



IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 29-07-2025

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THE HON'BLE MR. JUSTICE SENTHILKUMAR RAMAMOORTHY

(T)OP(TM) No. 406 of 2023

M/s. Karim Hotels Pvt. Ltd., Registered Proprietor of
the trade mark, "KARIM/KARIM'S/KAREEM"
16, Gali Kababiyar, Bazar Matia Mahal,
Near Jama Masjid, Delhi 110006.

..Petitioner

Vs

1. AL Kareem, Registered Proprietor of the
impugned Trade Mark "AL Kareem" (Device)
AL Kareem Hotel, 12-2-290 Old Milan Talkies,
Zeba Bagh Asif Nagar, Hyderabad 500028.
(Telangana)
2. The Registrar of Trade Marks,
Intellectual Property Bhawan, G.S.T.Road,
Guindy, Chennai 600032.

..Respondents

Prayer: Transferred Original Petition (Trade Marks) is filed under Sections 47, 57 & 125 of the Trade Marks Act, 1999, to remove/rectify/expunge the entry pertaining to the impugned trademark AL KAREEM under No.3385555 in Class 43 from the register.

For Petitioner: Ms.Ridhima Goyal
Mr.Mohammed Affan
for M/s.Diwan Advocates

For Respondents: Mr.P.Venkata Ramana



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for Mr.K.Hema Prakasa Rao for R1

Mr.Rajesh Vivekananthan, DSG for R2

ORDER

Factual Background

The petitioner is a private limited company incorporated under the corporate name 'Karim Hotels Private Limited'. By asserting that the trade mark 'KARIM' has been used by the petitioner in relation to the restaurant business since 1913, the present petition has been filed to rectify the Register of Trade Marks by expunging the entry relating to the device mark



, which was registered under Trade Mark No.3385555 in Class 43 from the Register of Trade Marks. As is self-evident from the petition, the request for rectification by removal is on the basis that the impugned mark is deceptively similar to the petitioner's trade mark 'KARIM' and that, consequently, the entry relating to the impugned mark was made without sufficient cause.

Counsel and their contentions

2. Oral arguments on behalf of the petitioner were advanced by Ms.Ridhima Goyal and Mr.Mohammed Affan. Oral arguments on behalf of the contesting respondent were made by Mr.P.Venkata Ramana. Mr.Rajesh



Vivekananthan, learned Deputy Solicitor General, appeared on behalf of the 2nd respondent. Both parties also filed written arguments.

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3. Learned counsel for the petitioner opened her submissions by stating that the trade mark 'KARIM' was first adopted and used in relation to the restaurant business by the predecessors of the petitioner in 1913. She submits that the said mark has been used openly, honestly and continuously since then. As evidence of use, learned counsel relies upon publications in the electronic and print media. In particular, by relying upon an article updated on 02.09.2005 in Rediff.com, it is stated that the article records that KARIM'S is the best restaurant in Delhi serving non-vegetarian food since 1913. Learned counsel also relies upon the travel guide section of the New York Times, issue dated 25.07.2012, which refers to the Old Delhi institution near the Jama Masjid mosque passed down through four generations of Haji Zahiruddin's family since 1913.

4. Apart from the above mentioned publications, learned counsel relies on the multiple registrations obtained by the petitioner for word and device marks containing the prominent element KARIM. By referring to the certificate in respect of Trade Mark No.833801, learned counsel submits that the application was filed on 24.12.1998. She also relies upon the status of Trade Mark



No.1143864, which mentions use since 01.04.1913. In order to establish that the petitioner has generated significant turnover from the restaurant business under the mark KARIM, learned counsel relies on certificates issued by Chandna Associates, Chartered Accountants. By reference to certificate dated 27.04.2015, she submitted that the turnover and gross profit from financial year 2003-2004 to 2013-2014 is certified therein. Likewise, with reference to certificate dated 14.01.2021, she pointed out that the turnover and gross profit from financial year 2014-2015 to financial year 2020-2021 is mentioned therein. She further submitted that the petitioner was incorporated in 1987 by referring to Certificate of Incorporation dated 14.08.1987.

