
(2016) 10 DEL CK 0093

In the Delhi High Court

Case No : Writ Petition (C) No. 2735 of 2012.

The Financial Times Ltd. - Petitioner @HASH The Times Publishing House Ltd.

Date of Decision : 07-10-2016

Acts Referred:

Civil Procedure Code, 1908 (CPC) — Order 18 Rule 4
Evidence Act, 1872 — Section 3
Trade and Merchandise Marks Act, 1958 — Section 110, Section 9(1)(d), Section 92, Section 93

Citation : (2016) 234 DLT 305 : (2017) 3 RAJ 144

Hon'ble Judges : Rajiv Sahai Endlaw, J.

Bench : Single Bench

Advocate : Mr. P.S. Raman, Sr. Advocate with Mr. Aparajitha Vishwanath, Mr. Gaurav Mukherjee, Mr. J.V. Abhay, Mr. Raghav Pant, Mr. Avijit Deb, Ms. Ashima Obhan, Advocates, for the Petitioner; Mr. Hemant Singh, Mr. K. Datta, Mr. Shashi P. Ojha and Mr. Rahul Malhotra,

Final Decision : Dismissed

Judgement

Mr. Rajiv Sahai Endlaw, J. - These four petitions, each under Article 226 of the Constitution of India, impugn the common order (No.91/2012) dated 4th April, 2012 of the Intellectual Property Appellate Board (IPAB) in the five proceedings between the Financial Times Ltd., London (FTL) and Times Publishing House Ltd., New Delhi (TPHL).

2. This judgment is concerned with the challenge made to the part of the said order of IPAB dismissing the application of TPHL for opportunity to cross-examine the deponent of the affidavit by way of evidence filed by FTL.

3. Before dealing with the aforesaid aspect, it is necessary to narrate the events leading to the said challenge.

3.1. On 9th March, 1987, FTL applied for registration of the trademark "Financial Times" in Class 16 of the Fourth Schedule to the Trade Marks

Rules, 2002 in its favour.

3.2. On 23rd July, 1990, TPHL obtained a certificate under the Press and Registration of Books (PRB) Act, 1867 for the title "Financial Times" in its favour.

3.3. On 30th August, 1991, FTL obtained registration of trademark "Financial Times" in its favour in Class 9.

3.4. On 1st January, 1993, TPHL applied for registration of "Financial Times" as a trademark in its favour in Class 16.

3.5. On 29th October, 1993, the trademark "Financial Times" was registered in the name of FTL in Class 16.

3.6. On 2nd December, 1993, TPHL filed proceedings in the High Court of Delhi for cancellation of the registration of the mark "Financial Times" in Class 16 in favour of FTL.

3.7. On 3rd December, 1993, FTL filed a suit in the City Civil Court at Bangalore, Karnataka for permanent injunction to restrain TPHL from infringing its registered trademark "Financial Times" and/or from passing off its newspaper Financial Times as that of FTL.

3.8. On 16th February, 1994, FTL obtained registration of the trademark "FT" in its favour in class 16.

3.9. On 2nd March, 1994, the City Civil Court, Bangalore granted interim injunction restraining TPHL from using the trademark "Financial Times".

3.10. On appeal of TPHL, on 19th April, 1994, the aforesaid interim stay was vacated by the High Court of Karnataka.

3.11. FTL preferred a Special Leave Petition to the Supreme Court; vide order dated 23rd September, 1994, TPHL was permitted to continue using the trademark "Financial Times", subject to certain conditions.

3.12. Upon coming into force of the Trade Marks Act, 1999 (TMA), proceeding aforesaid filed by TPHL in High Court of Delhi for cancellation of registration of the mark "Financial Times" in the name of FTL in Class 16 is transferred to the IPAB and given No.TRA/6/2005/TM/DEL.

3.13. Vide judgment dated 24th September, 2002, the suit aforesaid filed by FTL in City Civil Court, Bangalore was dismissed by a detailed judgment; the first appeal preferred by FTL to the High Court of Karnataka is pending consideration.

3.14. On 22nd June, 2005, the mark "Financial Times" was registered in favour of TPHL in class 16.

3.15. However, on 10th October, 2005, the Registrar of Trademarks suo moto cancelled the registration aforesaid in favour of TPHL.

