

(2005) 03 AP CK 0077

Andhra Pradesh High Court

Case No: C.M.A. No. 2711 of 2004

Chennai Hotel Saravana Bhavan
and Others

APPELLANT

Vs

Hotel Saravana Bhavan

RESPONDENT

Date of Decision: March 30, 2005

Acts Referred:

- Civil Procedure Code, 1908 (CPC) - Order 39 Rule 1, Order 39 Rule 2
- Copyright Act, 1957 - Section 51
- Partnership Act, 1932 - Section 58
- Trade and Merchandise Marks Act, 1958 - Section 27
- Trade Marks Act, 1940 - Section 21, 29

Citation: (2005) 4 ALD 263 : (2005) 3 ALT 789

Hon'ble Judges: Elipe Dharma Rao, J

Bench: Single Bench

Advocate: Movva Chandrasekhar Rao, for the Appellant; P. Jagadish Chandra Prasad, for the Respondent

Final Decision: Allowed

Judgement

@JUDGMENTTAG-ORDER

Elipe Dharma Rao, J.

Aggrieved of the order and decree dated 4-8-2004 made in I.A. No. 1015 of 2004 in O.S. No. 20 of 2004 by the learned V Additional District Judge, Tirupathi, allowing the petition filed under Order 39 Rules 1 and 2 C.P.C. restraining the appellants herein - defendants in the suit, and their men from using the name of Hotel Saravana Bhavan or Chennai Hotel Saravana Bhavan or similar type name to their hotel business at Car Street, Srikalahasti, till the disposal of the suit, the defendants preferred this Civil Miscellaneous Appeal.

2. Originally the suit was filed for declaration that the registration of defendant's firm in the name as Saravana Bhavan or Chennai Saravana Bhavan or running hotel business in that name is null and void, inasmuch as it is identical and resembles the name of the plaintiffs firm and tends to cause confusion in the public and damaging the reputation of the plaintiff firm. The plaintiff also sought consequential relief of permanent injunction. It is the case of the plaintiff that they started hotel business at Srialahasti at D.No. 4/39 in the name and style of "Zen Park" in the month of April, 1998 and subsequently changed its name as "Hotel Saravana Bhavan" as per the proceedings R.C. No. Chittoor/01/1/2364/98-99, issued by Commercial Tax Officer, Srialahasti. Subsequently, they entered into partnership deed dated 1-1-2001, accordingly, it was registered with the Registrar of Firms bearing No. 49/2004 on 15-6-2004 and also made a representation to the Registrar to get the trade mark registered under the Trade Marks Act, 1999 and the Government of India Trade Marks Registry assigned No. 12899989. Thus since April, 1998, the plaintiff's firm is doing hotel business under the name and style of Hotel Saravana Bhavan and had been paying taxes and ESI contributions promptly and regularly to the concerned Departments.

3. While so, the defendant, on 27-9-2001 inaugurated their hotel business as Swarna Residency and Swarna Restaurant Private Limited, at D.No. 4/46 to 49, in Car Street, Srialahasti, which is just four buildings away from the plaintiff's firm, and in due course of time, having developed eye sore over the prosperity of the plaintiff's business, wanted to start its business in the name and style of Hotel Saravana Bhavan and in furtherance of their desire, suppressing the fact of existence of the plaintiff's business, in the same name and style, at Srialahasti, stealthily got the firm Registration Certificate as M/s. Hotel Saravana Bhavan on 17-9-2003. It is further submitted that the defendants-appellants wantonly opted the said trade name and to get defame to the plaintiff using the plaintiff's name of the trade name i.e., Hotel Chennai Saravana Bhavan, which is similar to the plaintiffs trade name and thus infringed the Trade Mark with a motive to bring disrepute to the plaintiff firm. It is also averred that the appellants though got the registration certificate as Hotel Saravana Bhavan at D.No. 4/46 to 49 stealthily, they are running the trade as Chennai Hotel Saravana Bhavan and put up boards in the name of Chennai Hotel Saravana Bhavan deceptively in the same name of the plaintiff to cause confusion and also proclaimed that they will not allow the plaintiff to run the business in its firm name.

