

**IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION**

INTERIM APPLICATION (LODGING) NO. 38837 OF 2022
IN
INTERIM APPLICATION (LODGING) NO. 26556 OF 2022
IN
COMMERCIAL IP SUIT (LODGING) NO. 26549 OF 2022

GoDaddy.com LLC & Anr.

...Applicants
Org. Def. Nos. 15 and 16

IN THE MATTER BETWEEN :

Bundl Technologies Private Limited

...Plaintiff

Versus

Aanit Awattam alias Aanit Gupta & Ors.

...Defendants

- Mr. Sharan Jagtiani, Senior Counsel a/w Mr. Rohan Cama, Mr. P. Mehta, Ms. Debarshi Dutta and Mr. Arjun Bose, i/by Solaris Legal, for Applicants.
- Mr. Hiren Kamod, Mr. Vaibhav Keni, Ms. Neha Iyer, Mr. Rohan Lopes, Mr. Prem Khullar and Mr. Anees Patel i/by Legasis Partners, for Plaintiff.

CORAM : MANISH PITALE, J

DATE : 23rd JANUARY, 2023.

P. C. :

1. By this application filed by the Defendant Nos. 15 (GoDaddy.com LLC) and 16 (GoDaddy India Web Services Private Limited), the said Defendants are seeking clarification/modification /recall of order dated 29th November, 2022, passed by this Court in Interim Application (L) No. 26556 of 2022.

2. The background of this application is that the Plaintiff

herein filed the present Suit, being aggrieved by the Defendant Nos. 1 to 13 infringing the registered trademark of the Plaintiff i.e. “Swiggy”, pertaining to Swiggy Instamart Platform. The Plaintiff is an e-commerce entity engaged in the business of operating an online market place through its website www.swiggy.com along with applications for mobile and handheld devices.

3. The Plaintiff approached this Court alleging that in June, 2022, it received an e-mail from a person from Jamshedpur, Jharkhand, stating that the Defendant No. 3 had approached him, claiming to be an employee of the Plaintiff and thereafter the said Defendant, along with Defendant No. 1, collected Rs. 11,800/- from him under the promise of bringing the said person on board the “Swiggy Instamart Platform” of the Plaintiff. The Defendant No. 1 shared an UPI QR code, bearing a logo of the Plaintiff Swiggy Instamart, through which the said person made payment on the false representations given by the said Defendants.

4. The said person further informed the Plaintiff that other similarly situated innocent persons were duped by the said Defendants into parting with various sums of money on the false promise of being brought on board the Swiggy Instamart Platform of the Plaintiff.

5. It was when the said persons suspected foul-play, as further e-mail correspondences with the said Defendants and others did not lead to anything concrete, that they directly approached the Plaintiff and the entire conspiracy of the said Defendants came to light. In this backdrop the Plaintiff made further inquiries and found that the infringing domain names “btpl.info” and “swiggyinstamart.co.in” were being used illegally by such Defendants.

6. In this backdrop, the Plaintiff filed the present suit alongwith application for interim reliefs. The Plaintiff pressed for grant of *ex-parte* ad-interim reliefs, considering the urgency of the matter. By order dated 24th August, 2022, this Court granted *ex-parte* ad-interim reliefs in favour of the Plaintiff. The said order was executed and the Court Receiver submitted his report.

7. When the application was subsequently listed before this Court on 29th November, 2022, the Plaintiff pressed for grant of further ad-interim reliefs in terms of prayer clauses (e) and (g), which specifically pertained to Defendant Nos. 15 and 16, who have filed the present application. It was the case of the Plaintiff that Defendant Nos. 15 and 16, being the Registrars of the impugned Domain Names, ought to be directed to suspend the impugned domain names with a further direction not to register any domain name containing the mark “Swiggy”, for which the Plaintiff holds

trademark registration, without prior authorization of the Plaintiff.

8. On 29th November, 2022, this Court passed its order recording the submission of the learned Counsel appearing for Defendant Nos. 15 and 16, that the information sought by the Plaintiff was already provided in terms of the direction contained in the *ex-parte* ad-interim order dated 24th August, 2022. This Court further recorded that the learned Counsel appearing on behalf of the Defendant Nos. 15 and 16 made a submission to the effect that the said Defendants would abide by any directions that may be given by this Court. In this backdrop, by the said order dated 29th November, 2022, this Court directed as follows:

“4. Considering the facts and circumstances of the present case, particularly the contention raised on behalf of the Plaintiff that unless the impugned domain names are suspended, there is possibility of further misuse of the Plaintiff’s registered trademark ‘SWIGGY’ this Court is convinced that further ad-interim reliefs can be granted. Accordingly, further ad-interim reliefs are granted as follows:

“(e) pending the hearing and final disposal of the suit, an order be passed directing the Registrar of Domain Names / Defendant Nos. 15 and 16 to suspend the impugned domain names;

(g) pending the hearing and final

disposal of the suit this Hon'ble Court be pleased to pass an order directing Defendant Nos. 15 and 16 not to register any domain name containing the Plaintiff's mark 'SWIGGY' without prior authorization of the Plaintiff."