3.16. TPHL filed OA/4/2006/TM/DEL before the IPAB against the suo moto order of the Registrar of Trade Marks cancelling the registration aforesaid granted in

favour of TPHL in Class 16.

3.17. On 14th August, 2006, FTL applied to the IPAB for cancellation of the registration in favour of TPHL of the mark "Financial Times" in Class 16 and the said proceeding was given No.ORA/112/2006/TM/DEL.

3.18. In April, 2007, TPHL applied to IPAB for cancellation of registration of mark "FT" in favour of FTL in Class 16 and the said proceeding was given No.ORA/67/2007/TM/DEL.

3.19. TPHL filed ORA/64/2007/TM/DEL before the IPAB seeking cancellation of registration of the mark "Financial Times" in the name of FTL in Class 9.

4. IPAB, by the impugned order dated 4th April, 2012:

i) Allowed TRA/6/2005/TM/DEL thereby cancelling the registration of mark "Financial Times" in Class 16 in name of FTL.

ii) Allowed ORA/112/2006/TM/DEL thereby cancelling the registration of mark "Financial Times" in Class 16 in name of TPHL.

iii) Allowed OA/4/2006/TM/DEL thereby setting aside the suo moto order of Registrar cancelling the registration in name of TPHL of the mark "Financial Times" in Class 16.

iv) Allowed ORA/64/2007/TM/DEL thereby cancelling registration of mark "Financial Times" in Class 9 in name of FTL.

v) Dismissed ORA/67/2007/TM/DEL whereby TPHL had sought cancellation of the mark "FT" in Class 16 in the name of FTL.

5.1 FTL has filed W.P.(C) No.2735/2012 impugning the order aforesaid of the IPAB allowing TRA/6/2005/TM/DEL (directing removal of the mark "Financial Times" in the name of FTL from Class 16 of the Register of Trade Marks).

5.2 FTL has filed W.P.(C) No.2737/2012 impugning the order aforesaid of IPAB allowing ORA/64/2007/TM/DEL (directing removal of the mark "Financial Times" in the name of FTL from Class 9 from the Register of Trade Marks).

5.3 TPHL has filed W.P.(C) No.2745/2012 (a) impugning the order aforesaid of the IPAB allowing ORA/112/2006/TM/DEL (directing removal of the mark "Financial Times" in the name of TPHL from Class 16 of the Register of Trade Marks); (b) impugning the findings of the IPAB against TPHL while allowing TRA/6/2005/TM/DEL; and, (c) seeking a declaration that IPAB was bound by the findings of the City Civil Court, Bangalore).

5.4 TPHL has filed W.P.(C) no.3483/2012 impugning the order aforesaid of the IPAB of dismissal of ORA/67/2007/TM/DEL (denying cancellation of registration of mark "FT" in Class 16 in name of FTL).

6. Needless to state, all the petitions were entertained and vide interim order,

the operation in entirety of the order aforesaid of the IPAB was stayed.

7. Hearing of arguments in the petitions was commenced on 30th October, 2015. It was inter alia the contention of the counsel for TPHL that the dismissal by the IPAB (at the foot of the impugned order dated 4th April, 2012) of MP No.157/2010 filed by TPHL in TRA/6/2005/TM/DEL, seeking opportunity to cross-examine the witness of FTL whose affidavit by way of evidence was filed before the IPAB, was bad and there was thus a need for remand of the matter to the IPAB with an opportunity to TPHL to cross-examine the witness of FTL and a direction to thereafter decide afresh.

8. Being of the view that in the event of the said argument of the counsel for TPHL being accepted, the matter will have to be remanded and the decision on the challenge to the other findings of the IPAB should await, with consent, the counsels were heard on the said aspect and order on the said aspect reserved on 18th February, 2016. Being further of the view that in the event of not agreeing with the said contention of the counsel for TPHL, further hearing of the petitions be not delayed owing to the challenge being made by TPHL thereto, it was further observed while reserving order that in the event of the said contention of TPHL being rejected, further hearing would go on and the order rejecting the said argument of TPHL would come into effect along with the final order on the petitions.

