



O.A.Nos.374 & 375 of 2023 and A. 1
of 2023 in C.S.(Comm. Div.) No. 100 of 2023

O.A.Nos.374 & 375 of 2023 and A. No.2519 of 2023 in
C.S.(Comm. Div.) No. 100 of 2023

ABDUL QUDDHOSE,J.

Paulsons Beauty and Fashion Private Limited,
represented by its Authorised Signatory
Shabnam Banu

.. Applicant/plaintiff

VS

Sulthana Restaurant

.. Respondent/defendant

The Suit has been filed for infringement and passing off.

O.A. No.374 of 2023 has been filed to grant an order of interim injunction to restrain the respondent/defendant from in any manner passing off the applicant's/plaintiff's trade mark and trading style 'SULTANA'S BIRIYANI' by using the trade mark and trading style 'SULTANA'.

O.A. No.375 of 2023 has been filed to grant an order of interim injunction to restrain the respondent/defendant from in any manner infringing the applicant's/plaintiff's trade mark and trading style 'SULTANA'S BIRIYANI' by using the offending trade mark and trading style 'SULTANA'.



2.The applicant/plaintiff is having a registered trade mark 'SULTHAN'S BIRIYANI', which has been registered under the Trade Marks Act 1999 on 24.07.2019. A Legal Usage Certificate has also been obtained by the applicant/plaintiff on 10.05.2022 in respect of the trade mark 'SULTHAN'S BIRIYANI'. The applicant/plaintiff came to know that the respondent/defendant is carrying on restaurant business in the name and style of 'SULTHANA RESTAURANT', which according to the applicant/ plaintiff is deceptively similar to that of the applicant's/plaintiff's trade mark 'SULTHAN'S BIRIYANI'. The applicant/plaintiff issued a legal notice on 24.03.2023 to the respondent/defendant requesting the respondent/defendant to cease and desist from using the name 'SULTHANA'. Newspaper advertisements were also given by the applicant/plaintiff with regard to the applicant's/plaintiff's trade mark 'SULTHAN'S BIRIYANI'. Since the respondent/defendant has continued to use the name 'SULTHANA RESTAURANT', the Suit has been filed for infringement and passing off. According to the applicant/plaintiff, since the applicant/plaintiff is a prior user of the registered trade mark 'SULTHAN'S BIRIYANI', which is a registered trade mark of the applicant/plaintiff, the respondent/defendant does not have a right to use the name 'SULTHANA RESTAURANT'. According to the applicant/plaintiff, the respondent/defendant started their restaurant business in the name of



'SULTHANA RESTAURANT' only in March 2023. In the aforementioned circumstances, the suit has been filed.

3.These Original Applications have been filed by the applicant/plaintiff seeking for interim injunction, which are the subject matters of consideration today.

4.A counter affidavit has been filed by the respondent/defendant denying the contentions of the applicant/plaintiff. They would state as follows:

a)The suit filed by the applicant/plaintiff for alleged infringement and passing off is not maintainable. According to them, the applicant/plaintiff has projected a false case and has filed a suit by making absolutely false and incorrect averments;

b)According to the respondent/defendant, the respondent/defendant is a seller of juices, tea, shawarma, biriyani, burgers, etc. at a small restaurant/eatery, which is completely different from the line of business of the applicant/plaintiff, who sells vegetarian and non-vegetarian food in a spacious and well furnished areas, which has a different ambience altogether;



c)According to the respondent/defendant, the type of customers catered to by the applicant/plaintiff is completely different from the customers of the respondent/defendant;

d)According to the respondent/defendant, the name of the shop of the respondent/defendant is 'SULTHANA', which is explained in wikipedia as 'SULTANA OR SULTANAH', which is a female royal title and the feminine form of the word 'SULTAN'.

e)According to the respondent/defendant, the term is officially used for female monarchs in some Islamic states and historically it was also used for sultan's consorts. According to the respondent/defendant, there cannot be any trade mark for the name 'SULTHANA' as it is a universal common name.

f)According to the respondent/defendant, the applicant's/plaintiff's restaurant is 'SULTHAN'S BIRIYANI', whereas the name of the respondent's/defendant's restaurant is 'SULTHANA RESTAURANT' and is also written in a different style than that of the applicant/plaintiff. Therefore, according to the respondent/defendant, there is no resemblance of name between that of the respondent/defendant and that of the applicant/plaintiff.



