

ADMINISTRATIVE PANEL DECISION

Luxury India Solutions PVT. LTD. v. Domain Admin, Matrimony.com Limited
Case No. D2023-3976

1. The Parties

The Complainant is Luxury India Solutions PVT. LTD., India, represented by Ravi Verma, India.

The Respondent is Domain Admin, Matrimony.com Limited, India, represented by KRIA Law, India.

2. The Domain Name and Registrar

The disputed domain name <jodii.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 31, 2023. On September 25, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 25, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. In response to a notification by the Center that the Complaint was administratively deficient, the Complainant filed a first amended Complaint and a second amended Complaint on October 14 and 23, 2023 respectively.

The Center verified that the Complaint together with the amended Complaints satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on October 24, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 13, 2023. The Response was filed with the Center on November 8, 2023.

The Center appointed a panelist in this matter on November 16, 2023. However, on November 17, 2023, the Center notified the Parties that the said panelist had recused itself from the case due to a late disclosure of a potential conflict with one of the Parties.

The Center appointed Shwetasree Majumder as the sole panelist in this matter on November 20, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is in the business of providing matrimonial and match making service in India. The Complainant's trademark JODISEARCH.COM is registered since December 1, 2014 in India (registration number 2853339). The Complainant's business website is "www.jodisearch.com" and the said domain name was registered on November 12, 2014.

The disputed domain name was registered on July 24, 2010. The Respondent too is in the business of providing matrimonial services in India. The Respondent's website "www.jodii.com" is one of its several websites where such matrimonial services are offered. The Respondent has filed Indian trademark applications for its mark JODII and JODII stylized marks, all of which have been opposed by the Complainant. The opposition proceedings are pending before the Indian Trade Marks Office.

It is common knowledge and also a non-contested fact that in regional languages of India, the term "jodi" means a couple, pair or a partnership.

Prior to filing the Complaint, the Complainant had sent a notice to the Respondent to cease and desist from using the mark JODII and also its website "www.jodii.com". The Respondent in its reply had refused to comply with the Complainant's demands. Copies of the Complainant's notice and the Respondent's reply are submitted by the Respondent as Annex 13.

5. Parties' Contentions

A. Complainant

The Complainant was established in the year 2014 in India and provides matrimonial and match making services under its trademark JODISEARCH.COM. The Complainant has several Indian trademark registrations for JODISEARCH.COM and the earliest of which is its Indian registration number 2853339 dated December 1, 2014.

The Complainant states to have adopted the trademark JODISEARCH.COM in the year 2014 when it commenced operations for offering matrimonial services. The Complainant claims that its matrimonial services under its trademark JODISEARCH.COM are well-known and popular across India. The Complainant's website is "www.jodisearch.com" and it has registered the domain name in the year 2014. The Complainant claims to have advertised and promoted its mark JODISEARCH.COM in various media sources and has filed copies of such advertisements as Annex H with the Complaint.

The Complainant admits that "jodi" is a word of vast usage throughout India and means a couple or partnership. Its further stated by the Complainant that the term "jodi" has a special significance qua matrimony and therefore, in itself is non-registrable. It is the Complainant's case that the Respondent has maliciously and with an intention to evade the principles mandated under the law of the land has, by only adding the letter "i" behind the generic term "jodi" sought to register trademark JODII which is descriptive and generic.

The Complainant alleges that the disputed domain name is identical or confusingly similar to its trademark JODISEARCH.COM because it incorporates the entirety of "jodisearch". Further, the disputed domain name differs from the Complainant's JODISEARCH.COM only by the generic Top-Level Domain ("gTLD") ".com"- which has to be ignored during comparison under the first element.

The Complainant also argues that it had established its matrimonial services in 2014 under the name and style of Jodisearch Matrimonial and registered its domain name <jodisearch.com> which is identical to the disputed domain name. The Complainant requests that the Panel ought to find that the disputed domain name is confusingly similar to its mark JODISEARCH MATRIMONIAL.

The Complainant also submits that by virtue of longstanding use since 2014, the Complainant's mark has gained immense reputation and goodwill.