4. The defendants filed their counter denying the averments. It is stated that they have given the name of Chennai Hotel Saravana Bhavan depending entirely on the huge reputation, by Hotel Saravana Bhavan of Chennai and inspired to give the name, they have clearly shown in the outer name board of the hotel the figure of Kripananda Varrier, who inspired the owners of Saravana Bhavan, Madras to give the name of Saravana Bhavan to their hotel with his blessings to the owners of Saravana Bhavan Hotel. It is stated that the word Saravana Bhavan became generic

and have lost all exclusivity or distinctiveness as a trade name and, therefore, the plaintiff cannot claim any exclusive right to use the name of Saravana Bhavan and their trade name as Chennai Hotel Saravana Bhavan, at any rate, is distinctive and different from the trade name of the plaintiff as Hotel Saravana Bhavan. It is averred that the photo of Lord Subramanya or Lord Saravana on one side and the photo of his Bhaktha and staunch devotee Sri Kripananda Varrier on the other side of the name Chennai Hotel Saravana Bhavan, makes it clear to every one, whether literate or illiterate, that the defendant's hotel is entirely different from the hotel of plaintiff. It is stated that though the plaintiff firm entered into partnership deed in the year 2001, they have manipulated the documents to show that they are doing business ever since 1998. It is further submitted that the suit is not maintainable as the Trade Mark is sought to be registered in the names of three individuals and not in the name of plaintiff firm. The reputation of the plaintiff firm is denied, as such the question of defendant's developing eye sore at the turn over, does not arise.

5. On behalf of the plaintiff-respondent herein, Exs.A-1 to A-36 are exhibited while on behalf of the defendants-appellants, Exs.B-1 to B-15 are exhibited.

6. The court below, on scrutiny of the documents, and referring to catena of decisions, accepted the contention of the plaintiff and came to the conclusion that a perusal of Exs.B-1 to B-15 shows that the appellants herein started their hotel business in the name of Hotel Saravana Bhavan. but the board is depicted as Chennai Hotel Saravana Bhavan and thus using the same name as Hotel Saravana Bhavan, naturally creates confusion in the mind of public, more particularly, in the minds of the pilgrims who visit on pilgrimage and, therefore, having regard to the decision [Virendra Dresses Vs. Varindra Garments](#), granted the relief of temporary injunction, restraining the defendants and their men from using the name of Hotel Saravana Bhavan or Chennai Hotel Saravana Bhavan or similar type name to their hotel business at Car Street, Srikalahasti, till the disposal of the suit.

7. Aggrieved of the same, the defendants preferred this Civil Miscellaneous Appeal contending that the court below has failed to note the distinction between infringement of trade mark and passing off action, though the difference was brought to the notice in a decision S.M. Dyechem Limited v. Cadbury (India) Limited (AIR 2000 SC 2114). It is further contended that there is no word "Chennai" in the trade name of the respondent, there is no photo of Lord Saravana (Subramanya Swamy) and Sri Kripananda Varrier on the name board, etc. and contended that the court below ought to have held that in view of the additions, get ups and trade dress up of the name of the hotel of the appellants, there is quite distinction between the two trade names. It is further contended that the first appellant was registered earlier i.e., on 17-9-2003 while the respondent was registered later u/s 58 of the Indian Partnership Act. It is further contended that the hotel of the respondent is situated at a different locality at Peerla Chavidi Street and not in the same locality where the hotel of appellant is situated i.e., Car Street and the name of the hotel of

respondent is "Zen Park" which was interpolated by writing the name of Saravana Bhavan. It is further contended that the court below has erred in holding that the same persons who are running Swarna Residency Restaurant in the 1st and 2nd floors of the building are running "Chennai Saravana Bhavan" in the ground floor while in fact, Swarna Residency Restaurant is being run by a private Limited Company whereas the appellant hotel is being run by a partnership firm. Several other grounds are urged which would be met during the course of discussion hereinafter.