9. The counsel for TPHL argued:

(i) that cancellation proceedings TRA/6/2005/TM/DEL were initiated under Section 56 of the Trade and Merchandise Marks Act, 1958 (TMA, 1958) and cancellation proceedings ORA/112/2006/TM/DEL, ORA/64/2007/TM/DEL and ORA/67/2007/TM/DEL were under Section 57 of TMA but since the provisions are the same, the same is irrelevant;

(ii) that the said cancellation proceedings are considered as an original proceedings;

(iii) that though IPAB is not required to give opportunity to cross-examine in all cases but when the same is requested for, it cannot be denied;

(iv) that Section 92 of TMA requires the IPAB to be guided by the principles of natural justice, though not bound by the procedure laid down in the CPC;

(v) that though TPHL filed M.P. No.157/2010 in TRA/6/2005/TM/DEL for cross-examination of the witness of FTL whose affidavit by way of evidence was filed before IPAB but IPAB did not pass any order thereon and took up that application at the stage of final arguments and has at the foot of the impugned order dated 4th April, 2012 rejected the said application without giving any reason;

(vi) that the deposition of witness of FTL before the IPAB is contrary to the deposition of the witnesses of FTL before the City Civil Court, Bangalore and the IPAB has failed to deal with the said contention of TPHL;

(vii) reliance was placed on *Rajiv Arora v. Union of India* (2008) 15 SCC 306 to contend that demand for cross-examination cannot be declined;

(viii) reliance was placed on order dated 2nd September, 2015 of the Supreme Court in Civil Appeal No. 4228/2006 titled *Andaman Timber Industries v. Commissioner of Central Excise, Kolkata-II* holding that not allowing the assessee to cross-examine the witnesses whose statements were made the basis of the order of the Adjudicating Authority is a serious flaw which makes the order a nullity, inasmuch as it amounted to violation of principles of natural justice because of which the assessee was adversely affected and that it was not for the Tribunal to do guess work as to for what purpose the witnesses were sought to be cross-examined;

(ix) reliance was placed on *Bareilly Electricity Supply Co. Ltd. v. The Workmen* AIR 1972 SC 330 followed in *Khushi Ram Behari Lal v. New Bharat Rice Mills* (2011) 46 PTC 493 (Del.), *Ayaaubkhan Noorkhan Pathan v. State of Maharashtra* (2013) 4 SCC 465, *State of M.P. v. Pappoo @ Saleem and Ravi Karan Tripathi v. U.P. Public Service Tribunal* to contend that right of cross-examination is a part of principles of natural justice;

(x) that requiring a party before the IPAB to satisfy IPAB before hand as to on what aspect it needed to cross-examine the witness of the other side, would amount to disclosure of the line of cross-examination and reduce the efficacy of cross-examination;

(xi) that IPAB was required to pass a reasoned order allowing or disallowing cross-examination;

(xii) that IPAB, in the impugned order, has looked at some evidence and discarded other, ignoring the principle that if any statement of the witness is held to be false, the same discredits the witness and no part of his evidence can be looked at;

(xiii) attention was invited to CM No.14185/2013 in W.P.(C) No.2737/2012 setting out the inconsistencies in the statement of the witnesses of FTL before the City Civil Court, Bangalore and the statement of the witness of FTL before the IPAB;

(xiv) that the test of "distinctiveness" is more in registration proceedings with validity whereof IPAB was concerned than in an action for passing off with which the City Civil Court, Bangalore was concerned but still the IPAB has returned findings, on the basis of testimony of witness of FTL, contrary to of the City Civil Court, Bangalore without giving opportunity to TPHL to cross-examine the said witness;

(xv) that IPAB, while believing the evidence of witness of FTL, did not refer at all to the evidence of TPHL;

(xvi) that IPAB erred in believing the evidence of the witness of FTL observing

that it had "no reason to disbelieve the same"

(xvii) that the denial by IPAB of opportunity to TPHL to cross-examine the witness of FTL is arbitrary.

10. I had during the hearing enquired from the counsel for TPHL (i) as to what was the procedure followed before this Court when cancellation/rectification proceedings were adjudicated by this Court i.e. whether cross-examination was allowed as a matter of right, as in a suit and if not, on what parameters; (ii) what would be the effect of the transfer of TRA/6/2005/TM/DEL instituted in this Court to the IPAB i.e. whether the said right if any of cross-examination would be carried forward to the IPAB; and, (iii) what was the stage at which TRA/6/2005/TM/DEL were, at the time of transfer from this Court to IPAB.

