

**(2016) 09 BOM CK 0089**

**BOMBAY HIGH COURT**

**Case No:** Notice of Motion No. 1687 of 2015 In Suit No. 846 of 2015.

People Interactive (India) Private  
Limited a Company incorporated  
and registered under the  
Companies Act, 1956 having its  
registered office at 205,  
Shiv-e-Numh, Dr. Annie Besant  
Road, Worli, Mumbai Highway,  
Vile Parle (East), Mumbai 400 018  
- Plaintiff @H

APPELLANT

Vs

RESPONDENT

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**Date of Decision:** Sept. 14, 2016

**Acts Referred:**

- Trade Marks Act, 1999 - Section 29

**Citation:** (2016) 6 AIRBomR 275 : (2017) 1 MIPR 161 : (2016) 68 PTC 509 : (2016) 68 PTC 225  
: (2017) 3 RAJ 587

**Hon'ble Judges:** G.S. Patel, J.

**Bench:** Single Bench

**Advocate:** Mr. V.R. Dhond, Senior Advocate, a/w Mr. Rashmin Khandekar, a/w Mr. Hemant Thadani and Mr. Anshul Saurashtri i/b Krishna and Saurashtri, Advocates, for the Plaintiff; Dr. V.V. Tulzapurkar, Senior Advocate a/w Mr. Ashish Kamat and Mr. Srivardhan Deshpande

**Final Decision:** Disposed Off

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### **Judgement**

**G.S. Patel, J.** - The Plaintiff seeks to restrain Defendant Nos. 1 to 4 (collectively, "the contesting Defendants") from using the domain name secondshaadi.com in any manner, including as part of the domain name for their web-based matrimonial services. The Plaintiff also seeks to restrain the contesting Defendants from "passing off" their website as that of the Plaintiff. The final relief sought is to restrain

Defendant No. 5, a webhost and a domain name registrar, from hosting the contesting Defendants' website, and to direct it to de-register or terminate the contesting Defendants' domain name registration.

2. When the suit was first filed, there was a complaint that the contesting Defendants had used articles and material from the Plaintiff's website. This has been resolved since. Both sides accept this.

3. The Plaintiff belongs to the People Group of Companies. It owns several well-known websites, brands and trade marks. Among these are the marks Shaadi.com and Shadi.com. The 1st Defendant is registrant of the domain name www.secondshaadi.com. Defendant Nos. 1, 3 and 4 are Directors of the 2nd Defendant. The website is operated through the 2nd Defendant.

4. In 1996, one Siddharth Mehta, the Plaintiff's predecessor-in-title adopted the mark Shaadi.com in relation to online matrimonial services. The Plaintiff acquired Mehta's rights in the mark and the domain name under an Assignment Deed dated 9th October 2001. From that time, the Plaintiff has used the mark and domain name to provide online matrimonial and matchmaking services. The device and label mark SHAADI.COM(1) and the word mark SHADI.COM(2) were registered in 2004 in Class 42. The Plaintiff's other word marks SHAADI.COM(3) and SHADI.COM(4) (not used by the Plaintiff) were subsequently registered in 2009 in Class 45. The registration certificates of all these marks claim user since 1996. Apart from its online services, the Plaintiff has bricks-and-mortar establishments for similar services offered in person. It also has registrations for the marks Shaadi.com Centre(5) Shaadi Times(6) Shaadi Point(7) Shaadi Mobile(8) and Shaadi TV(9). Shaadi Times carries a disclaimer of non-exclusivity over the word Shaadi.

1. Plaintiff, Exhibit "E2", p. 91

2. Plaintiff, Exhibit "E4", p. 95

3. Plaintiff, Exhibit "E1", p. 90

4. Plaintiff, Exhibit "E3", p. 94

5. Plaintiff, Exhibit "E5", p. 97

6. Plaintiff, Exhibit "E6", p. 100

7. Plaintiff, Exhibit "E7", p. 102

8. Plaintiff, Exhibit "E8", p. 104

9. Plaintiff, Exhibit "E9", p. 106

5. Exhibit "C" to the Plaintiff lists the Plaintiff's annual worldwide sales and promotional expenses under the mark Shaadi.com since 2000(10). These are substantial. Its gross revenue increased from approximately Rs. 32 Lakhs in

2000♦2001 to about Rs. 141 crores in 2014♦2015. Promotional expenses for 2014♦2015 stood at Rs. 45 crores. Some promotional material is on record(11). The Plaintiff claims it has 20 million registered users for its various services, and that since January 2007, its primary website [www.shaadi.com](http://www.shaadi.com) has had 12.4 billion recorded visitors. The Plaintiff has won many awards. Therefore, the Plaintiff claims that its services under this mark and domain name have acquired substantial goodwill and repute.

