

IN THE HIGH COURT OF KERALA AT ERNAKULAM

PRESENT:

THE HONOURABLE MR.JUSTICE THOTTATHIL B.RADHAKRISHNAN
&

THE HONOURABLE MR. JUSTICE SUNIL THOMAS

WEDNESDAY, THE 5TH DAY OF AUGUST 2015/14TH SRAVANA, 1937

FAO.No. 226 of 2014 ()

(AGAINST THE ORDER DATED 28/2/2014 OF THE VTH DISTRICT COURT AT
ERNAKULAM IN I.A.NO.4231/2013 IN O.S.NO.29/2013)

DEFENDANT/PETITIONER:

KANNAN KRISHNAKUMAR,
ASIAN DOSAS, TC 42/84, SRI. VILAS
VALLAKADAVU.P.O., THIRUVANANTHAPURAM-695008.

BY ADVS.SRI.S.SAJU
SRI.P.M.SHAMEER

PETITIONERS/PLAINTIFFS:

1. M/S PAI BROTHERS-36 VARIETIES OF DOSAS,
DOOR NO. 40/8774A, PAI BROTHERS BUILDING,
PAI BROTHERS LANE, M.G.ROAD
ERNAKULAM, A PARTNERSHIP FIRM REPRESENTED BY ITS
MANAGING PARTNER MR. SHIVANANDA PAI.

2. M/S. PAI THATTU DOSA,
DOR NO. 50/2344A, GROUND FLOOR, A.S. TOWEERS
NH-17, EDAPPALLY
ERNAKULAM REPRESENTED BYH ITS MANAGING PARTNER
MR. PRADEEP S. PAI.

3. SIVANANDA PAI,, AGED 58 YEARS
S/O. PADMANABHA PAI,
RESIDING AT CHERUKARAYATHU PARAMBU HOUSE
KRISHNASWAMY ROAD, PULLEPADY, ERNAKULAM.

4. PRADEEP.S. PAI,, AGED 34 YEARS
S/O. PURUSHOTHAMA PAI
RESIDING AT CHERUKARAYATHU PARAMBU HOUSE
KRISHNASWAMY ROAD, PULLEPADY, ERNAKULAM.

5. SUMESH.N. PAI, AGED 35 YEARS,
S/O. NARASIMHA PAI
RESIDING AT CHERUKARAYATHU PARAMBU HOUSE
KRISHNASWAMY ROAD, PULLEPADY, ERNAKULAM.

6. GANESH.S. PAI, AGED 25 YEARS,
S/O. SHIVANANDA PAI
RESIDING AT CHERUKARAYATHU PARAMBU HOUSE
KRISHNASWAMY ROAD, PULLEPADY, ERNAKULAM.

R4 BY ADV. SRI.BABU KARUKAPADATH
R4 BY ADV. SMT.M.A.VAHEEDA BABU
R4 BY ADV. SRI.K.A.NOUSHAD
R4 BY ADV. SRI.P.U.VINOD KUMAR
R-R4 BY ADV. SRI.KANDAMPULLY RAHUL
R4 BY ADV. SRI.MITHUN BABY JOHN
R4 BY ADV. SRI.J.RAMKUMAR

THIS FIRST APPEAL FROM ORDERS HAVING BEEN FINALLY HEARD ON
16-06-2015, THE COURT ON 5/8/2015 DELIVERED THE FOLLOWING:

FAO NO. 226/2014

APPENDIX

ANNEXURE A1: COPY OF THE PLAINT IN O.S. 29/2013 DATED 8/10/2013

ANNEXURE A2: COPY OF THE I.A. NO.4231/2013 FILED BY THE PLAINTIFFS
DATED 7/10/2013.

ANNEXURE A3: COPY OF THE COUNTER AFFIDAVIT FILED BY THE PETITIONER IN
I.A. 4231/2013 IN O.S. NO.29/2013 DATED 9/12/2013

ANNEXURE A4: COPY OF THE COMMISSION REPORT GIVEN BY THE ADVOCATE
COMMISSIONER IN I.A. NO.4232/2013 IN O.S. 29/2013 DATED 15/11/2013.

