has been given due recognition by the Indian Trademark Registry. A printout of the list of Well-Known Marks from the official website of the Indian Trade Mark Registry has been placed on record as **Exhibit PW1/21**. He states that the registered trademarks of the plaintiff mentioned in the plaint have been renewed and are subsisting on the register of the Registrar of the Trade Marks. The photocopies of the Certificates of the Trade Mark are placed on record as **Ex.PW1/4 to PW1/10**. He states that

sometime in May, 2013 the plaintiff company found out about the Defendant no.3 shop in Ernakulum, Kerala which was found to be using the plaintiff's well-known YAHOO trademark as a part of its trading name 'YAHOO BEAUTY CARE AND HAIR STYLES'. He states that the plaintiff instructed an independent investigator to investigate into the infringing activities of the Defendant. The report states that the Defendant is running a salon in the name and style of "YAHOO BEAUTY CARE AND HAIR STYLES" and has the hoarding and signboard displaying the same in a prominent manner. The investigation report and photographs are placed on record as **Ex. PW1/22** and PW1/23.

16. In view of the averments made in the plaint and the un-rebutted evidence filed by the Plaintiff, the Plaintiff has established that it is the registered proprietor of the said trademark 'YAHOO!' in class 25. It thus has a statutory right to the exclusive use of the same. The Plaintiff has also proved that the use of the mark by the Defendants 'YAHOO BEAUTY CARE AND HAIR STYLES SALON' constitutes a violation of plaintiff's statutory right as it is structurally, visually and phonetically identical to the registered trademark of the Plaintiff. The acts of the Defendants also appear to be lacking bonafide. The infringing business activities and the deceptively similar trademark enjoyed by the Defendants will lead to passing off of the services as that of the Plaintiff.

17. Learned counsel for the plaintiff has submitted that he does not press the relief for rendition of account of profits.

18. Accordingly, a decree of permanent injunction is passed in favour of the Plaintiff and against Defendants No.1, 2 and 3 restraining the said Defendants from manufacturing selling, advertising, dealing in goods or providing services

regarding any beauty care, hairstyling or preparations of cosmetics under the trademark 'YAHOO' or 'YAHOO BEAUTY CARE AND HAIR STYLES' or any other trademark that may be deceptively similar with the trade mark 'YAHOO!' of the plaintiff. The plaintiff shall also be entitled to costs of the present suit. The suit is disposed off.

JAYANT NATH, J.

JANUARY 30, 2015
Sh./Nat.