10. Plaintiff, p. 58.

11. Plaintiff, Exhibit "B" p. 54; Plaintiff, Exhibit "D", p.59.

6. The contesting Defendants launched their website at the domain name [www.SecondShaadi.com](http://www.SecondShaadi.com) on 25th January 2006. This website caters to those seeking to marry again; hence the name. The contesting Defendants' website has a very different market position from that of the Plaintiff. It caters to a much more select group, not quite as large as the Plaintiff's. The contesting Defendants have used the mark [secondshaadi.com](http://secondshaadi.com) for almost eight years. They say they have gained much popularity within their segment. They also claim to have spent much money on advertising and promotion. They market and promote their platform on social media too.

7. The Plaintiff says that in July 2007 it came across the 1st Defendant's [www.secondshadi.com](http://www.secondshadi.com). On 27th July 2007, the Plaintiff sent the 1st Defendant a cease-and-desist notice(12). The 1st Defendant declined to comply(13). It was only on 28th September 2013, i.e., a good six years after the 1st Defendant's reply to the Plaintiff's cease-and-desist notice, that the Plaintiff sent it another demand(14). This is of some consequence since a defence of acquiescence is raised. The 2nd Defendant replied on 15th October 2013, refuting the Plaintiff's claim, and, inter alia, specifically contending that the words "shaadi" and "shadi" are generic(15). The defences in the correspondence are also the defences to the present Motion.

12. Plaintiff, Exhibit "H", pp. 132-137

13. Plaintiff, Exhibit "H", pp. 138-142

14. Plaintiff, Exhibit "J", pp. 143-145

15. Plaintiff, Exhibit "K", pp. 146-150

8. Mr. Khandekar for the Plaintiff says that it is now settled law that a domain name has all the characteristics of a trade mark. The Defendants' domain name is deceptively similar to the Plaintiff's registered marks [Shaadi.com](http://Shaadi.com) and [Shadi.com](http://Shadi.com). He says the whole of the Plaintiff's mark is subsumed in that of the contesting Defendants. The Plaintiff's mark, he says, has now gained a "secondary meaning".

9. In fairness, Mr. Khandekar concedes that the mark [Shaadi.com](http://Shaadi.com) (in any of its various iterations) is not inherently distinctive: "shaadi" is a transliteration of the

Hindi word for marriage. Considered in a vacuum, he says, it is purely descriptive of the services in question. This does not, he submits, by itself preclude the Plaintiff from claiming a monopoly over the mark, since it is well-settled that even a descriptive mark can attain distinctiveness, and is, therefore, capable of being used as a trade mark. For this, he relies on the judgments in **T.V. Venugopal v. Ushodaya Enterprises Ltd, (2011) 4 SCC 85; Godfrey Philips India Ltd. v. Girnar Food and Beverages Pvt. Ltd., (2004) 5 SCC 257; ITC Ltd. v. Nestle India Ltd, MIPR 2015 (2) 40. Indchemie Health Specialities Pvt. Ltd. v. Intas Pharmaceuticals Ltd., 2015 (63) PTC 391 (Bom); Hi-Tech Pipes Ltd. v. Asian Mills Pvt Ltd., (2006) 126 DLT 353 and Info Edge (India) Pvt Ltd. v. Shailesh Gupta, ILR (2002) 1 Delhi 2** Mr. Khandekar submits that the Plaintiff's mark, by reason of extensive and continuous use, has achieved the necessary distinctiveness. It is, he says, a "household name" , and has achieved a "secondary meaning". According to Mr. Khandekar, the word "shaadi" is the "essential feature" of the Plaintiff's mark, and when used in relation to matrimonial services is associated with the Plaintiff's website alone. This is evidenced by the substantial promotional expenses and revenue generated. There are also the numerous awards and accolades received by the Plaintiff for the services provided under the mark, and reviews carried in leading magazines, newspapers and on web-portals. All of this, Mr. Khandekar says, shows that the Plaintiff's mark is ubiquitous and well-known. Therefore , he submits, Defendant No. 1's adoption of the domain name [www.secondshadi.com](http://www.secondshadi.com) is not bona fide, but merely an attempt to ride the wave of the Plaintiff's success. There is every chance that the general public would confuse the contesting Defendants' mark with the Plaintiff's. There have, in fact, been instances, he says, where the Plaintiff has received inquiries and complaints from the contesting Defendants' customers regarding services rendered under the mark [Second Shaadi.com](http://SecondShaadi.com) (22). He claims that the contesting Defendants use meta-tags to drive traffic to them from the Plaintiff's site (23). A Google search of the Plaintiff's mark also lists that of the contesting Defendants; and this only makes confusion more imminent (24).

22. *Plaint, Exhibit "L"*, pp. 151-187

23. *Plaint, Exhibit "N"*. p.189-194

24. *Plaint, Exhibit "M"*. p. 188.

