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O.A.Nos.450 and 451 of 2021
in
C.S.No.28 of 2021

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on :25.10.2021

Pronounced on :29.10.2021

Coram:

THE HONOURABLE DR. JUSTICE G. JAYACHANDRAN

O.A.Nos.450 and 451 of 2021
in
C.S.No.28 of 2021

O.A.No.450 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,
1st Floor, Grand Trunk Road,
Near Anjappar, Lakshmi Nagar,
Chrompet, Chennai 600 044. .. 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



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persons claiming under them and through them from in any manner providing services, displaying, advertising in all form of media and through internet, under the trade name/trading style KARAIKUDI 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.451 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,
1st Floor, Grand Trunk Road,
Near Anjappar, Lakshmi Nagar,
Chrompet, Chennai 600 044.

.. Respondent/Defendant



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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 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)

These applications for interim injunction are taken out by the applicant/ plaintiff in the suit filed for injunction against the defendant alleging infringement and passing off of the plaintiff's registered trademark 'KAARAIKUDI' and 'KAARAIKUDI CHETTINAD



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RESTAURANT'.

2.The contention of the applicant/plaintiff is that, the plaintiff is running a hotel business and had adopted the trademark 'KARAIKUDI' in the year 1989. The plaintiff and its sister concerns have many restaurants under various marks, like Amaravathi, Malgudi, The Dhaba, Amaravathi Bistro, Kabul and Duchess in addition to “KAARAIKUDI”.

3.The applicant is the registered proprietor of the word mark “KARAIKUDI” under classes 31 & 32; and the word mark “KAARAIKUDI” under classes 29, 30 and 42 and the device mark “KAARAIKUDI CHETTINAD RESTAURANT” under class 42.

4.While the said marks are valid and subsisting and it has been extensively used by the plaintiff and its sister concerns uninterruptedly, it is come to knowledge of the plaintiff during the month of February 2020 that, the defendant is carrying on business adopting the trademark 'KARAIKUDI CHETTINAD MESS' and the same has been used for the identical service viz., restaurant, which amounts to infringement of the



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registered trademark and passing off of the service. Claiming that the plaintiff the registered proprietor of the mark “KAARAIKUDI CHETTINAD RESTAURANT” and prior user of the mark, have statutory protect against infringement, hence, interim injunction is sought against the respondent/defendant for using the trademark and from passing off, pending disposal of the suit.

5.A common counter is filed by the defendant/respondent wherein, it is stated that, the defendant as a Private Limited Company running hotel business under the name and style of “KARAIKUDI CHETTINAD MESS”. The name 'KARAIKUDI' is a town situated in Sivaganga District, Tamil Nadu. The part of that area is commonly known as “CHETTINADU” and the said region is famous for its cuisine and the same was commonly referred to as 'KARAIKUDI CHETTINAD RECEIPE'. Therefore, the plaintiff have no exclusive right over the name 'KARAIKUDI CHETTINAD'. There are several restaurants all over the world selling the Chettinad foods in the name of 'KARAIKUDI CUISINE' or 'KARAIKUDI CHETTINAD CUISINE'. Therefore, the plaintiff wants



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indirectly a monopoly of using the name 'KARAIKUDI CHETTINAD' to their business. The word 'KARAIKUDI' and 'CHETTINAD' are the generic terms connoting geographical origin. The word, which is *publici juris* cannot be monopolised by the plaintiff by registration and cannot restrain others from using the word 'KARAIKUDI' or 'CHETTINAD' separately or jointly.

6.It is also stated that the registration for trade mark 'KARAIKUDI' was applied by one Mr.A.Ravikumar Reddy and Jayalakshamma as partners of the M/s Amaravathi Enterprises for classes under 31 and 32. However, they were not trading under the said name. Later, M/s Amaravathi Enterprises applied for registration of Device Mark by adding “A” and got the mark registered which is the name of a place (origin) and description i.e., 'KARAIKUDI CHETTINAD'. The license deed dated 01.06.2008 in favour of the plaintiff and assignment deed dated 31.12.2018 in favour of the plaintiff are nothing, but a dubious and invalid act in the eye of law. The original owner of the mark is Amaravathi Enterprises, a partnership firm. There is no evidence to show



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that they were in use of the alleged mark. The grant of registration for the town name (geographical origin) is in violation of the act. Hence, the defendant reserved the right to file necessary application to remove the mark as in valid.