5. The ad-interim reliefs granted earlier and the aforesaid ad-interim reliefs granted today shall continue to operate till the next date of listing."

9. The Applicants i.e. Defendant Nos. 15 and 16 have filed the present application seeking modification and part recall of the order dated 29th November, 2022. It is stated in the application that while the said Defendants would be complying with the ad-interim relief granted in terms of prayer clause (e), they would not be able to do so, insofar as prayer clause (g) is concerned. It is specifically stated that Defendant No. 16 is not even a Domain Name Registrar and that therefore, such directions cannot apply to Defendant No. 16. It is conceded that Defendant No. 15 is a Domain Name Registrar and that the said Defendant desires to place on record before this Court, the reasons why it would not be able to comply with ad-interim order granted in terms of prayer clause (g) and that therefore, modification/recall of the same is necessary.

10. The aforesaid Defendants have stated in the application

that their Counsel, on 29th November, 2022, had not submitted that they would abide by any directions that may be given by this Court, but the submission was that the Defendants would abide by any directions that may be given by this Court in terms of prayer clause (e). Thereafter, the said Defendants have stated reasons as to why the ad-interim order as per prayer clause (g) deserves to be recalled. It is submitted that as a matter of law, such a direction could not have been passed and that in any case, the underlying technology of registration of Domain names, being an automated process without any manual intervention, is such that it is impossible to comply with the ad-interim order granted in terms of prayer clause (g). It is submitted that such a view is already taken by this Court in another case. It is further submitted that if the said direction is not recalled, Defendant Nos. 15 and 16 would be vulnerable to an action of Contempt, even though compliance with the direction is beyond the capacity of the said Defendants.

11. The Plaintiff has filed its reply to the present application and it is submitted that none of the contentions raised in the application deserve consideration and the application deserves to be dismissed.

12. Mr. Sharan Jagtiani, learned Senior Counsel appearing for the Applicants (Defendant Nos. 15 and 16), submits that the

underlying technology for registration of domain names is an automated process, with no manual intervention or involvement of human element. It is submitted that there is no way in which Defendant No. 15, as a Domain Name Registrar, can assess the legitimacy of any domain name chosen for registration by a prospective Registrant. It is submitted that in such a situation, the ad-interim order granted in terms of prayer clause (g), being of dynamic nature, is beyond the capacity of the said Defendants to implement. It is submitted that the aforesaid aspect pertaining to the underlying technology was specifically noted and discussed in order dated 12th June, 2020, passed by this Court in Interim Application No. 1 of 2020 in LC-VC-GSP-24 of 2020 (*Hindustan Unilever Limited Vs. Endurance Domains Technology LLP & Ors.*). By placing reliance on the said order passed by this Court, it was emphasized that a Domain Name Registrar like Defendant No. 15, can at best be asked to suspend an existing registration, but since the entire process of registration is entirely automated and machine driven, there is no way in which the Domain Name Registrar like Defendant No. 15 herein can prevent the registration of a domain name containing the registered trademark of the Plaintiff. It is submitted that in the said order passed by this Court, the nature of the technology was taken into consideration and a similar relief claimed by the Plaintiff was rejected. In support of the said contention, the learned Counsel for the Applicants further relied

upon judgment and order dated 18th April, 2022, passed by the Delhi High Court in CS (COMM) 176/2021 *Snapdeal Private Limited Vs. GoDaddy.com LLC and Ors.*

13. In addition, the learned Senior Counsel submitted that, even otherwise, such a dynamic injunction cannot be granted, considering the requirements of law governing trademarks and other intellectual properties. The learned Senior Counsel submitted that, although a registered proprietor of the trademark holds rights *in rem*, while exercising such a right, it is necessarily *in personam*. By placing reliance on judgment of this Court in case of *Eros International Media Limited Vs. Telemax Links India Pvt. Ltd. & Ors.*¹ the learned Senior Counsel submitted that an action pertaining to infringement or passing off binds only the parties to such an action. On this basis, it was submitted that on each occasion when the Plaintiff notices such infringement, it will have to approach the Court for a specific order in the nature of ad-interim order in terms of prayer clause (e) for suspension of such allegedly infringing trademark. It was submitted that such an order can be issued only against an identified party. An *omnibus* direction in the nature of prayer clause (g) cannot be issued, as per the accepted position of law.

