

(1959) 07 MAD CK 0019

In the Madras High Court

Case No : Letters Patent Appeal No. 48 of 1959

T.I. Muhammad Zumoon Sahib

APPELLANT

Vs

Fathimunnissa alias Bibijan and Others

RESPONDENT

Date of Decision : 21-07-1959

Acts Referred:

Trade Marks Act, 1940 — Section 21, 35, 35(1)

Citation : AIR 1960 Mad 80

Hon'ble Judges : P.V. Rajamannar, C.J; Ganapatia Pillai, J

Bench : Division Bench

Judgement

Rajamannar, C.J.—There are not merits in this appeal. The suit was for an injunction to restrain the defendant from infringing a registered

trade mark. Admittedly one Muhomed Yoonus Sahib was the person in whose name the said trade mark was duly registered with the Registrar of

Trade Marks, Bombay, the trade mark being "" 708 Yoonus Beedi"" Yoonus died on 8-5-1953 and it is not denied that the plaintiffs-respondents

are his heirs. After the death of Yoonus the Plaintiffs continued to run his business and to manufacture and sell beedies under the said trade mark.

They found that the defendant was also manufacturing and selling beedies under a similar trade mark. Hence they brought the action out of which

this appeal arises.

The only plea which was put forward with some force in the trial Court is that covered by the issue ""Are the plaintiffs not entitled to bring this suit in

the absence of registry in their name?"" This plea was apparently based on two sections of the Trade Marks Act, 1940, Ss. 21 and 35. Section 21

inter alia provided that the registration of a person in the register as proprietor of a trade mark in respect of any goods shall give to that person the

exclusive right to the use of the trade mark in relation to those goods. That right is deemed to be infringed by any other person using a mark identical

with it or so nearly resembling it as to be likely to deceive or cause confusion in the course of trade. The definition of a registered trade mark in S.

2(1)(j) namely "" a trade mark which is actually on the register"" has reference to this section. Section 35 runs as follows:

35(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.

2. The plaintiffs had, on the date of the institution of the suit, not taken steps under S. 35 of the Act and obtained from the Registrar registration of

their title. At the end of the trial, however, they did obtain an order of the Registrar on 7-8-1954, recognising the title of the plaintiffs to the trade

mark. With leave of the Court the order of the Registrar was received in evidence and at their request the defendant was given leave to file an

additional written statement. Additional issues were framed, namely, whether the certificate granted by the Registrar was illegal and void and

whether the plaintiffs were entitled to rely on the certificate. The learned District Judges who tried the suit held that the suit was maintainable even

without an order of the Registrar under S. 35 of the Act, that in any event the plaintiffs had obtained an order under S. 35 pending the suit, and that

the suit was therefore sustainable.

It was contended before him that the registry of the name of the plaintiffs under S. 35 gives the plaintiffs a new cause of action; but that contention

was not accepted. In the result the suit was decreed. The defendant filed an appeal to this Court A.S. No. 109 of 1955, which was heard and

disposed of by Panchapakesa Ayyar J. The learned Judge took substantially the same view as the learned District judge on both the points. He

held that even before an order was passed under S. 35, a suit for infringement of a trade mark was maintainable, and that in any event, as the

plaintiffs had obtained an order under S. 35 before judgment was delivered in the

case, the defendant could not raise any further objection. He therefore dismissed the appeal. From the judgment of the learned Judge, this appeal has been filed by the defendant under the Letters Patent.

3. Mr. Srinivasa Aiyar vehemently contended that it is only the order of the Registrar under S. 35 which confers a right on the heirs of the original

registered proprietor to bring an action for infringement of the trade mark. He only relied on the provisions of Ss. 21 and 35 in support of his

argument, and was unable to cite any authority. There is nothing in S. 21 or S. 35 of the Act which supports this argument. Section 21 confers on

the proprietor in whose name the trade mark is registered the exclusive right to the use of the trade mark. That exclusive right is capable of

assignment, and on the death of the registered proprietor the right would devolve under the rules of personal law applicable to the party.

Such person or persons on whom the right has devolved would be entitled to the same right which the original registered proprietor has for the use

of the registered trade mark. It is true that S. 35 prescribes a procedure for the assignee or the representative to have registration of his title. The

fallacy in the argument of Mr. Srinivasa Aiyar, learned counsel for the appellant, is that it is this registration by the Registrar under S. 35(1) of

the Act that confers title on the representative. The registration is expressly stated in S. 35 to be "on proof of 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.

4. In any event the entire discussion is academic, because before the judgment was delivered in the case the plaintiffs filed into Court an order of

the Registrar under S. 35(1) recognising their title. Mr. Srinivasa Aiyar urged that the plaint should have amended because the registration under

S.35 really gave a fresh cause of action to the plaintiffs. It is again based on a fallacy. The cause of action is the infringement of the trade mark. The

order of the Registrar under S. 35 by itself does not give a cause of action. All that it gives is a recognition of the title which already inheres in the

legal representatives of the deceased proprietor.

As the learned District Judge points out, the logical result of the acceptance of learned counsel's argument is that during the interval which must

inevitably elapse between the date of the death of the registered proprietor and

an order of the Registrar under S. 35(1), any person could with impunity infringe the trade mark. Mr. Srinivasa Aiyar said that a passing off action could be field; but then that action is different in material particulars from an action for infringement of a registered trade mark. We see no substance in the contentions raised on behalf of the appellant. The appeal is therefore dismissed.

5. Appeal dismissed.