

N IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 21.08.2018

CORAM :

THE HONOURABLE MR. JUSTICE M.SATHYANARAYANAN

AND

THE HON'BLE MR. JUSTICE N.SESHASAYEE

O.S.A.No. 21 of 2017

and

C.M.P.Nos.1774 and 4411 of 2017

and

O.S.A.No.29 of 2017

and

C.M.P.Nos.4412 and 2824 of 2017

B.Vivekananthan,
Sole Proprietor,
Trading as Moonrakers Restaurant,
No.34, Othavadai Street,
Mamallapuram,
Tamil Nadu - 603104. Appellant in both Appeals

Vs.

1.B.Anandan,
Trading as Anand's MOONRAKERS RESTAURANT
31/6, Anderson Road,
Nungambakkam,
Chennai - 600 006.

2.B.Anandan,
Trading as Anand's Moonrakers,
No.46, Othavadai Street,
Mamallapuram,
Tamil Nadu - 603 104. Respondents in both Appeals

Common Prayer:- These Appeals are filed under Order XXXVI Rule 9 of O.S.Rules read with Clause 15 of the Letters Patent, to allow the present O.S.As., by setting aside the fair and decretal order dated 23.01.2015 in O.A.Nos.794 and 795 of 2014 in C.S.No.646 of 2014 on the file of this Hon'ble Court.

For Appellant : Mr.Bharath
For Respondents : Mr.Jeenasenan

COMMON JUDGMENT

[Judgment of the Court delivered by M.SATHYANARAYANAN,
J.,]

By consent, both the appeals are taken up and disposed of by this common judgment.

2. The appellant herein is the plaintiff in C.S.No.646 of 2014 and the applicant in O.A.Nos.794 and 795 of 2014.

3. The suit is filed for the following reliefs:

'a) To grant a permanent injunction restraining the Defendants, their directors, employees, officers, servants, agents and all others acting for and on their behalf from rendering service for providing food and drink; temporary accommodation; restaurant; bar and catering services; provision for holiday accommodation; booking and reservation services for restaurants and holiday accommodation and in any other manner, directly or indirectly, under the mark Anand's MOONRAKERS and/or any other mark deceptively similar thereto amounting to infringement of the Plaintiff's registered trademarks "MOONRAKERS" under registration number 2239422 in Class 43;

b) To grant a permanent injunction restraining the defendants, their directors, their directors, employees, officers, servants, agents and all others acting for and on their behalf from rendering service for providing food and drink; temporary accommodation; restaurant; bar and catering services; provision for holiday accommodation; booking and reservation services for restaurants and holiday accommodation and in any other manner, directly or indirectly, under the mark Anand's MOONRAKERS and/or any other mark deceptively similar thereto amounting to passing off the defendant's goods or business or services as those of the Plaintiff.

c) To grant order of delivery up of any brochures/printed material and/or any material which contributes ultimately to the

infringement of the plaintiff's trademarks ;
d) To direct the defendant for rendition
of accounts.'

4. The appellant/plaintiff, pending disposal of the suit, filed O.A.Nos.794 and 795 of 2014 praying for an order of ad-interim injunction restraining the defendants, their directors, employees, officers, servants, agents and all others acting for and on their behalf from rendering service for providing food and drink; temporary accommodation; restaurant; bar and catering services; provision for holiday accommodation; booking and reservation services for restaurants and holiday accommodation and in any other manner, directly or indirectly, under the mark Anand's "MOONRAKERS" and/or any other mark deceptively similar thereto amounting to infringement of the plaintiff's registered trademarks MOONRAKERS under registration number 2239422 in Class 43.

5. In the application for injunction is in respect of infringement of the trademark, originally, an exparte order of ad-interim injunction was granted on 10.10.2014 and an exparte order of interim injunction was granted in respect of passing-off also. Thereafter, the respondents/defendants had entered appearance and filed applications for vacating the interim orders.

6. The respondents/defendants pending disposal of the applications filed for vacating the interim orders, filed two affidavits of undertaking dated 08.01.2015 and 13.01.2015. The learned Judge, after taking note of the said affidavits of undertaking, especially the stand of the respondents that they will not use the word "MOONRAKERS", dismissed both O.A.Nos.794 and 795 of 2014 and aggrieved by the same, the appellant/plaintiff/applicant has filed these appeals.