The Complainant argues that the Respondent registered the disputed domain name with the motive to deceive the general public into believing that they are somehow associated, connected with or endorsed by the Complainant and further with an intention to ride on the goodwill and reputation associated with the Complainant. Hence, the Respondent has no legitimate rights or interests in the disputed domain name. The Complainant states that the disputed domain name has been registered in bad faith with a sole objective of creating confusion in the marketplace. The Complainant submits that the Respondent had no reason to adopt the disputed domain name except to create a deliberate false impression in the minds of consumers.

B. Respondent

The Respondent claims to be a pioneer in using the Internet as a vehicle/platform for matrimonial alliances in India, ever since it launched the website "www.bharatmatrimony.com" in the year 1999.

The Respondent claims to have launched a new product under its mark JODII in the year 2021 to cater to the needs of less educated persons who are looking for online matrimonial alliances. The Respondent has pointed out that it also purchased the domain name <jodii.in> on April 23, 2021. The Respondent claims that its mobile App titled "Jodii- Matrimony App for All", has more than 5 million downloads and that it has spent over INR 4 million in advertisement expenses. In support of these claims the Respondent has filed screen shots of the listing of its mobile app on the Google Playstore and a chartered accountant certificate as Annex 4 and 5 respectively.

The Respondent too admits that the word "jodi" is commonly used to refer a couple or a pair of people who are in a romantic or marital relationship. It is submitted by the Respondent that "jodi" is a descriptive term and is common to trade and no one can claim monopoly over the term "jodi".

The Respondent has submitted as Annex 9 a list of third party websites for matchmaking services, the domain names of which contain the term "jodi". The Respondent states that there are several third parties who have obtained Indian trademark registrations for Jodi formative marks and has submitted a list as Annex 10 with its Response.

The Respondent's rebuttals to the Complainant's allegations can be summarized as under:

- i) That the Complainant's registrations are for the mark JODISEARCH.COM as a whole but the Complainant has attempted to make out a case as though it has obtained registration for the word "jodi" per se. The Complainant's mark JODISEARCH.COM is not even remotely similar to the disputed domain name.
- ii) That the common part between the two marks/domain names is the term "jodi" for which the Complainant neither has pending application, nor a registered mark.
- iii) That disputed domain name was purchased as early as July 24, 2010, compared to the Complainant's domain name <jodisearch.com> which was only purchased on November 12, 2014 and therefore, there is no possibility of dishonesty the Respondent's part.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, the Complainant must prove each of the following three elements required under by a preponderance of evidence:

- i. the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- ii. the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- iii. the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires the Complainant to show that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights. It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison.

The test under the first element of UDRP typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. The WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7, provides the consensus view of UDRP panels: "While each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing".

In the present case, there is no doubt that the Complainant has trademark rights in the mark JODISEARCH.COM, however it has no independent trademark rights over "jodi". The Panel finds it difficult to agree with the Complainant's contention that the disputed domain name is identical or confusingly similar to JODISEARCH.COM. The gTLD ".com" in the disputed domain name can be disregarded for the purposes of comparison. But it's worth noting that the Complainant's rights vest in JODISEARCH.COM as a whole and therefore term ".COM" in the Complainant's mark cannot be disregarded during comparison under the first element.

It is clear that JODISEARCH.COM is not entirely subsumed in the disputed domain name. Also, the mark JODISEARCH.COM cannot be said to be recognizable in the disputed domain name. More importantly, the only common element between the disputed domain name and the mark JODISEARCH.COM is the term "jodi", which is a dictionary word. This fact is admitted by both the parties. Hence, the Panel is of the view that the term "jodi" cannot be treated as a dominant part of JODISEARCH.COM which is recognizable in the disputed domain name.

The Panel has perused Annex 9 of the Response and observes that there are several Jodi formative domain names have been registered prior to the Complainant acquiring the trademark JODISEARCH.COM. Thus the Complainant is not the first party and certainly not the only party to use the term "jodi" in its domain name for matrimonial services.

