



C.S.(Comm. Div.)No.122 of 2021

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Judgment reserved on	29.04.2022
Judgment pronounced on	14.07.2022

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The Hon'ble Mr. Justice **SENTHILKUMAR RAMAMOORTHY**

Civil Suit(Comm.Div) No.122 of 2021
and
O.A.Nos.826 & 828 of 2021 and A.No.442 of 2022

M/s.FreeElective Network Private Limited,
2, Thomas Nagar, 2nd Floor,
Little Mount, Saidapet,
Chennai - 600 015.

Rep. by its Director S.Anilkumar

... Plaintiff

vs.

M/s.Matrimony.com. Limited
No.94, TVH Belicia Towers,
Tower 2, 10th Floor, MRC Nagar,
Mandaveli, Chennai – 600 028.

... Defendant

The suit is filed under Order VII Rule 1 CPC and Order IV Rule 1 of O.S. Rules R/W Sections 27, 28, 29, 134, and 135 of the Trademarks Act, 1999 praying for a permanent injunction restraining the Defendant, by itself, its directors, men, servants, agents, representatives or anyone claiming



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through or under them from in any manner infringing the Plaintiff's registered trademark Jodi365 under No.1971072 in Class 99 and other registered trademarks by using a deceptively similar trademark Jodii or any other trademark deceptively similar to the Plaintiff's registered trademark or in any other manner whatsoever; (b) a permanent injunction restraining the Defendant, by itself, its directors, men, servants, agents, representatives or anyone claiming through or under them from in any manner passing off and/or enabling others to pass off the Defendant's services of software/website/mobile applications or any other Internet-related services or offline matchmaking services under the trademark Jodii as and for the Plaintiff's services by using, offering for sale, displaying, printing, advertising their services with a trademark Jodii or any other trademark identical or deceptively similar with that of the Plaintiff's Jodi365 or in any other manner whatsoever; (c) the Defendant be ordered to surrender to Plaintiff for destruction of all materials, brochures, screen prints, packing materials, advertising materials, and other materials, including on the Internet, bearing the trademark Jodii or any mark deceptively similar to Plaintiff's trademark Jodi365; (d) damages to the tune of Rs.1,00,00,000/- and for costs of the suit.



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by computer terminals, computer aided transmission of messages and images, etc.; and Class 41 covers education, providing of training and cultural activities, entertainment, education information, gaming, and publication of texts, etc. The registration was granted with effect from 26.05.2010 and is valid and subsisting up to 26.05.2030 after having been renewed for 10 years with effect from 26.05.2020. The device mark “Jodi365” has been used from the year 2009 honestly, openly and continuously. In the said device mark, the word “Jodi” is the distinguishing, prominent and essential feature. The Plaintiff's total revenue for the year ended March 2020 was Rs.31,28,190/-, as per the audited financial statement, and Rs.16,07,231/- for the year ended 31.03.2021 as per the provisional financial statement. It incurred advertising expenditure of about Rs.30 lakhs since December 2019 for advertising on Facebook. It launched a mobile application (app) version of “Jodi365”, which is available on the Google Play Store since January 2020, and more than 50,000 users had downloaded the said app. By relying upon press and media coverage in relation thereto, the Plaintiff further stated that its trademark has acquired considerable reputation and goodwill in the market.



3. In or about October 2021, the Plaintiff stated that it came to know that the Defendant had launched a mobile app under the name “Jodii”.

The Plaintiff alleged that the Defendant placed advertisements online targeting the Plaintiff's registered trademark on its website. Therefore, the Plaintiff asserted that the Defendant is fully aware of the Plaintiff's website and mobile app. Consequently, it is further alleged that the Defendant's actions are *mala fide*. Immediately upon discovering the Defendant's dishonest adoption of the infringing mark “Jodii”, the Plaintiff issued a cease and desist notice on 02.11.2021. By reply dated 17.11.2021, the Defendant stated that the Plaintiff is not entitled to monopolize the word “Jodi”. On the basis that both the Plaintiff and Defendant are engaged in the provision of substantially similar services and that the Plaintiff is the prior user of the registered trade mark “Jodi365”, the present suit was filed.

