

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

% *Date of Decision: 09.07.2024*

+ **FAO(OS) (COMM) 98/2024, CM Nos.30835-30837/2024**

SONOO JAISWAL AND OTHERS Petitioners
Through: Mr. Ajay Singh, Advocate.

Versus

ORACLE AMERICA INC..... Respondents
Through: Ms.Swathi Sukumar, Ms.Tanya
Varma, Mr.Prithvi Gulati, and
Mr.Ritik Raghuvanshi, Advocates.

CORAM:

HON'BLE MR. JUSTICE VIBHU BAKHRU

HON'BLE MR. JUSTICE SACHIN DATTA

VIBHU BAKHRU, J. (ORAL)

1. The appellants have filed the present intra-court appeal impugning an order dated 12.02.2024 (hereafter *the impugned order*) passed by the learned Single Judge in IA No.57/2024 in CS(COMM) No.2/2024 captioned *Oracle America Inc. v. Sonoo Jaiswal & Others*. In terms of the impugned order, the learned Single Judge has allowed the respondent's application under Order XXXIX Rules 1 and 2 of the Code of Civil Procedure, 1908 (hereafter *the CPC*) and interdicted the appellants (arrayed as defendants in the suit) or any other person acting on their behalf, from using the respondent's trade mark "JAVA" as a part of their domain name www.javatpoint.com and / or in relation to the services offered by them. The learned Single Judge has further directed that in the event the appellants use the mark JAVA, such use is

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required to be strictly in terms of “Third Party Usage Guidelines for Oracle Trademarks”, which are available on the respondent’s website www.oracle.com.

THE CONTEXT

2. The respondent is a corporation existing and incorporated under the laws of California, United States of America and is a part of Oracle Group of companies, which the respondent claims operate in over 175 countries. The respondent claims that it has secured registration of its trade mark JAVA and various formative marks. It uses the said trade mark in respect of variety of goods and services relating to computer hardware and software.

3. The respondent has filed the above-captioned suit [CS(COMM) No.2/2024], *inter alia*, praying for a decree of permanent injunction restraining the appellants, their partners, servants, agents and all others acting in concert with them, *inter alia*, from providing marketing or advertising, directly and indirectly any services and/or goods under the


trade mark JAVATPOINT and logo  or any other deceptively similar marks amounting to infringement of its trade mark.

The respondent also seeks a decree, *inter alia*, restraining the appellants from passing off their services as those of the respondent. In addition, the respondent also seeks an order directing transfer of the appellants domain name www.javatpoint.com (hereafter *the impugned domain name*) to the respondent and for permanently blocking and deleting the social media accounts of the appellants. The respondent also seeks a

decree for delivery of the infringing products and rendition of accounts. It further claims a sum of ₹2,00,01,000/- as damages for loss of sales, reputation and goodwill of its trade marks resulting from the activities of the appellants.

4. The respondent claims that its trade mark JAVA is a well-known trade mark and also seeks a decree order declaring the said trade mark to be a well-known trademarks under Section 2(1)(zg) of the Trade Marks Act, 1999 (hereafter *the TM Act*).


5. The respondent claims that the global revenue of Oracle Corporation increased in the last ten years from 38 billion USD in the financial year 2014 to 50 billion USD in the financial year 2023. It also claims that it had secured registration of the following trademarks:

“Trade Mark	Class	Date of Registration	Registration No.
JAVASCRIPT	9	06/02/1996	697361
	9, 38 & 42	28/10/2003	1246392
JAVA	35, 38, 41 & 42	27/09/2006	1491786
JAVA	42	10/08/2015	3028558
GO JAVA	35, 41 & 42	16/08/2016	3338534
JAVA	35 and 41	02/12/2015	3113728
JAVA	16, 35, 36, 37, 38, 41, 42, 45	31/01/2018	3741038
JAVA	9	30/03/1995	661023
JAVA DAY	41	30/11/2018	IRDI-4063635”

6. The respondent claims that its trademark JAVA is well known and was instantly identifiable as being distinctive of the business, goods

and services of its group. It claims that the trade mark had acquired immense reputation and goodwill owing to their long standing, extensive use, and wide publicity.

