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IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
NOTICE OF MOTION NO. 2586 OF 2012
IN
SUIT NO. 2549 OF 2012

1. **Jagdish Gopal Kamath,**
38B, Circle House, King Circle,
Mumbai – 400 019.
 2. **Suresh Gopal Kamath,**
38B, Circle House, King Circle,
Mumbai – 400 019.
 3. **Devavrat Jagdish Kamath,**
38B, Circle House, King Circle,
Mumbai – 400 019.
 4. **Jaiprakash Jagdish Kamath,**
38B, Circle House, King Circle,
Mumbai – 400 019.
 5. **Gopalkrishna Suresh Kamath,**
38B, Circle House, King Circle,
Mumbai – 400 019.
 6. **G.P. Kamath & Co.,**
a partnership firm, having its
registered office at 38B, Circle
House, King Circle,
Mumbai – 400 019.
- ... Plaintiffs

versus

Lime & Chilli Hospitality Services,
a Private Limited Company having
its registered office at 19/A, Laxminagar,
Behind Girnar Water Tank,
Jalgaon – 425 001.

... Defendants

APPEARANCES

FOR THE PLAINTIFFS **Mr.V.R.Dhond**, *Senior Advocate a/w*
Rashmin Khandekar, Ms.Bijal Trivedi,
Mrs.Bhagwati Trivedi i/b M/s.
Bhagwati & Co.

FOR THE DEFENDANT **Mr. Rahul Ajatshatru** *i/b M/s. Anand &*
Anand.

CORAM : **G.S.Patel, J.**

JUDGMENT RESERVED ON : **30th September 2014**

JUDGMENT PRONOUNCED ON : **11th March 2015**

JUDGMENT:

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A. OVERVIEW

1. In a narrow lane, one of three that branches off to the east from the roundabout at Maheshwari Udyan in Mumbai's central area of Matunga, there stands an unassuming eatery. A few steps lead into it. The space is not large: a few tables at the entry level with the proprietor at a high seat at the counter to the right of the entrance. Opposite the entrance is the kitchen with its serving hatches. A steep staircase to the left leads to a low-ceilinged mezzanine floor. Here, the space is even more cramped. On both levels, patrons share tables: large groups or families may spread across several tables and a solitary diner may find himself rubbing elbows with a complete stranger. This is Café Madras, the South Indian — or, more accurately, Udupi cuisine — specialty sit-down restaurant owned and managed by the Plaintiffs (“**the Kamaths**”), and it is both popular and renowned. Over time, it has acquired, say the Kamaths, a reputation *non-pareil*: the Kamaths pride themselves on the quality of their fare, traditional and authentic they say in every aspect, and the cleanliness of their kitchen. It is by no means a five-star establishment, and has no such pretensions. There is no fancy dinnerware (everyone has clean stainless steel) or table linen (paper napkins must do), but the service is quick and the food arrives fresh and there are long lines at its door every morning. The restaurant caters to all, from the well-heeled and wealthy to the decidedly middle class, with undifferentiated courtesy and efficiency. To be sure there are many other similar eating houses in the vicinity and elsewhere in Mumbai, but theirs, the Kamaths claim, stands apart. It is, they say, iconic.

2. The Kamaths claim to be the registered proprietors of the marks 'Café Madras' since 2005 in Classes 16 and 42. These registrations are valid and subsisting, without any application for rectification. The Kamaths have used these marks openly, continuously and extensively since 1951, generating considerable goodwill and a high reputation.

3. The Defendant, the Kamaths say, has copied the registered marks body and soul. The Defendant's adoption is fraudulent and dishonest and it is used in relation to eateries serving South Indian cuisine though at locations in Jalgaon and Nashik. Importantly, there was a horrific incident at one of those locations, one that caused demonstrable damage to the reputation and the goodwill of the Kamaths' marks.

4. The Defendant claims, in its various affidavits, that '**Café Madras**' is incapable of registration; that the Defendant's use is not in Classes 16 or 42; that there are several other establishments across India with the same name; that the Plaintiffs' claim of goodwill is not borne out by its sales; that this goodwill is, in any case, geographically limited and the Defendant's use in places several hundred kilometres away can have no possible diluting effect on and can cause no possible confusion with the Plaintiffs' use of the expression; and that the Plaintiffs cannot enforce their rights in view of Sections 18 and 28 of the Trade Marks Act, 1999. There is, the Defendant says, no question of any relief being granted to the Plaintiff.

5. Specifically, the Defendant's case is that what the Kamaths have registered is a device, one markedly different from the one on which the action is brought. In any case, neither 'Café' nor 'Madras' are registrable; and the combination is not registrable either. Far from having acquired any 'secondary' meaning, even the combination connotes, in the context of an eating house, a certain type of cuisine. There are a very large number of such eating houses with this name, the Defendant claims, and the Kamaths have not thought it fit to move against any of those. Taken together, the two words are therefore a purely descriptive and not a distinctive expression; and given the spread of use, it is a generic term for a restaurant or eating house that serves South Indian cuisine. There is no case made out of infringement, because there is nothing to infringe. There is also, the Defendant says, no case of passing off because the three-fold or 'Trinity' test is not satisfied: there is no representation, let alone a misrepresentation, by the Defendant that its establishments are in any way connected with the Kamaths'. In the areas where the Defendant has its establishment, it enjoys a reputation and a goodwill of its own. The Kamaths have none there. The Kamaths' reputation, if indeed they have one, is territorially and geographically restricted and extends no further than their vicinity or perhaps, at best, Mumbai.

6. I have heard Mr. Dhond, learned Senior Counsel for the Plaintiffs and Mr. Ajatshatru, learned Counsel for the Defendant extensively. With their assistance, I have considered the material on record. I have also studied their comprehensive written notes of arguments. I am not persuaded that the defence is either tenable or just. I have held that, *prima facie*, the material on record is sufficient

to warrant reliefs on both causes of action, i.e., of infringement and passing off. The Defendant's adoption of the mark is not *bona fide*. I have also found that the Plaintiffs' reputation and goodwill are not geographically and territorially limited in the manner the Defendant suggests. I have also found the Defendant's mark to be deceptively and confusingly similar to that of the Plaintiffs. Finally, I have also found that the Plaintiffs have established not just the possibility or likelihood of confusion or deception on their cause of action in passing off, but *actual* confusion and deception. I have, therefore, held in favour of the Plaintiffs. My reasons follow.

B. FACTS

7. In 1951, Gopal Purshottam Kamath (the 1st and 2nd Plaintiffs' father) began using the mark '**Café Madras**' for his restaurant in Matunga. On 29th December 1968, Gopal and his elder son, the 1st Plaintiff, Jagdish Kamath, entered into a partnership called M/s Café Madras. The mark was brought into that partnership. Ten years later, on 20th July 1978, the 6th Plaintiff partnership firm was formed. It took over the business of Café Madras and, too, that of another partnership firm, Gopalkrishna Hindu Hotel. From 1978 onwards, the 6th Plaintiff was periodically reconstituted. The last of these changes was in 2011, when it became a partnership of Plaintiffs Nos. 1 to 5.

8. On 27th February 2009, the Kamaths obtained registration effective from 13th October 2005 of the mark '**Café Madras**' in Class 42. A separate registration was also obtained, effective the same date, in Class 16.¹ These registrations (Nos. 1390976 and 1390977 at pages 30 and 31 of the Complaint) were subject to a solitary condition and limitation: no exclusivity was conferred for the use of the word 'Madras'. Legal certificates in respect of these registrations are on file at pages 93 to 96 of the Complaint. Registration was sought and obtained on the basis that the mark '**Café Madras**' had acquired distinctiveness on account of user from 1951 to 2005. A user affidavit was filed with the Trade Mark Registry to establish this. The Plaintiffs also sought and obtained registrations of this mark in as many as 27 countries and the European Union.

9. Exhibit "E" to the complaint at page 37 is a certificate by the Plaintiffs' Chartered Accountants attesting to their sales for the period 2003 to 2012. These are indeed substantial. The turnover for the year 2012 is nearly Rs. 1 crore. Advertising figures are insignificant but I believe this works to the Plaintiffs' advantage rather than against them, for the exhibits that follow, from Exhibit F at page 38 to Exhibit F-8 at page 47, show that the Plaintiffs' reputation and goodwill were both considerable and firmly established. There are, in those annexures, repeated narratives of the excellence of the Plaintiffs' 'South Indian tiffin' and attentive service. The eatery has won a large number of awards. There are, in the Affidavit in Rejoinder additional clippings and materials, including from Gordon Ramsay, the internationally renowned chef,

¹ Class 43, relating to 'services', was unavailable at that time.

extolling the quality of the Plaintiffs' food and service. There are also endorsements and encomiums from well-known personalities in entertainment, cinema and industry. The material is not limited to print either, but also extends to other media.

