

(2013) 04 IPAB CK 0008

In the Intellectual Property Appellate Board

Case No : OA/13/2011/TM/CH, M.P. Nos. 32, 180/2011 In OA/13/2011/TM/CH,
OA/58/2010/TM/CH, MP Nos. 324/2010, 129/2011, 152 to 154/2012
In OA/58/2010/TM/CH

M/S. Thalappakattu Biriyani & Fast Food

APPELLANT

Vs

M/S. Thalappakatti Ananda Vilas Biriyani Hotel And The
Deputy Registrar Of Trade Marks, Trade Marks Registry

RESPONDENT

Date of Decision : 05-04-2013

Acts Referred:

Citation : (2013) 04 IPAB CK 0008

Hon'ble Judges : Prabha Sridevan, J; V. Ravi, Technical Member

Bench : Division Bench

Advocate : M. Veeranthiran, V.T. Gopalan, M. Veeranthiran, Muthukumarasamy

Final Decision : Dismissed

Judgement

Prabha Sridevan, J

OA/13/2011/TM/CH

1. The mark in question was applied for by the respondent herein. It was opposed by the appellant. The respondent applied for Thalappakatti Biriyani

Hotel under Application No. 1408388 in Class 42. That was opposed by the appellant. Both the oppositions went in favour of the respondent herein.

Here we are concerned with the mark 1385141 applied for by the appellant. The appellant's application was made on 15.09.2005 claiming user from

30.04.2005. It was advertised in the TM Journal 1352 dated 16.08.2006. The notice of opposition was filed on 16.03.2007 by the respondent. The

respondents application was made on 23.12.2005 claiming user from 07.04.1957. It was advertised in the TM Journal No. 1371 dated 01.07.2007. The

appellant filed the Notice of Opposition on 08.01.2008. Hearing was held on

06.08.2010 in both the matters and Orders were passed on 20.09.2010

allowing respondents opposition and dismissing the appellants opposition and therefore the present appeals have been filed.

2. The facts before us are as follows:- Way back in 1957, one Nagasamy Naidu who is the Father of N. Dhanapalan who claimed to be the partner of

the firm Thalappakattu Naidu Ananda Vilas Biriyani Hotel (Thalappakkattu AVBH) commenced the hotel business. According to the pleadings, D.

Nagasamy Naidu always wore a Turban. He was referred to as Thalappakatti Naidu. According to the respondent the Biriyani stall was called

Ananda Vilas Biriyani Stall which became famous as Thalappakattu Biriyani Naidu Hotel. Nagaswamy died in 1978. The business was carried on by

his son N. Dhanapalan as Thalappakatti Ananda Vilas Biriyani Hotel. According to the respondent, it thereafter became a partnership firm with N.

Dhanapalan and his son D. Nagasamy as partners. They had acquired a huge reputation because of the quality of the Biriyani. Articles were

published in various journals. It was even mentioned in Tamil Movies with the result the word 'Thalappakatti' automatically referred to Biriyani. This

use of the word 'Thalappakatti' was continuous, extensive and open.

3. The appellant, claimed that one of their ancestors one Mr. Sulaiman was the Chief of the Horse Regiment in the palace of Raja of Sivaganga. He

used to wear 'Turban which is called Thalappakattu and according to the appellant, they were Thalappakattu Rawthers. They started the Hotel

business in a small scale in 2005 and as a mark of respect for their grand father and fore father they adopted the word 'Thalappakattu'. According to

the appellant they served extremely delicious Biriyani and the adoption was bonafide. They refuted the claim of the respondent that the father

Nagaswamy Naidu was known as the Thalappakattu Naidu and that they carried on their business only as Ananda Vilas Biriyani (AVB).

4. The Deputy Registrar of Trade Marks had held on the basis of the evidence that the respondents is the prior and genuine adopter and continuous

user of the mark Thalappakatti which is distinctive and unique and that the mark of appellants 'Thalappakattu' is an imitation and was likely to cause

confusion.

5. The period of user is undisputed. There is evidence which we will discuss herein after to show that the Biriyani cooked at the respondents outlets

was referred to as 'Thalappakatti Biriyani'. The appellant had come much later only in 2005. While it may be true that the appellant's grandfather wore turban, it is very difficult to accept that the respondent did not know about the Biriyani Hotel in Dindigul. The consumers are the same, the mark is almost identical. Therefore we will have to see why we should interfere with the Impugned Orders.