10. I find it difficult to accept this formulation, and must agree with Dr. Tulzapurkar for the Defendants, when he says that the word "shaadi" is generic and commonly descriptive. That word lends itself to no meaning other than its ordinary lexical one. "Shaadi" (and synonyms such as "vivah") mean matrimony or wedding. The word, as Dr. Tulzapurkar says, is generic. He points out that there are any number of entities that use the word to provide similar services: he has a list of 29 websites that all use "shaadi" in their domain name, and 10 companies that also prefix "shaadi" to their names (25). Whether or not this list is accurate is largely irrelevant, for "[shaadi.com](http://shaadi.com)" is a non-unique combination of words that clearly indicates the function and

purpose of the website.

25. Written Statement, pp. 261-262.

11. There are two issues here: first, the matter of acquisition of a "secondary meaning"; and, second, whether a domain name always assumes the features of a trade mark. As to the first, in *Indchemie* - a decision that does not, in my view, support Mr. Khandekar at all - Gupte J referenced **Miller Brewing Company v. G. Heileman Brewing Company Inc., 561 F.2d 75** and noted the "spectrum" of degrees of distinctiveness: (1) generic or commonly descriptive; (2) merely descriptive; (3) suggestive; (4) arbitrary or fanciful. Generic or commonly descriptive words - examples such as "necktie", "plastic", "soda", "perfect", "best", "No.1" come to mind - are used to name or describe the goods in question. These can never become trade marks on their own. They never acquire distinctiveness or a secondary meaning. They do not tell one man's goods from another's. They do not indicate origin. An expression in the second category, a merely descriptive term, is often used to describe some particular characteristic or ingredient: "airtight", perhaps. Ordinarily, even these are not registrable unless they have acquired a secondary meaning and refer exclusively to one particular trader's goods. In the third category we have suggestive words. These only hint at a feature or a specialty. The consumer must, in his mind, make the necessary link between the word and the goods. This class of expression requires no proof of acquisition of a secondary meaning to proceed to registration; it may, however, be hedged with a disclaimer regarding the manner of use. A wholly arbitrary or fanciful word is always registrable, and it always separates or distinguishes one person's goods from another's.

12. As a general rule, it seems to me that the principle is of obviousness. The degree of distinctiveness, and, therefore, the possibility of registration as a trade mark, is inversely proportional to the degree of obviousness: the more obvious the word, the less the degree of distinctiveness and the chances of its registration. I use the word "obvious" here to mean not "evident" but commonplace.

13. Words in everyday language, words of the common tongue are not to be allowed to be monopolized. Expressions that find themselves at the lower end of this four-position fretboard cannot easily be shifted higher up the scale. To make that ascent, it will not do to misspell the word. That, it is settled, is of no aid to the applicant. *Indchemie* discusses this aspect of the law (27).

(27). I do not think it is necessary to consider the other aspect that arose in *Indchemie*, viz., the question of the breadth or narrowness of the statutory use of the word "similarity". It is enough, I think, to note that Gupte J held, and I am Not only bound by his view but also agree whole-heartedly with it, that the statutory expression is not so elastic as to always allow trade mark protection granted to a narrowly defined class to be broadened to goods demonstrably distinct in character,

quality and purpose. This rubber-band approach of stretching statutory rights to include, willy-nilly, all circumstances without heed to particularity of registration is without basis in trade mark jurisprudence.

14. In my view, in *Indchemie Gupte J* did not advocate an overly rigid demarcation between these four classes. The law in the US might be different from the English common law and from our own adoption (and adaptation of it), and from our statutory provisions as well. In an outlying case, it may yet be possible for a mark to move from a lower class to a higher class of distinctiveness. The four-fold classification is a broad one; it is by no means the intellectual property or trade mark equivalent of an ancient, immutable and highly stratified caste system of any kind, where a mark is doomed to remain forever in the category in which it, on adoption, falls.

15. That takes us directly 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 (28). 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. That is the claim.

(28). **Nestle India Ltd. v. Mood Hospitality Pvt Ltd, (2010) 42 PTC 914 (Del).**

16. How is the acquisition of a secondary meaning to be shown or established? Does commercial success, even a high degree of success, always result in the acquisition of a "secondary meaning"? I do not believe this can be so. There is no presumption of secondary meaning acquisition. That needs proof; and the proof must be of uninterrupted use of considerable longevity without a competitor attempting to use it (29). When a person uses a common phrase, he runs the risk that others might also use the same expression or another very like it. In **British Vacuum Cleaner Company Limited v. New Vacuum Cleaner Company Limited, 1907 (2) Ch. D. 312, 328.** on which Dr. Tulzapurkar relies, Parker J held that there is a distinction between ordinary descriptive words and a "fancy word", one that does not primarily relate to the article, but perhaps to the person manufacturing it. There can be no restraint against the use of general words. The decision in **Office Cleaning Services Ltd. v. Westminster Window and General Cleaners Ltd, (1946) 63 R.P.C. 39, 43** too,

supports Dr. Tulzapurkar's contention. The expression in dispute was "office cleaning". The appellants claimed the expression was identified with their business to such an extent that any other traders who wished to use the expression as part of their trade name would have to differentiate it. Simons J held that where a trader adopts words in common use for his trade name, some risk of confusion is inevitable. But that risk must be run, or else the first user would be allowed to unfairly monopolise the words. In matters of this nature, courts accept even the smallest differences sufficient to avert confusion.