8. On the other hand, the learned counsel for the respondent-plaintiff tried to sustain the order impugned herein and submitted that the court below after thorough scrutiny of evidence and considering the ratio of judgments relied on by both the counsel, rendered a well considered order. It is his contention that the defendant started his business as Swarna Residency and Swarna Restaurant Private Limited, at D. No. 4/46 to 49, Car Street, Srikalahasti, just four buildings away from the plaintiff's hotel on its southern side and got inaugurated on 27-9-2001 by elite section of people and other dignitaries. It is also his contention that since the business of the plaintiff was flourished and got good reputation, to develop their business, the defendants wanted to start their business under the name and style of Hotel Saravana Bhavan, suppressing the fact of existence of the plaintiff's hotel in the name and style of Hotel Saravana Bhavan. It is further submitted that the first defendant wantonly obtained the trade name of plaintiff which is likely to cause confusion to the public and likely to get defame to the plaintiff as it is passing off arising out of the use by the defendants of the trade mark i.e., Hotel Chennai Saravana Bhavan, which is identical, deceptively similar to the plaintiff's trade mark i.e., in the name of Hotel Saravana Bhavan and infringements on the part of the defendants, causing damage to its reputation. Contending so, the learned counsel for the respondent submitted that the learned Judge having regard to these facts and the ratio of the decision in [Virendra Dresses Vs. Varindra Garments](#), , has rightly granted temporary injunction holding that using of the same name as Hotel Saravana Bhavan quite naturally creates confusion in the minds of the public more particularly in the mind of pilgrims, who visit Srikalahasti on pilgrimage and as such, this finding, does not call for any interference.

9. The arena of controversy revolves round passing off action and infringement of trade mark. Therefore, it is apt to know the difference and differentiation between these two. The Apex Court in a decision [Kaviraj Pandit Durga Dutt Sharma Vs. Navaratna Pharmaceutical Laboratories](#), dealing with Section 21 of the Trade Marks Act, 1940, has held:

".....An action for passing off is a common law remedy being in substance an action for deceit, that is, a passing off by a person of his own goods as those of another. But that is not the gist of an action for infringement. The action for infringement is a statutory remedy conferred on the registered proprietor of a registered trade mark

for the vindication of the exclusive right to the use of the trade mark in relation to those goods. The use by the defendant of the trade mark of the plaintiff is not essential in an action for passing off, but is the sine qua non in the case of an action for infringement. No doubt, where the evidence in respect of passing off consists merely of the colourable use of a registered trade mark, the essential features of both the actions might coincide in the sense that what would be a colourable imitation of a trade mark in a passing off action would also be such in an action for infringement of the same trade mark. But there the correspondence between the two ceases. In an action for infringement, the plaintiff must, no doubt, make out that the use of the defendant's mark is likely to deceive, but where the similarity between the plaintiff's and the defendant's mark is so close either visually, phonetically or otherwise, and the court reaches the conclusion that there is no imitation, no further evidence is required to establish that the plaintiff's rights are violated. Expressed in another way, if the essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that the get up, packing and other writing or marks on the goods or on the packets in which he offers his goods for sale show marked differences, or indicate clearly a trade origin different from that of the registered proprietor of the mark would be immaterial, whereas in the case of passing off, the defendants may escape liability if he can show that the added matter is sufficient to distinguish his goods from those of the plaintiff....."

