

IN THE HIGH COURT OF JUDICATURE AT MADRAS

(ORDINARY ORIGINAL CIVIL JURISDICTION)

FRIDAY, THE 15TH DAY OF DECEMBER 2017

THE HON'BLE MR. JUSTICE M.SUNDAR

A. No.6959 of 2017

in

C.S. No.832 of 2009

(*)M/s.Matrimony.com Ltd.,
No.94, TVH Beliciaa Towers,
Tower 2, 10th Floor,
MRC Nagar, Mandaveli,
Chennai - 600 028,
Rep. By its Director and its Chief Executive Officer,
Mr.Janakiraman Murugavel

(*) Amended as per order dated 12/9/2016 in A. No.4614/2016.

: Plaintiff

Versus

1)Google India Pvt. Ltd.,
No.3, RMZ Infinity - Tower E,
3rd, 4th and 5th Floors,
Old Madras Road,
Bangalore - 560 016

2)People Interactive Pvt. Ltd.,
(**)Shop No.33-36, D.No.96 & 104,
Ground Floor, Kavery Complex,
Nungambakkam High Road,
Nungambakkam, Chennai - 34.

(**) Amended as per order dated 21/1/2010 in A. No.6379/2009.

3) Jeevansanthi Internet Services Pvt. Ltd.,
1-H, Gee Gee Emerald,
151, Village Road,
Nungambakkam, Chennai - 600 034

4) Times Business Solutions Ltd.,
2nd Floor, Suprageet Complex,
New No.174, Old No.304,
TTK Road, Alwarpet,
Chennai - 600 018

(***) 5) Google Inc.
1600 Amphitheatre Parkway,
Mountain View, CS 94043.

(***) 5th defendant is impleaded as per order dated 30/9/2010 in A.
No.247/2010.

: Defendants

A. No.6959 of 2017

Google India Pvt. Ltd.,
No.3, RMZ Infinity - Tower E,
3rd, 4th and 5th Floors,
Old Madras Road,
Bangalore - 560 016

: Applicant / Defendant No.1

Vs.

1) M/s.Matrimony.com Ltd.,
No.94, TVH Beliciaa Towers,
Tower 2, 10th Floor,
MRC Nagar, Mandaveli,
Chennai - 600 028,
Rep. By its Director and its Chief Executive Officer,
Mr.Janakiraman Murugavel

: Respondent No.1/Plaintiff

2) People Interactive Pvt. Ltd.,
 Shop No.33-36, Door No.96 & 104,
 Ground Floor, Kavery Complex,
 Nungambakkam High Road,
 Nungambakkam, Chennai - 34.

3) Jeevansanthi Internet Services Pvt. Ltd.,
 1-H, Gee Gee Emerald,
 151, Village Road,
 Nungambakkam, Chennai - 600 034

4) Times Business Solutions Ltd.,
 2nd Floor, Suprageet Complex,
 New No.174, Old No.304,
 TTK Road, Alwarpet,
 Chennai - 600 018

5) Google Inc.
 1600 Amphitheatre Parkway,
 Mountain View, CS 94043.

: Respondents / Defendants

Application praying that this Hon'ble Court be pleased to frame additional issues and recast existing issues as listed in the Schedule herein below, in the instant suit, for complete and effective adjudication of the matters in controversy.

This Application coming on this day before this court for hearing the court made the following order:

This application for framing additional issues has been taken out by defendant No.1 in the main suit.

2. The lone plaintiff is respondent No.1 in this application. The other defendants, namely, defendants 2 to 5 are respondents 2 to 5 in this application. For the sake of convenience and clarity, parties are referred to by their respective ranks in the main suit.

3. Mr.P.S.Raman, learned Senior Counsel leading the counsel on record for defendant No.1, Mr.P.H.Arvind Pandian, learned Senior Counsel leading the counsel on record for the plaintiff, Mr.Vineet Subramanian, learned counsel for defendant No.2, Mr.Madhan Babu, learned counsel for defendant No.3, Mr.S.Rajendrakumar, learned counsel representing Mr.Prashanth Rajagopal, learned counsel for defendant No.4 and Mr.E.Balasubramanian, learned counsel for defendant No.5 are before this court.

4. I have heard all learned counsel.

5. Considering the limited scope of this application, suffice to say that the main suit is one for alleged infringement of a registered Trademark, though suit and pleadings may not be as simple as set out here. After completion of pleadings, issues were framed by this Court on 19.04.2017. As many as 14 issues were framed.