5. She next contended that the 1st respondent asserts use since 1965, but has failed to provide any credible evidence of use since then. In this connection, by referring to the application for registration, learned counsel pointed out that such application was filed on 12.10.2016 on “proposed-to-be-used” basis. As regards the documents submitted by the 1st respondent as evidence of use, learned counsel submitted that the Mutton Supply Contract Agreement dated 20.11.1996 had not been executed by Abdul Hameed Khan and, therefore, the said document is liable to be disregarded. By referring to the reply dated 12.08.2017 of the 1st respondent to the examination report, it was submitted that the 1st respondent has asserted use therein since 01.01.2001. Therefore, learned



counsel submitted that the 1st respondent has made incompatible and contradictory submissions with regard to the date of first use of the impugned mark.

6. By referring to several orders issued by the Delhi High Court in cases involving the petitioner, learned counsel submits that the Delhi High Court recognised the enormous good will and reputation of the petitioner. By referring to the judgment of the Hon'ble Supreme Court in *S. Syed Mohideen v. P.Sulochana Bai*, (2016) 2 SCC 683, particularly paragraphs 30, 31.2, 33.2, 34 & 36, it was submitted that the Supreme Court recognised the superior rights of the prior user and registrant.

7. For the above reasons, learned counsel concluded her submissions by contending that the impugned mark is deceptively similar to the petitioner's mark and that the continuance of the impugned mark on the Register is likely to cause deception or confusion among the public.

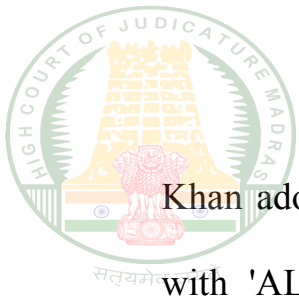
8. In response to these contentions, learned counsel for the 1st respondent raised the preliminary objection that the petitioner does not qualify as a 'person aggrieved'. By referring to the petition for rectification, particularly paragraphs K, O and ground A of paragraph 10, learned counsel submitted that the admitted



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position is that the petitioner is running its business in Delhi and the National Capital Region (NCR) and nowhere else. Merely because the petitioner has the future plan to open outlets outside Delhi, learned counsel submits that the petitioner is not prejudiced by the operation of the restaurant business by the 1st respondent in the State of Telangana. By relying on the judgment of the Supreme Court in *Kabushiki Kaisha Toshiba v. Toshiba Appliances Co. and others*, AIR 2009 SC 892 (*Toshiba*), particularly paragraph 57 thereof, learned counsel contended that only a person who would possibly be injured if the trade mark is allowed to stand qualifies as a 'person aggrieved' for purposes of Sections 47 & 57 of the Trade Marks Act, 1999 (the TM Act). For the same proposition, reliance was placed on the judgment of the Supreme Court in *National Bell Company v. Metal Goods Manufacturing Company (P) Ltd. and another*, AIR 1971 SC 898.

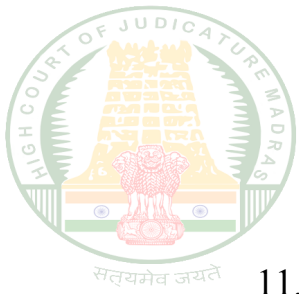
9. Without prejudice to the above preliminary submission, learned counsel submitted that the 1st respondent has used the impugned mark since 1965. In order to substantiate this contention, he relied upon the third party affidavit of Abdul Hameed Khan, which was affirmed on 26.09.2023. By referring to paragraph 2 thereof, he contended that the elder brother of the affiant, Shri. Abdul Kareem Khan, established a hotel near Nampally, Hyderabad in the year 1965. By further stating that the said Abdul Kareem



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Khan adopted the distinct portion of his name Kareem and prefixed the same with 'AL' which is a pious expression in the Islamic religion, he further submitted that the affidavit records that the affiant's elder brother passed on the business to him in the year 1992. By referring to the Mutton Supply Contract Agreement dated 20.11.1996, learned counsel submitted that the agreement may not have been executed by one of the parties thereto, but the same may be referred to as a piece of evidence in relation to the conduct of business under the name and style of AL KAREEM in 1996. On this issue, he also relied on receipt dated 20.11.1996 acknowledging receipt of a sum of Rs.10,000/- as security for the supply of beef in terms of the above mentioned contract.