14. It was further submitted that a dynamic injunction

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operating *in futuro* cannot be granted against the parties who have not even been identified. According to the learned Senior Counsel for the Applicants, the technology as it stands, does not provide for a facility to implement such a dynamic injunction operating in future. On this basis, it was submitted that the present application may be allowed in terms of the prayers made therein. It was also submitted that, in any case, the Defendant No. 16, not being a Domain Name Registrar, would not be bound by the directions, while Defendant No. 15 undertakes to abide by the ad-interim order granted in terms of prayer clause (e).

15. On the other hand, Mr. Kamod, learned Counsel appearing for the Plaintiff submitted that the contentions raised on behalf of the Applicants are unsustainable on both counts i.e. on the aspect of the technology involved while granting registration of the domain name and also with regard to the position of law. It was submitted that Defendant No. 15 itself had submitted before the Delhi High Court on affidavit in the case of *Snapdeal Private Limited Vs. GoDaddy.com LLC and Ors.* (supra) that subject to technical, financial and resourcing issues, the said Defendant could potentially prevent a user from registering names with the exact word, in respect of which the Plaintiff holds a registered trademark. On this basis, there are findings rendered by the Delhi High Court in the said case, in its order

dated 08th April, 2022. Therefore, it was submitted that it could not lie on the mouth of Defendant Nos. 15 and 16 to submit before this Court that it was technologically impossible to implement the ad-interim order passed in terms of prayer clause (g) on 29th November, 2022.

16. The learned Counsel further submitted that introducing a procedure for preventing users from registering names that would infringe a registered trademark, would at the most entail some costs for the said Defendants and the same could not be a ground to claim that it was impossible to comply with the ad-interim order granted in terms of prayer clause (g). It was further submitted that in paragraph no. 13 of the present application itself the said Defendants had indicated that even if such an ad-interim order was to operate and it was to be implemented by the said Defendants, prospective domain name Registrants could seek registration of infringing domain names through some other Registrars, thereby clearly indicating that the said Defendants were seeking recall of the ad-interim order passed by this Court in terms of prayer clause (g), only because that they would lose out on some profit that may be generated through registration of domain names that infringe the registered trademark of the Plaintiff. On this basis, it was submitted that, insofar as the underlying technology is concerned, the

contention raised on behalf of the said Defendants deserves to be rejected.

17. On the aspect of law, it was submitted that the ad-interim relief in terms of prayer clause (g) was correctly granted, as the Plaintiff being the registered proprietor of the trademark was entitled to exercise its rights to prevent infringement of its trademark by incorporation of the same in domain names of other entities. It was submitted that such directions were not unknown in this branch of law. It was submitted that, in fact, the Delhi High Court in a similar case passed an order on 20th July, 2022, in CS (COMM) 475 of 2022 (*Fashnear Technologies Pvt. Ltd Vs. Meesho Online Shopping Pvt. Ltd. & Anr.*) specifically directing the Domain Names Registrar therein not to register fake website/domain name containing the mark/name of the Plaintiff therein. It was submitted that even in the judgment and order of the Delhi High Court in the case of *Snapdeal Private Limited Vs. GoDaddy.com LLC and Ors.* (supra), upon which the learned Counsel for the said Defendants placed reliance, it was held that Defendant No. 15 herein was not justified in claiming that it could not take any steps under the automated technology to be able to prevent registration of infringing domain names. On this basis, it was submitted that the application deserved to be dismissed.

18. Having heard the learned Counsel for rival parties, two

aspects arise for consideration in the present application. The first aspect concerns underlying technology pertaining to registration of the domain names and the second concerns a legal issue. It is the stated case of the said Defendants i.e. the Applicants herein that underlying technology of registration of the domain names is a fully automated process with no manual intervention and that therefore, the Defendant No. 15, as the Domain Name Registrar, has no control over the manner in which a domain name registration is granted to a potential domain name registrant. This Court in its order passed in the case of *Hindustan Unilever Limited Vs. Endurance Domains Technology LLP & Ors.* Dated 12th June, 2020 (supra) has discussed in detail, the automated technology whereby a Domain Name Registrar grants registration to an applicant/registant. After referring to the said technology, this Court has rendered findings that whenever a domain name is free or available for registration, the registrant can simply apply to a domain name Registrar, like Defendant No. 15 herein, and by an automated process the registration is carried out and the registrant is able to use the domain name for which the application was submitted. It is recorded that once a domain name is released for registration by a Domain Name Registrar, it is available worldwide on the internet and that the process is entirely automated, with no manual intervention. On this basis, in the said case, this Court refused to grant ad-interim relief

claimed by the Plaintiff seeking an order restraining the Domain Name Registrar from allowing registration of any domain names/websites containing expressions or words that would infringe the registered trademarks of the Plaintiff therein.

