

IN THE HON'BLE HIGH COURT OF HOMELAND AT PANDORA

APPEAL FROM ORDER NO. 401 OF 2019

Mr Neil Jacob  
(Original Defendant No.3)

...Appellant

Versus

1. Wonder Holidays Pvt. Ltd.  
(Original Plaintiff)
2. Mr SV  
(Original Defendant. No.1)
3. Web Designer Ltd.  
(Original Defendant No.2)
4. Kenya Tours Pvt. Ltd.  
(Original Defendant. No.4)

...Respondents

**(In this note, parties are referred to as they appeared before the trial court in the plaint)**

- The plaintiff claims to be a travel operator maintaining global reservation system done through its product "journey.com". According to the plaintiff, it is engaged in B to B business model, viz. it deals with only the registered agents and not general public. The plaintiff claims that it has business in Asia Pacific Region. According to the plaintiff, it is into the business since 1999. It has developed two trademarks – "Wonder Holidays Group" and "journey.com", and has been using them since 2007. According to the plaintiff, it has applied for the registration of the said Trade Marks under class 39, 9 and 16 in 2015-16, and no oppositions are received and the trademarks are registered. Therefore, the plaintiff is the registered proprietor of the said trademarks and therefore, since according to the plaintiff, the defendants (more particularly defendant

no.3) are using their websites / domain names in the name of “www.wonderholidays.com.ca” and “www.planjourney.com”, the defendants are infringing its trademarks.

- Insofar as the defendant no.1 and 2 are concerned, defendant no.2 is a company providing web-hosting services, software solutions and provides licencing software, whereas defendant no.1 is Managing Director of defendant no.2. It is the case of defendant nos. 1 and 2 that in view of software agreement entered into between defendant no.2 and one Wonder Holidays Canada (signed by Mr Neil Jacob as its Director), the defendant no.2 has created webpage for Wonder Holidays Canada. Apart from this, they have no role to play in the entire dispute. Therefore, they have filed an application for deletion of their names as defendants in the suit. They have also filed reply to the injunction application as well as written statement to plaint, more or less raising the same contentions, as raised in the application for deletion.
- The defendant No.3 is the Director of one Wonder Holidays Canada (Canadian entity). The defendant no. 3 is apparently joined as a defendant on the basis that the application for website registration for “wonderholidays.com.ca” and “planjourney.com” was made by him. The defendant no. 4 has been joined as defendant only on the basis that while applying for website registration, the defendant no. 3 – Mr Neil Jacob – had given his email id ([nj@kenyatours.com](mailto:nj@kenyatours.com)) as the “Registrant email id”, since before joining the Canadian entity, he was working with Kenya Tours, and by mistake he mentioned his old email id with “Kenya tours” suffix while applying for website registration for the Canadian entity.
- In the plaint as well as injunction application, plaintiff has asserted that the domain name “planjourney.com” has been registered by Wonder

Holidays Canada. Similarly domain name "www.wonderholidays.com.ca" is also registered by the Canadian entity. In the plaint, the plaintiff very vaguely refers to some oral agreement between plaintiff and defendant no.3, allegedly executed in 2012, for running an entity called "Wonder Holidays CA" in Canada.

- Insofar as documents produced by the plaintiff along with the plaint are concerned, plaintiff has produced TM-1 Form for trademark "Wonder Holidays Group", which is merely an application for registration. The said trade mark has not yet been registered. The second Trade Mark "journey.com" is admittedly registered.
- With the said back ground, the plaintiff has prayed for permanent injunction against defendants from infringing the trademarks of the plaintiff being "Wonder Holidays Group" and "journey.com" by using the said trademark of other deceptively similar mark and including but not limited to "wonderholidays.com.ca" and "planjourney.com". It has also sought permanent injunction against defendants from infringing the trademarks of the plaintiff and from passing off their services as those of the plaintiff's. Prayer seeking accounts and damages to the tune of Rs. 50 crores are also sought.
- In the application or interim injunction, the plaintiff has prayed for temporary injunction against defendants from infringing the trademarks of the plaintiff being "Wonder Holidays Group" and "journey.com" by using the said trademark of other deceptively similar mark and including but not limited to "wonderholidays.com.ca" and "planjourney.com". It has also sought temporary injunction against defendants from infringing the trademarks of the plaintiff and from passing off their services as those of the plaintiff's. Prayer for destruction of all marketing material, stamps,

stationery, invoices, etc. bearing the trademarks “wonderholidays.com.ca” and “planjourney.com” is also sought.