10. With regard to the burden of proof and the essential features of identification, in action for infringement of trade mark, the Apex Court in the same judgment at paragraph No. 29, held as under:

"..... When once the use by the defendant of the mark which is claimed to infringe the plaintiff's mark is shown to be "in the course of trade", the question whether there has been an infringement is to be decided by comparison of the marks. When the two marks are identical no further question arises; for then the infringement is made out. When the two marks are not identical, the plaintiff would have to establish that the mark used by the defendant so nearly resembles the plaintiff's registered trade mark, as is likely to deceive or cause confusion and in relation to goods in respect of which it is registered. Where the question arises in an action for infringement the onus would be on the plaintiff to establish that the trademark used by the defendant in the course of trade in the goods in respect of which his mark is registered, is deceptively similar. This has necessarily to be ascertained by a comparison of the two marks - the degree of resemblance which is necessary to exist to cause deception not being capable of definition by laying down objective standards. The persons who would be deceived are, of course, the purchasers of the goods and it is the likelihood of their being deceived that is the subject of consideration. The resemblance may be phonetic, visual or in the basic idea represented by the plaintiff's mark. The purpose of the comparison is for determining whether the essential features of the plaintiff's trademark are to be found in that used by the defendant. The identification of the essential features of

the mark is in essence a question of fact and depends on the judgment of the court based on the evidence, led before it as regards the usage of the trade. It should, however, be borne in mind that the object of the enquiry in ultimate analysis is whether the mark used by the defendant, as a whole is deceptively similar to that of the registered mark of the plaintiff...."

11. Thus in a passing off action, the common law remedy, is for deceit viz., passing off by a person of his own goods as those of another, whereas, the action for infringement is a statutory remedy, available to the registered proprietor of a registered trade mark for the vindication of the exclusive right to use that trade mark in relation to the goods manufactured by him and thus, the use by the defendant of the trade mark of the plaintiff is not essential in an action for passing off, whereas it is a must in the case of an action for infringement of the trade mark and the onus would be on the plaintiff to establish that the trade mark used by the defendant in the course of trade in the goods in respect of which his mark is registered, is deceptively similar. But in the case of passing off, the defendant may escape the liability if he shows that the added matter is sufficient to distinguish his goods from those of the plaintiff. Thus, the essence of this ratio is that in an action for infringement of trade mark, it should be registered.

12. A Division Bench of this Court, in a decision [Teju Singh Vs. Shanta Devi](#), which arose u/s 27 of the Trade and Merchandise Marks Act, 1958, wherein passing off action was challenged, inasmuch as the trade name of the plaintiff was "One day electric Day Cleaners" and that of the defendants "Only 1 day Electric Dry Cleaners", the plaintiff's design was a man carrying a coat while the defendant's design a bird carrying coat, that the defendant had exhibited the picture of a lady on the wrappers while there was no such picture on the plaintiff's wrappers. Even their sign boards were totally different in their design and a common man was not likely to be deceived and there were no particulars given as to how the plaintiff's words acquired a distinctive meaning nor was evidence adduced to show that his words had acquired any reputation in the locality so as to identify the same with the plaintiff's business. In the context of these facts, a Division Bench of this Court, held that:

".... The onus is on the plaintiff to show that his goods acquired a reputation among the public by some distinctive mark, name, etc. the same principles which are applied in the case of an action for passing off, the goods are applied where the name of a person" business is imitated and passed off by another person as his own. It has now been uniformly laid down as settled rule that either in the case of goods or business, the plaintiff has to show that his mark has become so distinctive that the public regard the same as belonging to a particular source....."

It is further held:

".....So far as the possibility of the visual deception was concerned there was no scope for a customer being misled. In the circumstances, the words do not indicate any special skill and therefore, are only of a descriptive nature and not distinctive so as to sustain the passing off action...."

13. In the context of this principle, I will examine presently, whether there was any deception, either visual or phonetic or whether the words Hotel Saravana Bhavan, has any special skill and so distinct so as to sustain the action of passing off. Presently, I will discuss as to what is meant by descriptive nature of goods. In *Frang Reddaway and Frank Reddaway and Company Limited v. George Banham and George Banham & Company Limited* (1896 AC 199), the plaintiff was manufacturing and selling what is known as Camel Hair Belting. The defendant also began to sell belting made of camel's hair in the name of Camel Hair Belting. It was held that though the name was descriptive of the nature of the goods, it had come to be associated with the plaintiff business and that the defendant should adopt some other device to distinguish his goods. Further, whether the words are descriptive of the goods or not, the true test in determining is whether, as it is commonly used, it is reasonably indicative and descriptive of the thing intended. In order to be descriptive, within the condemnation of the Rule, it is sufficient if information is afforded as to the general nature or character of the articles and it is not necessary that the words or marks used shall compromise a clear, complete and accurate description.