7. The respondent/defendant is none other than the younger brother of the appellant/plaintiff/applicant and it is the case of the plaintiff that in a bid to establish the business for their livelihood, he and his elder brother started "MOONRAKERS RESTAURANT" in the year 1994 at Door No.34, Othavadai Street, Mamallapuram and the appellant/plaintiff/applicant honestly adopted the trademark "MOONRAKERS" way back in the year 1990. On account of tasteful ambience and providing quality food, it became an immediate hit and also gave varieties of food. The word "MOONRAKERS" is also registered vide application No.2239422 in Class 43. It is also the case of the appellant/plaintiff/applicant that subsequently on

02.08.2011, the defendant filed a trademark application under No.2184208 in Class 43 knowing pretty well about the prior adoption and use of the mark "MOONRAKERS" for several decades and the plaintiff opposed the same under opposition No.MAS-799204. An order came to be passed as to the abandoning of the application for non-filing of counter in time and as such the respondents/defendants cannot use the word "MOONRAKERS" and therefore, prayed for interim injunction. However, the claim of the appellant/plaintiff/applicant was strongly opposed by the respondents/defendants by filing a common counter affidavit stating that they also played their part in creating new dishes and in fact, in the website, phone number alone of B.Anandan was given and by way of after thought, the plaintiff has filed an application for registration of trademark and he has also filed rectification petition, vide Form 26 of the Act against the Trademark Registration of the respondents/defendants and the same is still pending.

8. It is further averred in the common counter that the appellant/plaintiff/applicant did not object the use of the word "MOONRAKERS" by his elder brother namely B.Shanmuganandan, and the present suit is filed by him on account of prejudice and exhibiting disparity, despite the fact he (Mr.B.Anandan) has played a very major role, and therefore, prayed for vacating the interim order.

9. Pending adjudication of the applications for ad-interim injunction and applications for vacating the interim orders, the respondents/defendants had filed two affidavit of undertakings dated 08.01.2015 and 13.01.2015 respectively and it is relevant to extract the same :

AFFIDAVIT OF UNDERTAKING

I, B.Anandan, son of B.M.Bujangaraj, Hindu, aged about 39 years, residing at No.179, 2nd Cross Street, T.K.M.Road, Mamallapuram, having come down to Chennai, do hereby undertake the following :

- 1) I am Defendant(s) in the above mentioned suit. I have started a Restaurant in Anderson Road, Nungambakkam, Chennai by the name of "Mahabs Moonrocks".
- 2) I undertake that I will not use the name "Moonrakers" for the purpose of running my restaurant situated in Nungambakkam, Chennai. I also undertake not to use the name "Moonrakers" in the Boards, Menu Cards, Bills, etc., in relation to my restaurant in Nungambakkam, Chennai.

Therefore, it is humbly prayed that this Hon'ble Court may record this undertaking and thus render justice.

Solemnly affirmed at Chennai)
this the 8th day of Jan.2015)
and signed his name in my)
Presence.)

BEFORE ME

AFFIDAVIT OF UNDERTAKING

I, B.Anandan, son of B.M.Bujangaraj, Hindu, aged about 39 years, residing at No.179, 2nd Cross Street, T.K.M.Road, Mamallapuram, having come down to Chennai, do hereby undertake the following :

- 1) I am Defendant in the above mentioned suit and the respondent in the applications.
- 2) I am running a restaurant in Mamallapuram in the name of "Anand's MoonRakers".
- 3) I undertake to change the name of the above restaurant as "MAHAB'S MOONROCKS" with the following words to be written in small letters in brackets underneath "a unit of moonrakers" with effect from 15.01.2015. I undertake not to use the word mark Moonrakers in the board, menu cards, bill, etc., in relation to my restaurant in Mamallapuram.

Therefore, it is humbly prayed that this Hon'ble Court may record this undertaking and thus render justice.

Solemnly affirmed at Chennai)
this the 13th day of Jan.2015)
and signed his name in my)
Presence.)

BEFORE ME

10. The learned Judge in the impugned common order, after extracting the facts, had taken into consideration the affidavits of undertaking in Paragraph No.19 and observed that since the defendant had undertaken to change the name of his restaurant as "MAHAB'S MOONROCKS" instead of "MOONRAKERS", which name is not deceptively similar to that of the plaintiff's trademark, formed the opinion that there is no need for continuing the interim injunction already granted and vacated interim injunction granted in O.A.Nos.794 and 795 of 2014 dated 10.10.2014.

11. Mr.Bharath, learned counsel for the appellant/plaintiff submitted that the purpose of affidavits of undertaking is not to use the mark "MOONRAKERS" and however, the respondent seeks to include the word "a unit of moonrakers" beneath/below "MAHAB'S

MOONROCKS" and the learned Judge has failed to advert to the said fact, and therefore prays for interference.