**(29). Marico Ltd. v. Agro Tech Foods Ltd, 2010 (44) PTC 736 (Del).**

17. As to this question of risk of similar use by others, the material on record is, in my view, against the Plaintiff. Annexed to the Affidavit in Reply is a very long list of rival or competing marks, at various stages. All use the word shaadi in some form or the other. Many are opposed by the Plaintiff. Several use the name of a community before the word shaadi (agarwalshaadi, konkanishaadi, patelshaadi and so on)(32). I do not think Mr. Khandekar's response is of much use; he says that the Plaintiff has obtained domain name registrations for a very large number of variants. This is hardly evidence of exclusivity. In fact, it points to the contrary, viz., that others have, and continue to, use the word shaadi almost at will. The Affidavit in Rejoinder does not further matters when it says that many of these users have been issued cease-and-desist notices by the Plaintiff (33). The fact is that there are many ventures, including online ones, that use the word "shaadi" as part of their corporate or trading name or as their domain names. Paragraph 12 of the Affidavit in Rejoinder tabulates companies that use the word "shaadi" in their names (34). I do not think it is at all possible for a claimant to say that there are no competitors or rival users because the claimant has moved against or restricted virtually every rival user. The test in such cases must be whether rivals have attempted to use the same commonly descriptive or generic (class 1) expression. If it is shown that they have, then the claims to exclusivity and to a secondary meaning must both fail. This is axiomatic: these rival uses show non-exclusivity, and establish that there are indeed many who use the word. This is precisely the risk the law says an adopter of a generic or commonly descriptive expression must expect to suffer. The test of exclusivity, an essential ingredient of the claim based on a "secondary meaning" can hardly be said to be satisfied.

32. Notice of Motion paper book, Exhibit "D-6", pp. 372-404

33. Notice of Motion paper book, pp. 411-414

34. Notice of Motion paper book, pp. 415-416

18. Exclusivity claims based on secondary meaning acquisition must be established by cogent material. References to sales and promotional expenses may be used to establish the acquisition of reputation and goodwill, i.e., to show the popularity of a mark. Mere use and statements of sales and expenses do not, of their own,

establish the acquisition of a secondary meaning (35). That proof is always required of goods or services in the second category, "merely descriptive" expressions; for these are not ordinarily registrable without such proof. That proof must be directed to establishing that the "merely descriptive" expression in question is now firmly established in the public imagination with the claimant and its goods and services. High sales and expenses will not do; the claimant must show from carefully neutralised market surveys, etc., that this is indeed how the public perceives the mark - not as a mere description, but a pointed reference to the origin, viz., the claimant. Use itself does not establish distinctiveness. The extent to which a mark has lost its primary meaning and the extent to which it has acquired a secondary one are conclusions to be drawn from evidence (36). That evidence, showing the displacement of the primary meaning by the secondary meaning, must be of the members of the public as well, not merely those specially placed to attest to its uniqueness (37).

(35). **In Stokely Van Camp, Inc & Anr v. Heinz India Pvt Ltd, 2010 (44) PTC 381 (Del)** Rajiv Shakhder J held: "There is no evidence in the form of consumer survey or otherwise which would at least prima facie have me believe that the registered mark ♦Rehydrate Replenish Refuel♦ has achieved trade mark significance in as much as the use of the expression brings to mind the trade origin of the product. Mere use of the mark alone does not necessarily translate in the mark obtaining ♦secondary distinctive meaning♦." The appeal failed: **Stokely Van Camp, Inc & Anr v Heinz India Pvt Ltd, MIPR 2010 (3) 273.**

(36). Kerly on Trade Marks, 14th Ed., Sweet and Maxwell, 2005♦2007

(37). Narayanan on Trade Marks, 6th Ed., pp. 272♦275, 10.21-10.24.

19. I will pause here for a moment to consider what it is precisely over which this claim of exclusivity is made. Is it "shaadi" or is it 35. In **Stokely Van Camp, Inc and Anr v. Heinz India Pvt Ltd, 2010 (44) PTC 381 (Del)**. Rajiv Shakhder J held: "There is no evidence in the form of consumer survey or otherwise which would at least prima facie have me believe that the registered mark "Rehydrate Replenish Refuel" has achieved trade mark significance in as much as the use of the expression brings to mind the trade origin of the product. Mere use of the mark alone does not necessarily translate in the mark obtaining "secondary distinctive meaning"." The appeal failed: "shaadi.com" (as in, shaadi dot com)" If it is the first, the claim fails entirely on the Indchemie/Miller Brewing four-part formulation, for the word falls firmly in the first category. To the end, I was unclear where exactly Mr. Khandekar placed his claim. The Plaintiff makes an express claim over the word "shaadi", saying not only is this part of the marks registered for real-world bricks-and-mortar services (such as "Shaadi Centre"), but that "shaadi" is the "essential and prominent" feature of the Plaintiff's marks (38). The claim in the plaintiff is, thus, for exclusivity over "shaadi". But this falls within the first Indchemie/Miller Brewing class of generic or commonly descriptive words. This is the lowest end of the