14. Reliance is further placed by the learned counsel for the appellant on a decision of the Supreme Court in *S.M. Dyechem Limited v. Cadbury (India) Limited* AIR 2000 SC 2114 to contend that the plaintiff is not entitled to temporary injunction inasmuch as the peculiar aspects of common features of disputed words viz., peculiar script and curve not copied by the appellants herein and the dissimilarities appearing to be more striking to the naked eye than similarity between the trade marks of both. This was a case, where injunction was sought by the plaintiff to restrain the defendant from using the word PICNIC as it allegedly amounted to infringement of the plaintiff's registered trademark for the use of the word PIKNIK and essential features of plaintiff's trademark. That apart the word PIKNIK, there was also the special script of words in block letters and curve in which those words were inscribed and the caricature of the boy with a hat occurring between the words "K" and "N", on the plaintiff's mark, while the defendant's mark contained the words PICNIC in a straight line, the script was normal and the words "Cadbury" were written above the words PICNIC and neither the peculiar script nor the curve nor the boy with a hat was found in the defendant's mark. In such circumstances, the Apex Court, held that the plaintiff was not entitled for injunction as aforesaid because the dissimilarities appear to be clear and more striking to the naked eye than any similarity between the marks. It was further held that as to the first test the peculiar aspects of the common features of PIKNIK namely the peculiar script and the curve have not been copied; then as to the second test, absence of the peculiar script in

the letters, the curve and the absence of the caricature of the boy with a hat, made the whole thing look dissimilar and these dissimilarities have to be given more importance than the phonetic similarity or the similarity in the use of the word PICNIC for PIKNIK. The Apex Court, having regard to the ratio laid down in Durga Dutt Sharma's case, further held that the proof of resemblance or similarity in cases of passing off and infringement are different. In a passing off action additions, get up or trade-dress might be relevant to enable the defendant to escape. In infringement cases, such facts do not assume relevance, but it is possible that on the same facts, a suit for passing off may fail but a suit for infringement may succeed because the additions, the get up and trade-dress may enable a defendant to escape in a passing off action. In these circumstances, where the injunction was sought by the plaintiff to restrain the defendant from using the word PICNIC as it allegedly amounted to infringement of the plaintiff's registered trade mark for the use of the word PIKNIK, on the basis of passing off action and the defendant's wrapper contained the word "Cadbury" above the words PICNIC, and there was no scope for a purchaser being misled, the relative strength would be more in defendant's favour and plaintiff would not be entitled to injunction.

15. On the basis of these principles, the learned counsel for the appellants contends that the defendant hotel was a partnership firm and was registered on 17-9-2003 u/s 58 of the Indian Partnership Act and they named it after Lord Saravana i.e., Lord Subrahmanyeswara Swamy and the plaintiff filed O.S. No. 20 of 2004, along with I.A. No. 1015 of 2004 for the grant of temporary injunction restraining the defendant from running their hotel under the name and style of Chennai Hotel Saravana Bhavan at Srikalahasti. It is contended that Saravana is a generic name which is being used in several parts of the country and abroad viz., Singapore, California (United States of America) Ontario (Canada), Dubai, etc. and contended that the plaintiff is not running the hotel under the name and style of Hotel Saravana Bhavan from 1998 muchless in 2001. It is also contended that the licence issued in Form II under the provisions of Food Adulteration Act shows that the plaintiff's hotel is being run at the same location i.e., Car Street, where the hotel of the defendant is being run. It is further contended that the old name Gen Park is struck off with ink and interpolated as that of Hotel Saravana Bhavan. Therefore, it is an issue which has to be enquired into, at the time of trial of the suit. It is further contended that the firm of the defendant is registered under the Indian Partnership Act on 17-9-2003 whereas, the firm of the plaintiff is registered on 15-6-2004. It is also sought to contend that the court below has not considered the distinction between infringement of trademark and infringement of passing off. The name board of the defendants consists of photos of Lord Saravana and his devotee Sri Kripananda Varrier on either side and is inscribed with High Class Veg. Restaurant and it is distinct from the inscription Vegetarian A/c. Restaurant. These distinct marks were not considered by the court below even though the principle underlying in M/s. S.M. Dychem Limited (3rd read above) was highlighted before the court below.