11. The counsel for TPHL, post verification, informed (a) that this Court had made Rules under Section 110 of TMA, 1958, Rule 13 whereof was as under:

"13. Application of the Code of Civil Rules and Forms of the Court?In cases not provided for in the foregoing Rules the provisions of the Code of Civil Procedure, 1908, and, the Rules and Forms of the Court, shall apply mutatis mutandis to the proceedings under the Act.

Provided that it shall not be necessary for the Court to frame issues and the evidence may be taken in the form of affidavits where the Judge so directs."

(b) that right to cross-examine available to TPHL before this Court was a substantive right and which was preserved by Section 100 of TMA; and, (c) that TRA/6/2005/TM/DEL at the time of transfer to IPAB was at the stage of filing of affidavits of evidence.

12. Per contra, the senior counsel for FTL argued:

(I) that right to cross-examine, unless expressly conferred, is not a substantive right; though there is a right to cross-examine in civil and criminal proceedings but there is no such right before the Tribunals constituted to speed up the matters by following the summary procedure;

(II) reliance was placed on Union of India v. Delhi High Court Bar Association AIR 2002 SC 1479;

(III) that the judgments cited by the counsel for TPHL are either with respect to civil or criminal courts or with respect to proceedings under the Customs and Excise laws where statements made on affidavit are intended to be used for imposing penalty and such judgments would not be applicable to the proceedings before the IPAB;

(IV) that the initiation of proceedings before this Court and transfer thereof to the IPAB is immaterial as the right of cross-examination is a procedural law and the procedure of the forum concerned will be applicable;

(V) reliance was placed on Swastick Pipes Ltd. v. T.T. Industries, the order dated

11th December, 2009 of IPAB in MP No.146/2009 in TRA/15/05/TM/DEL titled M/s Tarlochan Singh v. M/s Prem Flour Mills, the order dated 7th July 2011 and 12th December, 2011 of IPAB in MP Nos.04/2008 & 157/2010 in TRA/6/2005/TM/DEL titled M/s Times Publishing House Ltd. v. M/s The Financial Times Ltd.

(VI) that before IPAB, TPHL could claim a right to cross-examine the witness of FTL only on showing substantial ground and before this Court, TPHL can succeed only by establishing that the denial of cross-examination has caused prejudice to TPHL;

(VII) that TPHL filed MP No.157/2010 seeking to cross-examine as far back as in June, 2010; the proceedings before the IPAB were on 7th July, 2011 ordered to be listed for hearing on 12th December, 2011; on 12th December, 2011 though MP No.157/2010 was also listed but hearing on the merits of the proceedings started and MP No.157/2010 was not argued by TPHL and was ignored; TPHL did not contend that IPAB should not hear arguments on merits without hearing and deciding MP No.157/2010 first; even if IPAB was refusing to hear the said application, though that is not the case of TPHL, TPHL could have always come in writ petition seeking direction to IPAB to first decide the said application; the hearing of arguments on merits continued on 5th March, 2012 and 10th March, 2012 when orders were reserved ? on that date also MP No.157/2010 was not pressed; TPHL, even after the orders had been reserved, did not make any grievance that its application seeking right to cross-examine was pending; even after the order was pronounced, no grievance in this regard was made and TPHL filed its writ petition only after FTL had filed its petitions;

(VIII) TPHL has thus waived its right even if any to cross-examine and which right is capable of being waived;

(IX) reliance was placed on Manak Lal v. Dr. Prem Chand AIR 1957 SC 425 laying down that a plea of bias has to be taken at the first instance and it is argued that similarly a plea of denial of right to cross-examine also should have been taken in right earnest and having been not taken, stands waived;

(X) that the basis on which TPHL claimed right to cross-examine does not survive as on those points IPAB has held in favour of TPHL;

(XI) that the Executive of FTL who had deposed before the City Civil Court at Bangalore had left by the time the stage of evidence before IPAB was reached and hence affidavit by way of evidence of another executive was filed;

(XII) that TPHL has averred contradiction in the conclusion of IPAB with that of City Civil Court at Bangalore on four aspects i.e. (a) whether the words "Financial Times" are descriptive; (b) whether the words "Financial times" are common to newspaper trade; (c) whether the words "Financial Times" are in use by third parties in other countries; and, (d) whether FTL intends to come to India;

(XIII) that IPAB in the impugned order has held (a) the words "Financial Times" to be descriptive; (b) the words "Financial Times" to be common to trade; (c) the

words "Financial Times" being in use by third parties in other countries; and, (d) that FTL could not have entered into India till 2000 and therefore had no intention to come to India because the same would have been illegal but held "Financial Times" to be in use in India;

(XIV) that IPAB in addition held the words "Financial Times" to be well known; FTL to be a leader; "Financial Times" of FTL to have been imported into India though in limited numbers; and, FTL to be having agents in India; and "Financial Times" having acquired distinctiveness.

