



IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
INTERIM APPLICATION (L) NO. 564 OF 2024
IN
COMMERCIAL INTELLECTUAL PROPERTY RIGHTS
SUIT (L) No. 537 of 2024

UTI Infrastructure Technology and .. Plaintiff
Services Limited

Versus

Extra Tech World and ors .. Respondents

...

Mr.Rashmin Khandekar, Mr.Anand Mohan with Vijay Purohit,
Mr.Pratik Jhaveri, Ms.Nikita Bangera, Mr.Faizan M. Mithaiwala
and Mr.Samkit Jain i/b P & Law Offices for the applicant/orig
plaintiff.

Ms.Geetanjali Visvanathan (appearing through VC) for
respondent nos.12 and 13.

CORAM: BHARATI DANGRE, J.
DATED : 12th JANUARY 2024

P.C:-

1 In the Commercial Intellectual Property Rights Suit,
Interim Application (L) No. 564 of 2024 is moved without
notice for the reasons stated in paragraph no.51 of the Interim
Application.

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I find the reasons to be sufficient to consider the application of the plaintiff, seeking restrain orders against the defendants from, and/or in any way, infringing the plaintiff's copyright and the acts of passing off and hence, I have heard Advocate Rashmin Khandekar for the applicants.

2 In the Suit, the plaintiff seek a permanent injunction and restraint order against the defendants from infringing its plaintiff's copyrights and the acts of passing off, in the marks "UTI"/"UTI Infrastructure Technology and Services Limited"/"UTI ITSL"/"UTI PAN"/"UTIITSL" ("marks"), subsisting in the Plaintiff's label ("Label"), by the defendant nos.1 to 4, with an intention to misrepresent the citizens of India and the public at large, that they are authorized by the plaintiff or authorized to act at the behest of the plaintiff, in providing services relating to and in connection with the issuance of Permanent Account Number (PAN) Card.

The plaintiff is authorized by the Income Tax Department for processing the Permanent Account Number (PAN) and PAN related services like issuance of documents such as Aadhar Card, Voter ID, driving license, etc. The services provided by the plaintiff are exclusive in nature underpinning the national importance of its work, to the citizens of India, since PAN is a unique 10-digit alphanumeric identity allotted to each

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taxpayer by the Income Tax Department (“ITD”) under the supervision of the Central Board of Direct Taxes. PAN is mandatory to track and maintain record of all the financial transactions concerning a citizen of this country and corporations incorporated in India. The primary object of PAN is to provide a universal identification key to track financial transactions, for whatever reasons; one of the prominent reason being to ascertain the taxable component to prevent tax evasion.

3] The plaintiff has been acting as a service provider on behalf of the ITD since May 2003, for processing of PAN Applications and other PAN related services and the agreement for rendering these services is valid till March 2024.

It is the case of the plaintiff that the defendants have deliberately indulged themselves in the acts of infringement of the Plaintiff’s copyrights and passing off the Plaintiff’s marks by the unauthorized use of the Label and marks of the Plaintiff, in an almost identical/deceptively similar artistic style/manner, as that of the Plaintiff’s and the artistic work of the Plaintiff’s Label, as if the Defendants are authorized to provide the services which are exclusive to the Plaintiff.

In essence, the PAN cards and all other PAN related services offered by any entity other than the Plaintiff and Protean eGov Technologies Limited (earlier known as NSDL eGov), which has not been authorized by these entities, are dubious.

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According to the plaint, these unauthorized service providers such as the defendants, must be restrained and stopped from misrepresenting itself of being agents authorized by the plaintiff. The ramifications of the continual infringement of the Plaintiff's copyright in the Label and the passing off of the Plaintiff's marks by the defendants are far reaching and its repercussions will ripple through the foundation of the economy of India.

4] It is the case of the plaintiff that the defendant nos.1 to 4 are purporting to provide almost identical services as the Plaintiff and are unauthorizedly using it's marks and the Label on their websites. In fact, Defendant Nos. 1 to 4 have resorted to misrepresent to the public of being authorized to provide services on behalf of the Plaintiff and under the garb, they have unauthorizedly and fraudulently collected personal and confidential data from the public and issued fake PAN cards.

Defendant No. 14 are other unknown defendants against whom the Plaintiff is seeking a permanent injunction and restrain orders and they are the entities identified by the Plaintiff, who are unauthorizedly passing off the marks and infringing the Plaintiff's copyright on the Label and who have indulged themselves in misrepresenting the public as being authorized to provide services on behalf of the Plaintiff, despite the fact that they are not issued any licence or authority to use the marks and the label and/or provide services on it's behalf.