16. On the other hand, in reply to the contentions raised by the learned counsel for the defendants, the learned counsel for the plaintiff tries to sustain the findings of the court below. He submits that the starting of the business by the defendants in the self same name and style, in the very vicinity of the plaintiff's hotel, amounts to infringement of the Trade Marks Act, which is likely to cause confusion in the mind of public. Contending so, reliance is placed on a decision [Virendra Dresses Vs. Varindra Garments](#), . This is. a case where, the plaintiff was carrying on business of ready made garments under the name and style of Virendra Dresses and the defendant, some two years thereafter, started a similar business on the same street, as that of the plaintiff under the name and style of Varindera Garments and a suit came to be filed by the plaintiff for permanent injunction for passing off against the defendant and an application for interim injunction restraining the defendant from adopting the said trade name was also filed by the plaintiff along with the suit. When the trial Court refused to issue interim injunction, the Delhi High Court has held that the two trade names of the plaintiffs and the defendant were not distinctively different but were similar and this similarity was sufficient to give rise to great risk of confusion and it would mislead the people to believe that the business of the defendant was the business of the plaintiffs and, therefore, the order of the trial court, was, therefore, liable to be set aside and the plaintiffs were, therefore, held entitled for grant of interim injunction.

17. Reliance is further sought to be placed on yet another decision of Delhi High Court in Glaxo Smithy Kline Pharmaceuticals Limited (formerly known as Glaxo India Limited) v. Biovet Formulations 2004 (3) CCC 208 (Delhi) to contend that in a case of passing off action, court has to see the similarity between plaintiff's mark and the offending mark of the defendant and to determine whether there was any likelihood of deception and confusion. A suit for permanent injunction u/s 51 of the Copyright Act was filed for passing off and copyright. The plaintiff was manufacturing pharmaceutical preparations for veterinary use under the Trade Mark NILVERM with design container label registered as copyright while the defendant was manufacturing and marketing same drug bearing trademark as NILSOLE. The packing material of the defendant was a slavish copy of plaintiff's artistic work in material form in colour scheme, get up, layout, colour and combination and amounted to infringement of plaintiff's artistic work. In such circumstances, the court held that in a case of passing off action, court has to see the similarity between two trademarks to determine whether there was likelihood of deception and confusion to a person of average intelligence and imperfect recollection, overall structural similarity of product of defendant was likely to cause confusion. In the facts of the case, it was held that the defendant infringing the trademark of plaintiff and passing off its goods as those of plaintiff's and, therefore, the plaintiff is entitled to injunction and consequently granted injunction, as prayed for. To the same effect, is a judgment of Delhi High Court reported in Alfred Dunhill Limited v. R.P.S. Chawla and Ors. 2004 (3) CCC 415 (Delhi). In this case, the plaintiff was holding

the trademark of Dunhill for its exquisite and diversified range of luxury and fashion goods while the defendants were also engaged and were carrying business of manufacturing, distributing and selling various bicycle parts including paddles, axles and cycle seats bearing trade mark sunhill. The plaintiff filed a suit and sought interim injunction in the matter of passing off. The Delhi High Court, dwelling on the question whether two marks could be said to be deceptively, confusingly similar to each other, it was held that the conduct of defendant was relevant factor to know his bona fide. In that case, having regard to the facts of the case, it was held that the two words were phonetically similar and action of defendant in adopting Sunhill was not based on good faith and was not bona fide and, therefore, the plaintiff was held to be entitled to interim injunction.

