

IN THE HIGH COURT OF JUDICATURE AT MADRAS

RESERVED ON : 23-07-2026

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DATE OF DECISION : 11-08-2026

CORAM

**THE HONOURABLE MR JUSTICE P. VELMURUGAN
AND
THE HONOURABLE MRS.JUSTICE K. GOVINDARAJAN
THILAKAVADI**

**OSA(CAD) No.159 of 2022
and
CMP Nos. 20676, 20680 of 2022 & 19720 of 2024**

M/s FreeElective Network Private Limited
2, Thomos Nagar, 2nd Floor
Little Mount, Saidapet, Chennai 600 015
rep by its Director S.Anil Kumar

Appellant

Vs

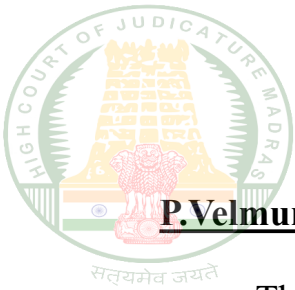
M/s.Matrimony.com Limited
No 94, TVH Belicia Towers, Tower 2
10th Floor, MRC Nagar, Mandaveli
Chennai 600 028

Respondent

Memorandum of Grounds of Original Side Appeal under Section 13 of the Commercial Courts Act, 2005 against the judgment and decree dated 14th July 2022 passed in C.S.(Comm.Div.)No.122 of 2021.

For Appellant: Mr.R.Sathish Kumar

For Respondent: Mr.P.S.Raman
Senior Counsel for
Mr.Arun C.Mohan



JUDGMENT

P.Velmurugan J.

This original side appeal invoking commercial appellate jurisdiction, is directed against the judgment and decree dated 14.07.2022 passed by the learned single Judge in Civil Suit (Com.Div.)No.122 of 2021, in and by which the suit filed by the appellant/plaintiff came to be dismissed.

2. The appellant, being the Plaintiff, filed the suit under Order VII, Rule 1 of the Civil Procedure Code and Order IV, Rule 1 of the Original Side Rules r/w Sections 27, 28, 29, 134, & 135 of the Trademarks Act, 1999 praying for the following reliefs:-

(a) 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 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,



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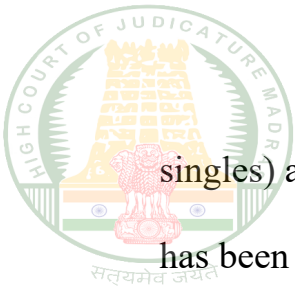


displaying, printing, advertising their services with a trademark Jodii or any other trademark identical or deceptively similar with that of the Plaintiff's Jodi365 or in any other manner whatsoever;

(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.

2. The appellant states that they are the registered proprietor of the trademark 'Jodi365' under No.1971072 in Class 99 as a single multi-class application for Classes 35, 38 and 41. The appellant's trademark 'Jodi365' is depicted as a device 'Jodi365', wherein the word 'Jodi' is the distinguishing, prominent and essential feature. Since 2009, they have been using 'Jodi365' honestly, openly and continuously and several people, numbering in excess of 3,25,000, have visited Jodi365.com from 2011 to date. The said trademark has also acquired substantial reputation and goodwill in the market. Their services through their website Jodi365.com-and complementary mobile application, Jodi365-are available across regions and countries. Since 1st December 2019, the advertising spend on one channel alone (Facebook) has been to the tune of almost USD Forty Thousand or Rupees Thirty Lakhs (with the 'Jodi365' brand verifiably noticed about 2.9 crore times by about 55 lakh targeted, eligible



singles) and documents proving the same were filed. Their website-Jodi365.com has been used and is in demand from several quarters. The website is also found to be one of the innovative start-ups and has featured in several leading magazines, newspapers, and websites. While things stood thus, in or about 20th October 2021, the respondent launched a mobile app, Jodii. The adoption of 'Jodii' by the respondent for their mobile app for matchmaking services could not have been without the knowledge of the appellant's website Jodi365.com and related mobile app, Jodi365. In fact, the respondent had placed paid online advertisements targeting the appellant's registered trademark and even in print media, the advertisements have appeared side by side. Immediately after appropriate enquiries and verifications, the appellant issued a cease-and-desist notice dated 2nd November, 2021 to the respondent stating that they are the registered proprietor of the trademark 'Jodi365' and that they have a website-Jodi365.com and also the mobile app-Jodi365 and that they have acquired substantial reputation and goodwill in the market for matchmaking and that the respondent's use of Jodii-mobile app for identical services would cause tremendous confusion and deception in the market, and called upon the respondent to stop using the trademark 'Jodii'. The said letter was received by the respondent and vide a reply dated 17th November 2021, the respondent refused to comply with the demands of the notice. In the aforesaid reply, the respondent states that they are the registered proprietors of 'bharatmatrimony'



and allied marks and that since the appellant's registration is for 'Jodi365' label, there is no right over the individual words therein. Further, according to the respondent, 'Jodii' is an arbitrary and original term, which is distinctive and that 'Jodii' is used under the world-famous house mark BharatMatrimony/Matrimony.com and that the appellant cannot monopolize the single dictionary word, 'Jodi'. On the basis that both the appellant and the respondent are engaged in the provision of substantially similar services and that the appellant is the prior user of the registered trade mark 'Jodi365', the suit came to be filed.