10. The Defendant claims to have started a restaurant in Jalgaon with the name Café Madras in 2004. There is little to support the assertion of this date. Sales and promotional expenses are shown, but from 2006-2007. These are also disputed.

11. The Plaintiffs claim that they learned of the Defendant's use of the mark Café Madras in 2012. On 11th June 2012, the Plaintiffs filed an application to amend the class of services for which their mark was registered.

12. On 21st June 2012, the Plaintiffs' Advocates sent a cease-and-desist notice to the Defendant. The Defendant replied on 29th June 2012, essentially seeking information and details. It seems that it was only thereafter, on 10th July 2012, that the Defendant applied for registration of the mark Café Madras. This application has a direct legal consequence on the issue of whether the mark is distinctive or descriptive; I will turn to this subsequently.

13. On 16th July 2012, the Plaintiffs sent a further cease-and-desist notice to the Defendant, which replied on 23rd July 2012. This was followed, till 25th September 2012, by further correspondence between the advocates for both sides. The Plaintiffs

claim that they learned in September 2012 that the Defendant had opened a second restaurant named Café Madras in Nashik.

14. The present suit was filed on 6th December 2012. The Plaintiffs sought leave under Clause XII of the Letters Patent. This was contested. Leave was ultimately granted by a detailed judgment dated 22nd April 2013.² This Notice of Motion was also filed on 6th December 2012. The Defendant filed an Affidavit in Reply in that month, claiming user from 2004-2005. However, only sales figures were given and that, too, only from 2006-2007. There is no evidence in that affidavit by way of invoices, promotional or advertising materials or third-party write-ups.

C. ISSUES, SUBMISSIONS & FINDINGS

15. Although Mr. Ajatshatru's arguments were restricted to the three or four key issues, his written notes of defence are very nearly encyclopedic and range much further afield, citing a very large number of decisions. Not all of these are germane, and some of the points canvassed in those written arguments are superfluous. While I have considered all the material presented, I have elected to focus only on such of those issues as appear to me to be necessary.

² *Jagdish Gopal Kamath v Lime & Chilli Hospitality Services P. Ltd.*, 2014 (3) Bom CR 446 : 2013 (4) Mh LJ 627

16. As I see it, the broad questions for determination are (i) whether the Plaintiffs have made out a sufficiently strong *prima facie* case on (a) their cause of action in infringement; (b) their cause of action in passing off; (ii) the nature and extent of the Plaintiffs' reputation and goodwill; and (iii) whether the Defendant's adoption of the mark is (a) *bona fide* or not, and (b) if not, whether that adoption is likely to prejudice or has actually prejudiced the Plaintiffs by dilution of the Plaintiffs' mark or damage to the Plaintiffs' reputation and goodwill, or both. These issues are closely interlinked, and each has its subsidiary issues.

C1. *Infringement*

17. Mr. Dhond submits that the mark used by the Defendant, '**Café Madras**' on a device of a banana leaf is identical or, at any rate, deceptively similar to, and therefore infringes, the Plaintiffs' registered trade mark in classes 16 and 42. The essential feature of the two competing marks is the expression '**Café Madras**'. These are structurally, visually and phonetically identical; the differences, if any, are trivial and irrelevant. The essential and prominent feature, the one that lingers in memory, is the expression or term '**Café Madras**'.

18. It is, I believe, too well settled to require further discussion that in comparing rival marks one must look at the mark as a whole. Persons recall marks in generalities and by an overall recollection of

an impression of it. We do not distinguish marks on the basis of niggling detail: whether a device or a mark uses, for instance, one feather or leaf or two, or whether a mark uses an accented letter or an apostrophe is hardly the matter that embeds in common memory. In an infringement action, the rival mark need not be an exact replica or clone. Trivial and non-distinctive matters — what one might describe as mere sideshows — do not sufficiently distinguish a competing mark.³ General and overall impressions are everything.⁴ The test is that of a person of average intelligence and an imperfect memory.⁵ It is true that the Plaintiffs' registration is subject to a condition or limitation *vis-à-vis* the word '**Madras**'. Yet that would make as good as no difference, for one must look at the mark in its entirety.⁶

19. On this test, the Defendant's mark would have to be held to be deceptively similar or identical to that of the Plaintiffs. There can be no doubt about the structural, visual and phonetic similarity between the two marks.

20. The Defendant has not challenged the Plaintiffs' registration by way of a Rectification Petition at any time. I must note that during arguments, Mr. Ajatshatru accepted that the Defendant did

³ *Rustom & Hornsby Ltd v Zamdara Engineering Co.*, AIR 1970 SC 1649

⁴ *M/s Hiralal Prabhudas v Ganesh Trading Co. & Ors.*, 1984 PTC 155 (Bom); *Amritdhara Pharmacy v Satyadeo Gupta*, AIR 1963 SC 449

⁵ *Corn Products Refining Co v Shangrila Food Products Ltd*, AIR 1960 SC 142.

⁶ *Serum Institute of India v Green Signal Bio Pharma Pvt Ltd & Anr.*, 2011 (47) PTC (Bom); *Pidilite Industries v S.M. Associates & Ors.*, 2004 (28) PTC 193 (Bom).

not seek to re-open the Plaintiffs' registration. He confined himself to the effects of that registration and the statutory defences available to him against it. It was not until the written arguments that this canvas was attempted to be widened by questioning the very registration itself, saying it was 'weak', 'unenforceable' and granted in respect of a descriptive and non-distinctive word. I will turn to these arguments presently.

21. Mr. Dhond's argument that the Defendant cannot examine the validity of the Plaintiffs' registration at the interlocutory stage is one that has now been decided by a Full Bench of this Court in *Lupin Ltd v Johnson & Johnson*.⁷ The Full Bench rejected the view taken in *Maxheal Pharmaceuticals v Shalina Laboratories Pvt. Ltd.*,⁸ itself based on the view in *Hindustan Embroidery Mills v K. Ravindra & Co.*,⁹ that it is not the 'practice' of this Court to consider the validity of a registration at an interlocutory stage and that while the mark remains on the register, though wrongly, it is desirable that others not imitate it. The Full Bench held that where the registration of the trade mark is *ex-facie* illegal, fraudulent or shocks the conscience of the Court, the Court is not powerless to refuse an injunction; but to establish these grounds, a very high degree of *prima facie* proof is required. It is open to a court to examine the validity of a registration for this limited purpose, and while there is no 'embargo' or any authority for any such 'practice', this examination is permissible in the exceptional situations mentioned

⁷ Judgment dated 23rd December 2014, Full Bench of Mohit S. Shah, CJ, S. J. Kathawalla and N. M. Jamdar, JJ; per Mohit S. Shah, CJ.

⁸ Appeal No. 88 of 2005.

⁹ 1967 (76) Bom.L.R. 146

earlier. Specifically, it is not sufficient for a defendant to show that he has a merely arguable case against the registration. He must show the registration to be illegal, fraudulent or one that sufficiently disturbs the judicial conscience to have it question the registration itself. Even if it does, the Court's view is only *prima facie*; the registration can only be finally challenged in appropriate rectification proceedings before the Trade Marks Registry.

22. As it happens, the Full Bench decision in *Lupin* does not detract from the strength of Mr. Dhond's argument. If anything, it places that argument on a much surer footing. To brush aside Mr. Ajatshatru's submission that the Plaintiffs' registration is itself 'improper' or 'weak' on the ground of some 'practice' that the Full Bench now says is without foundation seems to me a most tenuous approach. Mr. Ajatshatru's submission must more properly be tested against the parameters set by the *Lupin* Court: can the Plaintiffs' registration be said to be illegal? Fraudulent? Such that leaves the judicial conscience both shaken and stirred? I think not, and this is not even Mr. Ajatshatru's case. Importantly, the Defendant has taken no steps whatever before the Registry or the Board to challenge the Plaintiffs' registration. To question it at this stage is an argument of desperation.

