

**(2013) 03 IPAB CK 0007**

**In the Intellectual Property Appellate Board**

**Case No :** OA/58/2008/TM/DEL, M.P. Nos. 142, 210, 282/2012 In OA/58/2008/TM/DEL

Bhupinder Jain

APPELLANT

Vs

Sachdeva & Sons Industries Pvt. Ltd.

RESPONDENT

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**Date of Decision :** 07-03-2013

**Acts Referred:**

Transfer Of Property Act, 1882 — Section 53  
Code Of Civil Procedure, 1908 — Order 41 Rule 27

**Citation :** (2013) 54 PTC 204 (IPAB) : (2013) 3 RCR (Civil) 394

**Hon'ble Judges :** S. Usha, J;V. Ravi, Technical Member

**Bench :** Division Bench

**Advocate :** Manchanda, Gaurav Arora, Kamal Kishore Arora

**Final Decision :** Dismissed

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**Judgement**

V. Ravi, Technical Member

(No. 39 of 2013)

1. Three Miscellaneous Petitions filed by the appellant came up for hearing before us on 25.09.2012. The brief facts giving rise to these MPs are

stated below separately.

A.M.P. No. 142 of 2012:

1 a. The appellants and their family are engaged in the processing & marketing of rice of all kinds using several trade marks. Recently, the trade marks were divided by assigning and transferring it in the different name and entities.

b. The trade mark now in appeal UDAN PARI (amongst others) stands transferred/assigned to M/s Jain Riceland Pvt. Ltd., New Delhi in which the

appellant Shri Bupender Jain is also one of the Directors of the said company. Copy of the assignment deed executed on 12th April, 2012 by Shri

Bupender Jain trading as M/s Mahaveer Rice Traders, Delhi in favour of Jain Rice Land Pvt. Ltd. is also furnished. It has thus become imperative to

file the present M.P. for amendment/modification of the name & address of the appellant as this transaction took place during the pendency of the present appeal.

c. The subject M.P. has been filed bonafide in the interest of justice, equity and in good conscience without any delay.

d. No prejudice will be caused to the respondent if the said amendment in the name and address is allowed.

The respondent to the main petition have objected to this M.P. on the following grounds:

a. The petition is an after thought idea and belatedly filed.

b. The M.P. has been supported by a defective affidavit as it does not disclose the exact date on which Shri Bupender Jain became a Director of M/s

Jain Rice Land Pvt. Ltd. and deserves to be rejected outright.

c. There is no Board resolution authorizing Shri Bupender Jain to depose, verify and prosecute the instant appellate proceeding.

d. The appellant/petitioner has deliberately avoided filing the complete set of 'Articles of Association' and 'Memorandum of Association' of M/s Jains

Rice Land Pvt. Ltd. and is therefore not entitled to any relief.

e. The MP has been deliberately filed in an attempt to build up an entirely new case at the appellate's stage.

f. The MP is completely misconceived and an abuse of the process of law as it is filed after the evidence stage in the main petition has since long

been closed and the case is mature for hearing on merit. The appellants are determined to prolong the final adjudication of the main appeal and

g. their conduct is dishonest and malafide. During the last four years, since the filing of the impugned appeal, the appellant have filed three separate

MPs [No. 132/08, 186/08 and 187/08] all of which has been dismissed by the Board for valid reasons.

h. The so called assignment deed now tendered is a sham document as the appellants main application has already been dismissed by the Registrar

holding that they are not the proprietor of the impugned mark Udan Pari.

i. The impugned trade mark alone has been assigned by the appellant for a nominal sum of Rs. 1000/- to M/s Jain Rice Land Pvt. Ltd. The goodwill of business does not stand transferred/assigned automatically and the request for assignment is based on unproved statement.

j. The date of adoption of the impugned trade mark Udan Pari has not been disclosed and therefore the appellant have come before the Board with an unclean hand.

k. In view of the foregoing, no valid case for allowing the M.P has been set out and the same deserves to be dismissed.