4. The Defendant refuted the above averments and allegations by filing a written statement. The Defendant stated that it is the registered proprietor of the mark "BHARATMATRIMONY" and other allied marks, which have been used from the year 1999. According to the Defendant, the mobile app “Jodii” was launched in October 2021 under the Defendant's



house mark "BHARATMATRIMONY". The Defendant stated that the application is in Tamil and that the word "Jodi" directly refers to the nature and purpose of services offered. According to the Defendant, the Plaintiff has a registration in respect of the device mark "Jodi365" and not in respect of the word "Jodi". Consequently, by virtue of such registration, the Plaintiff is not entitled to a monopoly over the word "Jodi" or any variant thereof. The Defendant asserted that the device marks of the Plaintiff and the Defendant are not even remotely similar. The Defendant further stated that several other entities use the word "Jodi" as part of applications in relation to matchmaking or dating services. For such purpose, the Defendant has included a table containing relevant particulars in paragraph 15 of the written statement. Similarly, at paragraph 16 of the written statement, the Defendant has provided details of several websites which use the word "Jodi".

5. Upon considering the pleadings and documents, the following issues were framed:



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1)Whether the Plaintiff is the registered proprietor of the trademark JODI365 label under No.1971072 in Class 99?

2) Whether the Defendant's trademark JODII is deceptively similar to the Plaintiff's trademark JODI365?

3)Whether the Plaintiff can claim infringement of its registered trademark JODI365 by the Defendant's use of the trademark Jodii?

4) Whether the Plaintiff can claim passing off against the Defendant by the use of the trademark Jodii?

5) Whether the Plaintiff is entitled to the relief of damages against the Defendant?

6) Whether the parties are entitled to any other relief?

6. By order dated 11.02.2022, it was recorded that the parties do not propose to adduce oral evidence. The Plaintiff filed 14 documents. Therefore, the Plaintiff's documents were marked as Exs.P1 to P14.



Similarly, the Defendant filed 14 documents, which were marked as Exs.D1 to D14.

7. Oral arguments were advanced on behalf of the Plaintiff by Mr.R.Sathish Kumar, learned counsel, and on behalf of the Defendant by Mr.P.S.Raman, learned senior counsel, assisted by Mr.Arun C.Mohan, learned counsel. Both parties also submitted written arguments.

8. Learned counsel for the Plaintiff contended that the Plaintiff has used the mark “Jodi365” from the year 2009 onwards. The domain name was registered through a domain name registrar as jodi365.com(Ex.P1). Shortly after adopting the mark, the Plaintiff applied for and obtained registration under Class 99 as a single, multi-class application for Classes 35, 38 and 41(Ex.P2). The registration was duly renewed for a further period of 10 years from 26.05.2020 up to 26.05.2030(Ex.P3). Ever since, the Plaintiff contended that the trademark has been used honestly, openly and continuously. By pointing out that the word “Jodi365”, including minor variations thereto, when keyed-in on Google triggers the Defendant's advertisements, it was contended that the Defendant not only has prior knowledge of the Plaintiff's trademark but is dishonestly and consciously attempting to divert the Plaintiff's customers,



both potential and actual, to its app or website. Learned counsel pointed out that a cease and desist notice dated 02.11.2021(Ex.P12) was issued immediately upon discovering the use of the infringing mark “Jodii” by the Defendant. In spite of putting the Defendant on notice at the earliest point of time, the Defendant, by reply dated 17.11.2021(Ex.P13), contended that the Plaintiff is not entitled to protect the mark “Jodi365” and that the Defendant's mark is visually and phonetically different from the Plaintiff. With regard to the contention that the Plaintiff is not entitled to claim protection as regards the word “Jodi”, learned counsel contended that the Plaintiff is seeking protection for the device mark “Jodi365” of which the word “Jodi” is a prominent and essential feature. By referring to the use of the mark “Jodii” by the Defendant and the endeavour to register the same, learned counsel contended that an estoppel operates against the Defendant from contending the the element “Jodi” is not distinctive. Learned counsel As regards the other users of the mark, it was submitted that Plaintiff is the first user of the mark and that all the other users are subsequent. Besides, the use of the infringing mark by others does not absolve the Defendant of liability for infringement. By referring to precedent, he also contended that the “big fish should not allowed to swallow the small fish”.



9. As regards the defence that exclusivity cannot be claimed over

one of the elements of a composite mark, the Plaintiff contended that Section 17 of the Trade Marks Act, 1999 (the Trade Marks Act) would constitute a defence only if exclusivity is claimed over the word “Jodi”, whereas the Plaintiff claims exclusivity over the device mark “Jodi365” and that the use of the word “Jodii” by the Defendant is infringing and amounts to passing off because such mark is deceptively similar to the device mark “Jodi365”. Learned counsel relied upon Section 38 of the Specific Relief Act, 1963 (the Specific Relief Act) and pointed out that the requirements for the grant of permanent injunction under Section 38 thereof are different from the requirements under Order XXXIX, Rules 1 and 2 of the Code of Civil Procedure, 1908 (the CPC). In specific, Section 38 enables an aggrieved plaintiff to seek a permanent injunction subject to the requirements of Chapter VIII of the Specific Relief Act. Such an injunction may be granted where there exists no standard for ascertaining the actual damages caused or likely to be caused by the invasion of the plaintiff's right or where the invasion is such that compensation in money would not constitute adequate relief. He contended that the suit satisfies all the requirements of Sections 38 and 40 of the Specific Relief Act and that none of the circumstances