23. What underlies Mr. Ajatshatru's submission is this: first, that the Plaintiffs can have no monopoly in the expression '**Café Madras**' because 'Madras' has been expressly disclaimed, and 'Café' is clearly and without need of further explanation so commonplace a word that no exclusivity attaches to it; and, second,

that what the Plaintiffs have registered is only a *device mark* or a *label mark* and not a word mark at all.

24. To take the latter submission first: Mr. Ajatshatru submits that there is a distinction between a device mark, a word mark and a composite label mark. A word mark gets absolute protection. A device mark is restricted to its artistic depiction. A label or a composite mark gets both (the literary words and the artwork). The Plaintiffs' registrations in Classes 16 and 42 are, Mr. Ajatshatru says, only of a device mark (the words *Café Madras* in italics in a device of a rectangular box), and that since this is something the Defendant does not use, there is no infringement. Factually, this is incorrect. To the Further Affidavit dated 28th February 2013 filed by the 3rd Plaintiff, there are annexed the legal proceedings certificates. These put the matter beyond the pale: the Plaintiffs' registrations, on their applications in 2007 and 2009, are in respect of (i) the trade mark type: device; and (ii) the word mark: '**Café Madras**'. I do not think it is remotely possible for the Defendant to so wholly elide the plain contents of the legal proceedings certificates. Indeed, I must note that I found the Defendant's constant ducking and weaving on this issue less than inspiring. First, they ignored the clear and unambiguous contents of the legal proceedings certificates. Then they contended that in 2004 the Plaintiffs applied for registration of the mark Café Madras (the word, *per se*) but withdrew that application. The Defendant next alleged that the Plaintiffs had applied only for a device mark; that this would be established from the Plaintiffs' application for registration; and this application had not been disclosed. In a late affidavit dated 25th August 2014, the Plaintiffs did disclose their application, and it did not bear out the

Defendant's contention at all. Neither the application nor the Plaintiffs' attorney's covering letter in any way show that application to have been restricted to a 'device'. Confronted with this, in its written arguments the Defendant now contends that since the application does not say it is for a 'word mark', this necessarily means that it is for a device mark; i.e., to suggest, by necessary implication, that a device mark is somehow the default application. This is an argument so entirely without substance that it only needs to be stated to be rejected. The application cannot be assumed to be of a device. If it was in respect of a device, it would have said so. The registration of a device mark is neither a presumption nor axiomatic. In all of this, the Defendant continues to overlook the fact that the Legal Proceedings Certificates quite unequivocally state the registration to be also of a word mark.

25. But I will take the Defendant's case at its best, and will assume that the Defendant is correct that the Plaintiffs' registration is of a device mark. What of it? It is not enough merely to say, "here is a device; I do not use the device; therefore there is no infringement." We must, of necessity, consider what is the essential, prominent and leading feature of that mark, by whatever name called (label, device, composite, word). Even if the Defendant's case is to be accepted, there is nothing essential or prominent in that so-called device other than the words '**Café Madras**'. This is what is protected. It is no answer at all for the Defendant to say that it has used those very words but in some other stylization and, consequently, that there is no infringement. There is simply no basis for this in trade mark law; indeed, it defeats the statutory purpose and intent, for it would then be open hunting season on every single

such registration: every infringer could then claim a different ‘style’ or ‘font’ or placement and thus dilute a mark duly registered, and which registration remains unchallenged.

26. Mr. Ajatshatru says that the Plaintiffs’ mark is a ‘compound’ or a ‘transferred epithet’, comprising a word that is subject to a limitation and another that is common to the trade, and that the Defendant therefore has available to it the benefit of Section 17(2) of the Trade Marks Act, 1999 (“**the TM Act**”). That section reads:

17. Effect of registration of parts of a mark.—

(1) When a trade mark consists of several matters, its registration shall confer on the proprietor exclusive right to the use of the trade mark as a whole.

(2) Notwithstanding anything contained in sub-section (1), when a trade mark—

(a) contains any part—

(i) which is not the subject of a separate application by the proprietor for registration as a trade mark; or

(ii) which is not separately registered by the proprietor as a trade mark; or

(b) contains any matter which is common to the trade or is otherwise of a non-distinctive character,

the registration thereof shall not confer any exclusive right in the matter forming only a part of the whole of the trade mark so registered.

(Emphasis supplied)

27. I do not believe this to be a submission well-founded. Sub-section (1) clearly demands that where a trade mark contains 'several matters', the exclusivity attaches to the mark '*taken as a whole*'. This expression must be given some meaning. If Mr. Ajatshatru's interpretation is to be accepted, it would mean that Section 17(1) is wholly defeated by Section 17(2), and is rendered entirely otiose. Sub-section (2) operates in a distinctively defined arena. Where a person has registered a mark of multiple parts, he enjoys a monopoly of the entirety of that mark with all its parts '*taken as a whole*'. The registration of a mark with components does not give him rights over the individual integers in that mark unless those individual integers are separately registered (or applied for). Where the individual integers are non-distinctive and common to the trade, no rights accrue in the individual integers either ("the part of the whole"), but, by necessary implication, only in the aggregation of these. The fallacy in Mr. Ajatshatru's submission is in filtering the '**Café**' out of the decoction leaving only the disclaimed word '**Madras**'; or, to put it differently, in suggesting that the Plaintiffs claim some sort of monopoly or exclusivity in the word *Café*, the word *Madras* having been subjected to a condition of non-exclusivity. The Plaintiffs claim nothing of the kind. They lay no claim to the word *Café* nor the word *Madras* taken separately or disjunctively. The claim is to the expression taken as a whole, and it falls squarely within Section 17(1) of the TM Act.

28. Indeed, it seems to me that Mr. Ajatshatru runs himself onto its own sword. His submission is that the two words, taken separately, can enjoy no exclusive monopoly. If this is to be accepted, it must follow that, since the mark is registered, there

must exist a monopoly in the combination of the two words. Else, the registration is meaningless; and the Defendant's failure to impeach that registration strikes at the root of their own case. Additionally, given a subsisting registration and the Defendant's own case on the two words taken separately, it is only Section 17(1) that can give full voice to that registration. Section 17(2) has no application at all in this case. This being so, Mr. Ajatshatru's reliance on the Delhi High Court's decision in *Cadilla Healthcare Ltd v Gujarat Cooperative Milk Marketing Federation & Ors.*¹⁰ is of no assistance, because in that case the mark in question ("Sugar Free") was only ever used descriptively to extol the product. It was not used 'as a trade mark'. In any case, that decision was in an action for passing off and not in one for infringement, or one where the two causes of action were combined, as they are here.

29. Mr. Ajatshatru's submission in relation to Section 17 segues into his next proposition, viz., that the entire expression is one that is "common to the trade". I do not see how the Defendant can possibly take any such position. Of necessity, it means that *none* can lay any claim to exclusivity in this mark. But the Defendant has itself (a mere 13 days after it received a cease and desist notice from the Plaintiffs) applied for the registration of a device mark with the expression '**Café Madras**' as its leading, prominent and essential feature. Is it at all possible for the Defendant to say that the Plaintiffs' mark is 'common to the trade' and simultaneously apply for registration, implicit in which is the contention that it is *not* common to the trade and capable of exclusivity? I do not believe so,

¹⁰ 2008 (36) PTC 168 (Del)

and there exists in law a species of estoppel, as a rule of evidence, that militates against the acceptance of any such case. A man may not blow hot and cold. He may not disclaim something as incapable of protection while it lies in the hands of another and lay claim to protection of that very thing when in his own hands. He may not say that the mark is descriptive and does not lend itself to registration or exclusivity and then claim that very exclusivity by applying for a registration in his own name. Applications for registration are not idle formalities. Every application for registration has consequences. It carries with it the expectation of being granted exclusivity and a monopoly. It implies that the applicant believes the mark to be exclusive and capable of registration, that it is not generic, descriptive or common to the trade. An applicant cannot simultaneously make this claim and also contend that in the hands of another the very mark he chooses to monopolize by virtue of his application has no redeeming distinctiveness or that it is so utterly generic, descriptive and so common to the trade that no registration at all is possible. No person may say that such and such a mark is distinctive in my hands but not in yours. It is either distinctive and non-generic or it is not. The identity of the applicant does not make it so. It is the mark itself that is to be seen, not who applies for it. Every application for registration therefore posits an acceptance of distinctiveness. Colloquially, what is sauce for the goose is sauce for the gander. In law, this is the principle of approbation and reprobation, and it applies to the Defendant in this case.¹¹ The

¹¹ *Automatic Electric Ltd v R. K. Dhawan & Anr.*, 1999 (19) PTC 81 (Del.); *Ultra Tech Cement Ltd v Alaknanda Cement Pvt Ltd & Anr.*, 2011(5) Bom CR 588 (upheld in Appeal in *Alaknanda Cement Pvt Ltd v Ultratech Cement Ltd.*, 2012 (1) Bom CR 519); *Brihan Karan Sugar Syndicate Pvt Ltd v Lokranjan Breweries Pvt Ltd.*, 2014 (5) Bom CR 767

principle plainly has universal application: it was reiterated even in the context of a design infringement dispute in *Asian Rubber Industries v Jasco Rubbers*.¹² To say at once that the Plaintiffs' mark is descriptive and to apply for registration, no matter in what context, of a mark that contains substantially the same matter is, if I might be permitted to paraphrase a cliché, somewhat like carrying idlis to Udipi.