3. The respondent, refuting the above allegations, filed a written statement stating 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 respondent, the mobile app-Jodii was launched in October 2021 under the respondent's house mark 'BHARATMATRIMONY' with its application in Tamil and that the word 'Jodi' directly refers to the nature and purpose of services offered. According to the respondent, the appellant 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 appellant is not entitled to a monopoly over the word 'Jodi' or any variant thereof. The respondent asserted that the device marks of the appellant and the respondent



are not even remotely similar. The respondent 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 respondent has included a table containing relevant particulars in paragraph 15 of the written statement. Similarly, at paragraph 16 of the written statement, the respondent has provided details of several websites which use the word 'Jodi'. On this basis the respondent sought for dismissal of the suit.

4. The parties did not lead any oral evidence but marked the documents by consent in the suit. The appellant marked Ex.P1 to Ex.P13 and the respondent marked Ex.D1 to Ex.D14.

5. Upon consideration of the pleadings and documents, the following issues were framed:-

- 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?

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6. The learned Judge, after considering the oral arguments advanced by both sides, answering all the issues against the plaintiff, has dismissed the suit by the judgment and decree dated 14.07.2022. Challenging the same, the appellant/plaintiff is before this Court.

7. The learned counsel appearing on behalf of the appellant/plaintiff, reiterating the grounds raised in the appeal, would submit that when the principles of trademark law mandate that the trademarks ought to be compared as a whole and cannot be split, the learned Judge has committed a fundamental error of splitting the trademark 'Jodi365' and has held that 'Jodi' has not acquired distinctiveness. In other words, the learned Judge has accepted the case of the respondent to infringe a label mark by using a part of the same and to claim it is not an infringement, as it would fall within Section 17 of the Trade Marks Act, which is not the purport of the Act and can render all label marks useless. In this case, Section 17 does not have any application, since the respondent not only failed to challenge the registration of the appellant, but also applied for the phonetically identical mark 'Jodii' for registration. It has been held that the term 'Jodi' is descriptive without appreciating that there is no



direct reference to the services offered by the appellant. Even the respondent admits that there are at least two different definitions for the term ‘Jodi’ as ‘couple’ resembling the Tamil word ‘ஜோடி’, which in English translates to ‘match’. In fact, there is even a third meaning ‘pair’, which is the most relevant meaning for the said Tamil word. Clearly the word ‘Jodi’ has multiple meanings and would not necessarily invoke the reference of ‘matchmaking’ alone, as the term ‘Jodi’ for matrimonial services is only suggestive and has inherent distinctiveness and is hence inherently protectable. The impugned judgment has adopted an incorrect standard for ascertaining acquired distinctiveness by referring to examples of ‘Apple’ and ‘blackberry’ without considering that both the said trademarks are inherently distinctive with respect to computers or mobile phones, as the said marks are arbitrary choices, even as per the judgment in *Abercombie & Fitch V Hunting World Incorporated*. It has also been held that the trademark ‘Jodi365’ has in fact acquired distinctiveness, without considering that the mark cannot be split and the appellant cannot prove that only a part of the trademark has acquired distinctiveness. The impugned judgment has erred in formulating a test that the success or failure of the appellant would hinge on whether the sub-element ‘Jodi’ is distinctive or not is incorrect, as a trademark use is always composite and the distinctiveness of any sub-element cannot be separately proved and such a course is not even mandated under Section 17 of the Act. The impugned judgment has erred in holding that there are other

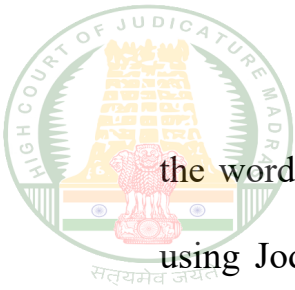


matrimonial and dating websites and apps using the term Jodi and held that the same is also indirect evidence that the term is descriptive and has not acquired secondary meaning for the reason that acquiring secondary meaning over a mark, though not necessary in the facts of the present case, is purely based on the evidence of the person claiming the same. Moreover, a trademark's having acquired secondary meaning cannot be defeated by its use by other parties. The reliance upon the case of **Consim Info** which was essentially regarding use of keywords in Google Ads (previously known as Google AdWords) is incorrect, since the present dispute is regarding domain names. The impugned judgment has erroneously decided the issue of passing off, which is an independent right of the appellant over and above the statutory right of infringement of trademark, by ignoring the unassailable and admitted fact that the appellant is the prior user of the trademark 'Jodi365' and has merely compared the two marks visually, without seeing that phonetical similarity cannot be ignored even when the visual appearance of the marks are different as per the binding precedent in the case of **Cadilla**. Even the defence of common to trade or publici juris is not available to the respondent, as the evidence on record is insufficient to establish either of the same.

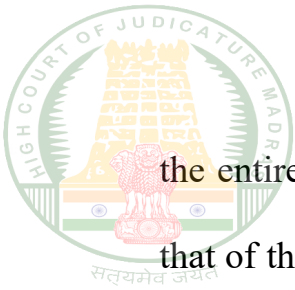
8. The learned counsel for appellant, by filing written submissions, would contend that a civil Court dealing with infringement or passing off cannot go