10. Based on the above documents, learned counsel contended that there is reasonable evidence of use at least since 1996, if not 1965 and, consequently, the 1st respondent qualifies as an honest and concurrent user under Section 12 of the TM Act. In support of the contention that honest and concurrent use qualifies as a valid defence, learned counsel referred to and relied upon the judgment of the Supreme Court in *London-Rubber Co. Ltd. v. Durex Products Incorporated and another*, AIR 1963 SC 1882, particularly paragraph 19 thereof. He also relied upon the judgment for the principle that even a small trader, whose sales are much lower than the larger adversary, is entitled to protection if such use is over a long time.



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11. Learned counsel next submitted that the advertisement relating to the impugned mark contains a geographical limitation inasmuch as the 1st respondent's use is confined to the State of Telangana. Consequently, he contends that there is no likelihood of deception or confusion among the public or any prejudice or detriment to the petitioner. After also contending that the rival marks are distinguishable and not deceptively similar, learned counsel concluded his submissions by submitting that the petition is liable to be dismissed.

12. By way of a brief rejoinder, learned counsel for the petitioner submitted that the registration of a trade mark confers pan-India rights on the registrant. Therefore, it is submitted that the petitioner cannot be denied protection merely on the ground that the mark is not being used currently in relation to the restaurant business in Hyderabad or otherwise in the State of Telangana. Learned counsel reiterated that the applications for registration were filed by the petitioner by asserting use since 1913 and that such use is corroborated in the multiple publications relied upon by the petitioner. Unless the entry relating to the impugned mark is removed from the Register of Trade Marks, learned counsel submits that the petitioner's rights would be diluted and that irreversible injury would be caused to the petitioner.



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Discussion, analysis and conclusion

13. In light of the rival contentions, the first question that falls for consideration is whether the petitioner is a 'person aggrieved'. Learned counsel for the 1st respondent relied upon the judgment of the Supreme Court in *Toshiba* to contend that only a person who would be injured in some possible way if the trade mark were allowed to stand would qualify as a 'person aggrieved'. Both Sections 47 & 57 of the TM Act enable a person aggrieved to petition for rectification. In *Hardie Trading Ltd. & another v. Addisons Paint & Chemicals Ltd.*, (2003) 11 SCC 92 (*Hardie Trading*), the Supreme Court dealt with the scope of the expression 'person aggrieved', as used in the corresponding provisions of the Trade and Merchandise Marks Act, 1958 (the 1958 Act). While interpreting these provisions, the Supreme Court concluded that the expression 'person aggrieved', in Section 56 of the 1958 Act which corresponds to and is *in pari materia* with Section 57 of the TM Act, should receive a wide construction. The relevant paragraphs are as under:

“31. In our opinion the phrase “person aggrieved” for the purposes of removal on the ground of non-use under Section 46 has a different connotation from the phrase used in Section 56 for cancelling or expunging or



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varying an entry wrongly made or remaining in the Register.

32. In the latter case the locus standi would be ascertained liberally, since it would not only be against the interest of other persons carrying on the same trade but also in the interest of the public to have such wrongful entry removed. It was in this sense that the House of Lords defined “person aggrieved” in the matter of Powell's Trade Mark [Powell's Trade Mark, Re, (1894) 11 RPC 4 : 1894 AC 8 : 70 LT 1 (HL)] :

“... although they were no doubt inserted to prevent officious interference by those who had no interest at all in the register being correct, and to exclude a mere common informer, it is undoubtedly of public interest that they should not be unduly limited, inasmuch as it is a public mischief that there should remain upon the register a mark which ought not to be there, and by which many persons may be affected, who, nevertheless, would not be willing to enter upon the risk and expense of litigation.

Whenever it can be shown, as here, that the applicant is in the same trade as the person who has registered the trade mark, and wherever the trade mark, if remaining on the



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register, would, or might, limit the legal rights of the applicant, so that by reason of the existence of the entry on the register he could not lawfully do that which, but for the existence of the mark upon the register, he could lawfully do, it appears to me he has a locus standi to be heard as a person aggrieved.”

14. In the case at hand, the undisputed position is that the petitioner is carrying on restaurant business under the trade mark 'KARIM'. The 1st respondent is also in the identical line of business, albeit confined to Hyderabad, Telangana. In the petition, the petitioner has averred that it intends to establish the restaurant business outside the NCR. The petitioner is also the registered proprietor of multiple trade marks containing the prominent element KARIM. In these circumstances, I conclude that the petitioner qualifies as a person aggrieved for purposes of Section 57 of the TM Act.