## 2. REJOINDER OF APPELLANT:

In rejoinder, the appellant state that the M.P seeks amendments which are formal, just and necessary for determination of the controversy in these

proceedings. It does not take away any defence or rights pleaded or raised by the respondent. The appellant further state that there has been no delay

in approaching the Board for seeking amendment of the name & address of the appellant. The parties to the deed are in family relation and they can

assign and transfer rights in their trade mark for consideration of even rupee one. The respondent/opponent herein have no right to interfere or

challenge the content of the assignment deed and or the consideration amount entered in the deed. All the grievances raised by the respondent are

baseless, frivolous and are not relevant to the proceedings.

## AUTHORITIES:

i) In support of the miscellaneous petition the appellant relied on the following authorities.

The respondent relied on the following authorities.

1. Union of India Versus Moksh Builders and Financiers Ltd and others etc.

Transfer of Property Act, 1882, Section 53-Sham transaction -- Real owner of a house purchasing it in name of his son -- Real owner in arrears of

large amount of income tax -- Incorporation of Company during recovery proceedings -- Company dominated by his son and his relatives -- Sale of

house by his son to Company -- Held it was sham transaction so as to save the house from sale for realisation of income tax.

2. M/s. Onam Agarbathi Company Versus The Deputy Commissioner of Income Tax

The taxing statute to be applied in order to assess the substance of transaction so as to ascertain whether it is a sham or make believe transaction or

one which is real and genuine and therefore is eligible for deduction of Commission payments under the Act -- Hence, Courts are required to look into

the form of transaction to find out its substance so as to ensure that there is no avoidance of tax by a method not permissible in law.

3. M. Venkataramana Hebbar (D) By Legal Representatives Versus M. Rajagopal Hebbar & Ors.

If a plea which was relevant for the purpose of maintaining a suit had not been specifically traversed, the Court was entitled to draw an inference that

the same had been admitted.

4. Mithoolal Nayak Versus Life Insurance Corporation of India

Assignee cannot claim benefit of contract -- Appellant who holds an assignment of the policy cannot stand on a better footing than the insured.

5. Definition of Goodwill (Law Lexicon) by P. Ramanatha Aiyar

Good-will: The good will of a business means every affirmative advantage, as contrasted with negative advantage that has been acquired in carrying

on the business, whether connected with the premises of the business of its name or style and everything connected with or carrying with it the benefit

of the business.

B.M.P. No. 210 of 2012:

1. This MP was also filed by the appellant seeking the relief of republication of the impugned trade mark in the Trade Marks Journal by the Registrar

on the following grounds.

a. M/s JAIN Rice Land Pvt. Ltd., New Delhi are the subsequent appellant of the impugned mark for which an MP has already been filed before the

Board under No. 142/2012 and which is pending adjudication.

b. It came to the knowledge of the subsequent appellant that the impugned trade mark was applied for as a label mark which however was published

as a word mark erroneously by the Registry in TM Journal Mega No. 5 dated 15.11.2003. The wrongly published trade mark was opposed by M/s

Sachdeva & Son Industries Pvt. Ltd. being Respondent No. 1 to the present proceedings.

c. Neither the earlier appellant M/s Mahaveer Rice Traders nor the present

respondent brought this major discrepancy to the knowledge of the registrar nor did the registrar take action to cancel the earlier wrongly published trade mark in the Journal. Instead the Asst. Registrar decided the opposition on merit and refused the appellant's application being the impugned mark under No. 1197850.

d. It has, therefore, become incumbent on the Board to remand the matter to the Registrar for re-publication in the Journal. If this is not done it would

lead to absurd consequences like i) in the event of the present appeal being allowed, and the impugned mark registered, third parties may file

rectification on the ground that the advertisement in the journal was improper or ii) if the appellant files an infringement suit it may fail on the ground

that the label trade mark of the appellant has never in fact been published in the journal. It is therefore, necessary to re-advertise the impugned trade

mark to avoid multiplicity of litigation & proceedings.

e. No prejudice would be caused to the respondent if the Board gives such direction accordingly.