30. The distinction that Mr. Ajatshatru draws is that the Defendant's application is for a device mark, and, for that reason, no estoppel attaches. But here again the Defendant's argument is self-defeating: I understood Mr. Ajatshatru to contend, at the very head of his arguments, that the Plaintiffs' registration is only of a device mark. That, as we have seen, is factually incorrect, but assuming that Mr. Ajatshatru is correct, then one must see what it is that constitutes the singular distinguishing feature of such a device. The answer to that is, and can only be, the expression '*Café Madras*'. Now if the Defendant's application too features precisely this as its leading feature, then it is no argument at all to say that there is some additional feature (in the Defendant's case a banana leaf) to distinguish the two marks.¹³ In *Pidilite Industries Ltd. vs. Jubilant Agri & Consumer Products Ltd.*,¹⁴ this Court said:

"14.4 In my view, as submitted by the Plaintiff, this attempt to distinguish itself, now belatedly made by the Defendant in

¹² 2013 (1) Bom CR 393 : 2013 (53) PTC 495 (Bom)

¹³ *Serum Institute of India Ltd v Green Signal Bio Pharma Ltd. & Anr.*, 2011 (47) PTC 452 (Bom)

¹⁴ 2014 (57) PTC 617 (Bom)

the written submissions does not withstand scrutiny for the reasons mentioned hereinbelow:

(i) The mark applied for by the Defendant is reproduced hereinabove. It is true that it is a label mark. However, if the mark is seen, the most prominent and noticeable part/feature of the mark is the word 'MARINE PLUS'. The mark has been described in the column "TM Applied for" as 'MARINE PLUS' – Label". The word 'MARINE' therefore forms a prominent and/or essential feature of the mark applied for. More importantly, the Defendants understood the trademark applied for as "MARINE PLUS".

(ii) The Defendant was therefore attempting to obtain a monopoly over the words 'MARINE' PLUS' and 'MARINE' and in view thereof, the rule of estoppel stated above will apply. The question to be asked is, "Had the Defendant's mark been registered, would it have objected and/or been entitled to object to 'MARINE PLUS' or 'MARINE' being used by someone else?" The answer is obvious.

(iii)

(iv) The applicability of the principle and/or rule of estoppel is not restricted to cases where the mark objected to and mark applied for are identical, but covers cases where there is identity of the prominent and/or essential features, as is evident from the decision of this Court in *Ultratech Cement Limited v. Alaknanda Cement Pvt. Ltd.* 2011 (5) BCR 588, decided on 28th June, 2011, where the doctrine/principle was applied. In that case, the Plaintiffs' mark was "Ultratech Cement. The Engineers Choice" and the Defendant had sought registration of a label containing the word "Ultra Tuff".

(Emphasis supplied)

31. Indeed, a judgment cited by Mr. Ajatshatru works against him: the situation I have described was precisely of the sort that was before Mr. Justice Kathawalla in *M/s Bade Miya, Mumbai & Ors. v Mubin Ahmed Zahurislam*,¹⁵ where the defendant claimed to be entitled to vend food in the trading name ‘**BADEMIYAN**’, as opposed to the plaintiffs’ well-established name ‘**BADEMIYA**’. This is a decision that is on all fours with the present case. Kathawalla, J held that adding some pictorials of camels and a token *N* at the end of the mark would make no difference.

32. I very seriously doubt if any person will attempt to differentiate between ‘**Café Madras**’ on its own and something like ‘**Café Madras with a graphic of a banana leaf and the tag-line essence of real Udupi kitchen**’. We do not test this from the perspective of a refined gourmet. A man of average appetite and imperfect palate will not see the kind of nuanced distinction Mr. Ajatshatru advocates.

33. What is the evidence on which the Defendant relies to show that the Plaintiffs’ mark is, as Mr. Ajatshatru claims, “common to the trade”? It is set out in paragraph 2.26 of the written arguments, where the Defendant claims that the word ‘*Madras*’ has been historically used to mean a South Indian cuisine eatery; and the word ‘*Café*’ is itself too commonplace to admit of any exclusivity. To evidence this, the Defendant has annexed to its affidavit dated 7th August 2014 a list of establishments that it claims uses these two

¹⁵ Judgment dated 25th March 2011 in Notice of Motion No.386 of 2011 in Suit No. 292 of 2011.

words, though not always together (i.e., some use ‘*Madras*’ and some use ‘*Café*’). The Defendant claims that there are in this list 24 establishments named ‘*Café Madras*’, of which as many as seven are in Mumbai alone. On this basis, the Defendant claims that both words are generic.

34. The law in this regard is well established. To succeed, the Defendant must establish that the marks on which it relies are many and that they are in extensive use and that they have, by reason of that wide usage, passed into the realm of the generic to the extent that they can no longer be said to describe any particular purveyor or user. It is not enough to merely show some use; the Defendant, on whom this burden lies, must show use by the trade that is extensive.¹⁶ This has been settled law for over five decades. In 1960, the Supreme Court in *Corn Products Refining Co. v Shangrila Food Products Ltd.*¹⁷ held:

“... It is clear, however, from that case, as we shall presently show, that before the applicant can seek to derive assistance for the success of his application from the presence of a number of marks having one or more common features which occur in his mark also, **he has to prove that these marks had acquired a reputation by user in the market ...**”

“... We may also refer to *in the matter of an application by Harrods Ltd. to Register a Trade Mark in Part B of the Register* mentioned in the quotation from Beck, Koller & Co’s case set out in the preceding paragraph. It was there said (p. 70):

¹⁶ *Pidilite Industries Ltd v Sai Associates & Ors.*, 2004 (28) PTC 193 (Bom); *Serum Institute, supra.*

¹⁷ 1960 (62) Bom. LR. 162

“Now it is a well recognized principle that has to be taken into account in considering the possibility of confusion arising between any two trademarks, that, where those two marks contain a common element which is also contained in a number of other marks in use in the same market, such a common occurrence in the market tends to cause purchasers to pay more attention to the other features of respective marks and to distinguish between them by those other features. This principle clearly requires that the marks comprising the common element shall be in fairly extensive use and, as I have mentioned, in use in the market in which the marks under consideration are being or will be used.”

The series of marks containing the common element or elements, therefore, only assist the applicant when those marks are in extensive use in the market. The onus of proving such user is of course on the applicant, who wants to rely on those marks. Now, in the present case, the applicant, the respondent before us, led no evidence as to the user of marks with the common element. What had happened was that Deputy Registrar looked into his register and found there a large number of marks which had either ‘Gluko’ or ‘Vita’ as prefix or suffix in it. Now of course the presence of a mark in the register does not prove its user all. It is possible that the mark may have been registered but not used. It is not permissible to draw any inference as to their user from the presence of the marks on the register.

(Emphasis supplied)

35. In *Charak Pharma Pvt Ltd v Glenmark Pharmaceuticals Ltd.*,¹⁸
Mr. Justice Kathawalla held:

24.1 The aforesaid contention is clearly fallacious. The Hon'ble Supreme Court in the case of *Corn Products Refining Co., vs. Shangrila Food Products Ltd. (supra)*, considered an absolutely identical contention by extracting a passage from *In Re. Harrods' Application*. Following the said passage which was extracted in paragraph 14 of the judgment, in paragraph 15 it was held by the Hon'ble Supreme Court that the series of marks containing the common elements can only assist the defendant when these marks are in extensive use in the market. The onus of proving such user is of course on the person, who wants to rely on the marks. The Hon'ble Supreme Court further held that it is possible that the mark may have been registered but not used and therefore it is not possible to draw any inference as to the user from the presence of the mark on the register.

