
(2004) 09 IPAB CK 0007

In the Intellectual Property Appellate Board

Case No : Transferred Appeal/RECTT No. 271/2004/TM/AMD (Appln. No. 1/98)

Devendra Kumar And Anr.

APPELLANT

Vs

Vitthal Prasad And Ors.

RESPONDENT

Date of Decision : 08-09-2004

Acts Referred:

Trade And Merchandise Marks Act, 1958 — Section 35, 35(1), 44, 44(1), 56
Trade Marks Act, 1999 — Section 100

Citation : (2006) 32 PTC 835 (IPAB)

Hon'ble Judges : S. Jagadeesan, J;Raghubir Singh, J

Bench : Division Bench

Advocate : Y.J. Trivedi, Dheeraj Seth

Final Decision : Allowed

Judgement

Raghubir Singh, J

1. This is an appeal filed as No. 1/98 in the High Court of Gujarat at Ahmedabad. It has been transferred to this Board in terms of Section 100 of the

Trade Marks Act, 1999.

2. This is an appeal against the decision of the Assistant Registrar of Trade Marks, Ahmedabad dated 15.12.1997 allowing TM-24 dated 28.3.94 in the

name M/s. Mahesh Chandra Dinesh Kumar to enter as the subsequent proprietor and disallowing TM-24 dated 25.3.94 for entering Shri Devendra

Kumar as the proprietor of the firm Mahesh Chand Dinesh Kumar. Shrikrishna Pauranik started the firm known as Mahesh Chandra Dinesh Kumar.

The said firm besides having the label registered under the Copyrights Act, 1957 held registration for the trade mark under No. 270560 in class 34.

Shrikrishna Pauranik expired on 23.09.73. Smt. Bhagwati Bai, widow of Shri Pauranik continued the business of her deceased husband till 1974 when

she entered into a deed of partnership dated 14.11.74 with Shri Vitthal Prasad, Shri Mahesh Chandra, Shri Dinesh Kumar, Smt. Gopi Bai and Shri

Jitendra Kumar as partners in the firm trading in the name and style of Mahesh Chandra Dinesh Kumar. Smt. Gopi Bai died on 14.8.89 and the

partnership was reconstituted on 30.8.89 with the remaining partners in the partnership. Consequent upon this, the request for entering into assignment

in Form TM-24 was filed on 28.3.94 on behalf of the firm M/s Mahesh Chandra Dinesh Kumar to bring on record the names of partners thereof.

Another request in Form TM-24 dated 25.3.94 was filed in the office of the Registrar by Shri Devendra Kumar claiming himself to be the only son of

deceased Shrikrishna Pauranik. He relied upon the will of his deceased father dated 14.1.73. Now the position was that there were two rival claims

before the Registrar in matter of entering into an assignment into the Register. Learned Assistant Registrar heard the parties and came to the

conclusion that Shri Devendra Kumar has failed to establish any right, interest of justification for his request in Form-24 dated 25.3.94 to be allowed

and has failed to satisfy him that the request on Form-24 dated 28.3.94 filed by Shri Vitthal Prasad, Mahesh Chandra, Shri Dinesh Kumar and Shri

Jitendra Kumar as partners of the firm M/s Mahesh Chandra Dinesh Kumar may not be allowed.

3. The appeal came up for hearing before the Board on 29.7.04. Learned Counsel Shri Y.J. Trivedi appeared for the appellant and learned Counsel

Shri Dheeraj Seth appeared for the respondents.

4. It is clear from the facts of the matter that on one side the brothers of the deceased who constituted the partnership in the name and style of

Mahesh Chandra Dinesh Kumar have led their claim for entering their names as subsequent proprietor in the registry. On the other side the son of the

deceased who was a minor when his father died has led his claim for entering as subsequent proprietor, being the proprietor of the said firm on the

basis of the will dated 14.1.73 entered into by his father.

5. Section 44 of the Trade and Merchandise Marks Act, 1958 (hereinafter referred to as the Act) provides as under:

44. Registration of assignments and transmissions -- (1) Where a person becomes entitled by assignment or transmission to a registered trade mark,

he shall apply in the prescribed manner to the Registrar to register his title, and

the Registrar shall, on receipt of the application and on proof of title to his satisfaction, register him as the proprietor of the trade mark in respect of the goods in respect of which the assignment or transmission has effect, and shall cause particulars of the assignment or transmission to be entered on the register:

Provided that where the validity of an assignment or transmission is in dispute between the parties, the Registrar may refuse to register the assignment or transmission until the rights of the parties have been determined by a competent court.

(2) Except for the purpose of an application before the Registrar under Sub-section (1) or an appeal from an order thereon, or an application under Section 56 or an appeal from an order thereon, a document or instrument in respect of which no entry has been made in the register in accordance with Sub-section (1), shall not be admitted in evidence by the Registrar or any court in proof of title to the trade mark by assignment or transmission unless the Registrar or the court, as the case may be, otherwise directs.

Proviso to Sub-section (1) read with the main provisions of Sub-section (1) is very clear in its language that in a case where the validity of an assignment is in dispute between the parties, the Registrar shall not enter the assignment until the rights of the parties inter vivos have been determined by a competent court. In the instant case whether the will is a genuine one or not or is subject to certain other statutory obligations is to be decided by a civil court of appropriate jurisdiction. In case the court reaches the conclusion that the will is a genuine one and according to the wishes of the deceased who was the proprietor of that firm, about which there is no dispute in the instant case, Shri Devendra Kumar may have to be entered as the subsequent proprietor excluding other persons constituting the partnership. In any case what is true to Sub-section (1) of Section 44 has been spelt out in umpteen number of cases by the courts. In *Muhammad Zumoon Sahib v. Fathimunnissa* AIR 1960 Madras 80 Justice Rajammannar, C.J. observed:

It is true that Section 35 (Section 44(1) of Trade and Merchandise Marks Act, 1958 is corresponding to Section 35 of the Trade Marks Act, 1940) prescribes a procedure for the assignee or the representative to have registration of his title. The fallacy in the argument of ... learned Counsel for the appellant, is that it is this registration by the Registrar under Section 35(1) of the

Act that confers title.... The title already exists in the legal representative and on proof of such title to his satisfaction, the Registrar registers him as the proprietor of the trade mark.

The principle has been followed in many other cases. The Assistant Registrar in a detailed order running into five pages has ventured into the area of

examining the genuineness of the will and its admissibility. No doubt that the firm was started as a proprietary concern by the father of the legatee

under the will. The Assistant Registrar has exceeded his jurisdiction in interpreting the genuineness of the will and its admissibility. The provisions of

Sub-section (1) of Section 44 are clear that in case of any dispute, it is only a Civil Court of competent jurisdiction which can decide about the rights of

the parties. The function assigned to Registrar under Section 44 is only to enter the assignment as a subsequent proprietor in favour of a person who is

holding the valid assignment.

6. Accordingly, the impugned order dated 15.12.97 passed by the Assistant Registrar of Trade Marks is set aside and the appeal is allowed. There is

no order as to costs.