7.The plaintiff running the restaurant in the name of Amaravathi serving different cuisine region-wise under different names. Kannada recipes use the trade name 'Malgudi', for the Punjabi foods use the trade name 'Punjabi Dhaba', for the chettinad foods use the trade name 'Karaikudi Chettinad'. The defendant had commenced business in the year 2013 under the name and style of 'KARAIKUDI CHETTINAD MESS' and the name has been adopted since the quality of Karaikudi Chettinad recipes known for its taste and preparation.

8.The Learned counsel for the applicant/plaintiff insists for an interim order on the ground that being the prior user of the word 'KAARAIKUDI CHETTINAD' and registered owner of the said mark, the trademark right has to be protected under Section 29 of the Trademarks



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Act, 1999. The defendant, who is admittedly the subsequent user, cannot adopt the similar name for similar business.

9.In support of his argument, he rely upon the judgment of this Court reported in **2018 (36) PTC 688 (Mad.)(DB) [Amaravathi Enterprises vs. Karaikudi Chettinadu]**. This intra-court appeal arose against the dismissal of the interim application seeking injunction against the respondent using the mark 'KAARAIKUDI CHETTINAD RESTAURANT'. The Division Bench of this Court, considering the phonetic similarity and visual similarity between the registered trademark of the plaintiff "KAARAIKUDI CHETTINAD RESTAURANT" and the deceptive and confusing infringed mark of the defendant "KARAIKUDI CHETTINAD RESTAURANT", granted injunction holding that, the plaintiff is the prior user of the mark. This judgment is of no support for the present case of the plaintiff.

10.The plaintiff herein is Amaravathi Restaurant Private Limited. The trademark protection is sought for the device 'KAARAIKUDI



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CHETTINAD RESTARUANT/word mark 'KAARAIKUDI/KARAIKUDI' from against the use of 'KARAIKUDI CHETTINAD MESS'. The registration for the word mark “KARAIKUDI” was initially obtained by Amaravathi Enterprises, who is the appellant in the case before the Division Bench relied by the plaintiff. The case of the plaintiff is that, the partners of Amaravathi Enterprises allowed the plaintiff to use the mark initially and later, gave license in the year 2008. Subsequently, assigned the right in the year 2018. The name under dispute in case cited is identical and the Court opined that the respondent had adapted the name with dishonest intention.

11.The Division Bench in that judgment has not considered the issue of generic nature or territorial geographical origin of the word found in the impugned trade mark. The interim order of injunction was granted based on prior user. Whereas, as pointed by the learned counsel appearing for the respondent, both the word 'KARAIKUDI' as well as 'CHETTINAD' are generic terms in nature and no person can claim exclusive monopoly over these words, unless they have attained any



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distinct and secondary meaning in respect of the plaintiff service or used by others deceptively without any bonafide reason. The use of the word 'KARAIKUDI CHETTINAD' *per se* will not amount to infringement of the registered mark of the plaintiff, unless the imitation or adaptation is identical and deceptive.

12.Per contra, the learned counsel appearing for the respondent would rely upon the following judgments, where the Courts have refused to grant registration or injunction for the word 'simla' in Tobacco products (*The Imperial Tobacco Co of India Ltd. v. The Registrar of Trade Marks and another reported in [1977 SCC online Cal 133]*) and for the word “Himalaya” in (*Bisleri International Pvt. Ltd., Western Express Highways v. Dr.Dadi Balsara, C/o Mount Everest Mineral Water Limited & Others reported in [CDJ 2011 IPAB 012]*). There two judgments are cited to emphasis that, even if the registration is granted in contravention to Section 9 of the Act for name of geographical origin, such grant of trademark being generic in nature and used by many in the same and different trade, had attained the character of a *publici juris* so



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cannot be monopolised by the plaintiff.

13.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.

14.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	For goods under Classes 29 and 30 For services under Class 42
2.	Device	KAARAIKUDI	For services under Class 42
3.	Wordmark	KARAIKUDI	For goods under Class 31
4.	Wordmark	KARAIKUDI	For goods under Class 32



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15.The applicant/plaintiff claim secondary meaning of the mark for their service. In this regard, the the following judgment is essential to refer.