24.2 The judgment of the Hon'ble Supreme Court in the case of *Corn Products (supra)* had been followed and applied by this Hon'ble Court in various matters relating to infringement and passing off. In the case of *Pidilite Industries vs. S.M. Associates & Ors. (supra)*, this Court in paragraph 58 held that it is not enough to prove that the marks are in use but the burden is to establish that the same is in "extensive use".

36. The list that the Defendant adduces is poor evidence indeed. It is a litany of names and website addresses derived from a casual saunter through an Internet-based search. There is no statement that this information has been in any way verified, or even attempted to be verified. This is a sort of 'lazy sweep', a trawling for data

¹⁸ 2014 (57) PTC 538 (Bom)

without assessment as to accuracy or validity. This is not what the law expects or demands. In its written arguments, the Defendant claims there are 24 outlets with the name ‘Café Madras’. There are not; there are 22 and these have both words in their name.¹⁹ Of these about a half dozen are said to be in Mumbai alone. It is at this point that the sheer casualness of this list becomes egregious. Of the six outlets with the name ‘Café Madras’ said to be in Mumbai, three belong to the Plaintiffs. One (“Old Madras Café”) is closed on an decree obtained by the present Plaintiffs²⁰ (and hence is shown in the accompanying photographs as closed and shuttered). Another is at Colaba; the Plaintiffs do not deny it. But it is said to be a small multi-cuisine restaurant with insignificant sales. The last is said to be at Bhandup but there is nothing produced to show that it even exists. The material relating to establishments outside Mumbai is even more paltry: several are little more than kiosks or roadside vendors, hardly comparable with the Plaintiffs’ and Defendant’s establishments. In fact, none of this is necessary at the interim stage, when a broad overview is enough, and it is sufficient to note that there is not sufficient material, at this *prima facie* stage, to find for the Defendant that the mark is common to the trade. It also matters

¹⁹ The others have one or the other word (either Café or Madras) in their names. Since the Plaintiffs claim no monopoly in the two words taken separately that enumeration is entirely irrelevant.

²⁰ Judgment dated 14th October 2013 in Suit No. 616 of 2013 along with Notice of Motion (L) No. 1444 of 2013, *G. P. Kamath & Co. v Green Oak Hospitality Pvt. Ltd.*

not a whit if the Plaintiffs have not sued any other alleged infringer. “Why me and why not him?” is no defence to an infringer.²¹

37. Is it possible for the Defendant to invoke Sections 30(1) and 30(2) of the TM Act? While Section 29 of the TM Act deals with infringement of trade marks, Section 30 specifies the limits of the effect of a registered trade mark. Section 30, in its entirety, runs thus:

Section 30.—Limits on effect of registered trade mark

(1) Nothing in section 29 shall be construed as preventing the use of a registered trade mark by any person **for the purposes of identifying goods or services as those of the proprietor provided the use—**

- (a) is in accordance with honest practices in industrial or commercial matters, and
- (b) **is not such as to take unfair advantage of or be detrimental to the distinctive character or repute of the trade mark.**

(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;**
- (b) ;

²¹ *Universal Twin Labs v Ranbaxy Laboratories Ltd.*, 2009 (39) PTC 9 (Bom) (DB); *Schering Corporation & Ors. v Kilitch Co. (Pharma) Pvt. Ltd.*, 1994 IPLR 1

- (c)
 - (d)
 - (e) the use of a registered trade mark, being one of two or more trade marks registered under this Act which are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration under this Act.
- (3)
 - (4)

(Emphasis supplied)

38. We are concerned here, if at all, with Sections 30(1) and 30(2)(a). What the first of these, Section 30(1), protects is the use by someone other than the proprietor of a registered mark, where such use is for the purposes of identifying the proprietor of the mark. For instance, a shopkeeper may display items or promotional material with a registered trade mark provided this use identifies the proprietor and the associated goods or services. The shopkeeper may not use that trade mark as identifying the goods or services of someone else. How this can assist the Defendant is unclear. The Defendant is not using ‘*Café Madras*’ to describe his business as a franchise or branch of the Plaintiffs. This is wholly outside the purview of Section 30(1). We must be careful to distinguish the legitimate use under Section 30(1) from the illicit use in passing off, where a defendant masquerades his goods or services as those of a plaintiff. Section 30(1) does not, of course, permit such passing off; it contemplates a narrowly tailored legitimate use by one person of another’s proprietary mark to uniquely identify the mark’s

proprietor's goods or services as those of the proprietor himself. A shopkeeper may display watches, for instance, of various brands, each uniquely showing the mark of its proprietor. He may not pass off his own goods as those of one of these other proprietors.

39. The consequence of accepting Mr. Ajatshatru's submission is that no proprietor of any registered mark gets any protection at all, for anyone else can always use that mark to describe his own competing goods or services as those of the mark's proprietor. This effectively rewrites the TM Act and wipes Section 29 off the statute book.

40. Similarly, Section 30(2)(a) is invoked without purpose. That section allows the use of a mark in relation to goods or services to indicate the kind, quality, purpose, value, geographical origin and so on. This "use of a mark" is not the same as "the use of a mark *as a trade mark*". It is the use of a mark *otherwise* than as a trade mark, i.e., purely for descriptive purposes. Here, the Defendant is using the mark not in any descriptive sense, but as a trade mark. This is obvious from the Defendant's own application for registration. It is hardly plausible to suggest that the Defendant uses 'Café Madras' to indicate descriptively that its services as a Café originate in Chennai or are "Madras-like" (whatever that means).

41. This is equally true of the argument that the Defendant is entitled to invoke Section 35 of the TM Act, a section that says:

"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 of quality of his goods or services."

(Emphasis supplied)

The Section proceeds on the footing that a rival's use of the mark is *bona fide*. If it is not, the Section has no application. Further, if the Defendant does not use the impugned mark in the descriptive sense, i.e., as a trade mark instead, Section 35 again has no role to play. Yet again, the Defendant cannot be said to be using the words '**Café Madras**' descriptively to connote the character or quality of his goods and services. If that were so, the Defendant could not have applied for a registration even of a device of which those words are the prominent, leading and essential feature.

42. Is the Defendant's use of the mark *bona fide*? In the first place, as Mr. Justice Kathawalla held in *Charak Pharma*, once the court in an infringement action finds that the marks are deceptively similar, the honesty of adoption is completely irrelevant. Further, given the longevity of the Kamaths' mark, the Defendant must be deemed to have had knowledge of its existence and market presence. The Defendant was, it is now settled, duty-bound to conduct both a market search and a search in the register. In *Bal Pharma Ltd. vs. Centaur Laboratories Pvt. Ltd. & Anr.*,²² a Division Bench of this

²² (2002) 24 PTC 226 (Bom) (DB)

Court held that where a party uses a mark, even concurrently, without troubling to ascertain whether or not the same mark is the subject matter of another's registration, he 'cannot be heard to complain for he has been using it negligently'; he ought to have taken the elementary precaution of taking a search of the Register to see if there existed a registration in another's name. I understand the words "cannot be heard to complain for he has been using it negligently" to mean that the rival user cannot defend his use of the rival or competing mark by claiming innocence of the other's registration, for it is his duty to check for a prior registration. The *Bal Pharma* court went on to hold, in effect, that if the rival user has indeed taken a search and nonetheless continues his use of the impugned mark, then he puts himself at risk of an action in infringement at the hands of the registered proprietor. To this, delay is no answer.