7. The respondent also states that Oracle Corporation owns and maintains a dedicated website, www.java.com, which contain particulars as to the current portfolio of the products and services under the JAVA trademarks. The domain name was registered on 6th June 1996 and the respondent claims that it is an extension of the intellectual property rights of the Plaintiff Group in the trademark JAVA.


8. The respondent is essentially aggrieved by the appellant's adopting the trade mark JAVATPOINT and  (hereafter referred to as *the impugned trade marks*). Additionally, the respondent is also aggrieved by the use of the term 'JAVA' by the appellants in their domain name JAVATPOINT.COM The respondent claims that the appellants have no association with its group and yet the appellants purport to offer "Oracle – certified training" on their website.

9. The respondent alleges that the appellants, *inter alia*, by the use of the impugned trademarks sought to commit passing off. Additionally, the respondent claims that the use of the impugned trademarks, the impugned domain name and any other trademark, which is visually, structurally and phonetically similar to its trade mark JAVA, infringes the respondent's trademarks.

10. The appellants have filed a joint written statement to contest the

suit instituted by the respondent on various grounds. The appellants claim that appellant nos. 2 and 3 are educational institution, which was established thirteen years ago with the object of educating students and youngsters about software development and all the coding languages, by providing lectures and tutorials. The appellants claim that they have been continuously, extensively and uninterruptedly providing lectures and tutorials to students free of costs with the sole object of educating them about programming and coding languages. The appellant nos. 2&3 claim that they are one of the leading institutions in the said field.

11. The appellants had also resisted the respondent's application for interim relief under Order XXXIX Rules 1 and 2 the CPC. The appellants claim that JAVA is a technology which consists of both a programming language and a software platform which runs on billions of devices. Thus, the same could not be monopolized by anyone or any particular entity. They also claim that the name of a programming language cannot be claimed as a trademark. According to the appellants, JAVA is a generic word and the respondent could not claim any monopoly over use of the said name.

12. The learned Single Judge considered the rival contentions and *prima facie* found that the impugned marks JAVATPOINT and  infringed the respondent's trademark JAVA. The learned Single Judge also held that, *prima facie*, the adoption of JAVA as a part of their corporate name, by appellant nos. 2&3 as well as using it as a part of the impugned domain name, amounted to

infringing use.

13. At the material time, the appellant nos.2&3 were named as Javatpoint Limited and Javatpoint Tech Pvt. Ltd. The learned Single Judge held that use of the trade mark JAVA as a part of the corporate name, *prima facie*, constituted infringement of the respondent's trade mark JAVA under Section 29(5) of the TM Act. The Court held that mere addition of the word 'tpoint' as a suffix to the respondent's trade mark JAVA did not make any material difference as JAVA was the dominant part of the corporate name. The learned Single Judge also held that appellants' use of the impugned marks is infringing in terms of Section 29(1) of the TM Act.

14. The learned Single Judge did not accept the contention that JAVA being a programming language was not eligible for protection under the TM Act. The learned Single Judge found that the appellants' use of the impugned mark was not referring to a programming language in a descriptive or educational context. The appellants had adopted JAVA as part of their trade mark; thus, infringed the respondent's right in its registered trade mark.

15. It is relevant to note that respondent had readily conceded that it did not object to the use of its trade mark JAVA by the developer community insofar as it is used as descriptive of their knowledge, proficiency in or use of the JAVA programming language. However, it alleged that use of the impugned trade mark by the appellants was not in the aforesaid context. This contention was accepted by the learned

Single Judge.

16. In view of the above, the learned Single Judge allowed the respondent's application for interim relief and interdicted the appellants from using the impugned trade mark or any other deceptively similar trade mark. The appellants were also interdicted from using the domain name www.javatpoint.com.

SUBMISSIONS

17. At the outset, the learned counsel appearing for the appellants submitted that appellant nos. 2&3 have changed their corporate name and are confining the present appeal to challenging the impugned order to the extent it interdicts the appellant not to use JAVA as part of their domain name www.javatpoint.com.