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”.



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16.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:-

“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



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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 noted that there was no geographical significance in the mark which were mere pet names. It was further held that Liverpool being a well known city is geographical and not capable of distinguishing the goods of any particular trader and such registration will tend to embarrass traders who are in the trade or who may hereafter so trade as they would have difficulty in describing their goods if prevented from using the word 'Liverpool' Cables.

39.In *A. Bailey and Ltd. v. Clark, Son and Morland Ltd.*, (1938) 55 RPC 253 known as *Glastonburys' case*, the respondents obtained registration as a trade mark of the word



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‘Glastonburys’ used in connection with goatskin slippers and the appellants brought an action to rectify the register by expunging trade mark ‘Glastonburys’. The prayer was allowed on the ground that (in spite of ‘S’) Glastonbury was a geographical name prima facie unregistrable under S. 9 and evidence was unsuitable to prove the word to be generally distinctive of the respondents' goods and the word was not adapted to distinguish. The court of appeal held that ‘Glastonburys’ had become distinctive and had acquired as secondary meaning indicating exclusively the goods of the respondents. The House of Lords on further” appeal held that the mark was not adapted to distinguish the goods of the respondents from those of other persons and its presence in the register would hamper rights of other traders. It was held that the word ‘Glastonburys’ is obviously a geographical name indicating the town of Glastonbury which had a reputation of manufacturers of Sheepskin slippers and parties were such manufacturers. It was observed that the respondents and future manufacturers of slippers in Glastonbury or their



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retail customers should not be hampered or restricted by the presence of the mark on the register while evidence was also insufficient to prove distinctiveness or that the mark was a fancy name.”

17. In ***Indian Shaving Products Ltd & another -vs- Gift Pack & another*** reported in ***1998 SCC Online Del 829***, the Delhi High Court has extracted the following passage from the book on titled “The Law Of Passing Off” by *Christopher Wadlow*, at page 315:-

“....a trader who chooses to use a name or mark which is prima facie descriptive of his goods, services or business runs the risk that the public will continue to use the term in its descriptive sense rather than identifying it with him. He must prove that the mark has acquired a secondary meaning as denoting his goods, and the burden of doing so is higher in proportion to the descriptive quality of the mark. Even if secondary meaning is proved two problems remain. One is that no trader can be prevented from using the word in its old descriptive sense if he avoids misrepresentation.....”



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“.....A mark which is prima facie descriptive will only be protected if it can be shown to have acquired secondary meaning; that is to say if it has become distinctive of the plaintiff. Of course distinctiveness is an essential precondition for all marks, whether descriptive or fancy, but the burden of proof is significantly higher for prima facie descriptive terms.”

18. In the said background, if one read Section 9(1)(b) and Section 30 (2)(a) of the Trademarks Act, 1999, it will clearly show that, in case of mark of geographical origin, there is an absolute ground for refusal of registration. Even in case registration granted, it is prone for cancellation or revocation and in any event, it will not get protection against infringement unless gained secondary meaning.

19. Back to the facts of the case in hand, the provisions of the Act as well as the claim of the plaintiff does not make out a *prima facie* case for any protection to its generic mark to grant injunction restraining the defendant/respondent from using the word “KARAIKUDI CHETTINAD



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MESS” for their hotel. Even though the plaintiff holds registration for the service device “KAARAIKUDI CHETTINAD RESTAURANT” under Class 42, this registration has been granted based on the registration for the word mark 'KARAIKUDI' under classes 30 and 31 obtained by Mr.A.Ravi kumar Reddy and A.Jayalakshamma as partners of Amaravathi Enterprises disclosing that they are using the mark since 21.04.1989.

20.It is the case of the plaintiff that, in the year 2008 license was granted in favour of the plaintiff M/s Amaravathi Restaurant Private Limited in which 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



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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.

21.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.

22.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



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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, he 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).”

23. In the case in hand, it is not even remotely shown any

misrepresentation by the respondent herein to lead the public that the



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business/service of the respondent is from the business house of the applicant (Amaravathi group).

24. 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 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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