specified in Section 41 operate so as to deny the relief of injunction to the Plaintiff. By referring to and relying upon Section 29(3) of the Trade Marks Act, he also contended that the Plaintiff is entitled to the presumption of confusion since both the Plaintiff and Defendant provide substantially similar services and the marks are near-identical. As regards the claim for damages, learned counsel contended that damages cannot be proved in matters of this nature and, therefore, the Court should exercise judicial discretion in awarding reasonable compensation.

10. In support of these contentions, learned counsel for the Plaintiff referred to and relied upon the following judgments:

(i) *B.K. Engineering Co. v. U.B.H.L. Enterprises (Regd) & Another*, 1985 Arb LR 269.

(ii) *Automatic Electronic Limited v. R.K.Dhawan and Another*, 1999 SCC Online Del 27.

(iii) *Laxmikant V. Patel vs. Chetanbhai Shah and another*, (2002) 3 SCC 65.

(iv) *Satyam Infoway Ltd v. Sifynet Solutions Pvt Ltd*, 2004 (28) PTC 566 (SC) (**Satyam Infoway**)

(v) *Central Park Estates Pvt Ltd and others v. Godrej Skyline Developers Private Limited and Another*(**Central Park Estates**), 2019 SCC OnLine Del 11580



(vi) *Dhariwal Industries Ltd. and another v. M/s.M.S.S. Food Products*, AIR 2005 SC 1999.

(vii) *Cadila Health Care Ltd v. Cadila Pharmaceuticals Ltd (Cadila)*, AIR 2000 SC 1952.

(viii) *Pidilite Industries Limited v. Jubilant Agri & Consumer Products Limited (Pidilite Industries)*, 2014 (57) PTC 617.

11. In response to the above contentions, learned senior counsel for the Defendant contended that the Plaintiff's registration is in respect of a device mark. The said device mark consists of the alpha-numeric element "Jodi365" and a non-alpha numeric element. Both the alphabetic sub-element element "Jodi" and the numeric sub-element "365" are descriptive. In fact, the Defendant contended that these are conspicuously descriptive in the context of a matrimonial website inasmuch as the word Jodi means pair or match and the numeral 365 represents the number of days in a year. Consequently, the Defendant contended that such a mark is entitled to the lowest degree of protection. Even if there is a small variation in the Defendant's mark, the Plaintiff is not entitled to relief.

12. Learned senior counsel further contended that there are several marks which use the word "Jodi", including in relation to



matchmaking or matrimonial services. Therefore, the Plaintiff is not entitled to relief since the mark is common to the trade and qualifies as *publici juris*.

It was pointed out that Google runs an AdWord programme in which various words are auctioned. One of the words being auctioned is “Jodi”. Since the word “Jodi” is descriptive of the nature of the services, no entity, including the Plaintiff, is entitled to claim monopoly over such word. The Defendant is an entity with tremendous reputation in the matrimonial services business and there is no likelihood of confusion because the Defendant's registered mark "BHARATMATRIMONY"(Exs.D1 and D2) is mentioned in the website. In support of these contentions, learned senior counsel for the Defendant referred to and relied upon the following judgments:

(i) *Ultratech Cement Limited v. Dalmia Cement Industries Limited*, 2016 (67) PTC 314.

(ii) *S.N.R. Dhall Mill v. Kaleesuwari Refinery Private Limited*, 2021 SCC Online Mad 1675.

(iii) *People Interactive (India) Private Limited v. Vivek Pahwa and others*, MANU/MH/1661/2016.

(iv) *Consim Info Ltd. v. Google India Pvt. Ltd(Consim Info)*, 2010 (6) CTC 813.

(v) *Consim Info Pvt. Ltd. v. Google India Pvt Ltd*, 2012 (5) LW 1.

(vi) *Matrimony. Com Ltd v V.Kalyan Jewellers India Ltd and others*, MANU/TN/2685/2026.



(vii) *P.M.Palani Mudaliar & Co v. M/s.Jansons Exports and another (Palani Mudaliar)*, 2017 SCC Online Mad 1090.