into the validity of the trademark involved and the same can be done only in a rectification proceeding. In the instant case, the respondent has not only failed to challenge, but has also stated that even if they challenge they may fail as 'Jodi365' is a composite mark and that their defence is only under Section 17 of the Trade Marks Act, 1999. The learned counsel relied upon the judgment of the Hon'ble Supreme Court in the case of *Patel Field Marshal Agencies & another v. P.M.Diesels Limited & others*, (2018) 2 SCC 112 and also the judgment of the Bombay High Court in the case of *Pidilite Industries v. Jubilant Agri & Consumer Products Limited*, 2014 (57) PTC 617 in support of his contentions. The learned counsel would emphatically contend that there is nothing in the scheme of the Trade Marks Act, 1999 to show that a rectification is not necessary at all in case a defence is taken under Section 17 of the Act. On the contrary, Section 30 lays down the defences of the Act, which includes objection under Section 9 of the Act. Both of these are necessary to be raised only in a rectification proceeding and any decision on the trademark or its effect can be taken only in a rectification proceeding. In other words, the learned counsel contended that even a defence under Section 17 ought to be raised only in a rectification proceeding. As held by the Hon'ble Supreme Court in *Patel Field Marshal case*, the respondent, who has not filed the rectification against the appellant's trademark, is deemed to have abandoned such right. So far as the defence taken by the respondent that the mark is used by others and therefore

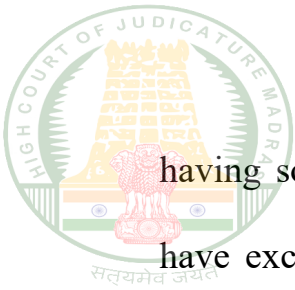


the word 'Jodi' is common to trade or *publici juris*, as the other websites are using Jodi as a part of their domain names is concerned, the learned counsel contended that there is nothing on record to show the volume, extent and reputation of business by these websites and thus the finding of common to trade is not based on qualitative evidence. In this context, the learned counsel relied upon the Division Bench judgment of this Court in the case of *P.M.Palani Mudaliar & Co. etc. v. M/s Jansons Exports & another*, 2017 SCC OnLine Mad 1090 quoting the book 'Law of Trade Marks and Trade Names' (13th Edn.) by Kerley that the proper test whether an exclusive right has become *publici juris* is whether the use of the trade mark by other persons has ceased to deceive the public as to the maker of the article and that piracy, which exceeds in volume the genuine goods may fail to destroy the reputation of a mark, if it remains surreptitious, so that the ultimate consumer never appreciates the true position. He also relied upon the judgment of the Hon'ble Supreme Court in the case of *National Bell C v. Metal Goods Mfg Co.*, (1970) 3 SCC 665 for the proposition that there was no evidence to show that the use by others of the word 'Fifty' or the numeral '50' was substantial and the plea that there was common use of the trademarks must fail and therefore, it is impossible to sustain the contention founded. Further, Ex.D14 which are screen shots of apps using Jodi as part thereof, even shows another person using Jodii itself from 2019, but has only 50 users. Therefore, this evidence would be against the respondent/defendant, as



the entire series of mobile apps therein show very negligible user compared to that of the appellant or the respondent. Hence, on evidence, the plea of *common to trade* raised by the respondent ought to fail and therefore the impugned judgment holding against the appellant is legally unsustainable.

9. The learned counsel further contended that the present appeal against passing off is on the ground that the impugned judgment had considered the visual impression of the labels used in services and concluded that there is no passing off. This is incorrect in the light of the binding precedent in *Cadilla Healthcare v. Cadilla Pharmaceuticals*, AIR 2001 SC 1952. Further, the mere visual comparison of the marks without advertent to the phonetical similarity of 'Jodi365' and 'Jodii' is untenable, in the light of the ratio laid down in *Cadilla's* case, paragraphs 18 to 20. Therefore, the finding on the relief of passing off is clearly untenable and is liable to be set aside. The learned counsel also relied upon Ex.P10 to show that the respondent has used targeted advertisements using 'Jodi365' as a keyword in YouTube and Google Play store. This shows that the respondent was aware of the use of 'Jodi365' as a trademark by the appellant/plaintiff and had prior knowledge about them and thus the adoption of 'Jodii' itself is dishonest. Further the respondent has filed trademark applications for Jodii itself both as a label and as a word. The same is opposed by the appellant and pending before the Trademark Registry. The respondent,

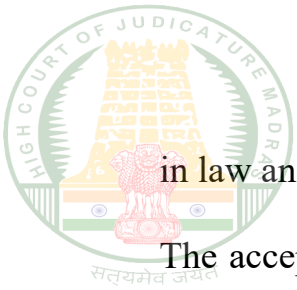


having sought for a registration before the Trademark office stating that they have exclusive right over the trademark 'Jodii', cannot take a contrary stand before this Court that the trademark is descriptive. In this context, the learned counsel relied upon the judgment of the Delhi High Court in the case of *Automatic Electric Limited v. R.K.Dhawan and another*, 1999 SCC OnLine Del 27. The learned counsel finally contended that when the services offered by the appellant and the respondent are essentially matrimonial sites and both cater to the same customers who are desirous of matrimonial relationships, it could be seen that the customers who are desirous of availing the services of the appellant are likely to be confused and enrol with the respondent's website thinking that they are associated with each other in view of the deceptively similar trademarks. In this regard, the learned counsel submitted that C.M.P.No.19720 of 2024 has been filed by the appellant to place on record the document shown in the schedule as additional evidence. Therefore, the learned counsel sought for allowing the appeal by setting aside the impugned judgment.