15. Since the petition has been lodged both under Sections 47 & 57, it is necessary to briefly deal with whether there is sufficient evidence of non-use by the 1st respondent. The 1st respondent has filed *inter alia* the following documents: contract agreement for mutton supply dated 20.11.1996; the restaurant administration tool kit of the delivery app, Zomato, issued on 24.08.2016; a copy of the provisional trade licence in respect of Al Kareem



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Hotel issued by the Greater Hyderabad Municipal Corporation on 29.10.2018; and the licenses issued by the Food Safety and Standards Authority of India (FSSAI) for the Al Kareem Hotel. While the quality of evidence presented by the adversaries could have been better, there is undoubtedly evidence of use by the 1st respondent, including in the five year period culminating three months prior to the date of institution of the petition. Therefore, the challenge under Section 47 is unsustainable.

16. Turning to the challenge under Section 57, such challenge is mounted primarily on the ground that the petitioner is the prior user and had adopted and used the mark since 1913. In order to substantiate use since 1913, the petitioner relies upon publications in the print and electronic media. The publication in Rediff.com on 02.09.2005 refers to KARIM'S as a restaurant serving non-vegetarian food since 1913. The said article also refers to KARIM'S not having any branches until the 1990s and that branches have now been opened in Nizamuddin, Kailash Colony, Noida, Gurgaon and Kamla Nagar. The publication in the New York Times, issue dated 25.07.2012, also refers to the establishment of a restaurant near the Jama Masjid mosque by Haji Zahiruddin's family since 1913. Although a publication in the year 2012 may not qualify as the best evidence of use since 1913, even proceeding on the basis that it is evidence of use, the article refers to use by Haji Zahiruddin's family. The



petitioner has not traced title from Haji Zahiruddin's family by placing on record necessary link documents.

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17. The other piece of evidence regarding use since 1913 is in the form of the trade mark application of the petitioner. By way of illustration, the status document pertaining to Trade Mark No.1143864 contains an assertion of use since 01.04.1913. Once again, merely based on the assertion in the application, no definitive conclusion on use may be drawn especially in view of the absence of any documents tracing the title of the petitioner from the predecessors. The Certificate of Incorporation of the petitioner discloses that the entity was incorporated on 14.08.1987. The certificates issued by Chandna Associates, Chartered Accountants, disclose the turnover from financial year 2003-2004.

18. Against this backdrop, the evidence of use presented by the 1st respondent warrants scrutiny. The 1st respondent relies on the third party affidavit of Abdul Hameed Khan. The affiant states that he is the father of Abdul Majeed Khan, the proprietor of the 1st respondent. He also states that his elder brother, Shri.Abdul Kareem Khan, established the restaurant business in Hyderabad in the year 1965 by adopting the distinctive portion of his name, KAREEM, and prefixing AL, which has religious significance. He further states that his elder brother passed on the business to him in the year 1992. Neither



party opted to adduce oral evidence in this petition and the petitioner also did not exercise the option of cross-examining the affiant of the third party affidavit. While this is not an entirely ideal or satisfactory situation, the case has to be adjudicated on the basis of available evidence.

19. In addition to the above affidavit, the petitioner has placed on record the Mutton Supply Contract Agreement dated 20.11.1996 between Abdul Hameed Khan and Mohd. Yousuf Qureshi. This document has been printed on stamp paper issued to Abdul Hameed Khan on 20.11.1996 and has been executed by the second party, Mohamed Yousuf Qureshi, but not by the first party. Since the two parties thereto have not signed the agreement, it cannot be relied upon as a contract. Learned counsel for the 1st respondent, however, contended that the document may nonetheless be relied on as a document evidencing the conduct of business under the name HOTEL AL KAREEM in the year 1996. Apart from the above mentioned agreement, the receipt dated 20.11.1996 is also on record. Abdul Hameed Khan has signed this receipt in acknowledgement of the receipt of a sum of Rs.10,000/- from Mohd. Yousuf Qureshi towards security for the regular supply of beef. If the two documents are examined conjointly, they qualify as evidence that restaurant business was carried on under the name AL KAREEM in 1996.