Issue Nos.1, 2 and 3:

13. Issue Nos.1 to 3 relate to whether the Plaintiff is the registered proprietor of the trademark “Jodi365”, whether the Defendant's mark “Jodii” is deceptively similar to the Plaintiff's trademark and whether the Plaintiff is entitled to relief in respect of infringement by the Defendant. These issues are closely inter-related and are dealt with jointly. The Plaintiff exhibited the Trademark registration certificate as Ex.P2. The said registration is in respect of the device mark. The registration is with effect from 26.05.2010. The annexure thereto discloses that the registration is in Classes 35, 38 and 41. Class 35 covers the service of advertising, computer databases, data search in computer files, etc. Class 38 covers telecommunications, communications by computer terminals, computer aided transmission of messages and images, etc. Class 41 covers education, providing of training and cultural activities, entertainment, education information, gaming, and publication of texts, etc. The Plaintiff has also produced the renewal certificate, which was exhibited as Ex.P3. The said renewal certificate evidences that the registration is valid for a period of 10 years from 26.05.2020. Thus, the undoubted position is that the Plaintiff is the



registered proprietor of the device mark “Jodi365”. Till date, it appears that there is no proceeding for rectification at the instance of the Defendant or any other person. The Plaintiff has filed a Chartered Accountant's certificate as Ex.P5 in respect of its annual revenue for the financial years ended 31.03.2014 to 31.03.2020.

14. Immediately upon discovering the Defendant's use of the allegedly infringing mark “Jodii”, the Plaintiff issued a cease and desist notice dated 02.11.2021, which was exhibited as Ex.P12. Thus, the factual position is largely undisputed. What remains is the consideration of the legal issue as to whether the Plaintiff is entitled to the reliefs claimed. To put it differently, whether the mark “Jodi365” is distinctive and entitled to protection and, if so, whether the use of the mark “Jodii” by the Defendant constitutes infringement of the Plaintiff's trademark “Jodi365” or passing off by the Defendant.

15. The principal defence of the Defendant is that the registration is in respect of a device mark and that the element “Jodi” in the composite mark is not entitled to protection. The Plaintiff cannot and does not dispute



that its registration is in respect of the device mark “Jodi365”. Nonetheless, the Plaintiff contended that the use of the mark “Jodii” by the Defendant infringes the device mark “Jodi365”. In support of this contention, the Plaintiff relied on **Satyam Infoway** for the proposition that a domain name is also capable of protection as a trade mark. In addition, the Defendant relied on **Central Park Estates** to contend that “Jodi” is the prominent and essential feature of the device mark “Jodi365” and therefore the said device mark is infringed by the use of the mark “Jodii” by the Defendant. In **Central Park Estates**, the Delhi High Court concluded that “Central Park” is the essential feature of the plaintiff’s trademark and the said trademark is infringed by the use of the mark “Godrej Central Park” by the defendant therein. In order to refute this contention, the Defendant contended that the Plaintiff is not entitled to claim monopoly over the word “Jodi” which is descriptive of matchmaking, dating and matrimonial services. The Defendant also relied on the use by various other entities of domain names and apps (Exs.D8 and D9) containing the word “Jodi” and asserted that the word “Jodi” is *publici juris*. It was also pointed out that, at paragraph 15 of the written statement, the Defendant set out a list of apps that use the word



“Jodi” in relation to matchmaking or dating services. In paragraph 16, domain names containing the word or element “Jodi” were enumerated.

16. The question whether the sub-element “Jodi” in the device mark “Jodi365” is the essential feature thereof and, more importantly, whether it has acquired distinctiveness is examined first. It should be noticed that the word “Jodi” is a common word in Tamil, Hindi and other Indian languages and means a pair or couple and “365” is a numeral which is equivalent to the number of days in a year. Trademarks are typically classified into four categories, which are placed in a spectrum. At one end are marks that are ineligible for protection, at the middle are marks that are entitled to protection subject to satisfaction of conditions and marks entitled to protection without conditions, and at the other end are marks entitled to strong unconditional protection. The placement of a mark on this spectrum is dependent on the product or service to which the mark is applied and, therefore, the exercise cannot be carried out in a vacuum. In the landmark judgment in *Abercrombie & Fitch Company v. Hunting World Incorporated*, 537 F.2d 4 (2d Cir. 1976) (***Abercrombie***), the US Court of Appeals for the Second Circuit held, in relevant part, as under:



“The cases, and in some instances the Lanham Act, identify four different categories of terms with respect to trademark protection. Arrayed in an ascending order which roughly reflects their eligibility to trademark status and the degree of protection accorded, these classes are (1) generic, (2) descriptive, (3) suggestive, (4) arbitrary or fanciful. The lines of demarcation, however, are not always bright...”