The Complainant has also argued that the disputed domain name is identical or confusingly similar to its mark JODISEARCH MATRIMONIAL. Here, the Complainant has failed to meet the standing requirement that it has rights in the mark JODISEARCH MATRIMONIAL. Firstly, the Complainant does not have any pending applications or registrations for this mark. Secondly, the Complainant has made conclusory allegations of having unregistered or common law rights in JODISEARCH MATRIMONIAL but has failed to substantiate it with specific evidence. None of the Annexes filed with the Complaint establish unregistered or common law rights in the mark JODISEARCH MATRIMONIAL. To establish unregistered or common law

trademark rights for purposes of the UDRP, the complainant must show that its mark has become a distinctive identifier which consumers associate with the complainant's goods and/or services (see [WIPO Overview 3.0](#), section 1.3).

Even assuming that the Complainant was able to establish unregistered rights in JODISEARCH MATRIMONIAL, the disputed domain name cannot be considered as identical or confusingly similar with this mark either, in view of the Panel's analysis in the preceding paragraph.

In view of the above, the Panel concludes that the Complainant has failed to satisfy paragraph 4(a)(i) of the Policy. Accordingly, this Panel need not address whether the Complainant has satisfied paragraphs 4(a)(ii) and 4(a)(iii) of the Policy.

B. Reverse Domain Name Hijacking

Paragraph 15(e) of the Rules provides that, if "after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding".

The Rules define Reverse Domain Name Hijacking as "using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name". The Panel also bears in mind that the Complainant in this case is represented by counsel and, therefore, and it should be held to a higher standard (see section 4.16 of the [WIPO Overview 3.0](#)).

The Panel concludes that the Complainant's actions constitute Reverse Domain Name Hijacking for the following reasons:

i) the Complainant, which is represented by counsel, should have appreciated the weakness of its case and the admitted fact that the term "jodi" which is the only common element in the disputed domain name and its mark JODISEARCH.COM, is a generic term. The Complainant admits that the term "jodi" is common to trade fairs and then in the same breath asserts that the Complainant's mark JODI has acquired goodwill and reputation. Given the undertakings in paragraphs 3(b)(xiii) and (xiv) of the UDRP Rules, past panels have held that a represented complainant should be held to a higher standard.

ii) the Complainant knew or should have known that the Respondent was not acting in bad faith, given the fact that registration of the disputed domain name is well before the Complainant acquired trademark rights. The disputed domain name was registered in the year 2010 and the Complainant acquired trademark rights in JODISEARCH.COM and also commenced operations only in the year 2014. The Panel presumes this to be the reason why the Complainant has cleverly abstained from mentioning the date of registration of the disputed domain name in its Complaint.

iii) the Complainant has made a false statement with an attempt to mislead the Panel by stating that "the disputed domain name is identical to the Complainant's prior registered domain name <jodisearch.com>". The Complainant is well aware that its domain name <jodisearch.com> was registered on November 12, 2014 and hence is not prior to the disputed domain name which was registered on July 24, 2010.

iv) the Complainant had clear knowledge of the Respondent's rights or legitimate interests in the disputed domain name. By way of letter dated May 25, 2023 the Respondent had drawn the Complainant's attention to the Indian Madras High Court order dated July 14, 2022 in CS (Comm. Div) No. 122 of 2021 between *M/s. FreeElective Network Private Limited vs M/s. Matrimony.com Limited* (the Respondent). In this order, the court ruled in the Respondent's favour and held that the Plaintiff is entitled to protect the composite mark being JODI365 but not the element "Jodi". The Complainant chose to ignore/ sidestep this judicial precedent which at its core upholds the Respondent's rights and interests under its business website "www.jodii.com".

7. Decision

For the foregoing reasons, the Complaint is denied. The Panel also finds that the Complaint was brought in bad faith in an attempt at Reverse Domain Name Hijacking and constitutes an abuse of the administrative proceeding.

/Shwetasree Majumder/

Shwetasree Majumder

Sole Panelist

Date: December 4, 2023