10. The learned Senior Counsel appearing on behalf of the respondent/defendant, by filing written submissions, would contend that the impugned judgment requires no interference, as the learned Judge has clearly held that while the composite mark 'Jodi365' had acquired distinctiveness, the constituent element 'Jodi' remained descriptive and non-distinctive, and



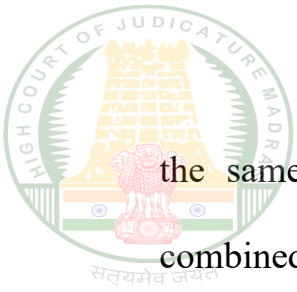
therefore the appellant could not claim exclusive rights over the word 'Jodi' under Section 17 of the Trade Marks Act, 1999. It has also been held that the respondent's use of the mark 'Jodii' did not constitute infringement or passing off and dismissed the suit in its entirety. The learned Senior Counsel also took us through the findings of the learned single Judge holding that the word 'Jodi' is descriptive and the term 'Jodi' is extensively used by third parties viz., several matrimonial and dating websites and although the composite mark 'Jodi365' may have acquired distinctiveness through long use, the sub-element 'Jodi' had not acquired secondary meaning and is not distinctive. The learned Senior Counsel also pointed out that the learned Judge has rejected the appellant's plea of estoppel as against the respondent, holding that the respondent 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 and concluded that the sub-element 'Jodi' is non-distinctive, like the individual elements 'Bharat' and 'Matrimony' relying upon *Consim Info case*. The impugned judgment recognised that the defence of *publici juris* was available on the facts of the case, but held that no finding thereon was necessary in view of the conclusion that 'Jodi' is non-distinctive. The learned Senior Counsel highlighted that the appellant's claim is expressly barred under Section 17 of the Trade Marks Act 1999, as the appellant has filed only a registration certificate of its composite mark 'Jodi365' with accompanying artwork, which is admittedly inadmissible



in law and has omitted to file the legal user certificate as is statutorily mandated.

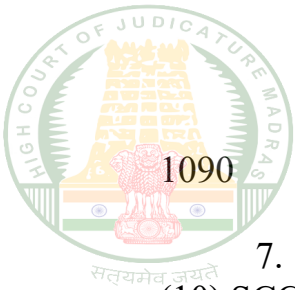
The accepted position is that the appellant has never even applied for the word

‘Jodi’ per se and has only the limited benefit of a composite registration, the particulars of which in any event cannot be discerned from a mere registration certificate. The impugned judgment expressly held that extending protection to the non-distinctive element ‘Jodi’ would render Section 17 otiose, since the statutory provision limits exclusivity to the registered composite mark and not to its non-distinctive components. Even the differences between the appellant’s and respondent’s marks and the services provided therein, did not give rise to any likelihood of deception or confusion amongst the customers, as the respondent has always been advertising and using ‘Jodii’ under their housemark BHARATMATRIMONY/MATRIMONY.COM/Tamil Matrimony. The learned Senior Counsel also brought to our notice that the services offered by the respondent are limited to matrimony i.e., to find a life partner and are priced at a nominal rate catering to the working classes in Indian/vernacular languages, when compared to the services offered by the appellant explicitly curated to an elite audience priced at a higher range which includes providing opportunities such as dating. Therefore, the chances of any manner of confusion between the services of the parties herein is impossible, as they cater to completely different segments and no evidence as to the manner of confusion has been provided by the appellant to even provide a basis for this Court to come to a conclusion on



the same. In view of the quality of services provided by the respondent combined with the reputation of their house mark and nominal rate at which the services are being offered, the number of downloads for the respondent's app on Google play store is significantly higher (1,00,000 + downloads) when compared to the number of downloads of the appellant (50,000 + downloads) as shown in Ex.D6. So far as the petition filed by the appellant for receipt of additional evidence is concerned, the learned Senior Counsel would submit that the alleged documents are dated post the filing of the suit and created for the purposes of this appeal, which cannot be permitted to be brought on record, as the appellant is trying to raise a new point in the appeal stage, when they had failed to prove the point of confusion at the first instance in the suit. The learned Senior Counsel also relied upon the following judgments in support of his contentions and sought for dismissal of the appeal:-

1. Ultratech Cement Ltd v. Dalmia Cement (Bharat) Ltd., 2016 (67) PTC 314
2. SNR Dhall Mill v. Kaleesuwari Refinery Pvt.Ltd., 2021 SCC OnLine Mad 1675
3. People Interactive (India) Pvt.Ltd., v. Vivek Pahwa & others, MANU/MH/1661/2016
4. Consim Info Pvt.Ltd. v. Google India Pvt.Ltd., 2012 (5) LW 1
5. Matrimony.com Ltd v. Kalyan Jewellers India Ltd., & others, MANU/TN/2685/2020
6. P.M.Palani Mudaliar & Co v. Jansons Exports, 2017 SCC OnLine Mad



7. Khoday Distilleries Ltd v. Scotch Whisky Association & others, 2008 (10) SCC 723

8. Judgment in OSA No.263 of 2020 dated 21.04.2026 (Hatsum Agro Product Ltd., v. M/s Patanjali Biscuits Pvt.Ltd & another)