The definition of a generic term in *Abercrombie* is: “a generic term is one that refers, or has come to be understood as referring, to the genus of which the particular product is a species.” In *Miller Brewing Company v. G. Heileman Brewing Company, Inc.* 561 F.2d 75 (7th Cir. 1977), the US Court of Appeals for the Seventh Circuit defined a “generic or common descriptive term as one which is commonly used as the name or description of a kind of goods.”

17. Since a generic term describes either the product/service category or the product/service, no person is permitted to monopolize or appropriate such term and claim exclusive use thereof. For example, trademark protection and exclusivity cannot be claimed over the term “car”



when used for a motor car or “radio” or “television” when used in relation to the said products. In contrast to generic or common descriptive terms, a descriptive term describes a characteristic or ingredient or quality or intended purpose of a product or service. Such terms may be entitled to protection provided they acquire distinctiveness and secondary meaning. In *Zatarains, Inc. v. Oak Grove Smokehouse* 698 F.2d 786 (**Zatarains**), the US Court of Appeals for the Fifth Circuit formulated four tests to discern if a mark is descriptive: whether the mark has a dictionary meaning; whether imagination is required to connect the product or service to the mark and, if so, how much; whether competitors are likely to need the terms used in the mark to describe their product or service; and the extent of use of the term by others to market a similar product or service. If the above tests were to be applied to the sub-element “Jodi” in its application to a website or app that facilitates subscribers to find a long-term partner or spouse, the sub-element “Jodi” in the mark is a dictionary word in the Tamil and Hindi languages meaning a pair or couple. The term directly refers to the intended purpose of the service and it is not necessary to exercise one's imagination to make the connection. While the use of the term as a trademark by other providers of similar services is not necessary, the term may be required to be used at least



descriptively by other service providers in the same field. Finally, the evidence on record discloses that a number of other service providers use the element “Jodi” as part of their website or app. It should also be noticed that “Jodi” is clearly indicative of the intended purpose of the service, but it does not describe the service. Because it clearly refers to and does not merely suggest the intended purpose, it falls within the descriptive and not the suggestive category. As a descriptive mark, it certainly does not have inherent distinctiveness. This leads to the question whether the mark has acquired distinctiveness.

18. In support of the claim of acquired distinctiveness, the Plaintiff asserted and adduced evidence of open, honest and continuous use from the year 2009. The Plaintiff also provided evidence that more than 325,000 persons visited the website Jodi365.com from 2011 to date(Ex.P4), and also placed evidence of its annual turnover for the years ended 31.03.2020 and 31.03.2021. The Plaintiff also placed evidence of significant coverage in the press and media(Ex.P8). Section 9(1) of the Trade Marks Act deals with absolute grounds to refuse registration and the proviso thereto, which carves out an exception, is extracted below:



“Provided that a trade mark shall not be refused registration if before the date of application for registration it has acquired a distinctive character as a result of the use made of it or is a well-known trade mark”

Section 32 deals with distinctiveness acquired post-registration and is as under:

“Protection of registration on ground of distinctiveness in certain cases. -- Where a trade mark is registered in breach of sub-section (1) of section 9, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration and before commencement of any legal proceedings challenging the validity of such registration, acquired a distinctive character in relation to the goods and services for which it is registered.”

In this case, the registration of the mark was with effect from 26.05.2010 and the use thereof was from 2009. While there is no doubt that the use has been for a considerable period and the Plaintiff has provided reasonable evidence of reputation in this line of business, the question that follows is whether this is sufficient to draw the inference that the mark has acquired



secondary meaning. A more nuanced question would be whether such secondary meaning extends protection to the sub-element “Jodi”, and these aspects are considered next.

19. In *People Interactive (India) Private Limited v. Vivek Pahwa and others* 2016 SCC Online Bom 7351 (**People Interactive**), the Bombay High Court grappled with the meaning of acquisition of secondary meaning in the context of Shaadi.com and secondshaadi.com. In paragraph 15 of the SCC Online Report, it was held as under:

“That takes us generally to the question of 'secondary meaning' or 'secondary significance'. When does an expression acquire a 'secondary meaning' and how does it acquire it? Again, this is a phrase much bandied about, and I do believe we need to pause to consider what is meant by all this. What do we mean when we say that an expression has 'acquired a secondary meaning'? This must necessarily mean that the primary meaning of the expression, the one with which it began, has been lost. It is left behind. The expression no longer means what it once did. It has assumed a new avatar. It has transcended its original connotation and now references exclusively in the public mind



the claimant's products, goods or services, i.e. that there is an identification of the mark with the claimant rather than with the goods or services in and of themselves. The claim of a 'secondary meaning' posits a priori that the expression once had a more commonplace, ordinary meaning – this is the meaning that is now lost. In its first iteration, the expression found place lower on the Indchemie/Miller Brewing scale. It has since moved upward by acquiring a secondary meaning.”