18. He submitted that the domain name was an address and the same was not used as a trade mark, therefore, the question of the domain name infringing the respondent's trade mark did not arise. He submitted that the learned Single Judge had failed to note that the use of the JAVA mark was reasonably necessary to convey to the general public that the appellants were offering courses in JAVA language. It also contended that the term JAVA was used only to indicate the content of the courses offered by the appellants and no presumption could be drawn that the appellants were masquerading as the respondent or a part of the same group. He also submitted that several persons from rural areas access the appellants' portal for learning programming languages and the impugned domain name was informative as to the lectures and tutorials

offered by the appellant nos.2&3.

19. He submitted that the learned Single Judge had erred in referring to the decision in the case of *Satyam Infoway Ltd. v. Siffynet Solutions (P) Ltd.*¹ as no case of diversion of internet traffic was established.

REASONS & CONCLUSION

20. As stated above, the learned counsel for the appellants has confined the challenge to the present appeal to challenging the impugned order to the extent it has interdicted the appellants from using JAVA as part of their domain name www.javatpoint.com. The appellant nos. 2&3 have already changed their corporate name to “TPOINT Global Ltd.” and “TPOINT Tech Pvt. Ltd.”

21. The only question to be addressed is whether use of the word JAVA as part of the domain name “www.javatpoint.com” would constitute infringement of the respondent’s trade mark.

22. In *Satyam Infoway Ltd. v. Siffynet Solutions (P) Ltd.* (*supra*), the Supreme Court had explained that the use of a domain name, which was to provide an address for the computers on the internet had now developed to a mode of carrying out commercial activity, and had authoritatively held that a domain name, is capable of distinguishing the subject of trade or services made available to potential users of the internet. The Court had also held that the principles of trademark law in particular to those relating to passing off, would also be applicable in

¹: (2004) 6 SCC 145

the context of use of domain name. The relevant extract of the said decision is set out below:

“11. Analysing and cumulatively paraphrasing the relevant parts of the aforesaid definitions, the question which is apposite is whether a domain name can be said to be a word or name which is capable of distinguishing the subject of trade or service made available to potential users of the internet.

12. The original role of a domain name was no doubt to provide an address for computers on the internet. But the internet has developed from a mere means of communication to a mode of carrying on commercial activity. With the increase of commercial activity on the internet, a domain name is also used as a business identifier. Therefore, the domain name not only serves as an address for internet communication but also identifies the specific internet site. In the commercial field, each domain-name owner provides information/services which are associated with such domain name. Thus a domain name may pertain to provision of services within the meaning of Section 2(1)(z). A domain name is easy to remember and use, and is chosen as an instrument of commercial enterprise not only because it facilitates the ability of consumers to navigate the internet to find websites they are looking for, but also at the same time, serves to identify and distinguish the business itself, or its goods or services, and to specify its corresponding online internet location [Ryder, Rodney D.: Intellectual Property and the Internet, pp. 96-97.]. Consequently a domain name as an address must, of necessity, be peculiar and unique and where a domain name is used in connection with a business, the value of maintaining an exclusive identity becomes critical.

“As more and more commercial enterprises trade or advertise their presence on the web, domain names have

become more and more valuable and the potential for dispute is high. Whereas a large number of trade marks containing the same name can comfortably coexist because they are associated with different products, belong to business in different jurisdictions, etc., the distinctive nature of the domain name providing global exclusivity is much sought after. The fact that many consumers searching for a particular site are likely, in the first place, to try and guess its domain name has further enhanced this value [See Rowland, Diane and Macdonald, Elizabeth: *Information Technology Law*, 2nd Edn., p. 521.] .”

The answer to the question posed in the preceding paragraph is therefore in the affirmative.

13. The next question is, would the principles of trade mark law and in particular those relating to passing off apply? An action for passing off, as the phrase “passing off” itself suggests, is to restrain the defendant from passing off its goods or services to the public as that of the plaintiff's. It is an action not only to preserve the reputation of the plaintiff but also to safeguard the public. The defendant must have sold its goods or offered its services in a manner which has deceived or would be likely to deceive the public into thinking that the defendant's goods or services are the plaintiff's. The action is normally available to the owner of a distinctive trade mark and the person who, if the word or name is an invented one, invents and uses it. If two trade rivals claim to have individually invented the same mark, then the trader who is able to establish prior user will succeed. The question is, as has been aptly put, who gets these first? It is not essential for the plaintiff to prove long user to establish reputation in a passing-off action. It would depend upon the volume of sales and extent of advertisement.