18. The learned counsel for the respondent further sought to place reliance on a latest decision of the Apex Court in [Satyam Infoway Ltd. Vs. Sifynet Solutions Pvt. Ltd.](#), to contend that when there is likelihood of confusion to public and when the plaintiff is prior user, the plaintiff is entitled to interim injunction. In this case, the plaintiff which was carrying on internet business through domain name starting with words "sify" sought injunction for passing off action, u/s 29 of the Trade Marks Act, against the defendant, which subsequently started business under domain name "siffynet". The fact that plaintiff is the largest internet service providers in the country and the reputation and goodwill of the plaintiff was not disputed by defendant. The court, on consideration of the fact that the words "sify" and "siffy" were visually and phonetically similar and thus the defendant adopted its name after the plaintiff and, therefore, the explanation that the word "Siffy" was derived from the names of its promoters was held only an afterthought, and held that there is every likelihood of confusion to the public, more particularly when both plaintiff and the defendant were providing the similar services. It is further held that there is sufficient evidence to show that the plaintiff is prior user and that the public associate Sify with plaintiff and, as such, in such circumstances, in the facts of the case, it was held that balance of convenience was in favour of plaintiff and therefore, the plea of the defendant that no prejudice would be caused to the plaintiff as it had another domain name was rejected.

19. In the backdrop of contentions raised by both the counsel and the judicial pronouncements relied on by them and the placed in the facts and circumstances of the case, I shall now first proceed to consider whether any of the parties can claim exclusive rights over the trade mark and whether the provisions of the Trade Marks Act insofar as infringement of Trade Mark is concerned.

20. At the outset, it must be remembered that for claiming exclusive right over a trademark, one has to register the same under the provisions of the Trade Marks Act. In the instant case, evidently, neither the plaintiff nor the defendants have registered their trademark under the provisions of the Act and the remedy for its infringement is a statutory remedy conferred on the registered proprietor of the

said trademark for vindication of his exclusive right. The infringement of trademark can be noticed if the essential features of the trademark of the plaintiff have been adopted by the defendant. On the other hand, an action for passing off is an action for deceit i.e., a passing off by a person of his own goods as those of another and this is a common law remedy and the defendants may escape the liability, if they show that the added matter is sufficient to distinguish his goods or characteristics viz., trade-dress, get up or additions, from those of the plaintiff.

21. As observed earlier, neither the plaintiff nor the defendants have registered their trademark, as contemplated under the Act. On the other hand, the contention of the plaintiff is that since it has registered the firm under the Partnership Act and the Commercial Tax Department has issued certificate, Ex.A-1, evidencing payment of tax and contribution to the ESI for its employees, therefore, the subject matter of the suit falls within the ambit of infringement of trademark.