20. The question that arises on the basis of the above discussion is whether the 1st respondent qualifies as an honest and concurrent user for purposes of Section 12 of the TM Act. Although the expression 'concurrent' has been construed as not requiring neck-to-neck concurrency, it clearly requires some degree of concurrency or contemporaneity. The 1st respondent has adduced some evidence of use since 1996. In contrast, the petitioner has adduced weak evidence of use of the mark since 1913 by alleged predecessors; reasonable evidence of use since incorporation on 14.08.1987; and convincing evidence of use by the petitioner since 2003-2004.

21. In this factual matrix, it is necessary to set out Section 12 of the TM Act, which is as under:

“12. Registration in the case of honest concurrent use, etc.

In the case of honest concurrent use or of other special circumstances which in the opinion of the Registrar, make it proper so to do, he may permit the registration by more than one proprietor of the trade marks which are identical or similar (whether any such trade mark is already registered or not) in respect of the same or similar goods or services, subject to such conditions and limitations, if any, as the Registrar may think fit to impose.” (emphasis added)



From the text of Section 12, it is noticeable that the provision may be resorted to not only in the case of honest and concurrent use, but also if other special circumstances, in the opinion of the Registrar, make it proper or appropriate to permit the registration by more than one proprietor of identical or similar trade marks in relation to similar goods or services.

22. The evidence on record indicates that the 1st respondent adopted the impugned mark honestly. Even when the application of the 1st respondent was examined, the petitioner's marks were not cited in the examination report. The advertisement relating to the mark in the Trade Marks Journal evidences that a geographical limitation was imposed, whereby the mark would be used only within the State of Telangana. At several paragraphs of the petition, the petitioner stated that its restaurants are functioning only in the NCR. By way of illustration, at paragraph 10, in relevant part, it was stated as under:

“.... The petitioner is continuously extending its business in Delhi NCR and it has at present half a dozen restaurants in running business. The Petitioner in future has also planned to open its outlets outside Delhi and in this regard it has already started drawing the plans.”

Although the petitioner contends in course of oral submissions that restaurants have been opened under the trade mark/trade name KARIM outside the NCR, no evidence to that effect has been placed on record. In any event, it is common



ground that the petitioner has not established a restaurant, either directly or through a franchisee, in the State of Telangana. Whether the 1st respondent falls within the scope of the expression “other special circumstances” falls for determination in this factual context.

23. Before drawing conclusions in this connection, it is also necessary to refer to Section 35 of the TM Act, which is as under:

“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 or quality of his goods or services.”

As is evident from the text of Section 35, the said provision *inter alia* prescribes that the proprietor of a registered trade mark or a registered user thereof is not entitled to interfere with the *bona fide* use by a person of his own name or that of his place of business or of the name of any of his predecessors in business or of the name of the place of business of any of his predecessors in business. The 1st respondent asserts that the name KAREEM was adopted on the basis of the name of the 1st respondent's uncle, whose name was Abdul Kareem Khan. Although the evidence in this regard by way of the third party affidavit does not



qualify as the best evidence, in the absence of any evidence to the contrary and bearing in mind that Kareem is a common name among Muslims, it cannot be disregarded.

24. Therefore, considering the following: some evidence of use of the mark AL KAREEM since 1996 and convincing evidence of use in the recent past; the use being confined to Hyderabad, Telangana; the fact that the petitioner is currently not applying the mark to any restaurant in Hyderabad or anywhere in the State of Telangana; and the geographical limitation that appears to have been imposed by the Registrar of Trade Marks when the 1st respondent's trade mark was registered, I am inclined to conclude that the 1st respondent's registration is entitled to protection in terms of Section 12 of the TM Act and that use of the mark is entitled to protection under Section 35 thereof. This is, however, subject to imposing an express geographical limitation in the Register of Trade Marks to the effect that the 1st respondent's mark shall only be applied to restaurant services provided in Hyderabad, Telangana. The Registrar of Trade Marks is directed to incorporate this limitation/condition within 30 days from the date of receipt of a copy of this order.

25. (T)OP(TM)No.406 of 2023 is disposed of on the above terms without any order as to costs.



29-07-2025

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Index : Yes/No

Internet : Yes/No

Neutral Citation : Yes/No

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To

The Registrar of Trade Marks,
Intellectual Property Bhawan,
G.S.T.Road, Guindy, Chennai 600032.



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(T)OP(TM) No. 406 of 2



SENTHILKUMAR RAMAMOORTHY, J.

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