14. The second element that must be established by a plaintiff in a passing-off action is misrepresentation by the defendant to the public. The word misrepresentation does

not mean that the plaintiff has to prove any mala fide intention on the part of the defendant. Of course, if the misrepresentation is intentional, it might lead to an inference that the reputation of the plaintiff is such that it is worth the defendant's while to cash in on it. An innocent misrepresentation would be relevant only on the question of the ultimate relief which would be granted to the plaintiff [*Cadbury Schweppes v. Pub Squash*, 1981 RPC 429 : (1981) 1 All ER 213 : (1981) 1 WLR 193 (PC); *Erven Warnink v. Townend*, 1980 RPC 31 : (1979) 2 All ER 927 : 1979 AC 731 (HL)] . What has to be established is the likelihood of confusion in the minds of the public (the word “public” being understood to mean actual or potential customers or users) that the goods or services offered by the defendant are the goods or the services of the plaintiff. In assessing the likelihood of such confusion the courts must allow for the “imperfect recollection of a person of ordinary memory” [*Aristoc v. Rysta*, 1945 AC 68 : (1945) 1 All ER 34 (HL)] .

15. The third element of a passing-off action is loss or the likelihood of it.

16. The use of the same or similar domain name may lead to a diversion of users which could result from such users mistakenly accessing one domain name instead of another. This may occur in e-commerce with its rapid progress and instant (and theoretically limitless) accessibility to users and potential customers and particularly so in areas of specific overlap. Ordinary consumers/users seeking to locate the functions available under one domain name may be confused if they accidentally arrived at a different but similar website which offers no such services. Such users could well conclude that the first domain-name owner had misrepresented its goods or services through its promotional activities and the first domain-owner would thereby lose its custom. It is apparent, therefore, that a domain name may have all the characteristics of a trade mark and could found an action for passing off.

17. Over the last few years the increased user of the internet has led to a proliferation of disputes resulting in litigation before different High Courts in this country. The courts have consistently applied the law relating to passing off to domain name disputes. Some disputes were between the trade-mark holders and domain-name owners. Some were between domain-name owners themselves. These decisions, namely, *Rediff Communication Ltd. v. Cyberbooth* [AIR 2000 Bom 27], *Yahoo Inc. v. Akash Arora* [(1999) 19 PTC 201 (Del)], *Dr. Reddy's Laboratories Ltd. v. Manu Kosuri* [2001 PTC 859 (Del)], *Tata Sons Ltd. v. Manu Kosuri* [2001 PTC 432 (Del)], *Acqua Minerals Ltd. v. Pramod Borse* [2001 PTC 619 (Del)] and *Info Edge (India) (P) Ltd. v. Shailesh Gupta* [(2002) 24 PTC 355 (Del)] correctly reflect the law as enunciated by us. No decision of any court in India has been shown to us which has taken a contrary view. The question formulated at the outset is therefore answered in the affirmative and the submission of the respondent is rejected.”

23. An entity’s domain name serves as an internet address. Thus, use of a trade mark as a part of domain name is likely to indicate an association between the proprietor of the trade mark and the proprietor of the domain name. It is well settled that a trade mark serves as a source identifier and the use of a trade mark in a domain name has the propensity to mislead the users into believing that the sources of the goods and services covered by the trade mark would be accessible by the domain name, which incorporates the trade mark in question.