6. A technical objection was taken that the mark was applied for in the name of Thalappakatti Biriyani Ananda Vilas Hotel and therefore the Counter

Statement filed by Dhanapalan should not have been taken on record and any TM-16 filed thereafter will not cure the defect. Therefore, it appears as

if the appellant has to succeed its case on this slender thread of technicality. The Commercial Tax Department Assessment Orders have been filed to

show that the Assessee is Ananda Vilas Biriyani and after 1997 the Assessee is Thalappakatti Naidu Ananda Vilas Biriyani Hotel. There is the

Notice of Demand issued under the Sales Tax Rules for the year 2001-2002 that has been served on Thalappakatti Naidu Ananda Vilas Biriyani

Hotel. In 1998, we find that the respondent had started a branch in Coimbatore and there is a certificate of registration issued by the Commercial Tax

Officer in favour of Thalappakatti Naidu Ananda Vilas Biriyani Hotel. The Income Tax is in the name of Dhanapalan proprietor of Thalappakatti

Naidu Ananda Vilas Biriyani & Chappatti Stall. This is for the year 1989-90. There are many such orders to the same effect showing Dhanapalan as

the Proprietor of Thalappakatti Naidu Ananda Vilas Biriyani & Chappatti Stall. Then there are bills raised for the advertisements in the name of

Thalappakatti Naidu Ananda Vilas Biriyani & Chappatti Stall. Of course there are some documents which show claims in the name of Ananda Vilas

Biriyani & Chappatti Stall. There is a letter dated 30.10.1995 addressed by one Krishna & Krishna from Andaman indicating that a Biriyani Stall like

the respondent could be opened in Andaman. This indicates that the fame of the respondents had reached Andaman. In fact, it is addressed to

Thalappakatti Biiriyani Kadai Urimaiyalar Avargalukku"" [To the proprietor of Thalappa Katti Biriyani Shop]. There is an advertisement in the

Dhinamalar"" issue dated 14.04.1995 showing Thalappakatti Naidu Biriyani Kadai with the picture of the gentleman. Many such advertisements have

been enclosed of the year 1995, 1996 and so. On the question and answer feature of ""Tarasu 1991"", there is a reference to Dindigul Thalappakatti

Kadai Biriyani. In the 'Varamalar' of the year 22.02.1996 there is a reference given to the respondent's Biriyani. There is an article which says that

this Hotel is not a Five Star Hotel but there is no VIP who has not enjoyed the Dhindigal Thalappakatti Naidu's Biriyani. This is in an issue of

'KUMKUMAM'. There is an interview of Mr.Dhanapalan in a Magazine in January, 2006 which speaks of the history of the shop and that he knew

even from the 1950s when he was just a one year old child that his father started the business and it was called Thalappakatti Kadai. From 2006,

Suryan FM Radio has advertised the respondents products. There are proceedings before the Hon'ble Madras High Court and at paragraph 43 of the

order of the Division Bench it is stated that "" If the essential feature of the trade mark of Plaintiff have been adopted by the Defendant, the Defendant

cannot contend that plaintiff is not entitled to protection of the entire word mark and that there is no infringement of the entire mark. Essential feature

in the mark is Thalappakatti. According to Plaintiff, their grandfather was famous for his Biriyani and was also well known for the turban (Thalappa)

which he tied around his head and he was associated with the Thalappa and he decided to name his first restaurant as Thalappakatti Naidu Biriyani

Kadai and Plaintiff using the trade name since 1957 and maintaining the quality. Defendant having used the essential feature of the mark

Thalappakatti is a clear case of infringement.

7. Long before this controversy arose, there are news items which speak of the commencement of business in 1957 and how the word Thalappakatti

has made its imprint in the entire Tamil Nadu. This is a News paper dated 20.10.1995. In ""Dhinamalar"" of the year 1995, there is a memorial to the

Father which says ""Biriyani Enrale Thalappakatti enra ninavai thandhidum"". (Even the mention of Biriyani will recall Thalappakatti's menu").

8. The learned Counsel appearing for both sides made their submissions. Submissions made for respondents were of course based on prior user,

continuous use, strong reputation and dishonesty in adoption for which he relied on the documents mentioned above.

9. Learned Senior Counsel appearing for the appellant on the other hand submitted that no one would mistake one device for the other. The Mark of

the respondent had a Man with the turban whereas the mark of the appellant had just a turban and curve. According to the learned Senior Counsel

appearing for the appellant, a common man looking at the two marks will not confuse or mistake one for the other. The learned Counsel referred to

Prima Reality Vs. Union of India (UOI) and Others"" - 1996-11 (SCC) where it was held that the appellant was a firm with the name ""Prima Realty

whereas in the cheque the payee was described as ""Prime Reality Limited"" and that the limited company is not a firm and the tender could not be

treated as a valid tender. This arose under the Income Tax Act. The other decision relied on is ""Ram Autar Lal Jain Vs. The Minister of Transport

and Ors."" 1974 1 (SCC) 305 where it was held that under the Motor Vehicles Act in an application for such carriage permit to a route, if the applicant

dies pending application, the areas and legal representatives cannot be substituted, if the deceased applicant did not possess any vehicle of his own. A

Memo was also filed on behalf of the appellant to show that Thalappakatti Hotel was registered on 15.04.1998 and it is still active. This Memo relates

to the entitlement of the appellant to have his mark (Thalappakattu) registered.

10. But at the stage of opposition, any person can oppose the registration. And here, the opposition has been filed by N. Dhanapalan, carrying on

business at 15, Eastern Street, Dindigul. In his opposition, he has stated that his father started business in 1957 and the use been continuous. The issue

relating to TM(16) filed by the respondent will be separately dealt by us. Here, we only have to see whether the appellant has honestly and bonafidely

adopted the mark.

