



O.A.Nos.452 and 453 of 2021
in C.S.No.29 of 2021

IN THE HIGH COURT OF JUDICATURE AT MADRAS

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Reserved on : 25.10.2021	Pronounced on : 29.10.2021
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Coram:

THE HONOURABLE DR. JUSTICE G. JAYACHANDRAN

O.A.Nos.452 and 453 of 2021
in
C.S.No.29 of 2021

O.A.No.452 of 2021

Amaravathi Restaurants Private Limited,
No.1, Cathedral Road,
Chennai 600 086,
Rep.by its Chief Financial Officer,
Mr.D.Rami Reddy

... Applicant/Plaintiff

/versus/

Karaikudi Chettinadu Mess,
No.75, Ranganathan Street,
Rameshwaram Road,
T.Nagar, Chennai 600 017.

... Respondent/Defendant

Prayer:- Original Application has been filed under Order XIV, Rule 8 of O.S. Rules read with Order XXXIX, Rules 1 and 2 and Section 151 of C.P.C., praying to pass an interim injunction restraining the respondent, themselves, its partners/proprietor as the case may be, successors-in-business, servants, heirs, servants, agents, representatives and all other persons claiming under them and through them from in any manner providing services, displaying, advertising in all manner providing services, displaying, advertising in all form of media and through internet, under the trade name/trading style KARAIKUDI



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CHETTINAD MESS in respect of hotel, restaurant and hospitality service or other allied and cognate service/goods amounting to infringement of the applicant's registered trademarks KAARAIKUDI and KAARAIKUDI CHETTINADU RESTAURANT or as being in some way connected with the applicant and/or in any manner whatsoever, pending disposal of the suit.

For Applicant :Mr.Arun C.Mohan

For Respondent :Mr.A.Swaminathan

O.A.No.453 of 2021

Amaravathi Restaurants Private Limited,
No.1, Cathedral Road,
Chennai 600 086,
Rep.by its Chief Financial Officer,
Mr.D.Rami Reddy

... Applicant/Plaintiff

/versus/

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Prayer:- Original Application has been filed under Order XIV, Rule 8 of O.S. Rules read with Order XXXIX, Rules 1 and 2 and Section 151 of C.P.C., praying to pass an interim injunction restraining the respondent, themselves, its partners/proprietor as the case may be, successors-in-business, servants, heirs, servants, agents, representatives and all other persons claiming under them and through them from passing off and enabling others to pass off Respondent's



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restaurants and business as and for applicant's restaurants and business by use of service mark/trade name KARAIKUDI CHETTINAD MESS or any name/mark similar to applicant's services mark/trade name KAARAIKUDI CHETTINAD RESTAURANT or in any other manner whatsoever, pending disposal of the suit.

For Applicant :Mr.Arun C.Mohan

For Respondent :Mr.A.Swaminathan

COMMON ORDER

(The case has been heard through Video Conferencing)

The applicant herein is the plaintiff in the suit claiming injunction against the defendant using the mark “KARAIKUDI CHETTINAD MESS” as infringement and passing off its registered trademark “KAARAIKUDI CHETTINAD RESTAURANT” being in use since 1989.

2. These applications are filed for interim injunction, pending suit and the common affidavit filed along with these two applications states:-

a). The applicant is in the hospitality industry and in the course of the business, the applicant adopted *inter alia* the trademark 'KARAIKUDI' in the year 1989 in respect of restaurants serving Chettinad cuisine both vegetarian

and non-vegetarian. The applicant is part of SAVERA GROUP and is a sister



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concern of M/s.Shyam Enterprises Private Limited. The applicant and its other sister concerns have an arrangement between them regarding the use of their trademarks.

b).The applicant is the registered Proprietor of the word mark 'KARAIKUDI' (Classes 31 and 32), 'KAARAIKUDI' (Classes 29, 30 and 42) and device 'KAARIKUDI CHETTINAD RESTUARANT' (Class 42). These registration stood in the name of M/s. Amaravathi Enterprises, a Proprietor concern, now assigned to and in favour of the Applicant Company vide, deed of assignment dated 31.12.2018 and license deed dated 01.06.2008. As of now, the above mentioned marks are in the name of the applicant having stepped into the shoes of the erstwhile proprietors. The appellant has its restaurants at several places in Chennai under the service mark “KAARIKUDI CHETTINAD RESTUARANT” since 1989 and has attained tremendous reputation, goodwill with respect to the restaurant and foods.