5.It is contended by the respondent/defendant that though the font used may be same, as alleged by the applicant/plaintiff, the said font is not patented or copyrighted by the applicant/plaintiff. He further contends that the said font is a universal Arabic font/calligraphy and everyone is free to use the said font. It is also contended by the respondent/defendant that the territorial operations of the applicant/plaintiff is restricted to the state of Tamil Nadu as seen from the Legal Usage Certificate, whereas the respondent/defendant is carrying on its business in Karaikal outside the state of Tamil Nadu.

6.Learned counsel for the applicant/plaintiff reiterated the contents of the affidavit filed in support of these applications. He drew the attention of this Court to the following authorities in support of his contentions:

a)A Division Bench judgment of the Delhi High Court in the case of M/s.Kirorimal Kashiram Marketing and Agencies Pvt. Ltd. vs. M/s.Shree Sita Chawal Udyog Mill reported in 2010 SCC Online Del 2933;

b)A decision of the Hon'ble Supreme Court in the case of S.Syed Mohideen vs. P.Sulochana Bai reported in 2016 2 SCC 683;

c)A decision of the Hon'ble Supreme Court in the case of Cadila Health Care Ltd. vs. Cadila Pharmaceuticals Ltd. reported in 2001 (5) SCC 73;



d)A Single Judge judgment of this Court dated 10.03.2016 passed in Civil Suit No.76 of 2014 in the case of Castrol Limited and another vs. Mohammed and another.

7.Learned counsel for the respondent/defendant also reiterated the contents of the counter affidavit filed in these applications. In support of the contention of the respondent/defendant, he relied upon the following authorities:

a)A decision of the Hon'ble Supreme Court in the case of Skyline Education Institute (Pvt.) Ltd. vs. S.L.Vaswani and others reported in AIR 2010 SC 3221;

b)A Single Judge judgment of this Court dated 30.09.2022 in the case of Apple Kids Education Pvt. Ltd. vs. Manjula Srinivasan reported in 2022-5-Law Weekly 90.

8.Learned counsel for the respondent/defendant also relied upon Section 28(2) of the Trade Marks Act, 1999 and would submit that since the Legal Usage Certificate has been obtained by the applicant/ plaintiff only for the state of Tamil Nadu, the usage of the Trade Mark of the applicant/plaintiff is also restricted only to the state of Tamil Nadu. Therefore, the applicant/plaintiff cannot claim exclusive right for the usage of the Trade Mark in other places outside the state of Tamil Nadu.



9.Learned counsel for the respondent/defendant would submit that since the respondent/defendant is carrying on business only at Karaikal, the suit filed by the applicant/plaintiff is not maintainable as the applicant/plaintiff cannot seek exclusive right of usage of the trade mark in Karaikal.

10.Learned counsel for the applicant/plaintiff also relied upon Section 33 of the Trade Marks Act, 1999 and would submit that the respondent/defendant was very well aware of the usage of the trade mark of the applicant/plaintiff. But despite being aware, the respondent/defendant is using the same trade mark and therefore, Section 33 of the Trade Marks Act 1999 gets attracted, which prohibits the respondent/defendant from using the name 'SULTHANA RESTAURANT'.

Discussion:

11.Admittedly, the applicant/plaintiff is having registration only in respect of 'SULTHAN'S BIRIYANI' through a Trade Mark Registration Certificate dated 24.07.2019. A Legal Usage Certificate of the applicant's/plaintiff's trade mark 'SULTHAN'S BIRIYANI' dated 10.05.2022 also makes it clear that the exclusive right granted to the applicant/plaintiff to use the trade mark 'SULTHAN'S BIRIYANI' is restricted only to the state of Tamil Nadu. Section 28(2) of the Trade Marks Act makes it clear that the exclusive right to use the trade mark shall be



subject to any condition and limitation to which the registration is subjected to.