43. In *Gorbatschow Wodka KG vs. John Distilleries Ltd.*, Dr. Justice Chandrachud (as he then was), said:

"... The fact that the Defendant made enquiries prior to the registration of the mark can provide no answer in the facts of this case. The Defendant is engaged in the same trade and it is impossible to accept that the Defendant would not have been conscious of the shape which was used by the Plaintiff for its bottles of Vodka both internationally and in India. The adoption of the shape by the Defendant is prima facie not honest. Counsel appearing on behalf of the Defendant asserts that the colour of the label adopted by the Defendant is different from that of the Plaintiff. But that again is of no consequence for, if the Defendant were to be allowed to use the bottle, there would

be no control over how the bottle would be used. The Defendant cannot be compelled to use only a green coloured label, nor can the Plaintiff be confined to the use of the label which is blue in colour. **The true test is not as to whether the Defendant took a search from the Design Register.** As the first user of the shape, the Plaintiff was not bound to register it under the Designs Act, 2000. **If the Defendant knew that the bottles of the Plaintiff with a distinctive shape were in the market — as a prudent person in the trade would know upon a diligent enquiry — no amount of search in the Register would bring it within the purview of an honest adoption.**”

(Emphasis supplied)

44. Interestingly, the Defendant does not say whether it ever caused any search to be taken at all. On the contrary, it appears that the examination report of the impugned mark cited the Plaintiffs’ registrations. It is impossible to accept the proposition, therefore, that the Defendant’s adoption of the impugned mark was honest or *bona fide*. The auguries of innocence — a market survey, a search in the trade mark Register — are all missing. The Kamaths’ reputation and goodwill is not so localised that the Defendant, on the claim that it is based in Jalgaon, could possibly have been unaware of it. I will return to this aspect of the matter again shortly.

C2. *Passing Off*

45. How might we test the Plaintiffs' case in passing off? To succeed, the Plaintiffs must show that the Defendant is attempting to masquerade its services as those of the Plaintiffs. Now if the mark a defendant chooses to adopt so nearly resembles in its essentials the mark that the plaintiff can show they have used for a length of time, then confusion, deception and the likelihood of each are inevitable, and the plaintiff must succeed. In this case, there is not only such a similarity. Actual confusion is demonstrated.

46. At this stage, it is worth recalling some of the material cited by the Kamaths in support of their claim to having acquired a considerable reputation and much goodwill. There are, as we have seen, write ups in several popular magazines of a wide public circulation. These are not merely guides to eateries in the city, though there are those too. There are in addition write ups extolling the quality of the food and the service at the Kamaths' Café Madras eatery in Matunga. There are awards. There are laudatory comments on television and in the media. There is at least one international encomium, and it comes from an internationally renowned and highly regarded master chef, Mr. Gordon Ramsay. This is a tribute not in the context of western cuisine but a decidedly uncompromising local cuisine that claims to have remained true to its roots. Therefore, when Mr. Dhond says that his clients' eatery is 'iconic', he is perhaps understating his case. Given the material, it is not, I think, possible to accept the case Mr. Ajatshatru commends, viz., that the Kamath's Café Madras eatery has a very limited and

localised reputation, one that does not travel beyond the narrow frontiers of its immediate vicinity; at best, the city itself. For, if the goodwill and reputation in the Plaintiffs' Café Madras eatery is not geographically limited but travels further, then this is not without consequence. Confusion and deception are then likely, and the adoption of a mark that is confusingly or deceptively similar is apt to cause damage to the Plaintiffs. Mr. Dhond points out that no question arises of a mere likelihood of such damage: that has already occurred and it happened because there was a widely-reported instance in mid-May 2014 of a rat being found in the food served by the Defendants' establishment. This was reported in several leading newspapers (Maharashtra Times; Samna, Punya Nagari, Dainik Baatmandir, Deshdoot, Divya Marathi) as also in at least one Internet edition (Maharashtra Times). These clippings are Exhibits "A" through "G" of the Further Affidavit dated 16th June 2014 filed by the Plaintiffs. Every single one of these clippings refers to the offending establishment only as "Madras Café" or "Café Madras", not as "Lime & Chilli Madras Café" or with anything to distinguish it from being a branch or franchise of the Plaintiffs' eatery in Mumbai. This notoriety and disrepute has directly affected the Plaintiffs, says Mr. Dhond, and it is not difficult to see how or why.

47. I turn now to an aspect of this matter that seems to me to be of signal importance, and that is the question of how a reputation is built and affected with the advent of new modes of communication, specifically the Internet, and the impact of globalisation. In the written brief, Mr. Ajatshatru cites several authorities in support of the proposition that a business's goodwill is generally confined to its

market, i.e., that goodwill has a geographical limitation:²³ these are *Star Industrial Co Ltd v Yap Kwee Kor*;²⁴ *Athlete Foot Marketing Association Inc v Cobra Sports Ltd*;²⁵ *IRC v Muller & Co.'s Margarine Ltd*;²⁶ *Baskin-Robbins Ice Cream Co. v Gutman*;²⁷ and *Panhard et Levassor v Panhard Levassor Motor Co Ltd*.²⁸ Though one cannot fault Mr. Ajatshatru's industry, I do not think it is remotely possible to cull from these authorities the kind of *idée fixe* he suggests. For one thing, all these decisions are of some historicity: the earliest of 1901, the most recent of 1980; every single one of them before the advent of the Internet and the game-changing systemic shifts it has wrought in the way the world does business; indeed, in the way the world sees itself. At least two of them are from a time before the ordinary computers we now so take for granted were even envisioned. The Supreme Court's decision in *N. R. Dongre v Whirlpool Corporation & Anr.*²⁹ is, however, binding. It is also of 1996, much later than the latest of Mr. Ajatshatru's citations on this point, and it explicitly recognizes that it is not in every case that a reputation or goodwill is restricted to a domestic market. In some cases it may extend well beyond.

48. Mr. Dhond's submission is that in these days of wide (and deep) Internet access, it is inconceivable that the Plaintiffs' Café Madras is, as Mr. Ajatshatru would have it, entirely unknown

²³ Paragraphs 3.9 to 3.13 of the written arguments

²⁴ [1976] FSR 256

²⁵ [1980] PRC 343

²⁶ [1901] A.C. 217

²⁷ [1976] FSR 545

²⁸ [1901] 2 Ch 513

²⁹ (1996) 5 SCC 714

outside the city. I believe Mr. Dhond is correct. In earlier times, such a spread of information and knowledge would have been difficult to achieve and perhaps restricted only to the most posh and upper-end eateries. This is no longer true. The proliferation of websites that rank and review popular hotels and eateries puts information not only on desks of users from outside the immediate environs of any particular establishment but makes it available today even on cellphones and handheld devices. There are any number of such sites internationally, and some exclusively for Indian hotels and restaurants. The most popular of these are, possibly, Zomato.com and Burrp.com, among others. That these are used by almost everyone is self-evident. If further proof is needed, it is in this very record, and it is provided by the Defendant itself. For, in its listing of the so-called other eateries with the same name (Exhibit "C" to the Defendant's Affidavit in Reply dated 7th August 2014) 44 of the 51 items are cross-linked by their website addresses to entries and locations at zomato. The others are similar search engines (yellowpages.co.in, plus.google.com, mojostreet.com, timescity.com). Indeed, all the entries save one in this list are cross-referenced to some search engine, the only exception being that of a restaurant in a starred category hotel chain (ITC Hotels' Grand Chola, Chennai); and even that is referenced to a website. All of these are publicly accessible without geographical limitation. If this is so, then there can be no question that the Plaintiffs' reputation is not locally confined, contrary to what Mr. Ajatshatru suggests. Indeed, that suggestion is entirely without any kind of factual material to support it. Now a mere listing on one of these directory-style repositories is perhaps insufficient. On zomato.com, for instance, establishments are listed by area or city. Would that be a

sufficient defence? I do not believe so. For the Kamaths' reputation is not limited to these listings. It extends to a top-ranking in a generalized search on popular search engines. One consequence is that a market search by the Defendant prior to its adoption of the mark was not only possible, but had it been done would undoubtedly have shown the Plaintiffs' mark. A second consequence is that this material constitutes sufficient *prima facie* evidence of prior use by the Plaintiffs and of the extent of their reputation and goodwill. The third consequence follows, viz., damage to the Plaintiffs, their reputation and their goodwill by reason of the Defendant's adoption of the mark and, further, in the facts of this particular case, actual damage as a result of the curious incident of the rat in the *sambar*. It is possible, I think, to use these facets to derive a simple principle: a plaintiff's mark's reputation, goodwill and prior use may be supplemented with Internet-based material. Where such material exists, a rival user is expected to know of it and a defendant may even be deemed to be aware of it. The burden must then lie on the defendant to show that the rival use of the mark is such as would have no effect on the plaintiff's continued use of that mark. The fact that a defendant's mark or goods or service bearing that mark are not easily traceable on such Internet-based material is not enough to discharge that burden; for, evidently, any person adopts a mark only with a view to foster and build a reputation. In addition, where there is sufficient globally-accessible Internet material to show damage or to raise a presumption of damage to the plaintiff by the defendant's use of the mark, the defendant's burden is that much greater. This is in one sense something very like the 'butterfly effect' (we might call it 'the Google paradigm'): an adverse event in one place may well have severe consequences to the proprietor of a mark though he is in

another place altogether. The two users may be separated by much geographical distance. This paradigm is a bridge across that physical space; the illicit use by the rival arcs across geography and affects the claimant. It is also not necessary to show actual damage; where the rival use is such that an ordinary person would not unreasonably associate news of the adverse event in the defendant's goods or services as having happened to the plaintiff, confusion and deception must be held to have been established. It is also no answer any longer to say that because a person has a business such as an eatery (which needs a fixed 'abode') in one town, his reputation travels no further unless it is part of a chain. Nor is Café Madras alone in this. There are evidently many others that enjoy such a reputation.³⁰

49. There is enough material to show *prima facie* that the Plaintiffs have been using the mark '**Café Madras**' for several decades; at least since the early 1950's and possibly earlier. In the plaint and in their various affidavits, the Kamaths have been at some pains to demonstrate their extensive goodwill and reputation. They claim, on this basis, that the mark has acquired a secondary meaning and uniquely connotes their establishment and none other.