c). The mark 'KAARIKUDI' has lost its geographical significance by virtue of extensive use made by the applicant since 1989 and had acquired secondary meaning to connote and denote trade source and origin of the applicant's restaurants rather than description. In view of the high quality food and beverages served in the applicant restaurants, its annual sales turnover crosses crores of rupees and the applicant spent several lakhs for its promotional



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activities. While so, the respondent, with malafide intention, to cause confusion in the market and to gain illicit profits, had adopted the almost identical trademark “KARAIKUDI CHETTINAD MESS” with respect to an identical service/business i.e., hotels and hospitality services. To settle the matter amicable, the applicant caused cease and desist notice to the respondent on 05.03.2019. The respondent has not issued any reply nor desist from using the trademark “KARAIKUDI CHETTINAD MESS”.

d). When similar notice issued to the food delivery platforms like ‘Swiggy’ and ‘Zomato’, there was no reply from Swiggy, whereas Zomato has replied that, they cannot remove the listing of the respondent without Court order.

e).The respondent with obvious intention to take advantage of the enormous popularity of the trademark ‘KAARAIKUDI’ to enrich themselves at the well hard earned reputation of the applicant, dishonestly had adopted the name ‘KARAIKUDI CHETTINAD MESS’ for the identical business, thereby causing infringement and passing off. The word ‘Chettinad’ only denotes the kind of cuisine served at the restaurant. The use of the word ‘Karaikudi’ is a calculated attempt to deceive the public by diverting customers from the applicant. With the view to trade upon and get benefit out of the reputation and goodwill of the applicant, the respondent is using an almost identical service



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mark/trademark. The applicant is the prior user of the mark and its branches are spread over the length and breath of the Chennai City. The respondent is aware of this, hence the adoption of the well known mark of the applicant is not an honest adoption. Hence, injunction, pending suit, is sought.

3.To buttress the submission, the Learned Counsel for the applicant/plaintiff rely upon the judgment of this Court rendered in ***Amaravathi Enterprises -vs- Karaikudi Chettinadu*** reported in **2018 (36) PTC 688 (Mad DB)**

4. In the common counter filed by the respondent, the application is resisted on the following grounds:-

a). The suit itself is not maintainable, since there is no document to show that, the Finance Officer of the plaintiff company is competent to file the suit.

b). The Applicant company was incorporated only in the year 2007. While so, the claim of the applicant that it has *inter alia* adopted the mark 'Karaikudi' since 1989, is utter false.

c). Registration for a geographical place and description of service

is invalid.

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d). No document produced to show the applicant is the prior user of the mark Karaikudi. The registration of the name 'Karaikudi' in favour of the Amaravathi Enterprises for classes 31 and 32 was not used and no trade was carried adopting the said tradename. With the benefit of previous registration, the device mark for the service under class 42 was registered in the year 2004 by adding a letter 'A' in the word 'Karaikudi' and had obtained registration for a geographical name. To overcome the risk of invalidation, the license deed dated 01.06.2008 has been created dubiously projecting as if the trademark Karaikudi was used by them since 1989 and they are the prior user of the mark.

5. The Learned Counsel for the respondent, beside producing new paper articles on 'Karaikudi Chettinad cuisine' relied upon judgment which has emphasised that the trademark registration for names of geographic origin cannot be granted and if granted, the Proprietor cannot get monopoly over the name. Even if any little protection available to the applicant, in view of its registration, despite embargo under Section 9 of the Trademarks Act, the same diluted and become a mark "*Publici juris*". Since the word Karaikudi is used for Chettinad cuisine throughout the world as in the case of Harvey's Sauce, nobody can be deceived by the use of the word 'Karaikudi' to their hotel serving

'Chettinad Cuisine'. A list of establishment using the name 'Karaikudi



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Chettinad' furnished and relied by the respondent to show that, the name commonly adopted across the world.

6. Heard the Learned Counsels. Pleadings perused.

7. In the interlocutory stage, when considering the applications for interim relief of injunction, the test of *prima facie case*, *balance of convenience* and *irreparable loss* are the triple test for the Courts to take note.

8. In the instant case, the applicant/plaintiff seeks interim restraint order against the respondent/defendant from their use of the mark “KARAIKUDI CHETTINAD MESS” on the strength of the following registrations.