Section 28 of the Trade Marks Act is extracted hereunder:

'Section 28. Rights conferred by registration.—(1) Subject to the other provisions of this Act, the registration of a trade mark shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act.

(2) The exclusive right to the use of a trade mark given under sub-section (1) shall be subject to any conditions and limitations to which the registration is subject.

(3) Where two or more persons are registered proprietors of trade marks, which are identical with or nearly resemble each other, the exclusive right to the use of any of those trade marks shall not (except so far as their respective rights are subject to any conditions or limitations entered on the register) be deemed to have been acquired by any one of those persons as against any other of those persons merely by registration of the trade marks but each of those persons has otherwise the same rights as against other persons (not being registered users using by way of permitted use) as he would have if he were the sole registered proprietor.'

12. In the case on hand, the Legal Usage Certificate of the applicant/
plaintiff's trade mark 'SULTHAN'S BIRIYANI' dated 10.05.2022 restricts the



exclusive right available to the applicant/plaintiff over the usage of the trade mark

'SULTHAN'S BIRIYANI' only to the state of Tamil Nadu. Even though the suit has also been filed for passing off and Interlocutory Applications have also been filed to protect the applicant's/plaintiff's interest for the alleged passing off committed by the respondent/defendant, this Court is of the considered view that the interim injunction sought for by the applicant/plaintiff for passing off cannot be granted for the following reasons:

a)The respondent/defendant has not copied the same trade mark 'SULTHAN'S BIRIYANI', but is only using the name 'SULTHANA RESTAURANT', though biriyani may be one of the items, which is being served in the said restaurant;

b)Any non vegetarian restaurant fort that matter will serve biriyani and no person can claim exclusive rights to serve biriyani in their restaurant;

c)'SULTHAN' is a male name, whereas 'SULTHANA' is a female name. Both the names are common universal names;

d)The applicant/plaintiff is having a registered trade mark only in respect of 'SULTHAN'S BIRIYANI' and not in respect of 'SULTHANA RESTAURANT'. If the logic of the applicant/plaintiff has to be accepted, no person will have a right to use any universal common name;



e)No person will be deceived by using the name 'SULTHANA RESTAURANT' as 'SULTHAN'S BIRIYANI' is completely different from 'SULTHANA RESTAURANT'. The word 'BIRIYANI' is also not found in the name of the respondent/defendant;

f)No person of average intelligence for that matter will be deceived if a person uses the name 'SULTHANA' for his restaurant business as the applicant's/plaintiff's trade mark is 'SULTHAN'S BIRIYANI';

g)The essential features of both the marks are also different as seen from the comparison chart placed before this Court. As seen from the comparison chart, the name board of the applicant's/plaintiff's restaurant and the name board of the respondent's/defendant's restaurant are completely different. The applicant's/plaintiff's restaurant apart from using the name 'SULTHAN'S' also discloses 'Biriyani and much more' at the bottom of the name board, whereas the name of the respondent's/defendant's restaurant is 'SULTHANA' and below the name 'SULTHANA', it discloses that they sell 'tea and cofee, juice and sandwich, biriyani, fried rice and noodles, shawarma, grill and BBQ;

h)The letters and fonts of both the applicant's/plaintiff's and the respondent's/ defendant's name board are also not identical and there are dissimilarities between the letters 'S' and 'U' as the font of 'S' is different and on top of 'S' and 'U' there is an arabic script in the applicant's/plaintiff's trade mark,



whereas this is not shown in the respondent's/defendant's trade mark. Being a universal common name, which is being used commonly, the applicant/plaintiff cannot seek exclusive usage for an injunction to restrain the respondent/defendant from using the name 'SULTHANA' for its restaurant business. Further, the applicant/plaintiff is running a chain of restaurants in the name of 'SULTHAN'S BIRIYANI', whereas the respondent/defendant is having a small restaurant in Karaikal outside the state of Tamil Nadu and that too in a different name than that of the applicant/plaintiff. Nobody will be deceived by the usage of name 'SULTHANA' by the respondent/defendant as it will not affect the applicant's/plaintiff's business interest;

i)The essential features of the applicant's/plaintiff's registered trade mark 'SULTHAN'S BIRIYANI' and the essential features of the respondent's/defendant's name 'SULTHANA RESTAURANT' are different and are not deceptively similar;

j)Therefore, though the respondent/ defendant may not have obtained registration in respect of 'SULTHANA RESTAURANT', it will not enable the applicant/plaintiff to obtain injunction as prayed for in the Original Applications as both the names are not deceptively similar. The words "SULTHAN" and 'SULTHANA' as observed earlier are two different names and they are universal common names.