19. But, it is significant that Defendant No. 15 herein, on affidavit stated in the said case of *Snapdeal Private Limited Vs. GoDaddy.com LLC and Ors.* (supra), as recorded in the judgment and order dated 18th April, 2022, passed by the Delhi High Court that subject to technical, financial and resourcing issues, the said Defendant could potentially prevent users from registering names with the exact word or string of words that would infringe the registered trademark of the Plaintiff. Having recorded the said statement made on behalf of the Defendant No. 15 on affidavit, the Delhi High Court proceeded to hold that the said Defendant cannot claim that it has absolutely no knowledge or idea of the alternative domain names that are suggested when an application is made for registration of the domain name with such a Domain Name Registrar. It was recorded that when such an application is made, the Domain Name Registrar offers domain names automatically on the basis of an algorithm developed by the Registrar itself. It was specifically recorded that such offering of alternative domain names was not available when the name of the Registrar itself was incorporated in

such an application.

20. The Delhi High Court recorded that the Domain Name Registrar was not justified in claiming that since the process of sourcing alternative domain names was automated, it could not vouchsafe that the alternative domain names that would be thrown up would not contain a trademark, which was already registered. On the basis of the stand taken on the affidavit on behalf of Defendant No. 15, the Delhi High Court found that the arguments based on absence of algorithm or absence of technology to abide by an order of the Court, could not be accepted, for the reason that the algorithm itself was devised by the individual domain name Registrar like Defendant No. 15 herein. It is significant that the stand being taken before this Court is in the teeth of the stand taken on affidavit by the very same party before the Delhi High Court in the aforementioned case.

21. Insofar as the observations made by this Court in the case of *Hindustan Unilever Limited Vs. Endurance Domains Technology LLP & Ors.* (supra) are concerned, suffice it to say that this Court found that the process of registration of the domain names being an automated technology without manual intervention, as it stands, would not provide a facility for granting the kind of ad-interim relief that was sought by the Plaintiff in the present case. In the face of the affidavit filed on behalf of Defendant No. 15 before the Delhi High

Court, this Court finds that if a direction in the nature of the ad-interim relief in terms of prayer clause (g) is granted, the said Defendant would have to utilize an alternative algorithm to ensure compliance. In that light, the contention raised on behalf of the Plaintiff is correct to the extent that Defendant No. 15 is avoiding to do so, merely because it may have to bear some financial burden in that regard. Therefore, there is no substance in the contention raised on behalf of Defendant Nos. 15 and 16, that technologically it is impossible to comply with the ad-interim order granted in terms of prayer clause (g).

22. The second aspect of the matter pertains to the question as to whether, as a matter of law, such an interim order in terms of prayer clause (g) could be granted. This Court is of the opinion that there can be no dispute regarding the proposition that the Plaintiff claiming infringement of its registered mark is required to claim reliefs in the context of specific instances of infringement, relatable to individuals against whom orders can be passed by the Court. Even in a "*John-Doe action*", specific instance of infringement is identified, although there may be lack of information regarding the details of the individual or individuals who are responsible for such infringement. It is a recognized position that when a Plaintiff seeks reliefs on the basis of its rights in Intellectual Property Law, every time the Plaintiff

initiates an action and seeks remedy, it is an action *in personam*. This is observed in the context of copyright in the judgment of this Court in the case of *Eros International Media Limited Vs. Telemax Links India Pvt. Ltd. & Ors.* (supra) as follows:

17. *I must therefore consider what is it precisely that Mr. Dhond possibly means when he says that these are “rights in rem”. I find it very difficult to accept this proposition stated like this. It seems to me to be altogether too broad. As between two claimants to a copyright or a trade mark in either infringement or passing off action, that action and that remedy can only ever be an action in personam. It is never an action in rem. In trade mark law it is true that the registration of a mark gives the registrant a right against the world at large. It is possible that an opposition to such an application (before the Registrar) would be an action in rem, for it would result in either the grant or non grant of the registration, good against the world at large. But an infringement or passing off action binds only the parties to it. Take an example. A may allege infringement and passing off by B. A may succeed against B. That success does not mean that A must necessarily succeed in another action of infringement and passing off against C. The converse is also true. Should A fail in his action against B, he may yet nonetheless succeed in his action against C. This applies equally to copyright actions. A man may be able to demonstrate that his copyright in a film, a literary work, an artistic work or any other work in which copyright is said to subsist is infringed by a certain party. But he may not be able to show such an infringement at the hands of another party. Both are actions in personam. What is in rem is the Plaintiff’s or registrant’s entitlement to bring that action. That entitlement is a result of having obtained or acquired copyright (either by authorship or assignment) or having statutory or common law rights in a mark.”*