22. Having regard to these facts, I shall now proceed to examine whether the actions of the defendants-appellants attract infringement of trademark of the plaintiff, as contended by it. The name board of the appellants-defendants shows that it is Chennai Hotel Saravana Bhavan inscribed in big and bold letters while the name of the hotel of the Respondent is Hotel Saravana Bhavan inscribed in small letters, that the photo of Saravan (Lord Subramanya Swamy) is found on the left side of the board and that his devotees photo i.e., Sri Kripananda Varrier, on the right side of the defendants' name board. Further the description of appellants hotel is given as High Class Veg. Restaurant whereas, it is given as Vegetarian A/C. Restaurant as that of the respondent, the name board of the appellant is inscribed in both Tamil and English while it is in English and Telugu in respect of the respondent-plaintiff's hotel. Thus due to the additions, get up and trade-dress of the appellant's hotel, it is quite distinct from that of the respondent-plaintiff's hotel and in view of these dissimilarities, there is no scope of confusion in the mind of customers. The plaintiff has started the hotel business in the name and style of Zen Park and subsequently, the partnership firm started that business registering it in the year 2004 while the defendants-appellants have registered their firm and started its business earlier to the plaintiff. These aspects were lost sight by the court below. That apart, as contended by learned counsel for the defendants-appellants, the genuineness or otherwise of the documents relied on by the plaintiff has to be established during the course of trial. Therefore, having regard to the facts of the Division Bench judgment of this court in Teju Singh's case (2nd read supra) wherein the trade name of the plaintiff was "One day electric Day Cleaners" and that of the defendants "Only 1 day Electric Dry Cleaners", the plaintiff's design was a man carrying a coat while the defendant's design a bird carrying coat, that the defendant had exhibited the picture of a lady on the wrappers while there was no such picture on the plaintiff's wrappers, and their signboards were totally different in their design; and also having regard to the facts of the case in S.M. Dychem Limited v. Cadbury (India) Limited (3rd read supra) wherein the word PIKNIK, was inscribed

with a special script of words in block letters and curve in which those words were inscribed and the cartoons of the boy with a hat appearing in between the words "K" and "N", on the plaintiff's mark, while the defendant's mark contained the words simply as PICNIC in a normal script with the inscription of the words "Cadbury" above the words PICNIC, in the absence of peculiar script, the curve or the boy with a hat was found in the defendant's mark, it must be held that there are more dissimilarities than similarities, on comparison of the name boards of the plaintiff and the defendant and there is no scope for a common man to be swayed away by such highlighted dissimilarities. In these circumstances, I am of the considered view that the ratio laid down in *M/s. Virendra Dresses* (4th read supra) wherein the Delhi High Court has granted interim injunction holding that the two trade names of the plaintiffs (*Virendra Dresses*) and the defendant (*Varinder Garments*) were not distinctively different but were similar and this similarity was sufficient to give rise to great risk of confusion, does not fit in, in the facts of the case on hand. In *Biovet Formulations* case (5th read supra) which arose under Copyright Act, the artistic work in the material form and colour, get up, layout and combination was copied by the defendant. Thus the court, having regard to the oneness of such combination, held that the defendant has infringed the trademark of the plaintiff. As pointed out earlier, there are more dissimilarities than similarities between the trade name of the plaintiff and the defendants. Therefore, the principle laid down in this case can hardly be made applicable to the facts and circumstances of the case. The principle laid down in *Alfred Dunhill's* case (6th read supra) is of no avail to the appellants herein, inasmuch as the plaintiff and the defendant therein were carrying two different businesses and the arena of controversy was with regard to the conduct of the defendant in deceptively choosing the trade name as *Sunhill*, which phonetically sounds same as *Dunhill*, whereas in the instant case, there is dissimilarity in the name of the hotels itself. The addition of "Chennai" in the name of the appellants-defendants makes all the difference, besides other dissimilarities. Likewise, in *Satyam Infoway's* case (7th read supra), relied on by the learned counsel for the respondent, the Apex Court considered the phonetic similarity between the internet domain name of the plaintiff starting with "sify" and the defendant's name as "Siffy" and also discarded the explanation that the defendant derived the name from its promoters. But as stated earlier, the script in Tamil and addition of Chennai in name of the defendant's hotel, makes all the difference. Therefore, there is hardly any comparison of similarity between the trade names of the plaintiff and the defendant. It is submitted that the word *Saravana* has become generic and lost its characteristics of distinctiveness and consequently, the plaintiff cannot claim exclusivity of this trade name, more particularly when the hotel of the appellants is known as *Hotel Chennai Sharavana Bhavan*. For these reasons, the reasoning of the learned trial Judge that the pilgrims will be confused in their mind as to the identity of the hotel, cannot sustain. Consequently, the impugned order is set aside and the injunction granted by the lower court is vacated. The Civil Miscellaneous Appeal is accordingly allowed. No order as to costs.