



IN THE HIGH COURT OF JUDICATURE AT MADRAS

(ORDINARY ORIGINAL CIVIL JURISDICTION)

FRIDAY, THE 13TH DAY OF AUGUST 2021

THE HON'BLE DR. JUSTICE G.JAYACHANDRAN

A.No.2802 of 2021

in

C.S. No.395 of 2019

M/s. Matrimony.com Limited,
No.94, TVH Beliciaa Towers,
Tower-2, 10th Floor,
MRC Nagar, Mandaveli, Chennai 600 028
rep.by its General Manager - Legal & Regulatory
Mr.S.Ravichandran

... Plaintiff

-Versus-

People Interactive Pvt. Ltd.,
Old No.124/1, New No.14
Heera Panna Complex,
2nd Floor, G.N.Chetty Road,
T.Nagar, Chennai 600 017.

... Defendant

A.No.2802 of 2021

People Interactive Private Ltd.,
Old No.124/1, New No.14
Heera Panna Complex,
2nd Floor, G.N.Chetty Road,
T.Nagar, Chennai 600 017.

... Applicant/Defendant

Vs



M/s. Matrimony.com Limited,
No.94, TVH Beliciaa Towers,
Tower-2, 10th Floor,
MRC Nagar, Mandaveli, Chennai 600 028
rep.by its General Manager - Legal & Regulatory
Mr.S.Ravichandran

..Respondent/Plaintiff

Application praying that this Hon'ble Court be pleased to grant stay of all proceedings in Suit bearing number C.S.395 of 2019, until the final disposal the rectification applications filed by the Applicant/Defendant against the Respondent/Plaintiff's registered trademarks, set out at "Annexure "A" to the Plaint, which have now been transferred to this Hon'ble Court as set out at Schedule A hereto.

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

This application is taken out by the sole defendant in C.S.No.395 of 2019 to grant stay of all proceedings in the suit until final disposal of the rectification applications filed by the defendant before the Intellectual Property Appellate Board (Now transferred to this Court in view of the Ordinance issued by the Central Government on 04.04.2021, dissolving IPAB).

2. Before advertng to the merits of this application, this Court records certain facts pertaining to the suit which will enable to easily arrive at a conclusion.



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3. A batch of suits were filed by the matrimony.com claiming exclusiveness over the domain mark, since they have valid registration for several marks with suffix matrimony. After several rounds of interlocutory litigations between the parties, at last, the Hon'ble Supreme Court vide order dated 11.01.2021 in the batch of S.L.P., arising out of final order passed in O.S.A.Nos. 5 and 6 of 2020 by the Division Bench of this Court remitted back the matter with a direction without expressing any opinion on merits, requesting the High Court to tag C.S.No.327 of 2018, 395 of 2019, 277 of 2019, 418 of 2019 and 802 of 2018 along with C.S.No.832 of 2019 and decide them as expeditiously.

4. With due reverence to the Hon'ble Supreme Court direction, the Hon'ble Chief Justice of this Court has specially allotted the matter to be decided by the Commercial division of this Court. Accordingly, this Court been proceeding with the matter.

5. In the course of hearing, this Court found in some of the cases, the validity of the plaintiff's mark had been challenged before the IPAB and was pending and in few cases, the defendants are contemplating to file such an



which in effect has abolished the IPAB, a sort of uncertainty in the minds of the litigants had cropped up. Particularly in view of the expressions found in Section 124 of the Trademarks Act, which contemplates that whenever an application is pending before the Registry of the Trademark, the suit pending before the civil Court has to be stayed. Also even, if no such proceedings are pending, if the Court satisfies. The plea regarding the invalidity of registration of the plaintiff's or the defendant's trademark is prima facie tenable, the Courts has to adjourn the matter for a period of 90 days from the date of framing of issue in order to enable the party concerned to apply to the Appellate Court for the rectification of the register. Since the IPAB is dissolved, the question where the rectification application is filed and how to be decided has become a moot question.

6. This Court, on considering the spirit, scope and object of the provision Section 124 of the Trademarks Act, is of the view that question of granting stay of the pending proceedings will arise only when the forum to decide rectification and the forum to decide infringement are different. That was the position prior to Section 124 of the Act. When the forum to decide both the issues are one and the same then stay of proceeding will not arise only primacy to hear on relief ahead of another will arise provided it will be



part of the same section, we have to take clue from the latter part of Section 124(1)(b)(ii) which says that “the Court shall frame the issue and adjourned the matter by three months” so that, the parties can work out their remedy regarding the validity of the Trademark before the Registry of IPAB. Thereafter, he will revert back to the Court to decide the issue regarding the infringement.

7. Since it is the same Court which has to decide both the issue of infringement as well as the rectification of the mark, it is suffice to frame an issue regarding the validity of the plaintiff's mark and decided it as a preliminary issue in the course of trial. There is no necessity to stay the proceedings for the sake of deciding the rectification application.

8. As far as the suit in C.S.No.395 of 2019 is concerned, like in all other connected suits the issue regarding the validity has been already framed based on the pleadings. In such circumstances, the request to stay does not arise. Hence the application No.2802 of 2021 is dismissed.

Sd./-G.J.J
13.08.2021

//Certified to be true copy//

Dated at Madras this the day of 2021.

COURT OFFICER(O.S.)

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