11. The evidence filed by the respondent is very strong and we cannot disregard his case that the Thalappakatti had in fact become synonymous with

their Biriyani. It is true that the respondent had originally focused their business in Dindigul but the evidence shows that their fame had spread far and

wide and big political leaders had enjoyed their product and long before the controversy created by the appellant by the adoption of the mark in 2005,

the respondents had established their reputation by interviews with Dhanapalan, by news papers, in various magazines and even movies. In fact, the

repeated claim made by the respondent is that generation after generation people have enjoyed their Biriyani.

12. We cannot accept the case of honest adoption. It may be true that the grand father of the appellant was in Sivagangai Regiment and wore turban

but in the face of the evidence adduced by the respondent, our only conclusion

can be of dishonesty in adoption. Biryani is enjoyed by consumers from all classes and from all economic strata and also by people both literate and illiterate. The word Thalappakattu and Thalappakatti do not even have any phonetic difference. The last syllable is not stressed and the focus of the ordinary consumer will not be on the last word. In fact in speech both the Thalappakatti and Thalappakattu will be used interchangeably. The appellant clearly intended to ride on the respondent's reputation. The consumers come from the same category, the goods are the same. The fact that originally the respondent started the business only in Dindigul is irrelevant. Any ordinary person would easily conclude that the Dindigul people have started an outlet in Chennai. In fact, the respondent had much earlier started an outlet in Coimbatore. The Impugned Order was right in its conclusion of dishonesty of adoption, imitation and confusion. The user of the respondent precedes the appellant by 50 years. The appeal is dismissed with costs of Rs. 20,000/-. Miscellaneous Petition Nos. M.P.Nos. 32 & 180/2011 are closed.

OA/58/2010/TM/CH:

13. This appeal relates to a TM-16 filed by the respondent. The grounds raised are that they had no opportunity and Registry had mechanically taken on record the TM(16). It was also stated that the application No. 1408388 is invalid. It has been filed by a different party other than the proposed amendment in TM(16) namely Thalappakatti Naidu Ananda Vilas Biryani Hotel (Thalappakatti Naidu AVBH). The appellants are aggrieved by the order of Registrar allowing the TM(16).

14. The appellant filed a TM(16) to include an averments relating to pendency of proceedings before the Hon'ble High Court. The respondents filed TM(16) to change the name of the applicants to be read as Dhanapalan & Nagasamy partners of Thalappakatti Naidu AVBH and there was also a change of Counsel. Also, an Order had been passed by the Registrar relating to a hearing that took place on 22.04.2009 and a request was made in Form TM(57) by the appellant herein saying that at that hearing they were not given an opportunity. This review was allowed and then the two TM(16) were taken up.

15. We called for the original records. We find that originally the application was made in the name of Sh. N. Dhanapalan, D. Padmavathi and Shri

Nagasamy, Directors of Thalappakatti Biriyani Hotel Private Limited claiming user from 07.04.1957. They were represented by a Counsel who had

signed the Form TM(1). It was advertised Before Acceptance in the name of Thalappakatti Biriyani Hotel Private Limited as the service provider

with the same Counsel's name for address for service. Form TM(16) is for a change of the name of the applicants to be read as N. Dhanapalan, D.

Nagasamy partners of Thalappakatti Naidu AVBH famously known as Thalappakatti Biriyani Hotel. The other change is regarding the Counsel. This

application is made on 17.03.2008. The Counter Statement to the opposition by the appellant was filed on 18.03.2008 i.e. the date after the TM(16)

filed. TM-16 was ordered on 27.07.2010 in the absence of both the parties and the main matter was disposed on 20.09.2010. The respondents in the

opposition proceeding against them had stated that they would not be filing any separate evidence and would be relying on the evidence filed by the

opponents in the opposition proceedings to the appellants registration which is the subject matter of OA/13/2011, now that has been filed by P.

Nagasamy claiming to be the partner of Thalappakatti Naidu AVBH. In paragraph 3 of this opposition, it is stated that the business carried on by late

Shri Nagasamy Naidu (Thalapakatti Naidu) from 1957 was continued after him by N. Dhanapalan in the name and style of Thalappakatti Naidu

Ananda Vilas Biriyani Stall which is now called Thalappakatti Naidu Ananda Vilas Biriyani Hotel. After 1978 this business was carried on as a

partnership. It is stated that this business was changed into a partnership in April, 2002 by inducting N. Dhanapalan's son D. Nagasamy Naidu.

Paragraph 5 speaks of the promotion of the company in the name and style of Thalappakatti Biriyani Hotel Private Limited. Paragraph 6 of this states

that the opponent has taken steps to protect their mark by applying for registration. Therefore, we do not see any irregularity in the respondents

seeking amendment. If there is a difficulty, it lies in the respondents filing the pleadings before the TM(16) had been ordered. But in the back ground

of the pleadings which we have extracted here, we do not think any interference is warranted. This appeal is dismissed with no costs. Miscellaneous

Petition Nos. 324/2010, 129/2011 & 152 to 154/2012 are closed.

16. OA/13/2011/TM/CH is dismissed with costs of Rs. 20,000/-. OA/58/2010/TM/CH is dismissed with no costs.