
(2010) 02 DEL CK 0056

In the Delhi High Court

Case No : Writ Petition (C) 8875 of 2009 and CM 6241 of 2009

Mount Everest Mineral Water Ltd.

APPELLANT

Vs

Bisleri International Pvt. Ltd. and Others

RESPONDENT

Date of Decision : 22-02-2010

Acts Referred:

Citation : (2010) 171 DLT 298 : (2010) 43 PTC 129

Hon'ble Judges : Dr. S. Muralidhar, J

Bench : Single Bench

Advocate : Sanjay Jain, Meghna Mishra, R.N. Karanjawala, Bini Kalra and Manasi Gupta, for the Appellant; Amarjit Singh and Supreet Kaur for R-1 and Ravinder Aggarwal, CGSC for UOI, for the Respondent

Final Decision : Allowed

Judgement

S. Muralidhar, J.—An interesting question involving the interpretation of Section 98 of the Trade Marks Act, 1999 (TM Act, 1999), which is a provision similar to the repealed Section 112 of the Trade and Merchandise Marks Act, 1958 (TM Act, 1958), arises for consideration in this petition.

2. The Petitioner holds registrations for the mark "Himalayan" in respect of mineral water falling in Class 32. Copies of three certificates under registration Nos. 630661 ["Himalayan" (device of mountain)] dated 10th June 1994, 1078116 [word mark "Himalayan"] dated 4th February 2002 and 1078117 ["Himalayan (label)"] dated 4th February 2002 issued by the Trade Marks Registry, New Delhi, have been enclosed with this petition. There is one other application (registration No. 630647 in Class 32) filed for the word mark "Himalaya Springs (Dadi)" which is stated to be pending.

3. The Petitioner filed a suit CS (OS) No. 1172 of 2008 in this Court seeking to restrain Respondent No. 1 Bisleri International Pvt. Ltd. (BIPL) from using the trade mark "Himalayan" or any other trade mark deceptively similar to it in relation to the Respondent's goods and services. It is stated that an interim

arrangement was arrived at between the parties. On 24th June 2008 an order was passed by this Court in the suit recording the said arrangement. The suit is stated to be pending in this Court.

4. On 4th August 2008 the Intellectual Property Appellate Board (IPAB) sent the Petitioner a copy of an Application No. ORA/180/08/TM/DEL filed by BIPL under Sections 47/57/125 of the TM Act 1999 seeking rectification/removal of the petitioner's registered trade mark No. 630661 in Class 32. Likewise on 5th August 2008 the IPAB sent the Petitioner copies of two more rectification applications [ORA/181/08/TM/DEL and ORA/182/08/TM/DEL] filed by BIPL for rectification/removal of registered trade mark Nos. 1078117 and 1078116 respectively. The Petitioner filed its replies to the above applications on 15th October 2008. BIPL filed its rejoinder thereto.

5. On 18th November 2008, the Petitioner was served by the counsel for BIPL in the suit a copy of a statement dated 9th September 2008 submitted by the Senior Examiner of the Trade Marks, Mumbai to the IPAB in the aforementioned three rectification applications, in response to a notice dated 5th August 2008 issued to the Registrar of Trade Marks by the IPAB u/s 98 of the TM Act 1999. On 22nd November 2008 the said statement was covered in the media even before copies thereof could be served on the parties before the IPAB, including the petitioner. This prompted the petitioner to inspect the records of the IPAB.

6. The petitioner found that the Senior Examiner's statement dated 9th September 2008 had reached the IPAB on 12th September 2008 and was taken on record by it on that day. Yet, a certified copy of the said statement had been issued by the Assistant Registrar of Trade Marks (and obtained by BIPL) on 10th September 2008 itself. The petitioner's lawyers applied to the Trade Marks Registry at Mumbai on 8th December 2008 under the Right to Information Act 2005 (RTI Act) to ascertain the name of the party to whom a copy of the statement dated 9th September 2008 had been issued. The Mumbai office of the Trade Marks Registry forwarded the petitioner's RTI application to the New Delhi branch of the Trade Marks Registry since the three rectification applications belonged to the Delhi jurisdiction. In the meanwhile the Mumbai office of the Trade Marks Registry informed the petitioner's lawyers by a letter dated 5th January 2009 that after registration of the mark all the files related to the branch "are forwarded to the appropriate offices of the trade mark application." It was maintained that the Mumbai branch had "not given any opinion in such IPAB matters of Mumbai or any other branches." The petitioners were asked to contact the Branch Registry, New Delhi since the matter belonged to that office. The registration files were also with that office. By letter dated 16th January 2009, the New Delhi office of the Trade Marks Registry informed the Mumbai Registry that the "common opinion/statement dated 9th September 2008 had "not been issued from the Trade Marks Registry, Delhi."