ANNEXURE A5: COPY OF THE ADDITIONAL COMMISSION REPORT DATED 1/01/2014.

/TRUE COPY/

P.S. TO JUDGE.

**THOTTATHIL B. RADHAKRISHNAN &
SUNIL THOMAS, JJ.**

F.A.O. No. 226 of 2014

Dated this the 5th day of, August 2015

JUDGMENT

Sunil Thomas, J.

The sole defendant/respondent aggrieved by the temporary prohibitory injunction granted against him, by order in I.A. No.4231/2013 in O.S. No.29/2013 of the District Court, Ernakulam has preferred this appeal.

2. The plaintiffs/petitioners 1 and 2 are partnership firms run by the plaintiffs 3 to 6, who were the members of a family and were dealing with the family business of running restaurant/hotel, specialized in the making and sale of different varieties of dosa. They claimed that, in the course of their business, they conceived, invented and coined two trade names in the year 1986 as "Pai Dosa" and "Pai Thattu Dosa". The business was started about 27 years back as a road front stall and the above trade names/trade marks have been used by them since then. The business, especially that of making and sale of different varieties of dosa, under the above trade marks, have increased substantially and they have different branches in Ernakulam district. Due to the quality of service,

extensive use of trade mark and amount spent by them, the above logo and the trade name have acquired and earned high reputation and good will among the customers and public. They have spent huge amounts on advertisement and business promotion. By virtue of long, extensive and continuous use of trade marks and logo, it has achieved high reputation and goodwill and is identified by the customers and public with their business, especially regarding different varieties of dosa. In the meanwhile, they obtained registration under the Trade Marks Act, 1999 for their trade marks/logo as “Pai Brothers Fast Food 36 Varieties of Dosas” and “Pai Thattu Dosa”. No other person is entitled to use the above logo and trade marks or use any logo or trade name identical or deceptively similar to that of the plaintiffs in any of their business establishments or any advertisements. While so, it was understood that the respondent/defendant has started a hotel business recently at Thiruvananthapuram, under name and style “Asian Dosas Pai Dosas”. He has adopted and is using the trade mark 'Pai Dosa,' exactly as that of the plaintiffs and has exhibited boards in his shops at Thiruvananthapuram exhibiting trade mark 'pai dosa'

for promoting his business in various varieties of dosa. The trade mark/trade name used by the defendant is deceptively similar to that of plaintiffs and is used for identical business of making and selling different varieties of dosa. The above trade name used by the defendant is phonetically, visually and structurally similar to trade marks and trade names of the plaintiffs. The above name will create false impression and misunderstanding in the minds of ordinary persons of average intelligence and imperfect recollection. They have been passing off their goods as that of the plaintiffs. In the above circumstances, they are liable to be enjoined by an order of temporary prohibitory injunction.

3. The defendant/respondent in his counter affidavit denied the various allegations. It was contended that the trade using the name "Pai Dosa" or "Pai Thattu dosa" alleged to have been started in 1986 was misleading and without any factual basis. It was contended that they cannot claim trade mark right over the names of 'Pai dosa' and 'Pai Thattu dosa' since "Pai" is a common surname amongst the Gowda Saraswat Brahmins in India. The above name is a public juris and in prior use by various

persons. The word 'Thattukada' also derives its name from the 'dosa thattu' which is the iron plate used for making dosas. The plaintiffs could not have claimed exclusive ownership regarding the user of Pai Dosa and Pai Thattu Dosa. The registration obtained by them was intended to mislead. A rectification petition has been filed by the defendant before the Registrar of Trade Marks and is pending. The contention that the defendant has committed passing off and has used the trade name of the plaintiffs was incorrect. The defendant is a proprietary concern under the name and style of "Asian Dosas Pai Dosas" engaged in the business of various varieties of dosa. He has coined the word 'Pai' from the first alphabet of the names of his mother and grandmothers. The trade name "Asian Dosas Pai Dosas" is quite popularized by the defendant and by virtue of it, the trade mark is the exclusive trade property of the respondent. The trade mark has become popular, as a result of it being in the market for long, due to varieties of high quality dosas made by the defendant. It was understood that the plaintiffs have registered a similar trade mark and was involved in passing of goods and services as that of the defendant. Hence, the rectification