As is evident from the above extract, the Bombay High Court held that the primary meaning should be lost and the expression should have transcended its original connotation to acquire secondary meaning. If this standard were to be applied and tested against the well-known mark 'Apple', when used in the context of computers, there is sufficient basis to take judicial notice and conclude that the primary meaning of apple as referring to a type of fruit has not been lost. But when the word 'Apple' is used or the device mark is seen in the context of computers, it brings to mind a popular brand of computer and its maker and not the fruit. While undertaking this exercise, it should be noticed that the mark 'Apple', when used for computers, is far removed from its primary meaning. As a rule, the further the distance between the goods or



services to which the mark is applied and the primary meaning thereof, the easier it is to acquire secondary meaning. The converse is equally true. For instance, hypothetically, if 'Apple' were a mark used by a retailer of fruit, the acquisition of secondary meaning would be a herculean task. Instead, if it were used by a retailer of groceries, the difficulty would be moderate. Taking another example from the universe of fruits, when the word 'blackberry' is used in the context of mobile phones, it brings to mind the once immensely popular mobile phone, whereas, when used in the context of fruits, jams and the like, the word connotes the fruit. Indeed, even while recognising the secondary meaning in context, one continues to be aware of the primary meaning. Thus, I conclude that it is not necessary for the primary meaning to be lost but it is necessary that the primary meaning should be overshadowed in context by the secondary meaning. Whether this has happened to the mark “Jodi365” is considered next.

20. It was held in *People Interactive* that evidence of use, turnover and advertising expenditure are insufficient to establish secondary meaning and that neutralised market surveys may be required. In principle, I agree that strong evidence is required, be it survey-based or otherwise. In



Zatarains, the Court of Appeals surveyed precedents and held that the major

inquiry in assessing a claim for secondary meaning is the consumer's attitude towards the mark, and also held that “factors such as amount and manner of advertising, volume of sales, and length and manner of use may serve as circumstantial evidence relevant to the issue of secondary meaning”. By quoting *Aloe crème Laboratories 423 F.2d at 850*, it was further held that “the question is not the extent of the promotional efforts, but their effectiveness in altering the meaning of the term to the consuming public”.

The nature of the product or service should also be borne in mind while drawing conclusions on secondary meaning. For instance, general public recall and recognition is higher for consumer staples or even consumer durables, as a class of goods, or hotels, as a class of services, because a significant proportion of the population procures such goods or avails of such services, i.e. the addressable market is wider and larger. By contrast, the segment of the population that intends to or subscribes to a website or app that provides matrimonial or dating services is narrower. As noticed earlier, the Plaintiff's mark has an alpha-numeric element and it is pertinent to recognise that the numeric sub-element 365 does not expressly refer to the days of the year and is merely suggestive that the service is provided on



every day of the year. By making allowance for the nature of the service, if one puts oneself in the shoes of a subscriber or potential subscriber of the Plaintiff's services, there is sufficient basis to conclude on the basis of the fairly long history of use of the device mark "Jodi365" especially as a top level domain name, the business turnover and the like that the composite mark has acquired distinctiveness.

21. The Plaintiff also contended that the Defendant should not be permitted to contend that "Jodi" is not distinctive because it uses the mark "Jodii" and applied for registration thereof as a trademark (Ex.P14). This argument is attractive at first blush but cannot carry the Plaintiff far because the Defendant has the statutory right to contend that the sub-element "Jodi" is not distinctive and this cannot be defeated by an argument founded on estoppel. Ultimately, the success or failure of the Plaintiff would still hinge on whether the sub-element "Jodi" in the composite mark is distinctive. If it were held to be distinctive, there is no doubt that the mark "Jodii" is deceptively similar.