9. Judgment in C.S.(Com.Div.)No.119 of 2023 dated 21.01.2025 (PhonePe Pvt.Ltd v. BundlePe Innovations Pvt.Ltd & others)

11. We have considered the rival submissions and also perused the materials available on record.

12. The specific case of the appellant is that they are the registered proprietor of the trademark 'Jodi365' under No.1971072 in Class 99 as a single multi-class application for Classes 35, 38 and 41 and the said trademark is depicted as a device 'Jodi365', wherein the word 'Jodi' is the distinguishing, prominent and essential feature. The appellant has been continuously using 'Jodi365' from the year 2009 and several people, numbering in excess of 3,25,000, have visited Jodi365.com till date. The said trademark has also acquired substantial reputation and goodwill in the market and their services through their website Jodi365.com and complementary mobile application Jodi365, are available across regions and countries and that the website Jodi365.com has been used and is in demand from several quarters. Their website is also found to be one of the innovative start-ups and has featured in



several leading magazines, newspapers, and websites. However, in or about 20th

October 2021, the respondent launched a mobile app-Jodii and the adoption of

‘Jodii’ by the respondent for their mobile app for matchmaking services could

not have been made without the knowledge of the appellant's website

Jodi365.com and related mobile app, Jodi365. Since the respondent had in fact

placed paid online advertisements targeting the appellant’s registered trademark

and even in print media, the advertisements have appeared side by side, the

appellant issued a cease-and-desist notice dated 2nd November, 2021 to the

respondent stating that they are the registered proprietor of the trademark

‘Jodi365’ and that they have a website-Jodi365.com and also the mobile app-

Jodi365 and have acquired substantial reputation and goodwill in the market for

matchmaking and that the respondent's use of Jodii-mobile app for identical

services would cause tremendous confusion and deception in the market, and

called upon the respondent to stop using the mark ‘Jodii’. Having found the

respondent continuing their business with the mark Jodii, the appellant,

asserting that the appellant is the prior user of the registered trade mark

‘Jodi365’, filed the suit seeking to restrain the respondent from in any manner

infringing the appellant’s registered trademark ‘Jodi365’ and other registered

trademarks by using a deceptively similar trademark ‘Jodii’ or any other

trademark deceptively similar to the appellant’s registered trademark; to

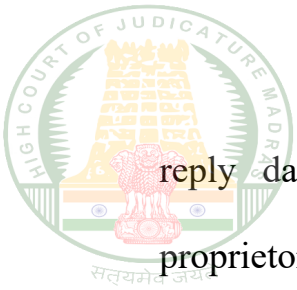
restrain the respondent from passing off the appellant’s services by using,



offering for sale, displaying, printing, advertising their services or any other trademark identical or deceptively similar with that of the appellant's trademark

‘Jodi365’; to order the respondent to surrender to appellant 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 appellant's trademark Jodi365 as well as to pay damages to the tune of Rs.1,00,00,000/- together with costs.

13. The case of the respondent is that they are the registered proprietor of the mark ‘BHARATMATRIMONY’ and other allied marks, which have been used from the year 1999 and according to the respondent, the mobile app-Jodii was launched in October 2021 under the respondent's house mark ‘BHARATMATRIMONY’ with its application in Tamil and that the word ‘Jodi’ directly refers to the nature and purpose of services offered. Since the appellant has a registration in respect of the device mark ‘Jodi365’ and not in respect of the word ‘Jodi’, by virtue of such registration, the appellant is not entitled to a monopoly over the word ‘Jodi’ or any variant thereof. The respondent also claimed that the device marks of the appellant and the respondent are not even remotely similar and that several other entities/websites use the word ‘Jodi’ as part of applications in relation to matchmaking or dating services. Even on receipt of the cease-and-desist notice from the appellant, the respondent vide a



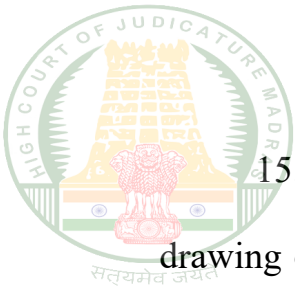
reply dated 17th November, 2021, asserted that they are the registered proprietors of 'bharatmatrimony' and allied marks and since the appellant's registration is for 'Jodi365' label, there is no right over the individual words therein and according to the respondent, 'Jodii' is an arbitrary and original term, which is distinctive and when 'Jodii' is used under the world famous house mark 'BharatMatrimony/Matrimony.com', the appellant cannot monopolise the single dictionary word, 'Jodi' and hence not entitled to any of the reliefs sought for in the suit.

14. Admittedly, in this case, both the appellant and the respondent, being engaged in the business of matchmaking, dating and matrimonial services, have not let in oral evidence and have only marked the documentary evidence in support of their claims. It is seen from the materials produced before this Court that the appellant is the registered proprietor of the trademark 'Jodi365' under No.1971072 in Class 99 as a single multi-class application for classes 35, 38 and 41 and the appellant's trademark is depicted as a device 'Jodi365', wherein the word 'Jodi' is the distinguishing, prominent and essential feature. The appellant has been continuously using the registered trademark from the year 2009 and several people, numbering in excess of 3,25,000, have visited their website Jodi365.com till date, thereby acquiring substantial reputation and goodwill in the market. While so, in or about 20th October 2021, the respondent

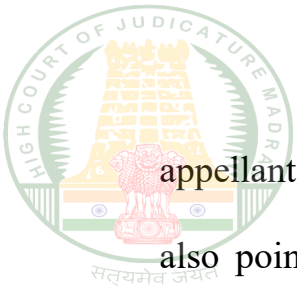


launched the mobile app-Jodii under the respondent's house mark 'BHARATMATRIMONY' with its application in Tamil and had placed paid

online advertisements in print media to appear side by side targeting the appellant's registered trademark. Immediately the appellant, being the prior user of the registered trademark 'Jodi365', issued a cease-and-desist notice dated 2nd November 2021 to the respondent to stop using the mark 'Jodii', for which the respondent replied that it is the registered proprietor of 'bharatmatrimony' and other allied marks and since the appellant's registration is for 'Jodi365' label, the appellant cannot monopolise the word 'Jodi', which is distinctive to their advantage, as the device marks of the appellant and the respondent are not even remotely similar and that several other entities/websites use the word 'Jodi' in relation to matchmaking, dating and matrimonial services. Therefore, the appellant asserts that the label mark of the respondent 'Jodii' is deceptively similar to that of the appellant's registered trademark 'Jodi365' and the customers who are desirous of availing the services of the appellant are likely to be confused and enrol with the respondent's website thinking that they are associated with each other in view of the deceptively similar mark. The attempt on the part of the respondent is nothing but to infringe on the appellant's trademark so as to pass off its services as that of the appellant and gain undue advantage by utilising the goodwill and reputation earned by the appellant in the market.