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The Defendant Nos. 5 to 13 are the Registrars, who have been added as the entities, who in their usual course of business permit the users to register domain names.

Defendant No. 14 is John Doe i.e., unknown defendant and have been arrayed, since it is impossible to identify such defendants.

5] It is the specific case of the plaintiff that there are various unscrupulous persons or entities who have been engaged in the fraudulent acts, and it is not possible to monitor the activities of such entities, as different domain names are floated from time to time in an attempt to pass themselves off as the plaintiff, to perpetuate the fraud and therefore, urgent ad-interim orders are sought by the Interim Application.

It is pleaded by the plaintiff that there are other unknown defendants i.e., Defendant No. 14, whose addresses are unknown and the Plaintiff apprehends that the unknown persons will provide services similar to that of the Plaintiff without any authority and may offend the marks and the Label by using it in an identical and/or similar manner as that of the plaintiff. The details of all such websites and the addresses are not known to the plaintiff, as on the date of filing of the present Suit and the Interim Application.

Considering the national importance of the services provided by the plaintiff, it seeks proactive orders to protect its

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mark and label to mitigate the substantial and potential monetary loss, which it may suffer along with loss of reputation and goodwill being caused to the plaintiff, through the illegal acts by many presently unknown persons.

6] It cannot be in dispute that the PAN system is of paramount importance on a national scale due to its multifaceted impact on governance, taxation, and financial integrity, and it can be said to be the cornerstone of a robust financial economic system. PAN related services are pivotal in fostering fiscal discipline and ensuring a transparent and accountable economic framework, as apart from being a unique identifier for individuals and entities, it also aim at streamlining the tax recovery and payment process.

Government of India has made it mandatory for PAN card holders to link the same to Aadhar Card, which is an acceptable proof of identification in India, and therefore, any potential misuse of the licence/authorisation to issue PAN cards, would be highly detrimental not only to the interest of the plaintiff, but also to the national interest.

It is the claim of the plaintiff that it has been using the Label since around 2019. Prior thereto, the Plaintiff was using a similar label with its former name i.e., UTI Infrastructure and Services Limited. Such similar label was also prepared for and on behalf of the Plaintiff, and is an original artistic work within the

meaning of the Copyright Act, 1957. The Plaintiff is also the owner of the similar label.

It is the claim of the plaintiff that its marks and label are the brand that is nationally and internationally renowned, clothed with reputation and goodwill earned through its efforts as an efficient service provider and by its long-standing continuous use, it has acquired distinctiveness and secondary meaning in the services that connote and denote the value of the Plaintiff's brand.

The Plaintiff's mark and the Label have been extensively advertised in several leading magazines, newspapers, televisions, online portals, social and other forms of media since many years, and the plaintiff has specifically pleaded that it has invested considerable amount of time and resources on enhancing the visibility and marketability of its marks and Label, to ensure absolute certainty of identification of the Plaintiff being the entity authorized by the Government of India to provide the requisite services.

The words "UTI"/ "UTI Infrastructure Technology and Services Limited"/"UTI ITSL"/ "UTI PAN"/ "UTIITSL" form an integral part of the Plaintiff's Corporate Name, Identity and is extensively used in India and in various parts of the world. The services under the well-known mark as mentioned above, and the Label, are being provided by the Plaintiff in several countries around the world for the citizens of India and abroad.

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In addition to the above, the Plaintiff has also acquired common law rights to the marks and the Label. Such common law rights have accrued to the benefit of the Plaintiff owing to the extensive, exclusive and continuous use of the marks and the Label in India and abroad.

The Plaintiff is the registered owner of the domain name <https://www.utiitsl.com> in India, which specifically caters to Indian citizens. The marks and the Label prominently features on it's website, which sets out all the details of the Plaintiff, as also the services offered by it. The website is interactive in nature and can be accessed by people from all over India and across the globe. Apart from the said website, the Plaintiff is the owner of several other domain names worldwide and it also provide services from its mobile application, social media (including Facebook, Twitter, etc.), email, video conferencing, chat, etc.

7 In or around December 2023, it came to the knowledge of the plaintiff that the websites listed in the application, were unauthorisedly using it's marks and the Label, and were also posing to be it's authorized service agents for the purpose of providing services relating to the issuance of PAN and related services, which was licensed to it by the ITD under various agreements executed. The plaintiff has noticed that the defendants have committed an egregious fraud, which cannot go unnoticed.

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8] The Interim Application has enlisted the details of the identified Domain Names of Defendant nos.1 to 4, who are passing off the marks and label and providing similar, identical services and it is apprehended that defendants who are known to operate in the respective field are likely to continue to infringe the plaintiff's/applicant's marks and label.