- The plaintiff has contended that since both the websites in dispute are accessible from **Pandora** and the plaintiff company being registered in **Pandora**, the local civil court of the city has jurisdiction to try and entertain the suit.
- Upon being served with the summons of the Court, as indicated above, the defendant nos. 1 – 2 have filed their reply and written statement to the injunction application and the plaint respectively. They have also filed an application for deletion of them as defendants from the suit on the ground that they have nothing to do with the dispute between the plaintiff and the rest of the defendants or the Canadian entity and there is no cause of action against them as they are not using the disputed websites / domain names. This application is pending.
- The defendant no. 4 has been served and it has also filed an application for deletion of its name as defendant on the ground that defendant no.4 has nothing to do with the dispute and/or the trademarks in question. It has been joined only on the basis of mistake of defendant no.3 while applying for website / domain name registration, wherein he has given his old email id containing name of defendant no.4, since before joining the Canadian entity, defendant no.3 was working with defendant no.4 and had an email id with the name of defendant no.4 in it. This application is pending.
- The defendant no.3 has been served with the summons of the Court through email and by Post at Canada. He has filed his written statement

to the Plaintiff as well as reply to injunction application. He has also filed an application under Order VII Rule 11 of the Code of Civil Procedure, 1908 (CPC) for rejection of the plaintiff on various legal grounds, as will be indicted hereinafter. He has mainly contended that the plaintiff is devoid of merits and suffers from gross suppression. The plaintiff has suppressed that one of its own Directors Mr JP is one of the Partner/Director of the Canadian entity. In fact the Canadian entity was incorporated with his vision of expanding the business of Wonder Holidays in Canada. Mr JP continues to be 25% stake-holder in Canadian entity. It is the case of defendant no.3 that the two websites / domain names of the Canadian entity were applied with the express consent and knowledge of Mr JP. It is only because of some internal finance related dispute that the plaintiff through other Director has filed the suit.

- It is the case of defendant no.3 that the logo, stationery, etc., of Canadian entity were all designed by the team of Mr JP. Further, the Canadian entity's stationery and website contains the name and website of Wonder Holidays and similarly, the website and stationery, etc. of Wonder Holidays contain the name of Canadian entity as its group Company.
- It is also contended that one of the two trademarks is unregistered mark, and hence, the prayers primarily sought for infringement are not maintainable. It is further contended that the entity, which is admittedly using the websites / domain names, and who is the "Owner" of the same, is not joined as a defendant in the suit. Hence, the suit is also bad in law in view of non-joinder as well as mis-joinder of necessary and proper party. Prime contention of lack of jurisdiction of the local trial court is also raised. It is contended that for the registered trademark, assuming without admitting, the infringement is committed by a Canadian entity, which is not joined in the suit and the local court would not have jurisdiction over the said entity. Insofar as the unregistered mark is

concerned, the cause of action has not arisen within the local limit of the trial court, and therefore also, the suit is not maintainable. It is contended that mere interactivity of any website would not confer jurisdiction to a particular court, unless it is shown that any "commercial transaction" from such website has actually taken place within the jurisdiction of that particular court.

- The Hon. Trial Court has granted an ex parte stay against defendants restraining them from using the websites / domain names in question. Hence, the Defendant No.3 has preferred Appeal against Order before the High Court, which is pending.

**Points to be considered:**

1. Can the plaintiff file a composite suit for (i) infringement of its registered trademark and (ii) passing off of an unregistered mark? Can this be said to be "barred by law"?
2. Can the Court in **Pandora** have jurisdiction to try and entertain a suit for passing off of an unregistered mark, which is apparently done by an entity in Canada?
3. Can the plaintiff file a suit against an entity (or join it in pending suit) registered under the laws of Canada alleging infringement?
4. Can the Plaintiff file a suit in **Pandora** only since it is residing / carrying out its business in Ahmedabad though no cause of action has accrued in there? Can Sec.134 TradeMark Act, 1999 be invoked without any cause of action?

5. Can the Court in **Pandora** have jurisdiction to try and entertain a suit for infringement of trademark where infringement is alleged only on the basis of an online website (interactivity not alleged) without there being any instance of commercial transaction? (refer Banyan Tree judgment)
6. Can the defendant take defence of “deemed license” in the given facts of case where plaintiff and Canadian entity has been working in past as group companies? (Common Director and names on stationery)
7. Can the Court in **Pandora** has its jurisdiction over Canadian entity in case it is found that it is violating the order passed by the Court?
8. Is the suit maintainable when the entity allegedly infringing trademark (or passing off) is not joined as a defendant?

**NOTE: Laws of State of Homeland is Pari Materia to Laws of India.**

## **Knowledge Partner:**

