



Yahoo! Inc. v. Akash Arora and another, 1999 Arb. L. R. 620 (Delhi High Court).

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Judgment delivered by Dr. M.K.Sharma

CASE FACTS

Yahoo Incorporation is the owner of the well known trade mark, Yahoo and of the domain name Yahoo.com; both the trademark and the domain name acquired a distinctive name, good will and reputation. Yahoo.com had been registered by Yahoo Inc with Network Solution Inc since 1995 and offers a whole range of web based services. The trade mark Yahoo had been registered or was close to being registered in 69 countries. Yahoo Inc had not registered its domain name in India.

Akash Arora started to offer web-based services similar to those offered by Yahoo.com under the name of Yahoo India. Yahoo Inc had sued Akash Arora for using a trade mark deceptively similar to its own and passing off his services as those offered by Yahoo Inc.

ISSUE:

Whether the act of Akash Arora in registering the domain name Yahoo India, to offer services similar to those offered by Yahoo Inc, is an infringement of the trade mark of Yahoo Inc and amounts to passing-off under the relevant sections of the Trademark and Merchandise Act?

RULE OF LAW

When a defendant does business under a name which is sufficiently close to the name under which the plaintiff is trading and that name has acquired a reputation and the public at large is likely to be misled that the defendant's business is the business of the plaintiff, or is a branch or department of the plaintiff, the defendant is liable for an action in passing off.

ANALYSIS:

Yahoo Inc contended that Akash Arora adopted the domain name of Yahoo to offer services similar to those of Yahoo Inc and had attempted to cash in on the good will generated by Yahoo Inc. because there was every possibility of an Internet user getting

confused and deceived, believing that both the domain names, Yahoo and Yahoo India belong to Yahoo Inc.. Therefore, Yahoo Inc. argued that Akash is liable for passing off.

As the two trade marks/domain names 'Yahoo!' and 'Yahoo India!' were almost similar and the latter offered services similar to those offered by the former and as the latter passed them off as being offered by Yahoo Inc., the court held Akash liable for passing off and restrained him from using the deceptively similar domain name.

The decision of the court in this case is based on the rationale that where the value of a name lies solely in its resemblance to the name or trade mark of another organization, the public is likely to be deceived by the use of such name and such act would amount to passing off.