
(2009) 03 IPAB CK 0019

In the Intellectual Property Appellate Board

Bisleri International Pvt. Ltd

APPELLANT

Vs

Dadi Balsara And Ors

RESPONDENT

Date of Decision : 31-03-2009

Acts Referred:

Trade Marks Rules, 2002 — Rule 119

Trade Marks Act, 1999 — Section 9, 9(1), 19, 31, 32, 57, 98(2)

Citation : (2009) 03 IPAB CK 0019

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

Bench : Division Bench

Final Decision : Dismissed

Judgement

S. Usha, Technical Member

1 . The main rectification applications have been filed for cancellation of the registered trade mark Nos. 630661, 1078116 and 1078117 all in class 32.

The miscellaneous petitions have been filed by respondents No. 1 & 2 for striking off the statement filed by respondent No. 3 on 18.11.08 when the

same was supplied by the counsel for applicant in CS (OS) No. 1172/08 pending before the Hon'ble High Court, New Delhi. For the sake of

convenience the respondents No. 1&2 who filed the miscellaneous petitions are termed as the petitioner herein and the applicants in the rectification

applications, and the respondent No. 3 as the applicant and the respondent No. 3.

2. Petitioner had discovered on 21.11.08 that the statement given by respondent No.

3 had reached the media and a vast coverage was given by the journalists in all editions of the Economic Times, the gist of which was that this

statement was the reason for the registration of the trade mark which is under challenge before this Hon'ble Board. Being aggrieved by such violation

of principles of natural justice, the petitioners have moved this Appellate Board as the same has also been filed as a statement in the main rectification

applications, which were taken on record by this Appellate Board on 12.09.08 and the same were due to be served on the parties to the rectification

application on or before 21.11.08. It is also questionable as to how the statement filed by the respondent No. 3 was served on the applicant without

simultaneously providing a copy to the petitioners herein. The affidavit in the suit filed by the applicant was furnished to the petitioners on 18.11.08

relying on the statement made by the respondent No. 3 herein. Whereas the petitioners were not given an opportunity to deal with the statement

before it could become the subject matter of public discussion. The fact that the applicant knew of the filing of the statement by the respondent No. 3

even before it was taken on record by the Appellate Board clearly shows that the respondent No. 3 had not acted with bonafides and in the interest of

natural justice, knowing fully well that the subject matter of the statement is sub-judice before the Hon'ble Delhi High Court and such steps could

prejudicially affect the interest of the petitioner. Apart from the irregularities and deviations from practice and procedures, it is submitted that the

statement of respondent No. 3 deserves to be struck off the records as it is:

a) not a statement under Section 98(2) of the Trade Marks Act, 1999 (hereinafter referred to as the Act);

b) against the basic provisions of the Trade Marks Act, 1999;

c) completely contrary to the established practices of the Trade Marks Office;

d) it affects the rights and interests of the respondents,

e) exposes the contradictory and inconsistent stance of the Registrar of Trade Marks;

f) violates the principles of natural justice.

3 . The petitioners, therefore, prays that the statement of the respondent No. 3 may be struck off the pleadings/records on the following grounds:

i) The statement is legally and factually incorrect and contrary to the provisions of law and has to be struck off from the pleadings so as to prevent

perpetuation of an error and inconsistency in the position of the respondent No. 3.

ii) The respondent No. 3 has no jurisdiction to file the statement expressing the opinion that the prior registration/s granted in favour of the petitioner

prima facie appear unjustifiable.

iii) The impugned registration has been granted by the Registrar, the Senior Examiner has no jurisdiction to file a statement under Section 98(2) of the

Act. As per the established practice, only officers of the designation of the Registrar, Joint Registrar, Deputy Registrar or Assistant Registrar has to

decide the matter.

iv) The Registrar himself has no power to suo moto review his own decision.

v) The statement or the opinion given by the Senior Examiner is contrary to the scope and ambit of Section 57 of the Act.