7. Meanwhile, on 12th December 2008, the Petitioner filed three miscellaneous petitions in the aforementioned rectification applications before the IPAB for

striking off the statement dated 9th September 2008 filed by the Senior Examiner of the Trade Marks Registry, Mumbai. It was contended by the Petitioner before the IPAB that the trade marks were registered in Delhi whereas BIPL had deliberately, and perhaps mala fide, impleaded the Mumbai Registry as a party to the rectification applications. It was submitted that the statement by the Senior Examiner of the Mumbai Registry had been filed in collusion with the BIPL. Moreover, the Senior Examiner of the Mumbai Registry had travelled far beyond the scope of his role u/s 98 and rendered an opinion to the effect that the registrations were incorrectly granted to the petitioner. This was contrary to the stand taken at the time of grant of registration and tantamounted to a review of the grant of the registration. It was accordingly submitted that the said statement should not be treated as evidence and should be struck off from the records.

8. By the impugned order dated 31st March 2009, the IPAB opined that the statement submitted by the Senior Examiner "seems to be like a report given by the Registry after registration". The IPAB was not inclined to go into the merits of the statement at the preliminary stage. It was also not prepared to examine the issue whether the Senior Examiner had the power to file a statement in a rectification application. Since the statement had been filed pursuant to the directions of the Registry of the IPAB, there was no illegality committed and, therefore, no case was made out for striking it off. Whether it was an opinion or only a statement and what its evidentiary value was, could not be gone into at the preliminary stage. Further, the IPAB observed that the Respondent could not pray that the other respondent's statement should not be considered when the statute itself permitted such respondent to file a statement. It was noted that the Registrar's interest was to merely preserve the "purity" of the register which no doubt was in public interest. Consequently by the impugned common order dated 31st March 2009 the IPAB rejected the petitioner's three miscellaneous petitions. The said order has been challenged in this writ petition.

9. Mr. Sanjay Jain, the learned Senior counsel, appearing for the Petitioner assailed the impugned order of the IPAB and submitted that:

(a) In terms of Section 98(2) TM Act 1999, it is only that Registry which has dealt with the subject matter of the registration, which is competent to file a statement before the IPAB particularly since such statement "shall be evidence in the proceedings"

(b) The TM Act 1999 has brought about the decentralization of the functioning of the Trade Marks Registry with the head office at Mumbai and branch offices in the different regions. Since each branch is a composite autonomous unit since 2003, there was no occasion for the Senior Examiner of the Mumbai Registry, who had not dealt with the registrations granted to the Petitioner, to file such a statement.

(c) A perusal of the statement filed by the Senior Examiner shows that it far

exceeded the scope of his role as envisaged u/s 98 of the TM Act, 1999. Instead of confining himself to the practice of the Trade Marks Registry in such cases, the Senior Examiner opined that the registration ought not to have been granted to the petitioner thus contradicting the earlier view of the Registrar on the basis of which the registrations were granted.

(d) While u/s 57 TM Act 1999, the Registrar can after a trade mark registration is granted, suo motu or in an application made in that behalf rectify the registered mark, it was not open to the Registrar, much less a Senior Examiner, when called upon to depose or file a statement u/s 98 to review the decision of a Registrar to grant registration.

(e) In response to a query made under the RTI Act, it was clarified that there was no notification designating the Senior Examiner u/s 3(2) of the TM Act 1999. Therefore, the plea that he was authorized to make a statement u/s 98(2) TM Act 1999 on behalf of the Registrar was incorrect, (f) Since the statement of the Senior Examiner of the Mumbai Registry was in support of BIPL and against the petitioner, it was evident that the statement had been filed in collusion with BIPL. This betrayed a partisan approach. The statement was a malafide exercise by the Senior Examiner of the powers u/s 98(2) TM Act 1999.