1.	Word mark	KAARAIKUDI I	For goods under Classes 29 and 30 For services under Class 42
2.	Device	KAARAIKUDI I	For services under Class 42
3.	Word mark	KARAIKUDI	For goods under Class 31
4.	Word mark	KARAIKUDI	For goods under Class 32

9. While the respondent/defendant counsel pleads that the plaintiff mark “KAARAIKUDI” is a geographical name so not protected against infringement, the applicant/plaintiff claim secondary meaning of the mark for their service. In

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this regard, the following judgment is to understand the expressions “geographical origin” and “Secondary meaning” and applied. In ***The Imperial Tobacco Co. of India Ltd. v. The Registrar of Trade Marks and another*** reported in 1977 SCC Online Cal. 133, the Division Bench has held that:-

“27. A geographical name according to its ordinary signification is such mark inherently or otherwise incapable of registration subject to such minor exceptions in regard to other aspects as noticed in judicial decisions referred hereinafter. In Corpus Juris Vol.63 (1933 Edn.) in Chapter of Trade Marks etc. Article 53 (pp.356-7) it is stated:

“Geographical terms and words in common use to designate a locality, a country, or a section of country cannot be monopolised as trade marks; but a geographical name not used in geographical sense to denote place of origin, but used in an arbitrary or fanciful way to indicate origin or ownership regardless of location, may be sustained as a valid trade mark”.

10. Further, in the same judgment in respect of distinctiveness and secondary meaning, the Court explains the term citing ***Liverpool Electric Cable Co. Ltd. Case (1929) 46 RPC 99*** and ***A.Bailey and Ltd v. Clark, Son an Morland Ltd (1938) 55 RPC 253*** as below:-



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“38.Though Cl. (d) of S. 9(1) which refers to geographical name in ordinary signification relates to registration in Part A of the register, the distinctiveness of the trade mark which makes it capable of distinguishing the applicant's goods, as required in Cl. (b) of S. 9(5) in respect of registration in Part B of the register, it is a vital and essential element for the purpose. Such distinctiveness is not possible for any geographical name in its ordinary or geographical signification. Though the rule has been relaxed in respect of small and insignificant place or where there is no geographical significance of the mark, if the geographical name propounded for registration is the name of an important country or a large district, county or city of commercial importance or has a geographical signification, the mark will be refused registration notwithstanding evidence of long and extensive use. In Liverpool Electric Cable Co. Ltd.'s case ((1929) 46 RPC 99) where registration was sought for trade mark ‘Liverpool’ in both Parts A and B of the register it was held that the name of an important commercial centre as Liverpool, even though it may in fact be distinctive of the goods in respect of which it is sought to register it is not registrable. In respect of Monte Rosa Cigarettes or Teneriffe Boiler Plates it was



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Mr.A.Ravikumar Reddy is one of the Director and thereafter, in the year 2018, the copyright has been assigned to the plaintiff. In any event, the device mark registered under Certificate No.565458, dated 05.10.2006, is for the device displaying in a unique way with 'AA' next to 'K' in the word 'KAARAIKUDI' which is the name of a place and generic in nature. Whereas the word 'KARAIKUDI' a name of the place in Tamil Nadu is available in public domain and used by several persons at various part of this State and Abroad for identical service and other goods or services. The mark 'KARAIKUDI CHETTINAD MESS' used by the defendant is a combination of a place name and region name which are closely associated and interchangeable. The word mark “KAARAIKUDI” or “KARAIKUDI” is not a coined word or invented word. The device mark “KAARAIKUDI CHETTINAD RESTARUANT” unless identical or deceptively similar, cannot be restrained from using by any honest concurrent user. Hence, the balance of convenience is absolutely not in favour of the applicant.

14. In so far as the plea of Passing off, this Court go by the ‘trinity test’ laid by the House of Lords in Jif Lemon’s case (*Reckitt & Colman -vs- Borden [1990] RPC 341*), which has become the standard test for passing off.



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The gist of the trinity test propounded by House of Lords in ***Jif Lemon's*** case is extracted below for the sake of clarity.

“First, the claimant must establish a goodwill or reputation, attached to the goods or services which he supplies in the minds of the purchasing public by association with the identifying 'get up' (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the [claimant's] goods or services.

Second, the claimant must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the [claimant].

Third, the claimant must demonstrate that he suffers, or in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the [claimant].”



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In the case in hand, it is not even remotely shown any misrepresentation by the respondent herein to lead the public that the business/service of the respondent is from the business house of the applicant. (*Amaravathi group*).

15. Therefore, when the plaintiff cannot claim monopoly over the mark 'KARAIKUDI', there is no loss as alleged and there is no case made out by the applicant/plaintiff for interim relief of injunction. Hence, these Original Applications for injunction are dismissed. No order as to costs.

Sd./-G.J.J
29.10.2021

//Certified to be true copy//
Dated at Madras this the day of 2021.

COURT OFFICER(O.S.)
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JJ 10/11/2021