

INTELLECTUAL PROPERTY APPELLATE BOARD

Guna Complex Annex-I, 443, Anna Salai, Teynampet,
Chennai – 600 018

(Circuit Bench Sitting at Delhi)

M.P.No. 317/2009

IN

OA/76/2004/TM/DEL

FRIDAY, THIS THE 15TH DAY OF JANUARY, 2010

HON'BLE Ms. S. USHA

VICE-CHAIRMAN

HON'BLE SHRI SYED OBAIDUR RAHAMAN

TECHNICAL MEMBER

M/s Mazda Motor Corporation
3-1, Shinchu, Fuchu-Cho,
Aki-Gun, Hiroshima-Ken,
Japan.

... Appellant/Respondent

(By Advocate: Shri Saurabh Banerjee)

Vs.

1. The Assistant Registrar of Trade Marks,
Baudhik Sampada Bhawan,
Plot No. 32, Sector 14, Dwarka,
New Delhi – 110 075.
2. The Registrar of Trade Marks,
Baudhik Sampada Bhawan,
Plot No. 32, Sector 14, Dwarka,
New Delhi – 110 075.
3. M/s Sahu Sewing Machine Co.,
Maya Bazar,
Gorakpur,
Uttar Pradesh.

... Respondent/Petitioner

(By Advocate: Shri Saurabh Kapoor for R1)

ORDER No. 6 of 2010**Hon'ble Ms. S. Usha, Vice-Chairman:**

The miscellaneous petition is filed by the third respondent with a prayer to dismiss the appeal as not maintainable. The original appeal is against the order dated 20.04.2004 passed by the respondent No. 1 dismissing the opposition and allowing the application for registration under No.590965 in class 7 to proceed for registration.

2. The petitioner herein had stated that the appellants i.e. the respondent in the miscellaneous petitions has not filed any miscellaneous petition to stay the issuance of the registration certificate or to stay the impugned order along with the original appeal and as such there is no stay for issuance of the certificate. The registration certificate has been issued by the respondent No. 2 very recently. In view of the fact that the registration certificate has been issued the appeal is not maintainable as it has become infructuous. The registered trade mark cannot be rectified as no relief has been sought in the appeal. The respondent failed to apply the specific provisions provided under section 95 of the Trade Mark Act, 1999. The registered trade mark cannot be rectified through an appeal. The respondent may opt for the alternative remedy if they are aggrieved. The original appeal sought to be dismissed as the registration certificate has already been issued.

3. The respondent herein filed their reply to the miscellaneous petition denying the various allegations except some allegations which were admitted. The miscellaneous petition is absolutely misconceived, baseless and not maintainable in law as there is no statutory bar on the maintainability of the appeal upon the issuance of the registration certificate. Merely because the certificate has been issued does not make the appeal infructuous when the appeal is pending.

4. The respondents No. 1 and 2 were put on notice of the instant appeal and were also directed to file statement if any by notice dated 03.08.2004. When that

is the case, they ought not to have issued the registration certificate. The respondent can not be restrained from exercising his legal rights to appeal on the ground that the certificate has been issued after five years of passing the impugned order. The Registrar ought not to have issued the certificate being aware of the appeal pending. There has been matters where no stay has been granted in spite of the application for stay. It is also submitted that even after grant of registration, the matter has been stayed. By issuance of the certificate after five years will in no way take away the rights of the appellant. The present petition be dismissed with costs.

5. We have heard the counsel for the petitioner/respondent Shri Saurabh Kapoor and counsel for respondent/appellant Sourabh Banerjee on 16.12.2009 at the circuit Bench sitting at Delhi.

6. The learned counsel for the petitioner submitted that the impugned order was passed on 20.04.2004 and the appeal was filed on 30.07.2004. The prayer sought in the appeal was only to set aside the impugned order. The appellant has not filed any petition for stay of the operation of the order along with the appeals as well has not given the reason for not filing the same. Now that the registration certificate has already been issued the same cannot be cancelled as there is no such prayer in the appeal, but the appeal ought to be dismissed as infructuous.

7. The counsel for the respondent in reply submitted that the appeal has been preferred well within the limitation period for proper adjudication. The relief sought for was to set aside the order as well as a direction to the Registrar not to proceed with the issuance of the certificate of registration. The grounds in an appeal are different from the grounds in an application for rectification. He further submitted that the Registrar was aware of the pending appeal and should not have issued the certificate after a lapse of five years. He also referred to Rules 59 and 62(1) of the Trade Mark Rules, 2003 and also section 23(1) of the Act for issuance of the certificate of registration. He further relied on some

judgements to say that the appeal will not become infructuous if the certificate is already issued.

8. In rejoinder the counsel for the petitioner submitted that no steps for stay was taken by the respondent as per section 95 of the Act and also that rule 62 was not applicable.

9. We have considered the arguments of both sides. The main contention of the petitioner/respondent was that the registration certificate has been issued and hence the appeal has become infructuous. On the other hand, the respondent/appellant submitted that the issuance of the certificate by the Registrar of Trade Marks during the pendency of the appeal after a lapse of five years, being aware of the appeal is wrong. We find some force in the submission of the respondent/appellant. On perusal of the records, it is clear that notice has been served on the respondents as early as 2004 itself. In this context, it is pertinent to mention the observations of this Board as regards issuance of the Certificate *in Kraft Jacobs Suchare Ltd., vs. Government of India 2004 (29) PTC 376 (IPAB) at Para 6* - "The bone of contention of the appellant is that in terms of section 109 of the Act read with Rule 121 of the Trade and Merchandise Marks Rules 1959, the Registrar should not have issued the certificate within three months from 19th December 1997, being the date of decision of the Assistant Registrar deciding the opposition in favour of the applicant and accepting the application for registration. In other words, he should have waited for the statutory period of three months, within which an aggrieved person can file an appeal, to elapse and thereafter only should have issued the certificate. We fail to comprehend any basis for this argument. The Registrar is within his rights to issue the certificate any time after the orders have been passed. Respondent No. 3, the then Registrar of Trade Marks has filed his counter affidavit on behalf of the 1st, 2nd and 3rd respondents denying all the allegations made by the appellant in the petition. We hold that there is nothing wrong in the action of the Registrar in issuing the certificate of registration without waiting for the period of filing of appeal to elapse."

10. The above matter was heard on merits even though the certificate was issued even before the limitation period and the above matter squarely applies to this case on hand.

11. Based on the observations, it could be said that it was the discretionary power of the Registrar to issue certificate and hence the Registrar has issued the same. The act of the Registrar, being fully aware of the pending appeal proceedings should not have issued the certificate when the matter is sub-judice. It only creates a doubt in our minds as it has been issued after five years at the time of hearing of the main matter. The appeal, in our opinion, has been filed well within time and is to be heard and decided on merits. The rights of the appellant or the respondent can be decided only on appreciation of facts and law depending on the circumstances of the case. The matter has not attained finality and to say that issuance of certificate has made the appeal infructuous is baseless.

12. We think it necessary to hear the parties concerned and decide the main appeal. The miscellaneous petition is dismissed and the Registry is directed to post the original appeal in the usual course. No order as to costs.

Sd/

(SYED OBAIDUR RAHAMAN)
TECHNICAL MEMBER

psn

Sd/

(S. USHA)
VICE-CHAIRMAN