10. Replying to the above submissions, Mr. Amarjit Singh, the learned Counsel appearing for the Respondent No. I BIPL, submitted that all records of registration of trademarks were kept at the head office of the Trade Marks Registry at Mumbai and this position continued at least till 2003. There is only one "Registrar of Trade Marks" in terms of the definition contained in Section 2(1) (y) of the TM Act 1999 read with Section 3 thereof. u/s 3(2) of the TM Act 1999, the Central Government may appoint "such other officers with such designations as it thinks fit for the purposes of discharging, under the superintendence and direction of the Registrar, such functions of the Registrar under this Act as he may from time to time authorize them to discharge". u/s 4 of the TM Act 1999 the Registrar may, without prejudice to the powers of the Central Government u/s 3(2), by order withdraw any matter pending before an officer appointed u/s 3(2) and "deal with such matter himself either de novo or from the stage, it was so withdrawn or transfer the same to another officer so appointed".

11. Referring to Section 5 of the TM Act 1999 Mr. Amarjit Singh submitted that the head office of the Trade Marks Registry is at Mumbai. There are several branches including one at Delhi. It is submitted that it is quite natural that the Registrar at the head office at Mumbai will have a better knowledge of the general practice followed by the Trade Marks Registry in the different branches. Once a rectification application is filed, then the Registrar has the right to be heard u/s 98 of the TM Act 1999. That right cannot be curtailed even by the IPAB. It is pointed out that although Section 98 does not specifically provide for delegation of the powers of the Registrar to any other officer, this power is derived from Section 3(2) itself. Referring to Rule 4 of the Trade Marks Rules, 2002 ("TM Rules 2002"), it is pointed out that the work of the Registry has been

decentralized and that is how the registrations in the instant case were granted to the petitioner at New Delhi.

12. Mr. Amarjit Singh submitted that the statement of the Senior Examiner in the present case sets out the factual position as found in the records. The statement notes that in the petitioner's pending application TM No. 630647 it was asked to issue a disclaimer to the effect that the registration of the trade mark shall give no right to the exclusive use of device of mountain and the word "Himalaya". The petitioner agreed to incorporate the said disclaimer. It was opined that such a condition was "inevitable in respect of impugned TM No. 630661 and should have been imposed as a matter of course." As regards Registration Nos. 1078116 and 1078117 they consisted of the word "Himalayan" and in the absence of any other feature of a trade mark character in the mark/label there was no scope for incorporating a disclaimer condition. Consequently, the said registrations were held to be prima facie not justifiable.

13. Mr. Amarjit Singh refers to the decision of the Division Bench of the Calcutta High Court in Protap Properties Private Ltd. Vs. State of West Bengal and Others, where it was held that the rules made in furtherance of the provisions of the Act cannot go beyond the scope of the Act. It is submitted that likewise a rule making authority, in this case, i.e., the Central Government in terms of Section 157 of the TM Act 1999, had to act within the limits of the powers granted to it. For the purpose of Section 98 of the TM Act 1999, Rule 4 would have no applicability. Further a perusal of Rule 8(2) shows that the requests in Forms TM-1, TM-5 and TM-26 are covered under Rule 4. All other requests are excluded from the ambit of Rule 4. Therefore, according to Mr. Amarjit Singh, the branch office is not vested with any exclusive jurisdiction to deal with the matters covered by TM 25 which is relatable to Section 98. Under Rule 10 of the TM Rules 2002 a notice or communication relating to an application may be issued by the head office or any of the other officers as authorised by the Registrar. Therefore, it is only the head office or an officer authorized by the Registrar who can exercise the right to appear and to be heard in the proceedings before the IPAB u/s 98. Consequently the statement filed by the Senior Examiner on behalf of the Registrar in the head office of the Registry, and as authorized by him (as is explicitly stated in the statement itself) was perfectly justified and in order. It only demonstrated the effective superintendence and direction of the Registrar. It is submitted that it is always open to the Petitioner to raise objections at the appropriate stage on the statement of the Senior Examiner and the IPAB would consider these contentions along with the evidence at that stage. As of now the IPAB had not expressed a view on the merits. Consequently, there was no occasion for this Court to interfere with the impugned order of the IPAB in exercise of its jurisdiction under Article 226 of the Constitution.

