
(2010) 12 IPAB CK 0006

In the Intellectual Property Appellate Board

Case No : M.P. 160/10 In OA/22/04/TM/DEL

Dinesh Chandra I. Vaghani And Ors.

APPELLANT

Vs

Surat Ram Gupta And Ors.

RESPONDENT

Date of Decision : 24-12-2010

Acts Referred:

Citation : (2010) 12 IPAB CK 0006

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

Bench : Division Bench

Final Decision : Disposed Of

Judgement

S. Usha, J

1. The main appeal is against the order of the Registrar dated 03.12.2003 dismissing the opposition No. DEL-T-1784 and application No. 601430 in

class 9 accepted to proceed to registration as per the provisions of the Trade marks Act, 1999 (hereinafter referred to as the Act).

2. Pending disposal of the appeal, the Respondents filed a miscellaneous petition seeking an order to stay the proceedings pertaining to the present

appeal till the final adjudication of ORA/143/06/TM/DEL - M/s Milton Plastics Limited v. Shri Amit Arora or in the alternative the Hon'ble Board to

hear the present appeal along with the matter ORA/143/06/TM/DEL.

3. The Appellants have been using the trade mark 'MILTON' since 1971 for their domestic containers. The Appellant's goods bearing the said trade

mark have been popular due to wide publicity and superior quality of the said goods. The Appellant's trade mark 'MILTON' is registered and is validly

subsisting as on date. The Appellants have also been manufacturing various other electric goods. The Appellants have expended huge sum of money

on advertisement and publicity of their said goods bearing the said trade mark. The Appellants have therefore acquired reputation and goodwill in the trade mark 'MILTON'. The Appellants are thus entitled to the exclusive use of the same in respect of the electric goods.

4. The observation made by the Delhi High Court reported in 2010 (42) PTC 456 (Del) Dinesh Chandra Vaghani and Ors. v. Union of India and

Others was quoted. Based on the observation, the Appellant's title was in jeopardy. The High Court had directed to adjudicate the title of the

Appellant and their right in regard to the registered trade mark. Therefore, the Appellant has no right to proceed with the appeal in view of the High

Court direction.

5. The order in ORA/143/06 will have a far reaching effect on the proprietorship of the alleged trade mark of the Appellant. The balance of

convenience is in favor of the Respondent. The Respondent will suffer irreparable loss if the miscellaneous petition is not allowed.

6. The Appellant filed their reply to the miscellaneous petition. The preliminary objection was that the petition is an abuse of process of law,

misconceived, vexatious and untenable. This is only to delay the adjudication of the appeal. The Respondent cannot challenge the title of the Appellant

as that was not the issue in the present proceedings before the Registrar. The Appellants are joint owners.

7. The High Court of Delhi had not laid any such condition that this matter has to await the outcome of the decision of the Registrar in TM 23.

Recordable of assignment is a mere ministerial act. The right is transferred the moment an assignment deed is executed. The other averments were

denied. The Appellants have also stated that they have no objection if the present appeal be heard along with ORA/143/06/TM/DEL.

8. The learned Counsel on both sides re-iterated whatever was stated in the miscellaneous petition and the reply respectively. The counsel for the

Respondent read out the observation made by the learned Judge in the writ petition. The counsel further submitted that the reply filed to the

miscellaneous petition was not supported by an affidavit and was to be rejected and not taken on record.

9. The counsel for the Appellant submitted that the order passed in the Writ Petition is of no relevance to this case on hand as the parties were

different. The counsel stated that they have no objection if the ORA/143/2006/TM/DEL is heard first and the present appeal later. As regards the

recordable of assignment the counsel relied on the judgment reported in 2009 (39) PTC 347 (Delhi) Sun Pharmaceutical Industries Limited v. Cipla

Limited to say that the delay in recordable by the Registrar of Trade Marks will not affect the rights of the parties. In reply to the submission that no

affidavit filed along with the reply to the miscellaneous petition, the counsel submitted that the rules do not prescribe the same.

10. We have heard and considered the arguments of both the counsel. The counsel for the Appellant has stated that they have no objection if the

alternate prayer to hear the present appeal along with the ORA/143/06/TM/DEL is allowed as well during the arguments submitted that they have no

objection if ORA/143/06/TM/DEL is heard first and then the present appeal. We therefore think it not necessary to go into the aspect to see if the

High Court has directed this Board to await the decision in the Form TM 23 or not.

11. In view of the above, both the matters i.e. OA/22/04/TM/DEL and ORA/143/06/TM/DEL will be heard together. Accordingly the miscellaneous

petition is disposed of on the above terms. The Registry is directed to post both the matters together, listing ORA/143/06/TM/DEL as the first item

and the appeal OA/22/04/TM/DEL as the second item.