15. In support of the claim of infringement made by the respondent, drawing our attention to the principles of trademark law, it was contended that the trademarks ought to be compared as a whole and cannot be split to come to the conclusion that the term 'Jodi' is descriptive, when the word 'Jodi' has multiple meanings and would not necessarily invoke the reference of 'matchmaking' alone, as the term 'Jodi' for matrimonial services is only suggestive and has inherent distinctiveness and is hence inherently protectable. The trademark use is always composite and the distinctiveness of any sub-element cannot be separately proved and such a course is not even mandated under Section 17 of the Trade Marks Act, 1999. Further the respondent has used targeted advertisements using 'Jodi365' as a keyword in YouTube and Google Play store with prior knowledge about the use of Jodi365 as a trademark by the appellant and thus the adoption of 'Jodii' itself is dishonest. The respondent even filed trademark applications for Jodii itself both as a label and as a word, which has been opposed by the appellant and the same is pending before the Trade Marks Registry. On the issue of passing off, it was contended that it is an independent right of the appellant over and above the statutory right of infringement of trademark, but the issue has been erroneously answered against the appellant by comparing the two marks visually, without taking note of the phonetical similarity as well the binding precedent of the Hon'ble Supreme Court in *Cadilla Healthcare*, by ignoring the vital fact that the



appellant is the prior user of the trademark 'Jodi365' from the year 2009. It was also pointed out that the defence of common to trade or *publici juris* is not available to the respondent, as the evidence on record is insufficient to establish either of the same.

16. We find force in the contentions made by the learned counsel for the appellant. It is not in dispute that the appellant's trademark 'Jodi365' is depicted as a device 'Jodi365', wherein the word 'Jodi' is the distinguishing, prominent and essential feature and has been used continuously from the year 2009, which has acquired substantial reputation and goodwill in the market across regions and countries, with the advertising spend on one channel alone (Facebook) to the tune of almost USD Forty Thousand or INR Thirty Lakhs. While so, the launching of the respondent's mobileapp-Jodii for identical matrimonial services like that of the appellant in the year 2021, in our considered opinion, would definitely cause confusion in the minds of the customers at large, as the mark is deceptively similar to the appellant's mark and more so, the appellant being the prior user. As rightly contended by the appellant's counsel, when the respondent has filed the trademark applications for Jodii itself both as a label and as a word claiming exclusive right over the mark 'Jodii', for which the appellant has filed opposition and the matter is pending before the Trademarks Registry, the respondent cannot take a contrary stand before this Court that the



mark is descriptive and state that their defence is only under Section 17 of the Trade Marks Act, 1999, which ought to be raised only in a rectification proceeding. In this regard, useful reference can be made to the judgment of the Hon'ble Supreme Court in the case of *Patel Field Marshall v. P.M.Diesels*, (2018) 2 SCC 112, wherein the Hon'ble Supreme Court has observed as follows:-

“31. Rather, from the résumé of the provisions of the 1958 Act made above, it becomes clear that all questions with regard to the validity of a trade mark is required to be decided by the Registrar or the High Court under the 1958 Act or by the Registrar or the IPAB under the 1999 Act and not by the civil court. The civil court, in fact, is not empowered by the Act to decide the said question. Furthermore, the Act mandates that the decisions rendered by the prescribed statutory authority [Registrar/High Court (now IPAB)] will bind the civil court. At the same time, the Act (both old and new) goes on to provide a different procedure to govern the exercise of the same jurisdiction in two different situations. In a case where the issue of invalidity is raised or arises independent of a suit, the prescribed statutory authority will be the sole authority to deal with the matter. However, in a situation where a suit is pending (whether instituted before or after the filing of a rectification application) the exercise of jurisdiction by the prescribed statutory authority is contingent on a finding of the civil court as regards the prima facie tenability of the plea of invalidity.

34. The intention of the legislature is clear. All issues



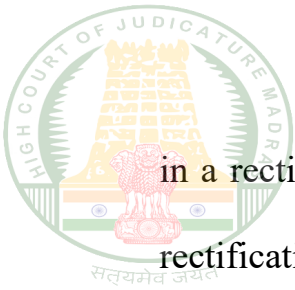
relating to and connected with the validity of registration has to be dealt with by the Tribunal and not by the civil court...

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35. The legislature while providing consequences for non-compliance with timelines for doing of any act must be understood to have intended such consequences to be mandatory in nature, thereby, also affecting the substantive rights of the parties. This is how Section 111(3) of the 1958 Act has to be understood. That apart, it is very much within the legislative domain to create legal fictions by incorporating a deeming clause and the court will have to understand such statutory fictions as bringing about a real state of affairs between the parties and ushering in legal consequences affecting the parties unless, of course, there is any other contrary provision in the statute. None exists in the 1958 Act to understand the provisions of Section 111(3) in any other manner except that the right to raise the issue of invalidity is lost forever if the requisite action to move the High Court/IPAB (now) is not initiated within the statutorily prescribed time-frame.