14. The above submissions require the Court to first examine the precise role of the Registrar in proceedings before the IPAB in the light of Section 98 TM Act 1999. The said provision is more or less similar to Section 112 of the TM Act

1958 except that wherever in the TM Act 1958, a reference was made to the High Court it has been replaced by the IPAB. The purpose of the Registrar being required to appear before the IPAB is to assist it in the proceedings pending before it on legal issues, on the practice in the Trade Marks Registry in like cases, or in relation to other matters "relevant to the issues and within his knowledge as Registrar." Such statement shall be evidence in the proceedings before the IPAB.

15. It is common ground that as a general practice, the IPAB does not permit oral examination of parties or cross-examination of the deponents of affidavits. The cases before the IPAB are decided essentially on affidavits. Also, it is not that as a routine the IPAB issues notice u/s 98 TM Act 1999 to the Registrar to either appear or file a statement in lieu thereof before the IPAB. It appears that for the purposes of the said provision, the Registrar is not a "party" to the lis between two or more contestants for a trade mark. Section 98 TM Act 1999 reads as under:

98. Appearance of Registrar in legal proceedings.

(1) The Registrar shall have the right to appear and be heard-

(a) in any legal proceedings before the Appellate Board in which the relief sought includes alteration or rectification of the register or in which any question relating to the practice of the Trade Marks Registry is raised;

(b) in any appeal to the Board from an order of the Registrar on an application for registration of a trade mark-

(i) which is not opposed, and the application is either refused by the Registrar or is accepted by him subject to any amendments, modifications, conditions or limitations, or

(ii) which has been opposed and the Registrar considers that his appearance is necessary in the public interest, and the Registrar shall appear in any case if so directed by the Board.

(2) Unless the Appellate Board otherwise directs, the Registrar may, in lieu of appearing, submit a statement in writing signed by him, giving such particulars as he thinks proper of the proceedings before him relating to the matter in issue or of the grounds of any decision given by him affecting it, or of the practice of the Trade Marks Registry in like cases, or of other matters relevant to the issues and within his knowledge as Registrar, and such statement shall be evidence in the proceeding.

16. Section 98(1)(a) gives the Registrar a right to appear in the proceedings before the IPAB in proceedings seeking rectification of the register or in which any question relating to the practice of the Trade Marks Registry is raised. He shall appear "if so directed" by the IPAB. u/s 98(2) in lieu of appearing and deposing, the Registrar may "submit a statement in writing signed by him, giving

such particulars as he thinks proper of the proceedings before him relating to the matter in issue...." The words "proceedings before him...", "decision given by him", "matters relevant to the issues and within his knowledge as Registrar" indicate that the person who has to appear before the IPAB as Registrar or submit a statement in lieu thereof has to have some knowledge of the proceedings. This can be either personal knowledge or knowledge derived from the records of the case. Where the Registrar's presence is required to assist the IPAB on the general practice of the Trade Marks Registry then it might perhaps be appropriate for a duly authorized officer of the head office at Mumbai to depose. Therefore, the submission on behalf of BIPL that in every case where a notice is issued to the Registrar u/s 98 to appear before the IPAB, it is an officer from the Mumbai Registry who has to be sent for that purpose, does not appear to be the correct interpretation of Section 98 either from the legal or practical point of view.

17. The TM Act 1999 has indeed brought about decentralization of the work of the Trade Marks Registry both de facto and de jure. Section 3(1) TM Act 1999 envisages a single Registrar of Trade Marks and Section 3(2) enables the central government to appoint such other officers to discharge such functions of the Registrar which he may from time to time authorise them to discharge under his supervision and directions. Therefore, if a Senior Examiner had to discharge the functions of a Registrar u/s 98 TM Act 1999, he would have to be appointed as such by the central government and then be duly authorised by the Registrar to discharge the functions u/s 98 TM Act 1999. Section 3(2) therefore permits a supervised and controlled delegation by the Registrar of his specific functions to a subordinate officer who has to be appointed for that purpose by the central government. The Registrar's powers to transfer matters pending before a subordinate officer to himself or to another subordinate officer are contained in Section 4 TM Act 1999. This also makes it clear that the subordinate officers have to function under the control and directions of the Registrar.

