

Law & Practice

# INDIA: Domestic Court's International Reach

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A recent preliminary injunction issued by the High Court in Delhi in a domain dispute may have ramifications beyond India.

On April 28, 2020, in the case of HT Media Limited & Anr. v. Brainlink International, Inc. & Anr. [CS (COMM) 119/2020 and IAs 3767-3771/2020], the Delhi High Court (court) restrained the defendants from using the domain name [www.hindustan.com](http://www.hindustan.com) (disputed domain) and from proceeding further with the suit filed by the defendants against the plaintiffs before the United States District Court for the Eastern District of New York (E.D.N.Y.).

The decision is peculiar since the plaintiffs' Indian rights have been enforced beyond the Indian territory against a U.S.-based domain name holder with an anti-suit injunction. If this decision is upheld, Indian domain name complainants may prefer infringement suits to dispute resolution policies, such as the Uniform Dispute Resolution Procedure, where thresholds are considered higher.

The plaintiffs submitted that they are the registered owners of the HINDUSTAN and HINDUSTAN TIMES marks, including Indian Registration nos. 1508548 and 1350439. The plaintiffs contended that the defendants were infringing, cybersquatting, and violating the plaintiffs' trademark rights.

When the plaintiffs tried to acquire the disputed domain, the defendants quoted a price of US \$3 million. Upon receiving a counteroffer, the defendants filed a declaratory suit for non-infringement before the E.D.N.Y.

The plaintiffs argued that the disputed domain was acquired by the defendants in bad faith because it was used for identical services in 1999 and then parked and not used again since 2000. On the

jurisdictional point, the plaintiffs argued that the cause of action had arisen in India, and relied on Section 134(2) of the Trademarks Act, 1999.

The court concurred with the plaintiffs' submissions and held the following:

- The defendants registered the disputed domain in bad faith.
- The defendants should be restrained from using and creating any third-party rights in the disputed domain, and to proceed further with the suit filed by them with the E.D.N.Y until the next hearing, and a case for anti-suit injunction was made out.
- The registering authority should block the disputed domain and maintain the status quo till the next hearing.

This decision could be debated on several aspects. These include: whether an ex-parte injunction was reasonable when the disputed domain had been registered since the 1990s; whether the plaintiffs can claim exclusivity in the word "Hindustan" (an alternate name for India); whether the Indian trademark registration(s) and the court can extend monopoly and maintain jurisdiction beyond India; and what would be the situation if the E.D.N.Y. decides that the Indian court's decision is not binding on it.

Recently, the defendant attempted to move the E.D.N.Y for passing a decision of default. Due to this, the plaintiff again moved an application against the defendant at the Delhi High Court for disobedience of anti-suit injunction order (since the E.D.N.Y was moved).

During the last hearing, the Delhi High Court stated that it would first hear the application filed by the plaintiff (claiming disobedience of the earlier order) and thereafter hear the defendant in relation to its application to vacate the injunction order. The matter was adjourned to July 9, 2020. However, the exact status at the E.D.N.Y was not in a position to be ascertained.

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