6. This application for additional issues has been taken out by defendant No.1 as aforesaid. It is predicated on the ground that additional issues, which are now sought to be framed, are imperative for an effective trial. Mr.P.S.Raman, learned senior counsel submits that it has become necessary to take out this application as some aspects of the pleadings were not brought to the notice of this

Hon'ble Court either by inadvertence or by oversight when draft issues were circulated and 14 issues were originally framed on 19.04.2017.

7. To be noted, as far as this application for framing additional issues is concerned, five additional issues are sought to be framed, one issue already framed is sought to be modified, i.e., issue No.1 and two other issues, namely issue Nos.4 and 6 already framed are sought to be deleted.

8. With regard to 14 issues already framed by this Court, in issue No.1, the term 'meta tag' needs to be deleted is the submission made by Mr.P.S.Raman, learned senior counsel. There is no disagreement on this amongst the counsel and this has in fact been articulated by the plaintiff in paragraph 13 of its counter affidavit in the instant application.

9. Therefore, to that extent, issue No.1 stands modified and now, the same would read as follows :

"1.Whether the defendants are infringing and / or enabling others to infringe plaintiff's registered trademarks Bharatmatrimony, Tamilmatrimony, Telugumatrimony etc., and / or its variants by including

them jointly and severally as "Adwords", "Keyword suggestion Tool" or as a keyword for internet search or in any other manner whatsoever?"

10. With regard to issue Nos.12 and 13, which inter-alia pertain to acquiescence, issues as framed refer to defendant No.3 alone. All the learned counsel before me agree that instead of restricting it to third defendant, it has to refer to all five defendants and therefore, it would be appropriate to replace 'third defendant' with 'defendants'. As there is no disagreement amongst counsel before me, this request is also acceded to.

11. Therefore, issue Nos.12 and 13 will now read as follows :

"12.Whether the use of the words Tamil, Telugu or Matrimony by the defendants is honest and common trade practice and can the plaintiff curtail such trade practice?

13.Whether the plaintiff has acquiesced the use of the descriptive words such as Bharatmatrimony.com, Tamilmatrimony.com, Telugumatrimony.com etc. by the defendants?"

12. With regard to deletion of issue Nos.4 and 6, I have heard all the learned counsel. Submissions made by learned senior counsel for defendant No.1 is opposed by learned senior counsel for plaintiff on the ground that these issues directly pertain to pleadings and that they are, in fact, relevant. It is also pointed out that these issues are directly relatable to pleadings of respective parties and therefore, no prejudice or hardship would be caused to defendant No.1 if these issues are not deleted and if parties go to trial with these two issues.

13. I have also heard learned senior counsel and he has taken me through the relevant portions of the pleadings. I have no hesitation in accepting the contentions of M.P.H.Arvind Pandian, learned senior counsel that issue Nos.4 and 6 do not deserve to be deleted as there are sufficient pleadings in this regard. These two issues need not be deleted and there is no ground for deletion. Therefore, that limb of the prayer in this application pertaining to deletion of issue Nos.4 and 6 is not acceded to / is negatived.

1. That leaves us with five additional issues which have been sought to be framed.

2.

15. I have heard detailed submissions made by the two senior counsel and all learned counsel. With regard to AdWords program, this commercial division is given to understand that defendant No.5 is the holding entity qua defendant No.1 which I am informed is a wholly owned subsidiary of defendant No.5. Under such circumstances, it is also submitted that AdWords program is being run only by defendant No.5 and that defendant No.1, a subsidiary of defendant No.5, has nothing to do with AdWords program. This has been put in issue. As it does not find place in the 14 issues framed earlier, additional issue No.1, as set out in the application, is sought to be framed.

16. In my considered opinion, it would be appropriate if it is couched in a different language than what has been set out in the affidavit. The additional issue regarding running AdWords program will now read as follows :

"Is AdWords program being run by defendant No.5
alone?"

To be noted, this will now be issue No.15 now.

17. With regard to additional issue No.2, it pertains to whether the plaintiff is entitled to claim protection over the subject marks. Considering the 14 issues that have already been framed after hearing

the learned counsel, I am of the considered opinion that it is not going to serve any useful purpose. More over, this issue is clearly encompassed and covered in 14 issues, which have already been framed. Therefore, I am of the view that this additional issue No.2, which is sought to be framed, is not necessary.

18. With regard to additional issue No.3 which is sought to be framed, the last limb of the issue as projected before me refers to consequence of an action. In an issue, it cannot contain an action and the consequence and that cannot become a question by itself much less a question which will be an issue in the suit. Therefore, I deem it appropriate to recast this additional issue and it will now read as follows :

“Whether the subject marks are distinctive and whether the plaintiff is entitled to protection of variants of the marks by adding a space between the conjoint words?”

This will be issue No.16 now.