## 2. RESPONDENT'S COMMENTS

The respondent has seriously objected to this MP stating that it has been deliberately filed solely with a view to initiate a 'denovo' proceedings instead

of final adjudication of the matter. The appellants' are seeking to raise new issues at a belated stage. Earlier, the Board had rejected four separate

MPs (132/2008, S.R. 186/2008 and 187/2008 and (S.R. No. 181/2009 regarding maintainability of the Review Petition dated 05.05.2009) in ORDER

No. 15/2009 in the three M.Ps aforementioned in OA/58/2008-TM/DEL. The respondents state that at no stage over the last many years from the

date of advertisement of the impugned mark in the Mega Journal dated 14.11.2003 or at any time thereafter at any stage of the proceedings, the

appellant had raised this issue even though the same counsel had been acting for them and therefore, the impugned MP deserves to be rejected

outright as the points raised therein had never been pressed before. The consequences of allowing this MP is only the setting up of new pleadings and

lead to negation of the justice for the respondents. The appellant are trying to improve the case at every stage of the proceedings and are now barred

from raising ""new points"" at the appellate stage in terms of Order 41; Rule 27 of the CPC. The Hon'ble APEX Court in 2007 (SCR) 901 had observed

as follows:

In case the petitioner contends that he had pressed that point also (which has not been dealt with in the impugned judgement), it is open to him to file an application before the same learned Judge (or Bench) which delivered the impugned judgment, and if he satisfies the Judge (or Bench) that the other points were in fact pressed, but were not dealt with in the impugned judgment, it is open to the concerned court to pass appropriate orders including order of review.

The respondent state that the appellants are twisting facts of the case to seek the relief of setting aside the order & decision dated 23.06.2008 passed by the Assistant Registrar based on materials, pleadings, submission on record. It is, therefore, urged that this MP be rejected with exemplary cost and the main appeal should also be dismissed simultaneously.

### 3. REJOINDER OF THE APPELLANT:

The appellants state that the grievances of the respondent in M.P. No. 210/2012 are basically assumption & presumption without any factual basis.

The assignment deed was executed in favour of the subsequent appellant Jain Rice Pvt. only 02.04.2012 and the new owner of the impugned mark is seeking appropriate justice in accordance with law to ensure correct & proper entry in the register of trademark in the event of the Hon'ble Board upholding the claims of the appellant. The rest of the rejoinder is denial of all the material averments agitated by the respondent.

### C.M.P. 282/2012:

1. a. This petition is also filed by the appellant. As stated earlier, the original appellant on record Shri Bupender Jain trading as Mahaveer Rice

Traders, Delhi assigned his several trade marks including the impugned trade mark to M/s Jain Rice Land Pvt. Ltd., Delhi on 12.04.2012.

b. The subsequent appellant thereafter took inspection of records and became aware through Registry's website that the counsel of Respondent No. 1

Shri K.K. Arora on 17th December, 2007 filed a letter to Registrar of Trade Mark, New Delhi, the material portion of which is quoted below:

As our clients are presently not sending any instruction to us, it is, therefore, requested that the Power-of-Attorney, executed in our favour, may

please be treated as withdrawn and henceforth, all types of communications, relating thereto be sent direct to the opponents ""M/s Sachdeva & Sons

Inds. Pvt. Ltd., Village & Post Office, Gilwali, Near Sangrana Sahim, Tarn Taran Road, Amritsar -- 143 022, Punjab State

c. The hearing before the Assistant Registrar in respect of opposition to the impugned application published in the Journal was held on 19.12.2007

when the respondent's counsel Shri K.K. Arora informed the hearing officer that he has no instructions from the opponents to proceed with the

matter. However, the Asst. Registrar by her order recorded that Shri K.K. Arora's power of attorney was on record but he refused to withdraw the

same. The Registrar instead of sending hearing notice afresh directly to the opponent heard the matter and passed an order on 23rd June, 2008

communicated to both the counsel The impugned order has been challenged in the main appeal.