18. The decentralization of the offices of the Trade Marks Registry with the head office at Mumbai and branch offices elsewhere is made possible by Section 5 TM Act 1999. u/s 6 while the Trade Marks Register containing entries in respect of all registered trademarks is kept at the head office, copies of the register are preserved at the respective branch offices. In practice the entire record of registration of a trade mark is now preserved at the branch where it was applied for, investigated into and granted. In the present case the three registrations of trade marks were granted to the petitioner by the Delhi branch of the Trade Marks Registry. Each certificate carries on the top right hand corner the name of the "Appropriate Office" as "Delhi". It was stated by counsel for both parties that in the present case if an applicant were to seek rectification u/s 57 of the TM Act 1999 of the petitioner's registered trademark then such application would have to be made to the Delhi Branch, which would have all the records of the registration of the marks. This position is also evident from the correspondence exchanged between the Mumbai and Delhi branches of the Trade Marks Registry

in the present case regarding the petitioner's application under the RTI Act.

19. A perusal of the Rule 4 of the TM Rules 2002 shows that it deals with the applications u/s 18, the notice of opposition u/s 21, the application u/s 47 and 57 "or for any other proceedings under the Act." It therefore includes proceedings u/s 98 as well. Further under Rule 8(2) an application or request in several forms can be made to "either the appropriate office or the head office". However, as rightly pointed out by the petitioner, the request in Form TM 26, i.e., the application for rectification of the register or removal of the trade mark from the register relatable to Sections 47 and 57 of the TM Act 1999 has to be lodged only in the concerned appropriate office.

20. As a corollary if an application for rectification is made to the IPAB and a notice is issued to the Registrar u/s 98 TM Act 1999, the concerned officer of that branch of the Trade Marks Registry where such registration was granted would be in a far better position to depose on the basis of his personal knowledge (if such officer had himself dealt with the registration) or on the basis of knowledge from the records. There would be little purpose in requiring an officer of the Calcutta Branch to appear and depose or file a statement in lieu thereof before the IPAB in relation to a registration granted in the Chennai or Delhi Branches. On the other hand, if the purpose of summoning the Registrar u/s 98 is to get him to speak about the general practice of the Registry and not with reference to any particular registration, then an officer from the head office might be better informed and therefore more competent than his counterpart in the branches. In the instant case, the Delhi Branch having granted the registrations of the marks sought to be rectified, and with the notice to the Registrar u/s 98 not being limited to deposing about the general practice of the Registry, where the Registrar was not himself going to depose, he should have ideally authorised an officer from the Delhi Branch to submit a statement to the IPAB. It is intriguing that the Registrar asked the Senior Examiner from the Mumbai office to file such statement. It is, therefore, not possible to accept the submission of the Respondents that as long as the Registrar has authorized an officer in terms of Section 3(2) TM Act 1999 then any subordinate officer including a Senior Examiner, not necessarily from the Branch of the Registry where such registration was granted, can appear and depose or file a statement u/s 98(2) of the TM Act 1999 on matters relating to such registration.

21. Given the scheme of the TM Act 1999 and the TM Rules 2002, in the context of decentralization of the work of the Trade Marks Registry, when the IPAB issues notice u/s 98 of the TM Act 1999 requiring the Registrar to appear or make a statement in lieu thereof before it, and if the Registrar himself is unable to appear, then only an officer of the branch which granted the registration should. That officer of the branch would have to be duly appointed by the central government and the authorised by the Registrar u/s 3(2) of the TM Act 1999 for that purpose.

22. The IPAB should as a matter of practice make a clear distinction about the

purposes for which it is requiring the Registrar to appear or make a statement in lieu of such appearance. The appearance or statement as the case may be could be for the purposes of explaining matters with particular reference to the case in which the application for rectification is filed or it could be about the general practice followed by the Trade Marks Registry.