petition was filed by him and is pending before the concerned authorities. Hence, the defendant is not liable to be enjoined. The plaintiffs were trying to encash the reputation, popularity and credibility and acceptability of the business and services of the defendant.

4. The court below, on evaluating the pleadings of the parties and counter affidavits and Exhibits A1 to A5 marked on the side of the plaintiffs, Exhibits B1 to B7 on the side of the defendant and Ext.C1 to C3 commission reports and photographs, concluded that the plaintiffs were prima facie entitled for an injunction and granted a temporary injunction restraining the defendant from using the trade name/trade mark or logo of the plaintiffs as “Pai Dosa” or “Pai Thattu dosa” till the disposal of the suit.

5. This is assailed in this appeal. Heard both sides and examined the records.

6. Ext.A5 is the registration certificate issued to plaintiffs, dated 13/6/2006 with effect from 25/10/2004 in relation to the trade name “Pai brothers fast food 36 varieties of dosa”. The plaintiffs have a case that the name 'Pai Thattu dosa’ has also

been granted certificate of trade mark by the concerned authorities, though a certificate was not produced before the court below. However, at the appellate stage I.A. No.1465/2014 has been filed to receive the above certificate, as additional evidence. However, the fact that they have obtained this trade mark registration is not seriously disputed. Virtually, it is admitted by the defendant that he has filed a rectification application before the Registrar of Trade Marks in relation to the above trade marks. The first plaintiff is claimed to be the business concern under the name and style of "Pai Brothers 36 varieties of Dosa" with the 3rd plaintiff as its managing partner. The second plaintiff is M/s.Pai Thattu Dosa with the 4th plaintiff as its managing partner. Admittedly, the defendant is running a restaurant under the name Asian Dosas Pai Dosas". The specific case of the plaintiffs is that they started the business of dosa in 1986. The defendant has not specifically denied this and the only contention was that, the statement of the plaintiffs in this regard was misleading and without any factual basis. Further, it is on record that the plaintiffs have obtained trade name registration with effect from 2004.

7. The definite contention of the defendant was that the plaintiffs were not entitled to claim exclusive user of words "Pai" or "Thattu" or "Dosa" independently or any of its combination with other terms. According to him, the above three terms are common generic terms and nobody can claim exclusive right over the above terms. It was also contended by the defendant that he himself has coined the term 'pai'. Though this contention is seen set up, there is absolutely no evidence as to when the defendant has started his business. On the other hand, the case of the plaintiffs is that the defendant started the business some time in 2013. There is no evidence to show that the defendant is the prior user of term 'Pai" independently or in combination with other words.

8. Even though the plaintiffs' contented that nobody can claim exclusive trade mark rights over the three terms 'pai' 'thattu' and 'dosa' independently or in combination with other expressions on the ground that they are common generic terms, he has set up a highly contradictory claim that he is entitled to use the word ' pai dosa' and claimed exclusive right over it. In other words, the defendant while contenting that no person can

claim exclusive right over any of the above three terms, himself is claiming exclusive right in using the term 'pai dosa', which cuts at the root of his very contention that the plaintiffs are not entitled to claim that, being a common term.

9. Another contention of the defendant is that the term "Pai" is the surname of Gowda Sarswat Brahmin and no person can claim exclusive right of over it. That very contention is detrimental to his own contention that the very term has been coined by him from the first alphabet of his mother and grand mother. In other words, he who contends that the term "Pai" cannot be exclusively claimed by any person, himself is claiming exclusive right over the term "Pai". In the above circumstances, the contention of the plaintiffs that no person can claim exclusive right over the terms "Pai" or "thattu" or "dosa" independently or in combination with other words is only to be rejected.