36. Thus, by virtue of the operation of the 1958 Act, the plea of rectification, upon abandonment, must be understood to have ceased to exist or survive between the parties inter se. Any other view would be to permit a party to collaterally raise the issue of rectification at any stage notwithstanding that a final decree may have been passed by the civil court in the meantime...

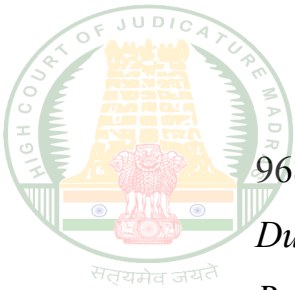
The above ratio makes it clear that any ground of challenge can be raised only



in a rectification and not in a civil suit. Once the respondent has not filed the rectification against the appellant's trademark, is deemed to have abandoned such right.

17. So far as the ground raised by the appellant on the issue of passing off is concerned, it is seen that the impugned judgment had considered the visual impression of the labels used in services and concluded that there is no passing off. However, considering the facts and circumstances of the case, we find that the mere visual comparison of the marks without adverting to the phonetical similarity of 'Jodi365' and 'Jodii' is untenable, in the light of the ratio laid down by the Hon'ble Supreme Court in the case of *Cadila Health Care Ltd v. Cadila Pharmaceuticals Ltd*, AIR 2001 SC 1952, wherein the Hon'ble Supreme Court has held as follows:-

“18. We are unable to agree with the aforesaid observations in *Dychem case* [(2000) 5 SCC 573]. As far as this Court is concerned, the decisions in the last four decades have clearly laid down that what has to be seen in the case of a passing-off action is the similarity between the competing marks and to determine whether there is likelihood of deception or causing confusion. This is evident from the decisions of this Court in the cases of *National Sewing Thread Co. Ltd. case* [(1953) 1 SCC 794 : AIR 1953 SC 357], *Corn Products Refining Co. case* [AIR 1960 SC 142 : (1960) 1 SCR



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968], *Amritdhara Pharmacy case* [AIR 1963 SC 449], *Durga Dutt Sharma case* [AIR 1965 SC 980] and *Hoffmann-La Roche & Co. Ltd. case* [(1969) 2 SCC 716]. Having come to the conclusion, in our opinion incorrectly, that the difference in essential features is relevant, this Court in *Dyechem case* [(2000) 5 SCC 573] sought to examine the difference in the two marks “PIKNIK” and “PICNIC”. It applied three tests, they being: (1) is there any special aspect of the common feature which has been copied? (2) mode in which the parts are put together differently i.e. whether dissimilarity of the part or parts is enough to make the whole thing dissimilar, and (3) whether, when there are common elements, should one not pay more regard to the parts which are not common, while at the same time not disregarding the common parts? In examining the marks, keeping the aforesaid three tests in mind, it came to the conclusion, seeing the manner in which the two words were written and the peculiarity of the script and concluded that “the above three dissimilarities have to be given *more* importance than the phonetic similarity or the similarity in the use of the word PICNIC for PIKNIK”.

19. With respect, we are unable to agree that the principle of phonetic similarity has to be jettisoned when the manner in which the competing words are written is different and the conclusion so arrived at is clearly contrary to the binding precedent of this Court in *Amritdhara case* [AIR 1963 SC 449] where the phonetic similarity was applied by judging the two competing marks. Similarly, in *Durga Dutt Sharma case* [AIR 1965 SC 980] it was observed that “in an action for



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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 plaintiffs 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.”

20. Lastly, in *Dychem case* [(2000) 5 SCC 573] it was observed in para 54 as under: (SCC p. 600)

“54. As to scope of a buyer being deceived, in a passing-off action, the following principles have to be borne in mind. Lord Romer, L.J. has said in *Payton & Co. v. Snelling, Lampard & Co.* [(1900) 17 RPC 48 : 16 TLR 56 (CA)] that it is a misconception to refer to the confusion that can be created upon an ignorant customer. The kind of customer that the courts ought to think of in these cases is the customer who knows the distinguishing characteristics of the plaintiff's goods, those characteristics which distinguish his goods from other goods in the market so far as relates to general characteristics. If he does not know that, he is not a customer whose views can properly be regarded by the Court. (See the cases quoted in *National Sewing Thread & Co. Ltd. v. James Chadwick & Bros. Ltd.* [AIR 1948



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Mad 481 : (1948) 1 MLJ 303] which was a passing-off action.) In *Schweppes case* [*Schweppes Ltd. v. Gibbens*, (1905) 22 RPC 601 (HL)] Lord Halsbury said, if a person is so careless that he does not look and does not treat the label fairly but takes the bottle without sufficient consideration and without reading what is written very plainly indeed up the face of the label, you cannot say he is deceived.”

These observations appear to us to be contrary to the decision of this Court in *Amritdhara case* [AIR 1963 SC 449] where it was observed that the products will be purchased by both villagers and townsfolk, literate as well as illiterate and the question has to be approached from the point of view of a man of average intelligence and imperfect recollection. A trade may relate to goods largely sold to illiterate or badly educated persons. The purchaser in India cannot be equated with a purchaser of goods in England. While we agree that in trade mark matters, it is necessary to go into the question of comparable strength, the decision on merits in *Dyechem case* [(2000) 5 SCC 573] does not, in our opinion, lay down correct law and we hold accordingly.”