23. That brings up the next issue concerning the content of the deposition or statement made by a Registrar or his duly authorised subordinate u/s 98. It may be recalled that u/s 98(2) TM Act 1999 such statement of the Registrar or his duly authorised subordinate "shall be evidence in the proceeding." The said provision requires the person making the statement to have dealt with the registration ("of the proceedings before him") and to have decided such matter ("of any decision given by him"). Where it is a matter concerning the practice of the registry it should have been "within his knowledge." Therefore the scope of the role of the Registrar or the subordinate officer authorised for that purpose is to depose based on personal own knowledge (if he has himself handled the matter) or on the basis of the knowledge derived from the record.

24. This does not mean that the Registrar or the officer subordinate to him duly authorised for this purpose, when directed to depose or make a statement before the IPAB u/s 98, can use the opportunity to explain why a certain registration ought to have or ought not have been granted. In other words this is not the occasion for the Registrar or the subordinate officer duly authorised for that purpose to review the decision already taken to grant the registration or comment on whether it was rightly granted. The Registrar is not a "contesting" party to the lis before the IPAB although he is a "necessary" party in terms of Section 98(1) TM Act 1999. He is made a party only to assist the IPAB in understanding what transpired in the proceedings that led to the registration and nothing more. For instance, in an application seeking rectification it is pointed out that an opposition filed pursuant to the publication of the application was not considered by the Registrar while granting registration. If there is a factual dispute whether such opposition was filed, or filed within time, then that fact can be verified by looking into the records. It is therefore necessary for an officer of the concerned branch in the Trade Marks Registry which has granted the registration and/or who has dealt with the matter to explain the position from the record. If he is asked to depose about the registrations which are challenged, and he does not stick to the record but makes a statement that might be seen as favouring one party, then he runs the risk of being impartial and partisan. That would undermine the credibility of the office of the Registrar, which is not one of the intended consequences of Section 98 TM Act 1999. Where his opinion on the general practice of the Trade Marks Registry is sought, he is expected to depose on such practice de hors the lis between the parties. In any event he is expected, for the purposes of Section 98 TM Act 1999 to strictly observe neutrality and objectivity.

25. The Registrar can when exercising powers u/s 57 reconsider his decision to

grant registration. That is a separate jurisdiction in which the Registrar performs a quasi-judicial function. However, when he is asked to appear and depose pursuant to a notice u/s 98 of the TM Act 1999, the Registrar does not perform any quasi-judicial function. He participates in the proceedings before the IPAB to assist it as a non-adversarial party without expressing opinion on the merits of the case. Consistent with the argument of the "purity" of the register, it is expected that the Registrar while appearing in proceedings u/s 98 TM Act 1999 will remain neutral and objective.

26. In the present case, there are several problems with the statement filed by the Senior Examiner from Mumbai before the IPAB. In the first place, it is not clear whether the Senior Examiner appeared and submitted a statement u/s 98(2) after being duly authorised by the Registrar for that purpose as mandated by Section 3(2) TM Act. Where a statement is filed u/s 98(2) TM Act, a copy of the notification of the central government u/s 3(2) appointing such officer for the purpose, and the authorization of the Registrar permitting him to appear and make a statement, ought to be appended to the statement. Absent the notification and authorisation u/s 3(2) of the TM Act 1999, an officer of the Trade Marks Registry cannot be asked to file a statement under the purpose of Section 98(2) of the TM Act 1999. In the instant case, no such notification u/s 3(2) issued by the Central Government appears to have been enclosed with the statement of the Senior Examiner. The reply dated 25th November 2009 sent by the Public Information Officer of the Trade Marks Registry, Mumbai to the Petitioner indicates that although the Senior Examiner who filed the statement was authorized by the Registrar for that purpose, there was no notification of the central government appointing him as the designated officer u/s 3(2) of the TM Act 1999.