distinctiveness spectrum; and, absent other proof, it is entirely immobilized, incapable of moving anywhere further up that scale. Shaadi is nothing but generic: it refers to marriage, not bicycles, pressure cookers or potato chips. I think it is wholly incorrect to take a generic or commonly descriptive expression as part of a mark, and then, by this process of deconstruction, lift the generic expression out of the mark, claim that it is "prominent" or "essential" or "leading", and then lay claim to an exclusivity it could never have had if used on its own. This seems to me to be a roundabout way of trying to achieve that which is impossible to begin with. I am unable to accept Mr. Dhond's submission in a late rejoinder, when I placed the matter for further arguments, that the word "shaadi" in relation to the Plaintiff's business, is inherently unique and not commonplace. That seems to me to be a wholesale abandonment of the manner in which the Plaintiff is laid. Mr. Dhond correctly says there is no claim over the "dot-com" part of it taken separately; but he insists that the use of the word "shaadi" uniquely connotes the Plaintiff, and always has done, in relation to online matrimonial services. What the Plaintiff provides is a matchmaking service. They are not wedding planners. The word "shaadi" is, therefore, in his submission distinctive. That, however, is not the basis on which his plaintiff proceeds. If Mr. Dhond is correct, no question would arise of the Plaintiff's mark needing to acquire "secondary significance"; it had the necessary distinctiveness to begin with.

(38). Plaintiff: paragraph 39, pp. 32-33; paragraph 19, pp. 17-18; paragraph 20, p. 18; paragraph 21, p. 21.

20. Given this, I will take it that the claim is over "shaadi.com", taken as a whole. Undoubtedly this is registered. Let us, however, consider what it is the Plaintiff does when it applies for and secures such a registration. It takes a commonly descriptive or generic word and tacks on a technically necessary suffix to it: .com. Every domain name needs some Top Level Domain ("TLD") suffix such as .com, .net, .org, .in, .gov and so on. Without one of these, the website and its related services do not function. These are, therefore, also entirely generic. They have no distinctiveness at all. No one can claim exclusivity in any TLD or any domain suffix of any level (such as .gov.in or .net.in), nor does the Plaintiff claim it. The result, possibly, is that if we follow Mr. Khandekar and Mr. Dhond down this path of deconstruction, then we are left with nothing that is on its own registrable and it then might well be perfectly legitimate to contend that neither shaadi nor dot-com are ever registrable. Therefore, what remains is the combination taken as a whole, and it is over this that the Plaintiff claims dominion: shaadi.com. But this surely begs the question; if both constituent integers are entirely commonplace, and one must look only to the mark or domain name as a whole, then the slightest differentiation must also surely be sufficient.

21. The real difficulty is that shaadi.com is an address. It is the Internet equivalent of a physical or terrestrial address. It directs a user to a particular part of the Web

where a domain name registrant stores and displays his information, and offers his services. A physical mailing address can never be a "trade mark" , properly so-called. "10 Downing Street" or "1600 Pennsylvania Avenue" are not trade marks. A web address is, technically, a mnemonic, an easy-to-recall replacement for a complex string of numbers that represent the actual Internet Protocol address (or addresses) where the website in question is to be found. It is impossible to remember something like <http://115.112.2.29> (39). Mr. Dhond's argument is that having adopted the "shaadi.com" as a domain name, a trade mark and a corporate name, the Plaintiff is entitled to the fullest of protection.

(39). That, as it happens, is the IP address of [shaadi.com](http://shaadi.com), the website

22. Every domain name that incorporates a trade mark enjoys the same protection as the mark, neither more nor less. In other words, use as a domain name does not diminish a trade mark. The proposition, often attributed to **Yahoo Inc v. Akash Arora and Anr., 1999 (19) PTC 201 (Del)** that a domain name is never "merely" an address, seems to me to be incorrect. It is primarily an address; but it may also enjoy protection as a mark. Every domain name, no matter how non-distinctive or. That, as it happens, is the IP address of [shaadi.com](http://shaadi.com), the website. how descriptive, is not per se entitled to trade mark-level protection. A domain name that uses, say, "Xerox" or "Kodak" , enjoys the full protection afforded to both expressions qua trade marks, simply because these are fanciful words capable of the highest level of trade mark distinctiveness. These domain names are not mere Internet addresses for finding a string of numbers. Their use in domain names does not alter or erode their trade mark status. The reverse, however, is untrue: it is incorrect to suppose that every domain name, because it is a domain name, automatically receives the full blown protection of a mark. If courts allow monopolies of this nature, then we should expect, and sooner rather than later, exclusivity claims over words like "grocery" , "secretary" , "investment" and so on because some persons have set up domain names using those words: "[grocery.com](http://grocery.com)" , "[secretary.com](http://secretary.com)" and "[investment.com](http://investment.com)". This is inconceivable, and it is not the law. Where a person uses a suitably distinctive trade mark, and has protection of it, his use of a domain name that has the same trade mark carries with it the same degree of protection. The fundamental requirement of distinctiveness remains true for both. An example, as an illustration, might suffice: using [wildebeest.com](http://wildebeest.com) for job hunting, for instance; there, the use of the expression is sufficiently distinctive.