18. In the light of the above ratio, we find in the case on hand that there is a deceptive similarity between the appellant’s mark and the respondent’s mark and agree with the contention of the appellant’s counsel that the customers who



are desirous of availing the services of the appellant are likely to be confused and enrol with the respondent's website thinking that they are associated with each other. In this regard, the appellant has also filed C.M.P.No.19720 of 2024 to place on record the document shown in the petition schedule viz., communications and transcripts/recordings of 11 sample communications between plaintiff and consumers confusing Jodi365 of the appellant/plaintiff and Jodii of the respondent/defendant, as additional evidence. Hence, accepting the reasons stated in the affidavit, C.M.P.No.19720 of 2024 is allowed and the document shown in the petition schedule is taken on record and marked as Ex.P15 on the side of the appellant/plaintiff.

19. One of the defences taken by the respondent is that there is no deceptive similarity in the mark of the appellant and the mark of the respondent, as the other websites are using Jodi as a part of their domain names and therefore the word 'Jodi' is common to trade or *publici juris* by relying upon Ex.D8 series. Though the learned single Judge did not record findings on the defence of *publici juris* in view of his conclusions on distinctiveness, as rightly contended by the learned counsel for the appellant, nothing is on record to show the volume, extent and reputation of business by the so-called websites and therefore, the respondent cannot raise the said defence orally in the absence of letting in qualitative evidence to prove the same. At this juncture, in order to



constitute *publici juris*, the observation of Kerley in his book “Law of Trade Marks and Trade Names” (13th Edn.), as referred to by the Division Bench of this Court in the case of *P.M.Palani Mudaliar & Co. etc. v. M/s Jansons Exports etc. & another*, 2017 SCC OnLine Mad 1090, is extracted hereunder:-

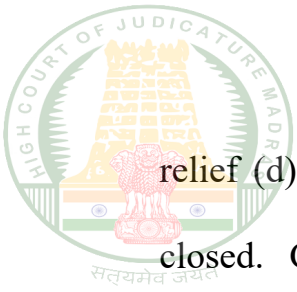
“20. Kerley in his book "Law of Trade Marks and Trade Names" (13th Edn.) states that names, which once carried a distinctive reference to a particular trader may, in consequence of successful piracies, or of their use by the trader himself for goods which are the goods of others, or are put forward as such, or for other reasons, lose it and fall into common use and become *publici juris*, in the same way as trade marks may be lost or abandoned. The proper test whether an exclusive right has become *publici juris* is whether the use of the trade mark by other persons has ceased to deceive the public as to the maker of the article and that piracy, which exceeds in volume the genuine goods may fail to destroy the reputation of a mark, if it remains surreptitious, so that the ultimate consumer never appreciates the true position.”

20. In the upshot, from the documentary evidence placed by the parties, we find that the appellant is the prior user of the registered trademark ‘Jodi365’ and depicted as a device, wherein the word ‘Jodi’ is the distinguishing, prominent and essential feature and running the business from the year 2009 by acquiring substantial reputation and goodwill in the market for matchmaking



services. Since the trademark use is always composite and the distinctiveness of any sub-element cannot be separately proved and such a course is not even mandated under Section 17 of the Trade Marks Act, the launching of the mobileapp-Jodii in the year 2021 by the respondent for similar matrimonial services as that of the appellant, after having filed the trademark applications for Jodii itself both as a label and as a word, which has been opposed by the appellant and pending before the Trade Marks Registry, in our considered opinion, would create a confusion amongst the customers, as the mark of the respondent is deceptively similar to that of the appellant.

21. In the light of the above discussions and conclusions, rejecting the contentions made by the learned Senior Counsel for the respondent and finding the judgments cited on the side of the respondent to be not applicable to the facts of the present case, the appellant is entitled to succeed in the appeal. Accordingly, while setting aside the impugned judgment and decree, the appeal stands allowed and the suit is decreed in respect of the reliefs (a) to (c) as prayed for by the appellant/plaintiff. So far as the relief of damages of Rs.1,00,00,000/- is concerned, since no oral evidence has been let in by the appellant to prove the extent of damages suffered by the appellant and only documentary evidence has been adduced by both parties, this Court is not inclined to award damages and hence, the appeal stands dismissed so far as



relief (d) is concerned. Consequently, CMP Nos.20676 & 20680 of 2022 are closed. Considering the facts and circumstances of the case, there shall be no order as to costs.

(P.VELMURUGAN J.) (K.GOVINDARAJAN THILAKAVADI J.)
11-08-2026

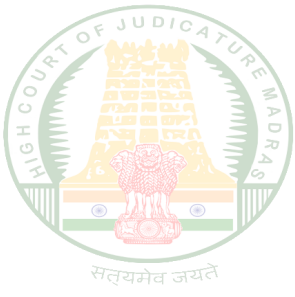
Additional Document exhibited by the Appellant/Plaintiff:

Sl.No.	Exhibit	Date	Particulars of Document
1	Ex.P15	02.12.2021 and 03.07.2024	Communications and transcripts/ recordings of 11 sample communications between Plaintiff and consumers confusing Jodi365 of the Appellant/Plaintiff and Jodii of the Respondent/Defendant

(P.VELMURUGAN J.) (K.GOVINDARAJAN THILAKAVADI J.)
11-08-2026

Index: Yes/No
Speaking/Non-speaking order
Internet: Yes
Neutral Citation: Yes/No

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OSA(CAD) No. 159 of 2022



**P.VELMURUGAN J.
AND
K.GOVINDARAJAN
THILAKAVADI J.**

SS

**Judgment in OSA(CAD)
No. 159 of 2022**

11-08-2026