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22. The Plaintiff contended that the sub-element “Jodi” therein is the essential, prominent and distinguishing feature by citing ***Pidilite Industries*** and ***Central Park Estates***. As is evident from paragraphs 12.7 and 12.8 of the PTC report, the Bombay High Court concluded in ***Pidilite Industries*** that the mark 'Marine', when used for a water-resistant adhesive, is not descriptive. Likewise, in ***Central Park Estates***, at paragraph 32 of the SCC Online Report, the Delhi High Court recorded the finding that the mark 'Central Park', when used for a real estate developer, is not descriptive. Protection was extended on that basis in both those decisions. Whether the sub-element “Jodi” has acquired distinctiveness or remains descriptive is addressed next. If one were to put the distinctiveness of “Jodi” to test, it is safe to conclude that it is highly unlikely that “Jodi” on a standalone basis would have been accepted for registration because it is inherently descriptive. After registering the composite mark, can the proprietor be permitted to claim exclusivity over the originally non-distinctive element? Yes, if such originally non-distinctive element has acquired distinctiveness and a secondary meaning but not otherwise. To answer this question as regards “Jodi”, the question to be posed is: does the term “Jodi”, when used in context, overshadow the primary meaning and bring to mind the service



provider or source, i.e. the Plaintiff? While such conclusion may be reached

as regards the composite mark, I am unable to conclude on the basis of the evidence on record that the primary meaning has been overpowered or that it has receded sufficiently to the background as regards “Jodi”. Therefore, the Plaintiff should not be permitted to achieve indirectly what it could not directly merely by relying on the essential features concept. Just as the failure to protect distinctive and essential elements of a composite mark could result in a subversion of Section 17 of the Trade Marks Act, *a fortiori*, extending protection to non-distinctive elements would render Section 17 otiose. The evidence on record discloses that several matrimonial and dating websites and apps use the term “Jodi” as an element in their trade name. In the absence of evidence of intentional and dishonest adoption, this is indirect evidence that the term remains descriptive and has not acquired secondary meaning. For reasons set out above, I conclude that the sub-element “Jodi” in the composite mark is non-distinctive, like the individual elements “Bharat” and “Matrimony” in “Bharatmatrimony” were held to be non-distinctive in ***Consim Info.***



23. Although the expression *publici juris* is not used and such a defence is not raised expressly in the written statement, the factual foundation was laid therein and the defence was raised in course of oral arguments. However, in order to constitute *publici juris*, as held in **Palani Mudaliar**, the use of the relevant mark by third parties should be so widespread that it exceeds use by the person claiming protection and relief. In view of the conclusions on distinctiveness, it has become unnecessary to record findings on the defence of *publici juris*. Issues 1-3 are disposed of as above.

Issue No.4

24. Issue No.4 deals with whether the Plaintiff is entitled to relief in respect of alleged passing off against the Defendant by the use of the mark “Jodii”. The Plaintiff relied on **Cadila** to contend that the phonetic similarity between “Jodi365” and “Jodii” cannot be jettisoned. In *Durga Dutt Sharma v. Navaratna Pharmaceuticals Laboratories*, AIR 1965 SC 980, the Supreme Court discussed the distinction between an action for infringement and passing off of a trademark. The relevant paragraph is extracted below:



“While an action for passing off is a common law remedy being in substance an action for deceit, that is, a passing off by a person of his own goods as those of another, that is not the gist of an action for infringement. The action for infringement is a statutory remedy conferred on the registered proprietor of a registered trade mark for the vindication of ‘the exclusive right to the use of the trade mark in relation to those goods’ (vide Section 21 of the Act). The use by the defendant of the trade mark of the plaintiff is not essential in an action for passing off, but is the sine qua non in the case of an action for infringement. No doubt, where the evidence in respect of passing off consists merely of the colourable use of a registered trade mark, the essential features of both the actions might coincide in the sense that what would be a colourable imitation of a trade mark in a passing-off action would also be such in an action for infringement of the same trade mark. But there the correspondence between the two ceases. In an action for infringement, the plaintiff must, no doubt, make out that the use of the defendant's mark is likely to deceive, but where the similarity between the plaintiff's and the defendant's mark is so close



either visually, phonetically or otherwise and the court reaches the conclusion that there is an imitation, no further evidence is required to establish that the plaintiff's rights are violated. Expressed in another way, 'if the essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that the get-up, packing and other writing or marks on the goods or on the packets in which he offers his goods for sale show marked differences, or indicate clearly a trade origin different from that of the registered proprietor of the mark would be immaterial; whereas in the case of passing off, the defendant may escape liability if he can show that the added matter is sufficient to distinguish his goods from those of the plaintiff.'

25. Therefore, a comparison of the two marks and trade dress becomes essential for passing off purposes. The two marks are set out below:



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Plaintiff's device mark	Defendant's label mark
	

Similarly, the trade dress from the respective mobile application is set out below:

Plaintiff's mobile app	Defendant's mobile app
	

If such comparison is carried out, other than the term “Jodi”, which has been held to be non-distinctive and, therefore, not entitled to protection, the overall impression is such that an inference of likelihood of deception or



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confusion cannot be drawn. Therefore, Issue No.4 is also decided against the Plaintiff.

