

(2007) 11 IPAB CK 0002

In the Intellectual Property Appellate Board

Case No : M.P. Nos. 84/2007 In OA/15/2006/TM/CH, OA/15/2006/TM/CH

P. Iya Nadar Charitable Trust, The South Indian Lucifer Match Works APPELLANT

Vs

R.A. Karthik, Trading As Abhishek Match Industries And The Assistant Registrar Of Trade Marks RESPONDENT

Date of Decision : 22-11-2007

Acts Referred:

Citation : (2008) 2 MIPR 240

Hon'ble Judges : Z.S. Negi, J;S. Usha, Technical Member

Bench : Division Bench

Advocate : Madan Babu, A.K. Ravindernath

Final Decision : Allowed

Judgement

M.H.S. Ansari, J

1. Instant appeal is directed against the order dated 20.12.2005 passed by the Ld. Assistant Registrar of Trade Marks, the 2nd respondent herein,

rejecting the opposition No. MAS-54894 filed by the appellant and allowing the trade mark under application No. 578091 to proceed for registration.

2. The miscellaneous petition for stay had come for hearing on 4.12.2006 orders were reserved thereon and the main appeal was directed to be posted

for hearing on 2.2.2007. Thereafter the same has been adjourned from time to time on the request of 1st respondent. The matter when it was listed

for hearing on 16.11.2007 and when called on, Shri Madan Babu learned Counsel appeared on behalf of appellant trust and made his submissions on

merits. None was present on behalf of 1st respondent. However, after learned Counsel Shri Madan Babu completed his arguments, Shri A.K.

Ravindernath learned advocate appeared and submitted on behalf of APR

Associates that the learned Counsel on record for 1st respondent was not doing well and filed petition in form-5 for adjournment of hearing. Orders were reserved.

3. After hearing Shri Madan Babu learned Counsel on behalf of the appellant and having perused the relevant pleadings and the evidence on record,

we are of the view that as the matter is covered by a judgment of this Board passed in OA/25/2006/TM/CH dated 19.3.2007 (Japan Tobacco Inc v.

R.A. Karthik and Anr.) no useful purpose will be served by retaining the matter on the file of this Board or by adjourning the same as prayed for on

behalf of 1st respondent. We accordingly reject the prayer for adjournment made on behalf of 1st respondent in form-5.

4. A few relevant facts need only be stated for the purpose of disposal of this appeal, they are, as can be seen from the order under appeal, as under:

On 29th July, 1992 an application was filed for registration of a trade mark consisting of the word OASIS along with device of a camel and other

features (label) under No. 578091 by Minor R.A. Karthik represented by his father and natural guardian Sri A. Ramamurthy, trading as The Abhishek

Match Industries, Bhuvadharini-83-Kamaraj Road, Sivakas -626 123 (Tamilnadu) (hereinafter referred to as ""the Applicant"") in respect of safety

matches in class-34. After some initial objections, the mark was ultimately ordered to be advertised as accepted for registration in the Trade Marks

Journal No. 1212 dated 8.12.1999 at page 150 and 151.

On 27.1.2000 M/s P. Iya Nadar Charitable Trust, Proprietors, The South Indian Lucifer Match Works, No. 12-A Chairman Shanmugha Nadar Road,

Sivakasi - 626 123 (hereinafter referred to as ""the opponent"") filed a notice of opposition to the aforesaid application.

The said opposition was numbered as MAS-54894. By the orders under appeal dated 20.12.2005 learned Assistant Registrar disallowed the said

opposition and directed that the application No. 578091 shall proceed for registration.

5. It also appears, that on 11.2.2000 another notice of opposition was filed by M/s R.J. Reynolds Tobacco Company. The same was numbered as

MAS-55004. By order dated 25.1.2006 passed by the learned Assistant Registrar of Trade Marks the opposition No. MAS-55004 was disallowed and

the application No. 578091 was directed to proceed for registration. The

opponent therein filed an appeal being OA/25/2006/TM/CH before this Board and the same was allowed by orders of this Board dated 19.3.2007 in the following terms:

19. In the result, appeal is allowed setting aside the impugned order.

The Application No. 578091 in class 34 is dismissed. The respondent No. 1/ applicant shall pay a sum of Rs. 1000 to the appellant as costs of these proceedings.