23. In **Info Edge (India) Pvt. Ltd. and Anr. v. Shailesh Gupta and Anr., 98 (2002) DLT 499 : (2002) ILR 1 Delhi 220** a learned single Judge of the Delhi High Court had before him a case where the plaintiff had the mark and domain name [naukri.com](http://naukri.com) in relation to employment placements and job hunting. The defendant seems to have used a domain name [naukari.com](http://naukari.com) and diverted traffic to his website [jobsourceindia.com](http://jobsourceindia.com). (42). There again, the argument of "secondary significance" was made and, on the material before the Court, seems to have been accepted.

That, however, was a clear-cut case of an attempted hijacking of the plaintiff's business. The defendant did contend that the expression naukri.com was generic, incapable of protection, that evidence was required and that there was no evidence of bad faith. Info Edge referenced the decision in **Marks and Spencer v. One-in-a-Million, 1998 FSR 265** but that again is distinguishable, because the offending mark used the plaintiffs' distinctive mark, first adopted for off-line use, and already a bricks-and-mortar mark, Marks and Spencer for the well-known and highly reputed chain (44). Info Edge is also not an authority for the proposition that every single domain name, by virtue of it being that and nothing else, and no matter how utterly descriptive and non-distinctive, automatically qualifies for protection as a trade mark. To accept that would be to elevate domain names to a position far higher than trade marks. The same tests apply to both. In any case, Info Edge clearly says that the view was a prima facie and tentative view.

42. There seems to be some confusion in the Manupatra report on the precise domain name that the defendant used

44. Other decisions cited in Info Edge do not carry us further. **Rediff Communications Ltd. v. Cyberbooth and Anr., (2000 PTC 209)** was a case where the competing domain names were rediff.com and radiff.com.

24. There is the additional factor glossed over in the more generalised (and incorrect) assertion that all domain names are trade marks that domain names are not owned; they are more in the nature of a rental. Like trade marks, they require periodic renewal or continued registration. This was noticed recently by a learned single Judge of this Court (A.K. Menon, J) in **Raymond Limited v. Raymond Pharmaceutical Pvt. Ltd. 2007 (35) PTC 334 (Bom)**.

63. Once registered a domain name constitutes an address in cyberspace where the registrant's website can be reached. Thus the coordinates and the location of a domain in cyberspace will be governed by the internet local authority and a domain can easily be identified by such coordinates. The domain name is an address which is not a permanent one. Once registered the registration lasts for a specific duration of time and subject to payment of registration fees for the specified duration if on or before the specified duration the domain name registration is extended the domain name will remain alive and accessible during such renewed period. If, however, renewal is not effected the domain and the website will not be accessible in cyberspace. Registration of trade-marks and domain names are not permanent. Trademarks registration can also be cancelled if improperly obtained or the failure to use a trade-mark may also result in its cancellation. However, failure to use a domain name will not necessarily result in its cancellation. The failure to renew the registration of a domain name will result in loss of the domain name.

(Emphasis added)

This actually presents a conundrum for the Plaintiff before me; for, should that domain registration lapse or be cancelled for any reason, nothing at all will remain of the trade mark itself, since the mark is nothing but the domain name.

25. In paragraphs 76 and 77 of Raymond Ltd. (46), Menon J said:

46. Paragraph numbers are from the Manupatra report

76. In India in absence of legislation expressly dealing with dispute relating to domain name leads such disputes to be taken up for adjudication in the Court including by way of action of passing off. The Statement of Objects and reasons of the Trade Mark Act, 1999 does not reveal any intention to widen the scope of amended Act so as to specifically cover the protection of trade-marks in domain names. The aforesaid mentioned standards of the UDRP will be useful as a guide for the appropriate tests to be applied. In my prima facie view, the use of the impugned domain name in the present set of facts is neither such as to take unfair advantage nor is it detrimental to the distinctive character of the plaintiff's registered Mark. Section 29(4) requires criteria all three sub-clauses to be satisfied unlike Section 29(8) referred to by Mr. Khandekar. Although trade-marks may be used as domain name(s) unless an impugned domain name is identical to a registered mark or the two are so alike so as to cause initial interest confusion to a man of ordinary intelligence, the domain name need not result in infringement of the mark or passing off.