50. The answer from the Defendant is only that the two words, taken disjunctively, are commonplace and that, consequently, the Plaintiffs can enjoy no monopoly in the two words taken together. For, according to Mr. Ajatshatru, the combination merely describes

³⁰ The venerable New York Times famously said it was worth travelling across the globe to eat at Mumbai's Trishna restaurant near Kala Ghoda. New Delhi's Dum Pukht too has legendary status even outside that city.

a restaurant or eatery serving a certain type of South Indian cuisine. The Plaintiffs cannot, Mr. Ajatshatru says, monopolize a phrase that is descriptive and generic.

51. This is simply wrong. The reasons are many. As we have seen, the first defence that the phrase is 'common to the trade' is not established. Second, even a generic or descriptive word can, in some situations, acquire distinctiveness. Again, that law is well-settled. Saying that no generic or descriptive word can ever become distinctive in any circumstances is an overbroad generalization. In *Info Edge (India) Pvt Ltd and another v Shailesh Gupta & Anr.*,³¹ a learned single Judge of the Delhi High Court held, citing Halsbury's Laws of England, that it is entirely possible for a word or phrase wholly descriptive of goods and services to become so associated with those of a particular person that their use by another amounts to a representation by the second that his goods or services are those of the first. Although the phrase may be primarily descriptive, it may acquire a secondary meaning connoting exclusively the products or services of a particular person and none other. Lengthy linguistic lucubrations do not always lend themselves to forensic accuracy: where a generic word or expression has acquired distinctiveness and uniquely attaches to the plaintiff and his business over considerable time and a defendant adopts a similar expression as his own, dishonesty and bad faith are self-evident. It is irrelevant whether the competing representation is intentional or otherwise. A combination of two commonplace individually descriptive words may indeed acquire, by dint of long, prior and continuous user in relation to

³¹ 2002 (24) PTC 355 (Del)

specific goods or services, protective rights where the words in question come to be uniquely identified with a particular purveyor.³² The Supreme Court itself has held that the “part of speech” test does not accurately describe case law results.³³ As the Supreme Court pithily put it:³⁴

A descriptive trade mark may be entitled to protection if it has assumed a secondary meaning which identifies it with a particular product or as being from a particular source.

52. Perhaps we might take a step back from these microscopic examinations and consider what precisely is the Plaintiffs’ claim. They have used the mark ‘**Café Madras**’ — those two words taken together — for half a century or more. The expression has come to define them, and it defines them with some degree of exactitude. The written material on record in the form of wide reportage shows this. Is it to be suggested that the phrase is generic, not distinctive in itself but merely distinctive of a certain type of cuisine? A man may adopt a phrase or an expression that contains multiple words, each of which is on its own commonplace and incapable of registration, yet taken together acquire a distinctiveness. He uses this year on year for several decades. He comes to be known by that expression, locally and perhaps even wider afield. Is he to be told by an imitator that all those years count for nothing? That a reputation carefully nurtured and built up is nothing more than dust? That a registration obtained and as yet unchallenged is merely a whisper in the wind? I

³² *Living Media India Ltd v Jitender V. Jain*, 2002 (25) PTC 61 (Del)

³³ *T. V. Venugopal v Ushodaya Enterprises Ltd.*, (2011) 4 SCC 85

³⁴ *Godfrey Philips India Ltd v Girnar Food & Beverages (P) Ltd.*, 2005 (30) PTC 1 (SC)

do not believe that is either the intent or the purpose of this branch of the law. All our cities have their landmark eateries, each with its unique name: Koshy's in Bangalore, Flurys in Kolkata, Gulati in New Delhi. These are undoubtedly unique. But there are others, too, with names that do lend themselves to the sort of vivisection Mr. Ajatshatru commends. Mumbai, for instance, is known for its 'street food', and there are vendors and purveyors of this kind of food who have acquired a reputation, goodwill and distinctiveness. Bhel-puri and pav-bhaji are among Mumbai's street food staples; yet *Vithal Bhel Puri* and *Sardar Pav Bhaji* are unique and distinctive, and there are not two such each. They each connote a single purveyor and none other. It also matters not that *Vithal* and *Sardar* are in themselves nouns and incapable of registration. What Mr. Ajatshatru suggests is that these distinctivenesses must be set at naught when along comes an imitator.³⁵

53. I do not think that the decision of the Delhi High Court in *Lowenbrau AG & Anr. v Jagpin Breweries Ltd & Anr.*³⁶ assists Mr. Ajatshatru in any way. There, an *ex-parte* injunction was vacated, a learned single Judge of the Delhi High Court enquiring into the validity of the registration and also finding that the mark in question did not, as a matter of record, uniquely identify the plaintiff and its goods. The plaintiff adduced scanty material in support of its claim of user. The word in question had been expressly disclaimed as had been a device of a lion. The word spoke of a special kind of beer and was extensively used in that way in Germany for over a hundred

³⁵ Again, the *Bade Miyan* case, *supra*, exemplifies just this sort of distinctiveness.

³⁶ 157 (2009) DLT 791

years. This is hardly an authority for the proposition that in no case can a generic word ever acquire a secondary meaning. Similarly, I do not see how the Court of Appeals' decision in *McCain International Ltd v Country Fair Foods Ltd & Anr.*³⁷ carries the defence any further. That, like *Cadilla Healthcare Ltd v Gujarat Cooperative Milk Marketing Federation & Ors.*³⁸ was a case only in passing off; it did not include an action in infringement. It must also be viewed in its factual context: there was no material before the court that the expression in issue ('**Oven Chips**') had been extensively used for anything more than just over a year or so. The court found that the words had never been used except in conjunction with the name, McCain. The court found that the words 'Oven Chips' were used only to describe a particular kind of article and not its manufacturer. That expression informed the purchaser of what was within the package. It is in this context that the court said that a descriptive name is one that describes the nature of the goods, not their source. Mr. Ajatshatru's extrapolation from this to some universal norm that anything containing two quotidian words is, *ipso facto* and *per se* descriptive is untenable. This is equally true of Mr. Ajatshatru's reliance on the decision in *My Kinda Town v Soll*³⁹ where the court found that the product in question ("Chicago Pizza") was only ever used descriptively. The decision in *Food World v Food World Hospitality Pvt Ltd.*⁴⁰ to the effect that descriptive marks enjoy a lower degree of protection does not lay down any generalized principle that no mark such as the Plaintiffs' in this case can ever be

³⁷ 1981 RPC 69

³⁸ *Supra.*

³⁹ 1983 RPC 407

⁴⁰ 2010 (42) PTC 108 (Del)

distinctive. It only says that, generally, descriptive marks enjoy a lower degree of protection. There is no quarrel with this proposition.

54. Have the words ‘**Café Madras**’, *prima facie*, come to be uniquely associated with the Plaintiff? On the material before me it would be difficult to hold that they have not. The Defendant would need to establish far more than it has to show otherwise. The countervailing evidence from the Plaintiffs is formidable indeed.

