

(2010) 09 IPAB CK 0008

In the Intellectual Property Appellate Board

Case No : S.R. No. 42/10/TM/IPAB

Bhatia Industries And Tiya Industries

APPELLANT

Vs

Sharad Pandey, Trading As Pandey Industries And The
Registrar Of Trade Marks

RESPONDENT

Date of Decision : 03-09-2010

Acts Referred:

Trade Marks Act, 1999 — Section 42, 45, 47

Citation : (2010) 09 IPAB CK 0008

Hon'ble Judges : S. Usha, J; Syed Obaidur Rahaman, Technical Member

Bench : Division Bench

Judgement

S. Usha, J

1. The rectification application has not been numbered but placed before us for deciding the issue of maintainability on the ground as to how one

application is filed by two applicants.

2. The counsel for the applicant stated that the second applicant M/s Tiya Industries adopted the trade mark TIYA in the year 1974 and had been

using the same continuously and extensively by which they have acquired an exclusive right to use the trade mark. They have obtained registration of

the trade mark TIYA under No. 299272 in class 6 as of 13.09.1974 and the same has been renewed till 13.09.1988. On 7th March, 1983 the second

applicant assigned the trade mark in favour of the first applicant M/s Bhatia Industries by a deed of assignment and transferred all rights and interest

in the trade mark in favour of the first applicant. The counsel further stated that as per Section 47 of the Trade Marks Act, 1999, there is no mention

as to that the application for rectification can be filed by only one applicant. The counsel further relied on Form-1 an application for removal of the

trade mark and stated that it mentions as ""I or we"" which is that it can be either by one or more persons. The counsel also relied on the judgment

reported in AIR 1959 Patna 54 Moti Lal v. The State

3. The counsel has further averred that by assignment the first applicant has stepped into the shoes of the second applicant and continues to use the

same continuously since 1974. The first applicant has filed a request on Form TM-24 for bringing on record the name of the subsequent proprietor but

the same could not be taken on record for various reasons. The registered trade mark was also not renewed. The first applicant has therefore made a

fresh application for registration of the trade mark.

4. We have heard and considered the arguments of the counsel. In the instant case, the above application is an application for rectification and the

application for rectification can be filed by a person aggrieved and need not have to be a registered proprietor or user. The mark which has been

assigned has not taken effect as per the provisions of Section 42 of the Trade Marks Act, 1999 (hereinafter referred to as the Act). As per Section 42

of the Act, the mark whether registered or unregistered, the procedure prescribed therein is to be followed within six months. If the same is not done

within six months, the assignment will become inoperative for registration of the title as per Section 45 of the Act. In such circumstances, it will be a

ground for rectification as the mark is wrongly remaining on the Register. In this case, it is seen that for this reason, in our opinion the first applicant

has made a fresh application. The rights whatever were with the second applicant has passed on to the first applicant by assignment. The first

applicant's own admission is also that they have stepped into the shoes of the second applicant. It has not been established as to how the second

applicant is a proper and necessary party to the proceedings. The objection raised by the Registry is, therefore, upheld.

5. Liberty is granted to the applicant to amend the application and the statement of case. The applicant is directed to strike off the name of the second

applicant and file the amended copy within 15 days from the date of receipt of this order.

6. In view of the above, the office objection is upheld. The applicant is at liberty to file amended copy of application and statement of case within a

period of 15 days from the date of receipt of this order. In case of default, the

registry is directed to strike out the name of the second applicant and number the application if in order otherwise.