10. The allegation of the plaintiffs is that the defendant by using a trade name, which is similar or deceptively similar to his registered trade name, has committed passing off. On the other hand, the case of the defendant is that he is entitled to claim exclusive trade right and he himself has coined the word "Pai".

This contention, as mentioned earlier, will take away all his defences since he himself admits that both the trade names are same and one is deceptively similar to the other. It is precisely on that ground that the defendant has sought rectification of the trade mark registration in favour of plaintiff. Hence, an enquiry as to whether the trade name used by the defendant is similar or deceptively similar to that of plaintiff is redundant.

11. The Supreme Court in various decisions has held that in case of proved of passing off, injunction can be granted. In **Heinzitalia v. Dabur India Ltd.**(2007 (6) SCC page 1), the Apex Court held that in the case of unregistered trade mark, passing off action is maintainable. Passing off action depends upon the principle that nobody has a right to pass his goods as goods of some body. In **Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.** (2001) 5 SCC 71), after analyzing all the earlier case laws, Supreme Court held that in passing-off action, while the question of deceptive similarity is being considered, it is the similarity, and not the dissimilarity between the nature and character of words that is crucial. It was held that the question has to be approached from the view point of an Indian

of ordinary intelligence and imperfect recollection .

12. There is absolutely no evidence to show that the defendant by long usage had acquired a trade right so as to defeat the claim of the plaintiffs who had prima facie established that he has been using that name at least since 2004 and has obtained registration. It is also an admitted fact that both are doing same business and are in the same field of activity and thereby doing competitive business. Evidently in such circumstances, if the trade name of the plaintiffs is used by the defendant, though it may not be with the intention of diverting the clients of the plaintiffs or to create confusion in the minds of the customers that the defendant's business is one run by the plaintiff firm, but it has the propensity of misleading the client. The defendant had a case that the area of operation of the plaintiffs and the defendant are two different far away places. According to the defendant, the plaintiffs have confined their business at Ernakulam, whereas the defendant had his shop at Thiruvananthapuram. It was contended that the customers in Thiruvananthapuram will not mislead to believe that it was a firm run by the plaintiffs at Ernakulam and hence there was no

question of deception and might not also divert the possible clients of the plaintiffs.

13. However, Exts. A1 to A3 are the newspaper reports which are indicative of the volume of business. Exts.A1 and A2 are two local news items one of which indicates that the plaintiffs have branches at Ernakulam, had earned good reputation through out the State and are extending its activities abroad. Ext.A3 is the newspaper item reported from Bangalore. Though at interlocutory stage, Exts.A1 to A3 Ext.A3 fairly indicates that the establishment of the plaintiffs have earned considerable reputation. Above all, it is on record that the rectification application has been filed on the ground that the defendant has conceptualized and popularised the term 'pai dosa' and is his exclusive intellectual property and by obtaining trade name registration, the plaintiffs have injured his business. This appears to be a double edged defence, since that contention itself show that the user by the one affects the business of other. Then the question narrows down as to who is entitled to use the trade name .

14. One of the main contention of the defendant was that

since rectification application is pending, he is entitled to retain his trade name, till the question is adjudicated by the competent authority. It is pertinent to note that the plaintiffs have obtained registration and the rectification application is still under consideration. Pendency of the rectification application cannot be a bar in granting an injunction.

15. The evaluation of the above facts lead to the definite finding that the court below was justified in concluding that a prima facie case has been made out and the balance of convenience favoured granting of injunction, failing which damage would be caused, which cannot be compensated in terms of money. The finding arrived at by the court below is supported by materials on record. We find no reason to take a different view.

In the light of the above, the appeal fails and the same is dismissed confirming the interim order of injunction granted by the court below. No costs. Sd/-

THOTTATHIL B.RADHAKRISHNAN

Judge

Sd/-

SUNIL THOMAS

Judge

/true copy/ PS to Judge.

dpk