13. Therefore, this Court is of the considered view that Section 29(9) of the Trade Marks Act, 1999 which the learned counsel for the applicant/plaintiff relies upon will not get attracted. Similarly, Section 33 of the Trade Marks Act, 1999 dealing with the 'effect of acquiescence', which the learned counsel for the applicant/plaintiff emphasises upon, has no bearing for the facts of the instant case. Since the two names namely, 'SULTHAN'S BIRIYANI' and 'SULTHANA RESTAURANT' are two different names, which are not deceptively similar, no person of average intelligence for that matter will get deceived by the usage of the name 'SULTHANA RESTAURANT' by the respondent/defendant as it is not deceptively similar to that of the applicant's/plaintiff's registered trade mark 'SULTHAN'S BIRIYANI'.

14. The judgments relied upon by the learned counsel for the applicant/plaintiff referred to supra has no bearing for the facts of the instant case. The judgment of the Division Bench of the Delhi High Court in the case of M/s. Kirorimal Kashiram Marketing and Agencies Pvt. Ltd., referred to supra was dealing with the trade mark 'Golden Deer' and a deceptively similar trade mark 'double deer'. Though in the said decision, the Delhi High Court was dealing with the male and female, found in the logo, it did not deal with universal common names as in the present case as this Court is dealing with two common names i.e.



'SULTHAN'S BIRIYANI' and 'SULTHANA RESTAURANT' and therefore, the said decision has no bearing for the facts of the instant case. The Division Bench of the Delhi High Court in the aforesaid judgment has also made it clear that the respondent's/defendant's mark must be so close either visually, phonetically or otherwise similar. As seen from the documents filed by the applicant/plaintiff, the applicant/plaintiff has not satisfied that the respondent's/defendant's mark is close, visually or phonetically, to the applicant's/plaintiff's trade mark 'SULTHAN'S BIRIYANI'. The respondent's/ defendant's mark is not deceptively similar to that of the applicant's/plaintiff's trade mark. The general public will not get confused between both the marks and they will never have the impression after visiting the restaurant of the respondent/defendant that it belongs to the applicant/plaintiff. The names 'SULTHAN' and 'SULTHANA' are not a rarity. They are personal names. The word 'SULTHAN' and 'SULTHANA' are not distinctive. They are universal common names, which would not be able to attribute any distinctive remembrance in the minds of the consumers. The applicant's/plaintiff's trade mark 'SULTHAN'S BIRIYANI' and the respondent's/defendant's trade mark 'SULTHANA RESTAURANT' will not cause confusion amongst the consumers as they are not deceptively similar. No person can claim monopoly over the name 'SULTHAN' or 'SULTHANA' though the trade mark 'SULTHAN'S BIRIYANI'



may have acquired distinctiveness. But that cannot guarantee exclusive rights over the name 'SULTHAN' and 'SULTHANA' as they are universal common names.

15.In the judgment relied upon by the learned counsel for the applicant/plaintiff in the case of S.Syed Mohideen vs. P.Sulochana Bai reported in 2016 (2) SCC 683, the Hon'ble Supreme Court was dealing with the rights of prior user of a registered trade mark. In the case on hand, the trade mark 'SULTHAN'S BIRIYANI' and 'SULTHANA RESTAURANT' are totally different and therefore, the prior user doctrine, which was discussed in the judgment of the Hon'ble Supreme Court, referred to supra, has no bearing to the facts of the instant case.