(XV) that if IPAB has erred in so holding, this Court would set aside the findings of IPAB and thus no purpose would be served in remanding the matter;

(XVI) that FTL has not challenged the findings of IPAB in favour of TPHL in these proceedings;

(XVII) that finally all these issues have to be decided by this Court and there is no need for cross-examination;

(XVIII) that while the City Civil Court at Bangalore was shackled by CPC and Rules of Evidence, IPAB was/is not;

(XIX) that even otherwise, the nature of evidence on the basis of which IPAB has reached the conclusion on which TPHL wants to cross-examine the witness is not such that FTL would be able to produce;

(XX) that TPHL, long before the disputes started, had a Syndication agreement with FTL and IPAB has relied on that to reach its conclusions;

(XXI) that TPHL as a licensee cannot challenge the rights of FTL as its principal; reliance was placed on Motorpresse International Verlagsgesellschaft Holding mbH & Co.(2005) 30 PTC 377 (Del);

(XXII) that goodwill and reputation gives distinctiveness;

(XXIII) that the policies of India, till the year 2000 did not permit a foreign newspaper to be established in India and thus FTL could not have any intention to come to India till then;

(XXIV) attention was invited to articles in newspaper, Times of India? of TPHL to contend that the findings of IPAB against TPHL do not call for any cross-examination of the witness of FTL;

(XXV) that TPHL is wanting remand only to delay;

(XXVI) that IPAB at several places in the impugned order notices the request of TPHL for cross-examination but holds that no cross-examination is required;

(XXVII) that now the law is settled that Trademark Law prevails over the Press Law.

13. The counsel for TPHL in rejoinder argued:

- (i) that IPAB has wrongly applied the test of distinctiveness and the same is not made out even on evidence;
- (ii) Motorpresse International Verlagsgesellschaft Holding mbH & Co. (supra) is not relevant as in that case there was a licence; moreover that case relates to copyright;
- (iii) that the argument, of TPHL having waived the right to cross-examine is misconceived as even IPAB does not hold so;
- (iv) that the TPHL in its written submissions filed before IPAB also made contentions with respect to MP No.157/2010;
- (v) that IPAB considered evidence of post the year 1993 and which was irrelevant and could not have been considered;
- (vi) that the Delhi High Court Bar Association (supra) is not against TPHL;
- (vii) that IPAB has returned findings on evidence which could not have been accepted without cross-examination;
- (viii) that IPAB has not considered the evidence of TPHL.

14. I have considered the rival contentions.

15. I am unable to accept the contention of the senior counsel for FTL, of TPHL, in spite of having filed the application therefor, having waived the right of cross-examination. From the factum of the application admittedly filed by TPHL claiming such right having remained pending till the commencement of arguments on merits in the proceedings, it cannot be presumed that TPHL had abandoned the said application. I am also unable to agree that from the conduct of TPHL of not insisting on such application being disposed of before commencing final arguments, presumption of abandonment arises. When cross-examination is not a matter of right and has to be sought and allowed, depending upon the need therefor, a Tribunal, ordinarily, to be able to assess the need for cross-examination, has to peruse nearly all the material on record and nothing strange is found in the IPAB taking up the application of TPHL claiming right of cross-examination along with the hearing on merits of the proceedings and during which hearing, IPAB, if had come to the conclusion of the need for cross-examination, would have allowed the cross-examination. Moreover, from the rejection in the impugned order of the cross-examination claimed by TPHL, it is quite evident that TPHL at no point of time gave up the said right.

16. The counsels, as would be obvious from above narrative, with reference to the facts of the case have argued on the correctness of the denial by the IPAB of opportunity to TPHL to cross-examine the witness of FTL.

17. I have thus perused the status of the affidavits by way of evidence filed before the IPAB in TRA/6/2005/TM/DEL filed by TPHL for removal of the registration of the trademark "Financial Times" in Class 16 in the name of FTL

and in which proceedings MP No.157/2010 was filed by TPHL seeking cross-examination of the witness of FTL.