23. The Supreme Court in the case of *Vidya Drolia vs Durga Trading Corporation*², in this context, also held as follows:

“48. A judgment in rem determines the status of a person or thing as distinct from the particular interest in it of a party to the litigation; and such a judgment is conclusive evidence for and against all persons whether parties, privies or strangers of the matter actually decided. Such a judgment “settles the destiny of the res itself” and binds all persons claiming an interest in the property inconsistent with the judgment even though pronounced in their absence. By contrast, a judgment in personam, “although it may concern a res, merely determines the rights of the litigants inter se to the res”. Distinction between judgments in rem and judgments in personam turns on their power as res judicata, i.e. judgment in rem would operate as res judicata against the world, and judgment in personam would operate as res judicata only against the parties in dispute. Use of expressions “rights in rem” and “rights in personam” may not be correct for determining non-arbitrability because of the inter-play between rights in rem and rights in personam. Many a times, a right in rem results in an enforceable right in personam. *Booz Allen & Hamilton Inc.* refers to the statement by Mustill and Boyd that the subordinate rights in personam derived from rights in rem can be ruled upon by the arbitrators, which is apposite. Therefore, a claim for

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infringement of copyright against a particular person is arbitrable, though in some manner the arbitrator would examine the right to copyright, a right in rem. Arbitration by necessary implication excludes actions in rem.”

24. Hence, it is clear that any such action initiated by the Plaintiff is necessarily an action *in personam* and not an action *in rem*. The Delhi High Court in the case of *Snapdeal Private Limited Vs. GoDaddy.com LLC and Ors.* (supra), after having made observations on the aspect of technology against the very same Defendant on the basis of affidavit placed on record, with which this Court concurs, found that an interim relief akin to the nature of interim relief sought by the Plaintiff as per prayer clause (g) before this Court in the application for interim reliefs, could not be granted for the reason that for each instance of infringement the Plaintiff would have to approach the Court. In fact, it is specifically noted that although approaching the Court on each occasion may be a cumbersome exercise, that could not be helped. In fact, this Court in the aforesaid order in the case of *Hindustan Unilever Limited Vs. Endurance Domains Technology LLP & Ors.*(supra) also observed that every time a new domain name is registered, which the Plaintiff alleges to be an infringement, it will have to approach the Court for specific orders.

25. This Court is also of the opinion that it would not be

appropriate to continue the ad-interim order granted in terms of prayer clause (g), as it would amount to granting an *omnibus* and global temporary injunction, operating *in futuro*. Each instance of infringement would require the Plaintiff to rush to this Court for a direction in this very suit or separate proceedings against specific parties but an *omnibus* direction as contained in prayer clause (g) could not have been granted. To that extent, there is substance in the contentions raised on behalf of Defendant Nos. 15 and 16, while seeking part recall of the order dated 29th November, 2022, passed by this Court.

26. Nonetheless, the rights of the Plaintiff in such circumstances cannot be ignored. The situation is peculiar in the present case where the public at large has suffered due to the nefarious activities of Defendant Nos. 1 to 13. Therefore, although this Court is inclined to partly allow the present application, an appropriate direction can be given to the Defendant Nos. 15 and 16, so as to facilitate the Plaintiff in seeking appropriate relief from this Court, if the occasion arises. To that extent the order dated 29th November, 2022, deserves to be modified.

27. At the same time, this Court is not in agreement with the contention raised on behalf of Defendant Nos. 15 and 16 that their counsel did not make a statement as was recorded in paragraph no. 3

of the order dated 29th November, 2022. Hence, prayer clause (a) of the present application is rejected.

28. Hence, for the reasons stated above the ad-interim relief granted by the order dated 29th November, 2022, in terms of prayer clause (g) is recalled and instead the order is modified to the extent that the ad-interim relief granted in terms of prayer clause (e) shall continue to operate and the Defendant Nos. 15 and 16, by way of an ad-interim direction, shall inform the Plaintiff on each occasion that registration of a domain name is granted, which contains the registered trademark of the Plaintiff “Swiggy”, through the automated process of registration of the said Domain Name Registrar. Upon such information being provided to the Plaintiff, it would be at liberty to take appropriate action in the matter.

29. The application stands disposed of in above terms.

(MANISH PITALE, J.)