16.In the judgment relied upon by the learned counsel for the applicant/plaintiff in the case of Cadila Health Care Ltd. vs. Cadila Pharmaceuticals Ltd., the Hon'ble Supreme Court has broadly stated that in an action for passing-off on the basis of unregistered trade mark generally for deciding the question of deceptively similarity, the following facts are to be considered:

a)The nature of the marks i.e. whether the marks are word marks or label marks or composite marks i.e. both words and label works.

b)The degree of resemblance between the marks, phonetically similar and hence similar in idea.



c)The nature of the goods in respect of which they are used as trade marks.

d)The similarity in the nature, character and performance of the goods of the rival traders.

e)The class of purchasers who are likely to buy the goods bearing the marks they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and/or using the goods.

f)The mode of purchasing the goods or placing orders for the goods.

g)Any other surrounding circumstances which may be relevant in the extent of dissimilarity between the competing marks.

17.Learned counsel for the respondent/defendant had relied upon two authorities, which have been referred to supra, which supports the case of the respondent/defendant. In the Skyline decision of the Hon'ble Supreme Court, referred to supra, it has been held that the word 'Skyline' cannot be exclusively used by any party as the word 'Skyline' is a generic word and the same is being used by thousands of persons and institutions as part of their trading name or business activities. It is also a well known fact that 'SULTHAN' and 'SULTHANA' are common generic names and it may be used by various establishments not alone by the respondent/defendant but also by others. Therefore, the decision of the Hon'ble Supreme Court in the case of Skyline Education Institute (Pvt.) Ltd.



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reported in AIR 2010 SC 3221 relied upon by the learned counsel for the respondent/defendant applies to the facts of the instant case.

18. Similarly, the decision of the learned Single Judge of this Court, relied upon by the learned counsel for the respondent/defendant in the case of Apple Kids Education Pvt. Ltd. vs. Manjula Srinivasan reported in 2022-5-Law Weekly 90 dealing with 'Apple Kids' and 'Apple Perks International School' held that since 'Apple' is a universal name, the respondent/defendant cannot be restrained from using the term 'Apple Perks International School'.

19. In the case on hand, the applicant/plaintiff has not been able to establish that the respondent's/defendant's name 'SULTHANA RESTAURANT' resembles the applicant's/plaintiff's trade mark 'SULTHAN'S BIRIYANI' and the respondent's/defendant's name 'SULTHANA RESTAURANT' is also not phonetically similar to the applicant's/plaintiff's name. 'SULTHAN' is a male name, whereas the respondent's/defendant's name 'SULTHANA' is a female name. Both are common universal names. The applicant/plaintiff is having a chain of restaurants, whereas the respondent/defendant is running a solo restaurant at Karaikal by name 'SULTHANA RESTAURANT'. The class of customers coming



to the applicant's/plaintiff's restaurant belong to an higher end, whereas the class of customers coming to the respondent's/defendant's restaurant belong to a different class much lower than that of the applicant/plaintiff.

20. Admittedly, the price of the food items in the applicant's/plaintiff's restaurant is higher than that of the respondent/defendant. The respondent/defendant is a small shop located at Karaikal, which is outside the state of Tamil Nadu. The general public will not be confused if the respondent/defendant carries on its restaurant business in the name and style of 'SULTHANA RESTAURANT'. There is no deceptive similarity between the applicant's/plaintiff's trade mark 'SULTHAN'S BIRIYANI' and the respondent's/defendant's name 'SULTHANA RESTAURANT'. The question of passing off by the respondent/defendant also does not arise. Hence, the applicant/plaintiff has not satisfied the mandatory requirements for obtaining an order of interim injunction as prayed for in the Original Applications. The applicant/plaintiff has not made out a prima facie case for the grant of an order of interim injunction as prayed for in the Original Applications. The balance of convenience is also in favour of the respondent/defendant. Irreparable loss/hardship will be caused to the respondent/defendant if interim injunction is granted in favour of the applicant/plaintiff in the Original Applications.



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21.For the foregoing reasons, there is no merit in the Original Applications.

Accordingly, these Original Applications are dismissed. Post the suit on
06.11.2023 for filing of draft issues.

13.10.2023

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