18. TPHL is found to have first filed affidavit dated 6th July, 2006 of its Director Mr. D.K. Jain inter alia deposing (i) that TPHL had adopted the newspaper title "Financial Times" since the mark "Times" was a part of the name of TPHL and "Financial" was the intended subject matter of the proposed English newspaper; (ii) that TPHL in order to supplement its right to use the title "Financial Times" granted under the PRB Act and to secure registration thereof also as a trademark under the TMA, 1958 got a search done and which revealed that FTL had obtained registration of the trademark "Financial Times" in Class 16 in respect of newspapers, magazines, periodicals etc.; (iii) that the title "Financial Times" had already been granted to TPHL for the purpose of newspaper publication under the PRB Act and TPHL alone thus had a right to use it as a title of newspaper in India and the grant of registration of the same title by the Registrar of Trademarks in favour of FTL gave an instrument to FTL to interfere with TPHL's proprietary right and gave an instrument to FTL to completely destroy the publication business of TPHL; (iv) that the trademark "Financial Times" got registered by FTL has a direct reference to the character of TPHL's newspaper which is a financial newspaper and it was so admitted by the witnesses of FTL in the suit in the City Civil Court at Bangalore; (v) that it was the admitted position by FTL that the trademark "Financial Times" conveys a meaning that the newspaper carries financial news of present time and trends; (vi) that there are a number of other financial and business newspapers around the world with the name "Finance" or "Financial" being part of their title; (vii) that the mark "Financial" as well as "Times" are conjunctively or disjunctively common to the newspaper trade; (viii) that the marks "Financial" as well as "Times" are part of common titles in the newspaper businesses all over the world; (ix) that there are Financial Times (Uganda), Financial Times (Canada), Financial Times (Sri Lanka) and Financial Times (Philippines); (x) that FTL had entered into an agreement with Financial Times of Canada to mutually co-exist in Canada and withdrawn whatever objections they earlier had against the Canadian newspaper; (xi) that the Newspapers Directory titled "Benn's Media" World-143rd Edition (Vol.III) and "Benn's Media" UK-143rd Edition (Vol.I) listing the newspaper titles with the mark "Financial" or "Times" or "Financial Times" published from various countries was tendered in evidence; (xii) hence, registration of the trademark "Financial Times" could not have been granted to FTL in view of the same being highly descriptive as well as common to the newspaper trade and prohibition envisaged vide Section 9(1)(d) of the Trade & Merchandise Marks Act; (xiii) that the Registrar of Trademarks had in fact raised objection to the grant of registration of the trademark "Financial Times" in favour of FTL on the ground of lack of distinctiveness envisaged vide Section 9(1)(d); the trademark application filed by FTL in the year 1987 was on "proposed to be used" basis; in order to overcome the objection, FTL amended the application and changed the basis from "proposed to be used" to "used since 1948" the amended claim of user