24. The Internet Corporation for Assigned Names and Numbers (ICANN) – a private organization which administers internet name and address system has an unambiguous policy which forbids registration of domain name if the domain name is identical or confusingly similar

to another person's trade mark. The Hon'ble Madras High Court in *Consim Info Pvt. Ltd. v. Google India Pvt. Ltd. : 2010 SCC OnLine Mad 4967* had referred to the role of ICANN as under:

“190. The Internet Corporation for Assigned Names and Numbers (ICANN) is a non-profit consensus organisation designated to carry on the administration of the Internet name and address system. It has control over domain names in the global or generic top level domain names (gTLDs). It administers the Internet Protocol and addresses issues of space allocation, protocol parameter assignment, Domain Name System management and root server system functions. It administers the Uniform Dispute Resolution Procedure, for resolving certain disputes by a non judicial process. Paragraph 4.1 of the said Policy enables ICANN to adjudicate a dispute between a third party and a Provider (i) if his domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights (ii) if he has no rights or legitimate interests in respect of the domain name, and (iii) if his domain name has been registered and is being used in bad faith. Paragraph 5 makes it clear that all disputes regarding domain name registration which are not brought pursuant to the mandatory administrative proceeding provisions of paragraph 4, shall be resolved through Court, Arbitration or other proceedings. Therefore, it is a non-exclusive remedy.”

25. It is clear that the registration of a domain name, which is identical or confusingly similar to a trademark is vulnerable to be cancelled or compulsorily transferred.

26. It is also relevant to refer to the following passage from *McCarthy on Trademarks and Unfair Competition*, which is set out as under:

“Could a Domain Name be an Infringement of Someone

Else's Trademark? Trademark or service mark infringement under the federal Lanham Act can occur if a domain name similar to someone else's previously used trademark is used without permission in a commercial sense, such as in connection with the sale, offering for sale, distribution or advertising of any goods or services in a context that is likely to cause confusion, mistake or deception. Commercial use of a domain name might also trigger the anti-dilution provisions of the Lanham Act. Egregious and bad faith uses of another trademark as a domain name might also be in violation of the federal Anti-Cybersquatting Protection Act (ACPA)."²

27. It is now well settled and accepted that the domain name, which incorporates the trademark, may constitute infringing use in given circumstances. It is relevant to refer to Section 29(5) of the TM Act, which reads as under:

“29. Infringement of registered trade marks.—

xxx

xxx

xxx

(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.”

28. As noted above, the domain name not only serves as an internet address, but as explained by the Supreme Court in *Satyam Infoway Ltd. v. Siffynet Solutions (P) Ltd.* (*supra*), is also used as a ‘business identifier’. Thus, clearly, the use of a registered trademark as a part of a domain name would fall within the scope of infringing use under

² Volume 5, J. Thomas McCarthy, Page No.25A-57

Section 29(5) of the TM Act. We concur with the learned Single Judge's view to the said effect.

29. Undeniably, subject to certain exceptions, a domain name is not a trademark. It is in nature of an address in the virtual world. Thus, use of a registered trademark as a part of the domain name is not use as a trademark, but as a mark. In terms of Section 29(2) of the TM Act, use of a mark in respect of similar goods, which indicates any association or is likely to cause any confusion, would amount to infringement of the trademark.

30. In the present case, it was admitted that the appellant's website accessed by the impugned domain name, hosted various courses, training program and internship program amongst other information. The said website also permitted users to contact the appellants to enroll themselves as teachers/instructors and work as employees. The same also provided access to a portal whereby the payments could be made by potential customers to avail the services of the appellants. The appellants were clearly using its website for its activities and the services provided by it. Thus, clearly, the use of 'JAVA' as a part of the domain name is not to function as an identifier for any programming language or any product of the respondent's group and associated with the activities and the services rendered by the appellants. The domain name was clearly meant to serve as an identifier of the appellants and its activities. It would thus, *prima facie*, follow that the use of the mark Java by the appellants as a part of their domain name would, *prima facie*, be an infringing use.

31. It is material to note that the Oracle Corporation also owns and maintains a domain name, www.java.com, the impugned domain name is *prima facie*, similar to the said domain name and, *prima facie*, we find merit in the contention that internet users may be confused to accept the impugned domain name as that of the respondent and its group or at least assumed that there was an association between the impugned domain name with the products and services of the respondent and its group.

32. In view of the above, we find no grounds to interfere with the impugned judgment. The appeal is unmerited and accordingly, dismissed. Pending applications also stand disposed of.



LEGALERS
BY THE PEOPLE. FOR THE PEOPLE. OF THE PEOPLE

VIBHU BAKHRU, J

SACHIN DATTA, J

JULY 09, 2024

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