6. Though several contentions of fact and law have been raised on behalf of the appellant by its learned Counsel Shri Madan Babu and we have been referred to various evidences on record, however, in the view that we have taken after having heard Shri Madan Babu, it is not considered necessary to refer to all such contentions advanced on behalf of the appellant. The reasons for the same shall be apparent from what is stated hereinafter.

7. A significant contention raised by Shri Madan Babu learned Counsel for the appellant was

i) that in view of the orders of this Tribunal dated 19.3.2007 (extracted supra) whereby application No. 578091 was dismissed, nothing really survives

for consideration in the present appeal as there is no application for registration of the applicant in the eye of law;

ii) that on identity of facts, the reasons based on which this Board allowed the appeal in OA/25/2006/TM/CH by orders dated 19.3.2007, should prevail

in the instant appeal as well.

8. We are inclined to accept the said contentions of Shri Madan Babu. We are also of the view that the instant appeal requires to be allowed in terms

of the orders dated 19.3.2007 in OA/25/2006/TM/CH. In view of the similarity of facts, especially with regard to the assignment by the applicant of

the trade mark during pendency of the opposition proceedings before the learned Registrar, which prevailed with this Board, the relevant observations

of this Board on this aspect, in its said order have been noted in paragraph 18 thereof, read as under:

18. Once there is assignment of the mark pending the application for registration, the applicant will cease to have any claim in respect of the mark. In

other words, he loses the locus standi to maintain the application. The right thereafter vests in the assignee to come on record by filing an appropriate

application for substitution of the name of applicant. Section 22 of the Act

provides for amendment of the application either before or after acceptance of the application. There is no bar for an applicant pending registration to transfer his rights but before such assignee can claim any right to the ownership of the mark on the basis of the assignment he must make out a case for registration, that is, if such assignee wants to avail of the benefits of the registration of the mark. There is nothing brought on record to indicate that any steps were taken by the assignee to come on record, instead registration of the mark by impugned order has been granted to the applicant who ceased to have any claims on his own showing. The application for registration ought to have been dismissed on this sole ground. We hold accordingly.

In light of the above and for the same reasons the instant appeal is liable to be allowed. Consequently the order under appeal is liable to be set aside.

9. With regard to M.P. Nos. 83 and 84 of 2007 suffice it to state here that the petitioner in the two MPs is one Janaki Match Company Private

Limited. The relief prayed for in MP No. 83 of 2007 is to implead the said petitioner as respondent No. 3 in the appeal. MP No. 84 of 2007 is filed by

the same petitioner (Janaki Match Company Private Limited) the relief prayed for is to ""amend the application for registration of the trade mark under

No. 578091 in Form TM-16 so as to read M/s Janaki Match Company Private Limited Bhuvadharini-83, Kamaraj Road, Sivakasi - 626 123 as

applicant for registration of trade mark in the place of R.A. Karthik proprietor...."" The averments made in support in the two petitions are common.

The petitioner (Janaki Match Company Private Limited) claims to be the assignee of the trade mark under application No. 578091 which is the subject

matter of the appeal. It is alleged that during the pendency of the opposition proceedings the 1st respondent was converted into a partnership firm and

that the partnership firm of Abhishek Match Industries has assigned to the petitioner two trade marks by two separate deeds dated 25.3.1999. A

common counter affidavit has been filed on behalf of the appellant opposing the petitions. In our view, the question of amendment of the application

under No. 578091 does not arise. The said application stands disposed by the order under appeal. The application for amendment, if at all, ought to

have been filed during the pendency of the opposition before the learned Assistant Registrar of Trade Marks. No steps having been taken to amend

the application or to come on record as the applicant, the instant two petitions, in our view are misconceived and are accordingly dismissed as not maintainable.

10. In the result the application for adjournment in Form-5 is rejected. M.P. Nos. 83 and 84 of 2007 are dismissed as not maintainable. The appeal is allowed in terms of our earlier order dated 19.3.2007. Consequently, the order under appeal is set aside. However in the facts and circumstances of the case, there shall be no order as to costs. A copy of the order be communicated to the Ld. Registrar.