vi) The statement or the opinion is outside the scope of Section 98(2) of the Act as the Registrar has to submit a statement giving particulars of the

proceedings before him relating to the matter in issue or grounds of any decision given by him affecting the said decision or the practice of the Trade

Marks Registry or other relevant issues that are within the knowledge of the Registrar, but in the instant case the statement given by the Senior

Examiner does not deal with the issues which fall within the scope of Section 98(2) of the Act but has gone beyond the scope and ambit of Section

98(2).

vii) The Senior Examiner has gone beyond the ambit of Section 98(2) of the Act. By doing so the statement given is contrary to the provisions of

Section 31 of the Act.

viii) The statement and the action of the respondent No. 3 is arbitrary, unwarranted and false and is self-contradictory statement, falling outside the

purview of Section 98(2) of the Act and also in contravention to various provisions of the Act which are incorporated to protect the vested rights of a

registered trade mark owner.

ix) The statement deserves to be struck off on the grounds of arbitrariness as the statement has been made without application of mind and with utter

disregard to the grounds on which the registration was granted.

x) The statement is also in violation of Sections 9, 31 and 32 of the Act.

xi) The statement made by the respondent No. 3 amounts to withdrawing the order of acceptance of registration which cannot be simply done in view

of Section 19 of the Act. If the respondent No. 3 back tracks its own stand the petitioner will be put to irreparable loss. The respondent No. 3 is

therefore estopped from filing such a statement.

xii) The statement made by the respondent No. 3 has not been made bonafide and in the interest of justice.

4 . The applicant filed reply to the miscellaneous petitions denying all the material facts. The applicant submitted that the MPs filed by the petitioner is misconceived and is an abuse of process of law and is liable to be dismissed, as a preliminary objection. The MPs have been filed with a view to cause delay in the hearing and disposal of the main applications. All the procedures have been completed as per the Intellectual Property Appellate Board (Procedure) Rules, 2003 and the MPs are after thought and filed only to delay the hearing/disposal of the main applications.

5. The petitioner has also not taken any steps to serve the respondent No. 3 against whom the relief has been sought. Under Section 98(2) of the Act, the Registrar has been conferred with statutory/legal rights to appear before the Appellate Board and be heard in any legal proceedings. The Registrar

has also been impleaded as a necessary party and hence the rectification applications have been duly served on him calling upon him to file a

statement. The statement filed by the Registrar is in terms of provisions of Section 98(2) of the Act which is an evidence in the proceedings under

law. The petitioner failed, neglected and deliberately omitted to state the provisions of law and rules of procedure under which the relief claimed in the

MPs i.e. striking off the statement from the records could be granted. The applicant has also stated that it is incorrect to say that the statement of the

Registrar was filed in the proceedings in CS (OS) No. 1172/08 and only then the petitioner became aware of the statement filed by the respondent

No. 3 before the Appellate Board in the rectification applications. In fact the applicant stated that the affidavit was furnished to the counsel for the

petitioner on 21.11.08 itself. The petitioner has no locus standi to pray for or seek order for striking off statement (material evidence) from the records

because it exposes false claims and assist the Appellate Board to arrive at a just decision in the matter. The MPs filed by the petitioner itself is

misconceived and is liable to be dismissed. It is also further stated that the grounds on which the MPs have been filed is baseless and totally irrelevant.

6. The matters were taken up for hearing on 13.02.09 in the Circuit Bench sitting at New Delhi. Learned Counsel Shri Amarjit Singh appeared for the

applicant and learned senior counsel Dr. Abhishek Manu Singhvi and Shri Sanjay Jain appeared for the petitioner. All the three miscellaneous petitions were heard together as the parties and the facts are same in all the three cases, same argument were advanced by both the counsel in all the three cases. Therefore, a common order is being passed for all the three petitions.