According to the plaintiff/applicant, it has an Information Technology Security System in place to detect and investigate the fake websites on the internet, who are misrepresenting, by pretending to be its authorized service provider, and there is a possibility that thousands of websites may be unauthorizedly representing to the public at large, that they are authorised service agents of the plaintiff/applicant, and such websites can be easily accessed through internet in India and/or outside India, by any member of the public.

In certain cases, the plaintiff has reason to believe that since the defendants are providing services identical to the one provided by it, such unauthorized domain/websites hosts may also be also printing and issuing fake PAN cards, by deceitfully collecting their personal and confidential data and misleading them into making payments and fabricating public documents.

9] On perusal of the plaint and the Interim Application and on hearing Mr.Rashmin Khandekar, who has assertively demonstrated that the websites, which belong to the rogue

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entities are misleading, deceptive and deliberately operated by these entities, with an object to piggyback upon the goodwill and reputation of the plaintiff/applicant and acquire confidential data from the individual citizens.

10] On being convinced that the conduct of the defendants in indulging such an act is illegal, in the wake of the statutory rights under Common Law earned by the plaintiff, and they being infringed/violated and compromised by such dubious websites, as there are unknown persons/entities engaged in fraudulent activity of imitating the applicant and its marks, such defendants and all parties known or unknown, deserve to be restrained from infringing the plaintiff's/applicant's copyright in the label and passing off the marks, as the rights vests in the plaintiff in rem, being the copyright holder thereof. Without a proper licence issued either by the applicant or the ITD, no person is entitled to benefit from its rights, which exclusively belong to the plaintiff/applicant.

11] On consideration of the necessary information provided in the Interim Application, the plaintiff/applicant deserves an ad-interim ex-parte order even without service, as it is impossible to track all the defendants and effect service upon them, and with the fake websites being continued to be active, it would cause irreparable damage and severe compromise of valuable confidential data of the plaintiff and also pose a threat at a national level.

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12] In the wake of the above, the plaintiff is entitled to the following reliefs :-

“a) that pending the hearing and final disposal of the suit a temporary order and injunction be passed by this Hon'ble Court restraining the Defendants, their proprietors, partners, employees, owners, associates, affiliates, entity and/or any other person claiming through them from infringing the Applicant's exclusive copyright in its Label at Exhibits A and D of the plaint by the use of any label that is identical and/ or that is deceptively similar and/ or substantial reproduction of the Applicant's Labels inter alia including through the offending/infringing copying of the Plaintiff's Label identified at Exhibits G to G-16 to the Plaint;

b) that pending the hearing and final disposal of the suit a temporary order and injunction be passed by this Hon'ble Court restraining the Defendants, their proprietors, partners, employees, owners, associates, affiliates, entity and/or any other person claiming through them from passing off its websites and/ or domain and/ or business as and for that of the Applicant by the use of the Applicant's Labels at Exhibits A and D and/or of the words/marks “UTI”/ “UTI Infrastructure Technology and Services Limited”/ “UTI ITSL”/ “UTI PAN”/ “UTIITSL” (identified at Paragraph No. 1 of the Plaint) and/ or by the use of any label/mark that is identical and/ or deceptively similar thereto, and further restraining the Defendants from misleading/ misrepresenting to any person that they have any association with the Applicant and/ or its business activities in any manner whatsoever;

c) that pending the hearing and final disposal of the suit a temporary order and injunction be passed by this Hon'ble Court directing Defendant Nos. 5 to 13, their directors/ proprietor/ partners, their principals, employees, agents, distributors, franchisees, representatives and assignees to:

- (i) Remove/ delete/ take down/ disable the unauthorised domains and/ or websites identified at Exhibit G1 to Exhibit G16; and
- (ii) Remove/ delete/ take down/ disable other offending/ unauthorised domains and/ or websites as and when shared by the Applicant;

e) *An order directing the concerned police station(s)/ Cyber Crime Departments/ to render necessary assistance to the Applicant in to ensure full and effective execution of the ad-interim / interim order of this Hon’ble Court in terms of the above.”*

In addition to the above relief, it is directed that in case the Registrars i.e. defendant nos.5 to 13, who has registered the websites/domain names of distinct entities, notice the name and label of the plaintiff/applicant, they are empowered to direct the entities, who have sought registration to pull down or remove/delete the use of the name and label of the plaintiff, on confirming that it is offending/unauthorized, by conducting a summary inquiry and upon the directions of the Registrars, such material from the website shall be taken down by the defendant no.14 and the other unknown defendants.

List the Application for further consideration on 20/2/2024.

Ex-parte ad-interim relief shall continue to operate till then.

(SMT. BHARATI DANGRE, J.)