Every domain name cannot therefore form subject of trade-mark protection. I may add a word of caution here by clarifying that to reach a conclusion on this aspect the facts of a case are material.

77. On analysis of the judicial pronouncements that have been pressed into service on behalf of the Plaintiffs it would require the Plaintiffs to establish that the defendant's use of the mark should be demonstrably not in accordance with honest practise in commercial matters and take unfair advantage or detrimental to the Plaintiffs' mark. In the context of the allegations of passing off the registration of the impugned domain name and use of Email-id must have resulted in misrepresentation in the course of trade to customer of the defendants and/or the plaintiffs, Apart from being calculated to injure it must also cause actual damage to the Plaintiffs. In the present case, I find no such evidence to indict the defendants. It is the Plaintiffs stated case and as argued before me that the Plaintiffs' mark is infringed by virtue of Section 29(4). Although I do not find merit in Mr. Khandekar's submission that the plaintiff's mark lacks distinctive character, I am of the prima facie view that the domain name has not been adopted without due cause or to take unfair advantage or cause any detriment to the distinctive character or repute of the Plaintiffs mark "Raymond" especially in the light of fact that the Plaintiffs case under Section 29(5) has been negated at the interim stage. Absence of sales figures of the defendants is not so critical in the present facts.

26. At this stage, the material before me is insufficient to support, prima facie, Mr. Dhond's argument that "people associate shaadi.com with my website". They may, and many possibly do. I just do not know if that is because shaadi.com is the Plaintiff's website address, or because they link "marriage" or shaadi exclusively with the Plaintiff or its services. That argument is also a mite self-defeating. If shaadi-dot-com is a destination for Indians seeking matrimony, then, by the same token, secondshaadi-dot-com must be the destination for those seeking to repeat the experience.

27. Mr. Kamath carries this further. If this be so, he says, then shaadi.com as a word or an expression is incapable of registration. Its constituent integers are both entirely generic. Their combination is a mere address. None may pillage or use that address, but that is because the domain name is registered to the Plaintiff, not because it is a trade mark. That registration is, he submits, vulnerable. He invites a finding to this effect. I notice that the certificate notes that a rectification application has been filed (47). I am not required to consider whether this registration as a word mark is liable to cancellation within the narrow exceptions in paragraph 59 of the Full Bench decision in **Lupin Ltd. v. Johnson and Johnson, 2015 (1) Mh.L.J. 501.** and I will, therefore, leave it at that. Certainly, though, this does not seem to me a case where an injunction should be granted. That would lead to highly inequitable results.

(47). Plaint, Exhibit "E1", p. 90

28. There is, of course, an additional complication to the Plaintiff's secondary-meaning argument. When Mr. Khandekar says shaadi.com has acquired a "secondary meaning", he must say what precisely was the primary meaning now said to be lost. That is not explained. It cannot be explained. The reason is plain and direct. That primary and only meaning was nothing more than a destination on the Internet. It was never first a trade mark later used to signpost an Internet destination, which is a very different thing and is true of other marks such as, say, kodak.com, nikon.com, polaroid.com or xerox.com. Shaadi.com came into being only as an Internet address, and there it remains. That is its primary and only connotation. It has none other. It is not the Plaintiff's case that shaadi-dot-com was conceived and adopted for offline use. Apart from the conflict between the oral arguments and the Plaint, I do not believe there is any evidence of shaadi.com having acquired a secondary meaning.

29. Dr. Tulzapurkar is also correct in submitting that Sections 30(2)(a) and 35 of the Trade Marks Act, 1999 ("TMA 1999") entirely cover the situation.

### **"30. Limits on effect of registered trade mark.**

(1)◆

(2) A registered trade mark is not infringed where -

(a) the use in relation to goods or services indicates the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services or other characteristics of goods or services"

**"35. Saving for use of name, address or description of goods or services** Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interfere with any bona fide use by a person of his own name or that of his place of business, or of the name, or of the name of the place of business, of any of his predecessors in business, or the use by any person of any bona fide description of the character or quality of his goods or services."

(Emphasis added)

30. Once, therefore, we find that both shaadi.com and secondshaadi.com are generic or commonly descriptive of their services (and each service is distinguishable), then Section 30(2)(a) must apply. Further, if these expressions commonly describe the nature of the services, then this use is also protected by Section 35.

31. In Notice of Motion (L) No. 2312 of 2014, I granted the Plaintiff an injunction against the proprietors of www.getshaadi.com (49). That relief, however, was in passing off. On those defendants' website, the emphasis was on the words "shaadi.com", and the word "get" was set off above the word "shaadi".

(49). Plaintiff, Exhibit "F1", p. 107♦120

The attempt was ex facie deceitful: those defendants attempted to divert traffic from the Plaintiff's site to theirs. This is certainly not so in the present case. The contesting Defendants place the word "second" prominently above "shaadi.com". The domain name is secondshaadi.com, a sufficient variation. There is also a device of what is presumably a leaf placed by the word "second". Below the expression "shaadi.com" is the tagline "Start a New Life", which is in no manner similar to the Plaintiff's tagline "The World's No.1 Matchmaking Service". The font and stylization of the contesting Defendants' mark is completely different from that of the Plaintiff. So, too, is the get up and look-and-feel of the two websites.