7 . The learned Counsel for petitioner mainly contended that the concerned Trade Marks Registry where the mark was registered was the Delhi and the applicant had impleaded the Mumbai Registry with malafide intentions. When Delhi Registry had jurisdiction to register the trade mark of the petitioner it was not made clear why the registry at Mumbai was impleaded. The counsel further submitted that the opinion/statement was given by the Senior Examiner, Mumbai on 9.9.2008 and the same was received by the Appellate Board on 12.09.2008. The statement was not served on the petitioner whereas the same was received by the applicant on 10.09.2008 itself. The petitioner had taken necessary steps to find out as to how the applicant had received the statement the very next day i.e. on 10.09.08 under the Right to Information Act. The counsel further submitted that the respondent No. 3 had colluded with the applicant and had filed the opinion/statement before this Appellate Board.

8 . The counsel also referred to Rule 119 of the Trade Marks Rules, 2002. The said statement was made use by the applicant in the civil suit which is pending before the Delhi High Court. The applicant has also not stated as to whether they had been using the mark prior to that of the petitioner. The petitioner has been using the trade mark since 1994. The counsel referred to the proviso to Section 9(1) of the Act. The counsel further submitted that the statement has been filed in collusion with the applicant and has got to be struck off the records.

9. The learned Counsel for the applicant contended that the filing of the statement by the Registrar was as per the provisions of Sub-section (2) of Section 98 of the Act. The statement filed by the respondent No. 3 is only a formal statement and not an evidence as contended by the petitioner. The counsel also brought to our notice the averments made in the application for rectification. The counsel also referred to the trade mark applications advertised in the Trade Marks Journal.

10. The counsel further submitted that the right to file statement by the

Registrar as per the provisions of Sub-section (2) of Section 98 of the Act is derived from the statute and the same cannot be disputed by the petitioner. The petitioner cannot ask for striking off the statement of the other party i.e. the respondent No. 3 who is a necessary party to the proceedings. Therefore, the statement cannot be struck off the record. The Registrar has only filed a statement and it is not an order. The evidentiary value of the statement can be evaluated at the time of final hearing of the rectification application. The applicant, therefore, prayed that the statement be not struck off the record and the miscellaneous petition be dismissed.

11. We have considered the arguments of both the counsel. The main submission of learned Counsel for petitioner is that the statement filed by the Registrar was not a statement but an opinion as the registrar had stated that the registrations are prima facie not justifiable and are wrongly made. We are of the view that the statement seems to be like a report given by the Registrar after registration. We are not inclined to go into the merits of the statement as to the validity in detail at this preliminary stage of the matter. That apart, we are also not going into the issue as to whether the Senior Examiner has powers to file a statement in the rectification application.

12. Sub-section (2) of Section 98 of the Act provides that the Registrar may submit a written statement in respect of the matter in issue and such statement shall be evidence in the proceedings. The statute itself provides that the Registrar may appear before the Appellate Board and submit his statement unless the Appellate Board otherwise directs. The Calcutta High Court in *C. Prihans v. Registrar* reported in (1971) 75 CWN 641 at page 647 has remarked that "" the fact that such one, having great experience behind him, does appear with a view to assisting the court, certainly not with a view to supporting his decision under appeal, is to be welcomed.

13. In the instant case, the respondent No. 3 has filed the subject statement as per the directions of the Registry of this Appellate Board. In such case, we don't find any illegality in filing of the statement by the Registrar and also find no cause in striking off the statement. We are of the view that the validity of the statement as to whether it is an opinion or just a statement and what is its evidentiary value cannot be gone into at this preliminary stage. That apart, we are of the view that one respondent cannot pray that the other respondent's statement should not be considered when the statute itself

provides that a particular respondent is to file a statement it cannot just like that be thrown away. The practice of the Registry is to be consistent with the provisions of the Act and Rules made thereunder. The Registrar's interest is merely to preserve the purity of the Register, which, no doubt, is in public interest.

14 . In view of the above, we find no merits in the miscellaneous petitions and accordingly the miscellaneous petition Nos. 01-03/09 are dismissed.

There shall be no order as to costs.