27. Secondly, the contents of the statement made by the Senior Examiner also indicate that it was not confined to the record of the case or to the general practice of the Trade Marks Registry in like cases. It went far beyond. The following three paragraphs of the said statement dated 9th September 2008 bear this out:

In the instant case, the words HIMALAYAN or HIMALAYAN MINERAL WATER, being purely descriptive, are not capable of being associated with the natural water sourced from Himalayas of any particular manufacturer and should be open to the trade in general for bona fide use in a descriptive sense. On the other hand, the use of the word HIMALAYAN allegedly as a trade mark in relation to natural water not sourced from Himalayan mountain range would be deceptive to offend the provisions of Section 9(2)(a) of the Trade Marks Act.

Based on these considerations, the condition as aforesaid [to the effect that registration of the trade mark shall give no right to the exclusive use of Device of mountain and word Himalaya] was imposed in respect of TM No. 630647 of the same applicant. A similar condition was also imposed in respect of registered TM No. 953164 of some other party, not involved in these proceedings, viz. United

Breweries. Such condition is inevitable in respect of the impugned TM No. 630661, and should have been imposed as a matter of course to clearly define the rights of the registered proprietor in the larger interests of other traders.

As far as the other two registered trade marks are concerned, viz. 1078116 and 1078117 in class 32, they consist of the word "HIMALAYAN" per se in respect of "Mineral Water". In the absence of any other feature of a trade mark character in the mark/label, there is no scope for imposing any such condition. Consequently, these registrations appear prima facie not justifiable. Accordingly, the entries in the Register in respect of these two trade marks may have to be considered as wrongly made and are wrongly remaining in the Register.

28. While some parts of the statement preceding the above three paragraphs relate to the general practice of the Trade Marks Registry as regards names of mountains being not acceptable for registration as trade marks in respect of "agricultural and natural produce", the above three paragraphs are clearly in relation to "the instant case." The highlighted portion of the above three paragraphs unambiguously state the opinion of the Senior Examiner that the petitioner's registrations have been wrongly granted. Since the statement constitutes evidence, and the deponent is not to be cross-examined, it puts the petitioner here at a distinct disadvantage in the proceedings before the IPAB. BIPL will undoubtedly seek to take advantage of the said statement as supporting its case for rectification. In light of the law explained above, such a statement is clearly unacceptable in law in terms of Section 98 of the TM Act 1999. It runs contrary to the legal requirement of the Registrar or his duly authorised subordinate having to strictly observe neutrality and objectivity in relation to the case on hand. Such a statement cannot be allowed to remain on the record of the rectification applications before the IPAB.

29. Consequently, this Court does not consider it necessary to examine the other objections raised by the petitioners to the above statement of the Senior Examiner. These include the absence of a reference to Sections 9 read with Sections 31(2) and 32 of the TM Act 1999 whereby a mark cannot be declared invalid if it has acquired distinctiveness after the grant of registration and before the challenge to the validity of such registration. The further objection is that the statement makes no reference to Section 26 of the Geographical Indication of Goods (Registration and Protection) Act 1999 which protects marks registered prior to 15th September 2003, the date when the said legislation was notified.

30. This Court is not able to accept the view expressed by the IPAB that it was not called upon at that stage to decide whether the said statement of the Senior Examiner should be accepted as evidence. When even a cursory reading of the statement of the Senior Examiner shows that it exceeded the scope of the role of the Registrar u/s 98 TM Act 1999, the decision whether it should be accepted as evidence ought to have been taken at once. If such decision is postponed and on the postponed date the IPAB comes to the conclusion that the Senior Examiner was either not competent to make the statement, or travelled beyond his brief

then the entire exercise would have to be repeated. This would lead to avoidable wastage of time.

31. For the aforementioned reasons, this Court has no hesitation in setting aside the impugned order dated 31st March 2009 of the IPAB. The three miscellaneous petitions filed by the Petitioner before the IPAB are hereby allowed. The statement dated 9th September 2008 of the Senior Examiner is directed to be taken off the records of the three rectification applications ORA Nos. 180, 181 and 182 /08/TM/DEL. This will, however, not preclude the IPAB from directing the Registrar u/s 98 TM Act to appear and depose before it or file a statement in lieu thereof consistent with the law and practice as explained in this judgment.

32. The writ petition is accordingly allowed with costs of Rs. 10,000/- to be paid by Respondent No. I BIPL to the Petitioner within four weeks from today. The application also stands disposed of.