D. THE DEFENDANT’S WRITTEN ARGUMENTS

55. Mr. Ajatshatru’s oral arguments were restricted to the issues I have dealt with. The written brief of arguments is considerably more expansive and covers material not urged. It is more than somewhat debilitating in its length. Unfortunately, much of it is irrelevant. For instance, I find that a good third of the brief is a needless and misdirected disquisition on grammar and syntax that proceeds on the entirely incorrect supposition that the Plaintiffs claim a monopoly in each of the two words ‘**Café**’ and ‘**Madras**’. They do not. In any case, the Plaintiffs’ mark is registered and Mr. Ajatshatru specifically conceded that the Defendant does not seek to re-open that registration. Even if this is permissible, following the decision of the Full Bench, this can only be in the most compelling circumstances. These do not exist in the present case.

56. Worse yet, the written arguments brief exemplifies a practice to be deprecated. Sprawling over 60 pages, the written brief cites more than 30 authorities and texts, though only half a dozen were actually ever cited. The written brief includes arguments not once made at the Bar. A statement expressly made and noted that the Defendant was not impeaching the validity of the Plaintiffs' registration has been sought to be substituted with a challenge never made. Statements of fact not on affidavit have been included, as have allegations made for the first time: for instance, that the decree obtained on 14th October 2013 against Green Oak Hospitality was got by fraud and was wrongful. That decree is no concern of the present Defendant. I see no reason to trouble myself at the ad-interim stage with a consideration of a welter of case law that does not in any way advance the cause of either side. I have dealt with the Defendant's authorities to the extent I have thought necessary. I do not propose to deal with the rest merely because they are included in the written brief. Further, so indiscriminate is the citing of these authorities that several are actually against the Defendant: *Bade Miyan*, as I have already noted, and, too, *Godfrey Philips* as also *Heinz Italia & Anr. v Dabur India Ltd.*⁴¹ In *Heinz*, an injunction was granted despite the objection that the mark in question was 'generic', precisely the argument taken by the Defendant in this case. Other decisions cited by the Defendant only state well-established propositions but without discernible application: *Regional Manager & Anr. v Pawan Kumar Dubey*⁴² and *Sanjay Singh*

⁴¹ (2007) 6 SCC 1

⁴² (1976) 3 SCC 344

& *Anr. v UP Public Services Commission*,⁴³ both cited for a principle on *stare decisis*.⁴⁴ Still others are clearly distinguishable: *Burberrys v Cording*,⁴⁵ where the word in question was used prior to the plaintiff's adoption of it; *Asian Paints Ltd v Home Solutions Retail (India) Ltd.*,⁴⁶ where the rival marks were found to be totally at variance; and *Marico Ltd v Agrotech Foods Ltd.*,⁴⁷ where the Delhi High Court examined the validity of the plaintiff's registration to arrive at a conclusion, something that, given the decision of our Full Bench, I am unable to do in this case. There are other authorities, too, cited willy-nilly. It is not, in my view, necessary to deal with these in any detail as they do not affect the outcome. There are some that, to my very great surprise, are cited in support of some argument of 'suppression' and 'fraud'. No such argument was ever advanced at the Bar and it is wholly improper to include this material in the written brief. There is no 'fraud' pleaded anywhere and, given the Defendant's conduct, it hardly lies in the Defendant's mouth to make such an allegation.

57. The well known tests for a case in passing off are met even on the authorities cited by the Defendant: *Cadilla Healthcare Ltd v Cadilla Pharmaceuticals Ltd.*,⁴⁸ for instance.⁴⁹ The rival marks or

⁴³ (2007) 3 SCC 720

⁴⁴ Paragraph 2.38 of the written brief.

⁴⁵ (1909) 26 RPC 693

⁴⁶ 2007 (35) PTC 697

⁴⁷ 2010 (44) PTC 736 (Del)

⁴⁸ (2001) 5 SCC 73

⁴⁹ Similarly *Tan-Ichi Co Ltd v Jancar Ltd.*, [1990] FSR 151 : a colourable motive, a slavish imitation, want of consent; *N. R. Dongre v Whirlpool Corp.*, (1996) 5 SCC 714 on reputations not being necessarily subjected to geographical limitations.

names are deceptively similar (in my view, indistinguishable). They are used in the same field of service. They cater to the same demographic. The Plaintiffs have an established reputation built up over a period of more than half a century. Deception and confusion are inevitable and, along with damage to the Plaintiffs, have actually taken place.

E. DELAY AND BALANCE OF CONVENIENCE

58. In cases such as this, delay on its own, unaccompanied by acquiescence, is no answer to an application for an injunction in an action in infringement and passing off.⁵⁰ In *D. R. Cosmetics Pvt. Ltd. & Anr. v J.R. Industries*,⁵¹ Dr Justice Chandrachud (as he then was) summarized the law thus:

15. The question as to whether a delay on the part of a Plaintiff in approaching the Court in an action for infringement or passing off is of such a nature and magnitude and in such circumstances as would disentitle the Plaintiff to relief cannot be determined on the basis of *a priori* considerations. The principle which underlies the concept of acquiescence is that a person who sits by indolently when another is invading his right cannot be heard to complain when by his acts and conduct he leads the other to substantially alter his position. As far back as in the year 1880, in a judgment of the Chancery Division in *Willmott v. Barber* (1880) 15 Ch. D. 96 it was held that

⁵⁰ *Midas Hygiene Industries v Sudhir Bhatia*, 2004 (28) PTC 121 (SC)

⁵¹ 2008 (38) PTC 28 (Bom)

an acquiescence which will deprive a man of his legal rights must amount to a fraud for, a man ought not to be deprived of his legal rights unless he has acted in such a way as would make it fraudulent for him to set up those rights. One of the essential ingredients of the doctrine of acquiescence is that the possessor of the legal rights must have encouraged his adversary in expending money or in doing some other acts which he has done either directly or by abstaining from asserting his legal rights.

(Emphasis supplied)

59. Recently, in *Medley Pharmaceuticals Ltd v Twilight Mercantiles Ltd.*,⁵² I had occasion to consider this issue, and the decision of the Delhi High Court in *Hindustan Pencils Pvt. Ltd. v. India Stationery Products Co. & Anr.*:⁵³

33. Similarly on the issue of delay, the Delhi High Court in *Hindustan Pencils (P) Ltd. vs. India Stationery Products Co. & Anr.* : AIR 1990 Delhi 19 has also held that **delay by itself is not a sufficient defence to such an action especially where the use by the defendants is fraudulent.** In *Hindustan Pencils*, the Delhi High Court considered the question of acquiescence and held that, **in law, the question arises where the proprietor of a mark, being aware of his rights, and being aware that the infringer may be ignorant of them, does some affirmative act to encourage the infringer's misapprehension so that the infringer worsens his position and acts to his detriment. A mere failure to sue without a positive act of encouragement is no defence and is no acquiescence. A defendant who infringes the plaintiffs' mark with knowledge of that mark**

⁵² 2014 (60) PTC 85 (Bom)

⁵³ AIR 1990 Delhi 19

can hardly be heard to complain if he is later sued upon it. A defendant who begins an infringement without searching the trade marks register is in no better a position. One who does take a search, finds the plaintiffs' mark and nonetheless continues his act of infringement is, however, certainly much worse off. Certainly he cannot allege acquiescence. That door is closed to him.

(Emphasis supplied)

60. There is no question of delay on the part of the Plaintiffs. This defence rests solely on the Defendant's claim to user since 2004 and of this, as we have seen, there is no evidence. This litigation at the interim stage has taken over two years. The Defendant has filed numerous affidavits and a copious set of written arguments. Yet there is no material to show this alleged user. What little it does show is since 2006/2007 and that is itself dubious at best. The Plaintiffs have moved in good time. There is no question of any delay defeating the Plaintiffs.

61. Have the Plaintiffs made out a sufficiently strong *prima facie* case? I would say so. Is the balance of convenience in their favour? Again, the answer must be yes. It is no answer to say that the Plaintiffs have not moved against every infringer or that there are other imitators in play. The Defendant's claim to *bona fide* concurrent user is not established. On the other hand, the damage to the Plaintiffs by the Defendant's user is so established, and it is no longer merely in the realm of possibility.

F. FINAL ORDER AND CONCLUSION

62. In these circumstances, the Notice of Motion is made absolute in terms of prayers (a) and (b). Mr. Khandekar, learned Counsel for the Plaintiffs, says on instructions that prayer (c) for the appointment of a Court Receiver is not pressed.

63. At the request of Mr. Ajatshatru, the operation of this order is stayed for a period of three weeks from today.

(G.S. PATEL, J.)