d. In view of the aforesaid letter mentioned in para (b), the appellant's state that Shri Kamal Kishore Arora had complete knowledge on 17th

December, 2007 but did not inform the Registrar of the same before the commencement of the proceedings to enable the Registrar to take further

action in accordance with law.

e. This MP has been filed for direction of the Board on the legal position of the consequences of withdrawal of Power of Attorney and also the non-

filing of Form TM -7 (prescribed under the Rules notifying the intention to be heard by the Registrar) and whether the Asst. Registrar had erred in not

passing an order under Rule 56(4) in view of the aforesaid circumstances?.

## 2. RESPONDENT'S COMMENTS

The respondents have again objected to this impugned petition on the same lines cited in the above mentioned two MPs stating that the MPs are waste

of time, energy and money and harassment of the respondent which will lead to negation of justice.

## 3. AUTHORITIES:

The following authorities are relied on by the appellant.

D. For convenience we shall first examine the merit of M.P. No. 210 of 2012 concerning the prayer for remitting the matter to the registry for re-

publication. If this is to be allowed the other two MPs and main appeal would fall on its own. The trade mark published is a word mark and the mark

applied for was a label mark. The error is serious and the only remedy available under law is to re-advertise the impugned mark. To be fair to the

registry, the impugned mark was published manually during the pre-computerisation era back in 2003 and this type of error is hopefully now a thing of

the past. We can also understand the anger and frustration of the respondent's Counsel who now faces the prospect of a fresh battle de novo. But

these cannot decide the fate of an appeal. It is a settled law that when a device mark is published as a word mark it has to be mandatorily re-published

whatever be the reason. All the contentions and pleadings of the respondent on this particular point are just elliptical arguments carrying little

conviction. We must, however, admit that the decision of the Asst. Registrar is based on a correct appreciation of the competing marks as applied for

by the appellant and the opponents/respondents trade mark reproduced below from the Asst. Registrar order dated 23rd June, 2008.

2. In fact, the appellant's counsel produced an order dated 11.09.2008 in respect of appellant's another application under No. 1197814 in Class 30 (also

opposed by same respondent) from official note-sheet downloaded from the net in which Deputy Registrar, New Delhi has made the following

comments which speaks of itself and reproduced.

On perusal of the record, it seeks that the mark published in the Journal as ""Noor Pari"" word per se. However, in the application file the same was

applied as a label mark consisting of the devise of a Fairy with the work 'Noor' and 'Pari' in different lines. The matter is heard ex parte. However, the

applicant's counsel had not mentioned that the mark was applied as a label mark and therefore, opposition is abated. Tribunal Section is directed to

forward this matter to the Journal Section for further necessary action as the publication of the mark is not proper

Signed

Dy. Registrar

11.09.2008

3. The Assistant Registrar had dismissed the application under appeal by her order on 23.06.2008. Even assuming the findings of the Asst. Registrar

are without any error, the factum of non-publication of the trade mark as applied is a fundamental mistake and the decision of the Asst. Registrar

cannot over-ride the requirement of law. In the result, MP. 210 of 2012 is allowed and the matter remitted back to the registry for consideration afresh



from the stage of Examination.

E. Once we reach this conclusion, the issues raised in MP. 142 of 2012 (concerning assignment) needs to be first adjudicated by the registrar in

accordance with law. M.P. 282 of 2012 also becomes infructuous in view of the foregoing and the main appeal OA/58/2005/TM/DEL is accordingly

dismissed for the afore mentioned reasons. In view of proved blameworthy conduct of the appellant which has put the Board and the respondent to

avoidable inconvenience, the appellant is directed to pay a sum of Rs. 5,000/- each to both the IPAB registry and the respondent within 15 days from

the date of receipt of this order.