Issue No.5

26. Since the claim for infringement and passing off failed, the Plaintiff is not entitled to damages. Before concluding, I must confess that the “big fish is swallowing the small fish” argument did tug at the heart strings, but eventually the mind prevailed.

27. In the result, the suit is dismissed subject to the observations on the acquired distinctiveness of the composite mark. Since the Plaintiff is the prior user of the mark, the registered proprietor thereof and it was held that the Plaintiff is entitled to protect the composite mark but not the element “Jodi”, the parties shall bear their respective costs. Consequently, all connected applications are closed.

14.07.2022

Index : Yes
Internet : Yes



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Plaintiff's witness: Nil

Defendant's witness: Nil

Documents exhibited by the Plaintiff:

Sl.No	Exhibits	Date	Particulars of Documents
1.	Ex.P1	2009	Plaintiff's domain name Jodi365.com order receipt and WHOIS printout, showing date of purchase and registration and documented 2009 version of Jodi365.com
2.	Ex.P2	26.05.2010	Trademark Registration details of the Plaintiff for Jodi365 under No.1971072 in Class 99
3.	Ex.P3	26.05.2020	Trademark Registration Renewal details of the Plaintiff for Jodi365 under No.1971072 in Class 99
4.	Ex.P4	2011-2021	Web analytics chart showing number of visitors to the Plaintiff's website Jodi365.com
5.	Ex.P5	2013- 2020	Statement of Annual Sales Turnover certified by the Chartered Accountant for the Plaintiff's company.
6.	Ex.P6	2019-2021	Details of promotional expenses incurred by Plaintiff's company on a single advertising channel
7.	Ex.P7	2020-2021	Google Play Store listing of Plaintiff's mobile app Jodi365
8.	Ex.P8	2014-2021	Relevant sample clippings of press and media coverage of Plaintiff's company.
9.	Ex.P9	Oct, 2021	Press report on Defendant's launch of Jodii



Sl.No	Exhibits	Date	Particulars of Documents
			mobile application.
10.	Ex.P10	January to Dec, 2021	Documents showing the Defendant's targeted advertisement using the Plaintiff's trademark Jodi365 on YouTube and the Google Play Store.
11.	Ex.P11	Jan, 2021	Prominent print ads of the Plaintiff's and the Defendant's competing services on the same page in multiple editions of a leading newspaper.
12.	Ex.P12	02.11.2021	Cease and desist notice sent from the Plaintiff to the Defendant with acknowledgment.
13.	Ex.P13	17.11.2021	Defendant's reply to the notice from the Plaintiff.
14.	Ex.P14	Nov, 2021	Defendant's use of Jodii in Television commercials.

Documents exhibited by the Defendant:

Sl.No	Exhibits	Date	Particulars of Documents
1.	Ex.D1	02.02.2005	Certified copy of the legal use certificate for trademark BHARATMATRIMONY under No.1335999 in class 16
2.	Ex.D2	12.04.2007	Certified copy of the legal use certificate for Trademark BHARATMATRIMONY under No.1548863 in classes 35 & 42.
3.	Ex.D3	03.05.2018	Board Resolution of the Defendant Company
4.	Ex.D4	-	Printout of Jodi365 from Google Play Store also showing number of downloads.
5.	Ex.D5	-	Printout of Jodii from Google Play Store
6.	Ex.D6	-	Printout of the website Jodii.com
7.	Ex.D7	20.10.2021	Article published in Times of India newspaper regarding Jodii by the Defendant.



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Sl.No	Exhibits	Date	Particulars of Documents
8.	Ex.D8	20.12.2021	Screen shot of website using the name JODI by other matrimonial service providers.
9.	Ex.D9	-	List of Apps using the name JODI by matrimonial service providers.
10.	Ex.D10	20.12.2021	Trademark Search conducted in Trademarks Registry website for the mark JODI in classes 35,38 & 41 and 45.
11.	Ex.D11	04.01.2022	Website extracts of Google website showing English meaning for the word "jodi" from the Google translate.
12.	Ex.D12	06.01.2022	Chartered Accountant Certificate proving expenses towards promoting the mark Jodii by the Defendant.
13.	Ex.D13	25.01.2022	Letter of Authority
14.	Ex.D14	-	Screen shot of the pages of the apps using JODI

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SENTHILKUMAR RAMAMOORTHY, J.

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Pre-Delivery Judgment

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