12. Per contra, Mr. Jenaseenan, learned counsel appearing for the respondents/defendants has drawn the attention of this Court to the common counter affidavit and would state that the respondents/defendants had also played an equal and important role in developing the business and being his brother, the appellant/plaintiff should have shown some compassion and in fact, he exhibited the same in favour of his elder brother B. Shanmuganandan. The learned counsel further submitted that since the mark namely "MAHAB'S MOONROCKS" is primarily visible with the word "a unit of moonrakers" sought to be used beneath the same, would not affect the alleged right of the appellant's/plaintiff's mark "MOONRAKERS". The learned counsel for the respondents/defendants would further submit that though the impugned order came to be passed as early as on 23.01.2015, the appeals came to be filed belatedly and came to be numbered only two years thereafter, the respondents/defendants continue to use the mark "MAHAB'S MOONROCKS" (a unit of moonrakers) and as such the appeals filed by the appellant/plaintiff/applicant may be dismissed.

13. This Court, has carefully considered the rival submissions and also perused the materials placed before it.

14. Though the respective learned counsels appearing for the parties made an attempt to canvas this Court in these appeals on the merits of the matter, this Court cannot go into the same for the reason that the learned Judge did not deal with the merits of the applications and taken into consideration the affidavits of undertaking.

15. The respondent/defendant in the first affidavit of undertaking dated 08.01.2015 in Paragraph No.2 undertook that he will not use the name "Moonrakers" for the purpose of running his restaurant situated at Nungambakkam, Chennai and also not to use the said name in the Boards, Menu Cards, Bill, etc., in relation to his restaurant in Nungambakkam, Chennai. In yet another affidavit of undertaking dated 13.01.2015, in Paragraph No.3, the respondents/defendants undertook to change the name of the restaurant in "MAHAB'S MOONROCKS" with the following words "a unit of moonrakers" beneath the said word with effect from 15.01.2015 and

undertaken not to use the mark "MOONRAKERS" in the Board, Menu Cards, Bill, etc., in relation to the restaurant in Mamallapuram.

16. It appears from the order, that though the learned Judge in Paragraph No.16 has referred to the second affidavit of undertaking dated 13.01.2015, has observed that since the respondents/defendants undertook to change the name of his restaurant at Mamallapuram from "MAHAB'S MOONROCKS" to "MOONRAKERS", had vacated the interim order.

17. The primordial submission of the learned counsel appearing for the respondents/defendants is that during the course of his arguments, the appellant/plaintiff/applicant has acceded to the request in the light of the second affidavit of undertaking, dated 13.01.2015. However, the said fact is seriously disputed by the learned counsel for the appellants/plaintiffs. This Court on going through both the affidavit of undertakings is of the considered view that the intention of the respondents/defendants is not to use the mark "MOONRAKERS", however, by the second affidavit of undertaking dated 13.01.2015 they sought to put the word "a unit of moonrakers" beneath the word "MAHAB'S MOONROCKS".

18. A perusal of the order would also indicate that the learned Judge though referred the second affidavit of undertaking dated 13.01.2015 in Paragraph 16 of the order, has taken into consideration the change of the word from "MOONRAKERS" to "MAHAB'S MOONROCKS". It is a settled provision of law that if there is any factual mistake, the remedy that may be open to them is to seek a review of the order. However, taking into consideration of the fact that the appeals came to be filed in the year 2015 and were numbered in the year 2017 and taken up for disposal in the year 2018, this Court is of the considered view that seeking Review of the order, may prolong the litigation. Since the main issue pertains to non-consideration of the second affidavit of undertaking dated 13.01.2015, and in these appeals, attempt has been made by the learned counsel appearing for the parties to advance arguments on merits, this Court is of the considered view that the matter is to be remanded for considering the purport of the affidavit of undertaking dated 13.01.2015, with regard to the use of the word "a unit of moonrakers" and if leave is granted by the learned Judge, they are also entitled to agitate the merits of their respective claim.

19. In the result, both appeals are allowed and the impugned common order dated 23.01.2015 is set aside and both the applications are remanded to the learned Single Judge for consideration and adjudication in the light of the second affidavit of undertaking, dated 13.01.2015 and subject to leave that may be granted, parties are entitled to agitate on merits of their claim. As a result of remanding of the matter, interim orders dated 10.01.2014 made in O.A.Nos.794 and 795 of 2014 in C.S.No.646 of 2014 stand revived. This Court has taken into consideration of the fact that from the date of impugned order on 23.01.2015 till the disposal of the present appeals, the respondents/defendants claim to have using the word "a unit of moonrakers" beneath the word "MAHAB'S MOONROCKS", is of the considered view that the said fact may be taken into consideration at the time of deciding the applications. No costs. Consequently, connected miscellaneous petitions are closed.

Sd/-
Assistant Registrar(CS v)

//True Copy//

Sub Assistant Registrar

ssn/lpp

To,

1.The sub Assistant Registrar,
Original side,
High court,Madras.

2.TheSub Assistant Registrar
Judicial Side,
High court,Madras.

+1cc to Mr.Jeenasenan. , Advocate SR.No. 58136

21cc to Mr.Bharath , Advocate SR.No. 457442,457441

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NRI (CO)

ASK(20/09/2018)