32. In Notice of Motion (L) 1504 of 2014, where the offending website was Shaadi Hi Shaadi.com, I granted the Plaintiff interim reliefs since, on comparing the two websites, I found very many similarities (50). Although the get up of the two websites was not identical, the defendants used the tagline "World's Biggest Matrimonial Service", which was far too similar to the Plaintiff's tagline (as it then was), "The World's Largest Matrimonial Service". Evidently, this was merely an attempt by those defendants to create an illicit association with the Plaintiff's website, since those defendants' website was nowhere close to being the "World's Biggest Matrimonial Service". Those defendants used code to divert traffic headed for the Plaintiff's site to their own, a case that is pleaded but not pressed in the

present case, and which, in any case, is unsupported by any cogent material.

(50). Plaintiff, Exhibit "F2", pp. 121-129

33. In any case, I do not see how either the getshaadi.com or the shaadihishaadi.com cases constitutes any kind of precedent. The latter was an ex parte ad-interim order. In fact, that defendant has never appeared. The former was after notice, but there again the defendant did not appear. There was no contest and the Plaintiff's claim was undefended.

34. The Plaintiff's claim fails on all counts. Mr. Khandekar begins, as I have noted, with the statement that shaadi is purely descriptive, an argument that Mr. Dhond later attempted to step back from, contending that the mark is inherently distinctive, i.e., not descriptive. I believe, prima facie, that the Plaintiff's mark is generic and commonly descriptive, and it is an address of an Internet destination. There is no question of it "now" referring exclusively to the Plaintiff's website; it never pointed to anything else. But that does not make it a trade mark. Being generic, commonly descriptive and an Internet address, the slightest differentiation is enough. Absent any proof of passing off or deceit (as in the other two cases), I do not see how the Plaintiff is entitled to an injunction. On the question of proof of passing off and deceit, I am bound by the decision of Menon J in Raymond Ltd.

35. Dr. Tulzapurkar also claims there is sufficient acquiescence in this case to dislodge the Plaintiff's claim. The contesting Defendants began operating their website in 2006. The Plaintiff, by its own admission, was aware of the contesting Defendants' website since 2007. It sent the contesting Defendants a cease-and-desist notice on 27th July 2007. The contesting Defendants responded on 13th August 2007, refusing to cease-and-desist. The Plaintiff did not reply. It was only on 28th September 2013, i.e., a full six years after the initial correspondence, that the Plaintiff sent the contesting Defendants another notice. That, too, met a denial. For those intervening years, the Plaintiff sat by idly and allowed the contesting Defendants to build their trade until it felt threatened. Indeed, Mr. Khandekar says precisely this, when he argues that in 2007, the contesting Defendants were too insignificant to merit legal attention or action; and that it is only now, when the contesting Defendants' operations have attained a certain critical mass, that the Plaintiff feels the threat. The contesting Defendants invested substantial sums of money to popularise and market their website. They amassed a significant client-base. The Plaintiff stood by with full knowledge of its rights and did nothing. This is not a case of a mere delay (51)

(51). **Midas Hygiene Industries Pvt Ltd. v. Sudhir Bhatia, (2004) 3 SCC 90.**

36. Acquiescence is a species of estoppel, and that makes it both a rule of evidence and a doctrine in equity. Where a party with knowledge of its rights stands silent and watches another deal with the property in a manner inconsistent with the claimant's right; and where the claimant makes no objection while the act

continues, progresses and grows, he cannot later be heard to complain. A trade mark proprietor who, not ignorant of his rights, sits on his hands and watches his competitor grow in the market, taking no action while the other does not, can claim no exclusivity. He must be deemed to have affirmed his rival's use of the mark. Paragraph 27 of the Plaintiff is fatal to the Plaintiff's case (52).

(52). Plaintiff, pp. 22-23

The Plaintiff submits that subsequent to the said letter dated 13th August, 2007 sent by Defendant No.1's Advocate to the Plaintiff, the Plaintiff did not initiate any action against the Defendants as at the relevant time the use by the Defendants of the offending mark was insignificant and/or minimal and/or small and/or intermittent and/or sporadic without affecting the business and/or interests of the Plaintiff and/or diluting and/or tarnishing and/or blurring its mark. However, the Plaintiff in or around September, 2013 learnt that the Defendants have started using the impugned mark Second Shaadi.com in relation to their impugned services in a commercial and full fledged manner in the course of the trade which is in direct conflict with the Plaintiff's rights and interests in and to the said mark Shaadi.com.

(Emphasis added)

37. For the foregoing reasons, the Notice of Motion fails. It is dismissed, with no order as to costs.