19. With regard to additional issue Nos.4 and 5, which are sought to be framed, after hearing learned counsel and after they have taken me through relevant portions of the pleadings, it unfurls

that both issues pertain to alleged suppression by the plaintiff. The alleged suppression pertains to two aspects of the matter. One aspect is disclaimers in the trademark registration certificate and the other pertains to the plaintiff's alleged participation in the AdWords program.

20. It is submitted before me that legal user certificate (Trademark registration certificate) was not before the court earlier and therefore, disclaimers were not readily discernible. It is this ground on which these two additional issues are now sought to be framed.

21. In my opinion, for issues in a suit, the aforesaid two additional issues as proposed are little verbose. To avoid verbosity and make it crisp, two issues can be rolled into one. Accordingly, now the recast issue reads as follows :

“Whether the plaintiff has suppressed disclaimers in the trademark registration certificates and its participation in AdWords program?”

This will be issue No.17 now.

22. To be noted, three additional issues framed today will be shown as additional issues and they will have serial Nos.15 to 17 in the list of issues already framed.

23. Mr.P.H.Arvind Pandian, learned senior counsel leading the counsel on record for the plaintiff submits that proof affidavit of P.W.1 has already been served on defendants and that in the light of the recast issues and in the light of three additional issues, it may be necessary to take back the proof affidavit and file proof affidavit afresh advertent to these aspects. There is no objection to this request from the other counsel. This request is acceded to. Though this forms part of order in this application, the Sole Commissioner shall take note of this aspect of the matter.

24. For the sake of convenience of trial and for the sake of convenience of all concerned, i.e., sole commissioner, counsel and litigants, Registry is directed to issue certified copy of 17 issues, i.e., 14 issues already framed by this court on 19.4.2017 with necessary changes in issue Nos.1, 12 and 13 which have been made today followed by three additional issues framed today, which shall be shown as additional issues and shall be given running serial numbers 15 to 17. To be noted, though obvious, this will now stand

substituted in place of earlier issues framed on 19.4.2017.

25. The 17 issues in the suit will now read as follows:

(1) Whether the defendants are infringing and / or enabling others to infringe plaintiff's registered trademarks Bharatmatrimony, Tamilmatrimony, Telugumatrimony etc., and / or its variants by including them jointly and severally as "Adwords", "Keyword suggestion Tool" or as a keyword for internet search or in any other manner whatsoever?

(2) Whether the defendants are passing off and / or enabling others to pass off the business and services of the plaintiff's competitors including defendants 2 to 4 as that of the plaintiff?

(3) Whether the defendants 1 and 5 are aiding the plaintiff's competitors including defendants 2 to 4 in infringement and passing off the plaintiff's registered trademarks and its variants by including it in the keyword suggestion tool?

(4) Whether the defendants 1 and 5 are illegally enriching themselves by sale of contextual advertising

space to the plaintiff's competitors including defendants 2 to 4?

(5) Whether use of the plaintiff's registered trademarks in the Adwords program of the defendants 1 and 5 amounts to infringement of the plaintiff's registered trademark?

(6) Whether the use of the plaintiff's registered trademarks or its variants as part of the Adwords program and keyword suggestion tool of the defendants 1 and 5 amounts to diverting the business of the plaintiff to its competitors including the defendants 2 to 4?

(7) Whether the acts of the defendants 2 to 4 in including the plaintiff's trademarks in the Adtext as well as in the URL link amounts to infringement and passing off the plaintiff's trademarks?

(8) Whether the plaintiff is entitled to the relief of damages as prayed for?

(9) Whether the plaintiff is entitled for a direction to surrender of goods and materials of the defendants as prayed for?

(10)Whether the plaintiff is entitled to a decree for rendition of accounts?

(11)To what other relief the plaintiff is entitled to?

(12)Whether the use of the words Tamil, Telugu or Matrimony by the defendants is honest and common trade practice and can the plaintiff curtail such trade practice?

(13)Whether the plaintiff has acquiesced the use of the descriptive words such as Bharatmatrimony.com, Tamilmatrimony.com, Telugumatrimony.com etc. by the defendants?

(14)Whether this Court has jurisdiction to try and entertain the present suit?

Additional issues :

(15)Is AdWords program being run by defendant No.5 alone?

(16)Whether the subject marks are distinctive and whether the plaintiff is entitled to protection of variants of the marks by adding a space between the

conjoint words?

(17) Whether the plaintiff has suppressed disclaimers in the trademark registration certificates and its participation in AdWords program?

26. Accordingly, this application stands disposed of.

Sd./- M.S.J.

15.12.2017

//Certified to be true copy//

Dated at Madras this the th day of 2017.

COURT OFFICER (O.S.)

TPY/2.1.2018

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