since 1948 was wholly false and fraudulent; (xiv) that FTL when called upon to produce evidence of user since 1948, submitted before the Registrar of Trademarks an affidavit of Mr. David James Hall, Company Secretary of FTL and which affidavit contained gross misrepresentation of facts; the affidavit placed reliance on documents of use of trademark "Financial Times" in India which were actually not enclosed; (xv) that there was no cogent evidence before the Registrar of Trademarks of any substantial and bona fide use of the trademark "Financial Times" by FTL in India which could be considered sufficient to infer acquired distinctiveness of the trademark; (xvi) that the Registrar of Trademarks yet waived his objection and accepted the application of FTL for registration; (xvii) that upon TPHL applying for certified copy of the affidavit aforesaid and the documents filed by FTL therewith, it was informed that certified copies could not be supplied as FTL had taken back such documents on the ground that they were required to be produced before a Court; however the said documents had never been produced before any Court; (xviii) that FTL had obtained registration by committing fraud; (xix) that FTL had made a false claim of user of the trademark "Financial Times" since 1948 in India to induce Registrar of Trademarks to waive objection to registration of "Financial Times" on the ground of being a descriptive mark; (xx) that whatever evidence was produced by FTL before the Registrar of Trademarks did not establish any genuine commercial use of the trademark "Financial Times" by FTL in India prior to 1987; (xxi) that despite absence of evidence of use, the Registrar of Trademarks granted registration in complete violation of the provisions of TMA, 1958; (xxii) that the meager sale of "Financial Times" newspaper of FTL in India cannot possibly meet the requirement to constitute "use" in India; (xxiii) that any use of the trademark for the purposes of the Act has to be substantial commercial use; (xxiv) that reputation in the case of newspapers and magazines is localised and it is a common practise all over the world to use titles for newspapers and magazines which are already being used in other countries; instances of New Statesman, UK and Statesman, India, Tribune, UK and The Tribune, India, The Daily Telegraph, UK and The Telegraph, India, The Independent, UK and Independent, India and of The Sunday Times, UK and Sunday Times, India were given and front pages of the said newspapers tendered in evidence; (xxv) that the goodwill or reputation acquired by newspapers is territorial and confined to the boundaries of the country wherein the publication or circulation is carried out; (xxvi) that even the meager and negligible circulation of the newspaper "Financial Times" of FTL in India is contrary to the provisions of the PRB Act and hence cannot be relied upon; (xxvii) that the buyers cannot buy the publication off the shelf even if they want to and any sporadic or intermittent use is no use in the eyes of law; (xxviii) that having regard to the nature and character of the newspapers and to the low price at which they are normally sold, the readership normally runs into lakhs of persons and commercial use must consequently assume a different meaning for the newspaper industry; (xxix) that the test of acquired distinctiveness is extremely high in cases of an attempt to monopolise a trademark which is descriptive in nature; (xxx) that there is bar in law to the grant of registration of

descriptive trademarks and any registration granted in contravention of such bar is contrary to law and void ab-initio; (xxxi) that FTL had obtained registration of "Financial Times" as a trademark only to injunct TPHL from publishing newspaper under the same name.

19. Mr. Khozem Merchant constituted attorney of FTL is found to have filed an affidavit verified on 7th July, 2007 as "evidence in support of registration" inter alia deposing (a) that the trademark "Financial Times" was adopted by FTL's predecessor in the year 1888; a copy of the first edition of the newspaper "Financial Times" published on 13th February, 1888 in United Kingdom (UK) was tendered in evidence; (b) that on account of extensive use and worldwide recognition thereafter, FTL under the title "Financial Times" became an internationally recognised brand with unique and valuation content; (c) that as on that date, the mark "Financial Times" was exclusively associated with FTL and formed the predominant and foremost feature of FTL's corporate name; (d) that the FTL's predecessor-in-interest was the first one to use the unique combination of the two words "Financial" and "Times" by using the expression "Times" in conjunction with the expression "Financial"; (e) that all the publications of FTL Group bear the trademark "Financial Times" and/or "FT" on them in addition to the title of the magazine to indicate that these are hosted, printed, published and circulated by the Financial Times Group; copies of some of the said publications were tendered in evidence; (f) that all the said magazines are circulated in India and are widely available in book shops, libraries etc.; (g) that though the FTL's newspaper "Financial Times" was initially published from London, on account of increasing dissemination, recognition and circulation outside UK, printing and publishing thereof was commenced in other countries also and as of then there were 23 printing and publishing centres of FTL around the world; (h) that FTL's "Financial Times" newspaper is read in nearly all countries of the world and is classified in the newspaper industry as an international financial newspaper with a very significant international reputation; (i) that in addition to news, FTL's newspaper "Financial Times" carries advertisements published by multinational organization, most of them known worldwide; (j) that FTL also has an online newspaper which can be accessed by readers through FTL's website www.ft.com and the said website also liberally displays the trademark "Financial Times" and "FT"; (k) that the trademark "Financial Times" is registered in many countries of the world covering a number of classes and wide range of goods and services; a list thereof was tendered in evidence; (l) that FTL also advertised in leading print media as well as through electronic and audio-visual media; (m) that owing to long-standing and extensive global use and registration for the trademark "Financial Times", the same had acquired significant goodwill and reputation which had transcended all geographical borders; (n) that FTL's newspaper "Financial Times" was named the "World's Best Newspaper" in 2005; (o) that FTL has used the trademark "Financial Times" in India since the year 1948 in respect of newspaper and since 1977 in respect of printed matter, periodicals, publications and books; (p) that FTL has since the year 1948 exported the

newspaper "Financial Times" to India and distributed the same through several distributors; (q) that from 1948 to 1985, Central News Agency, New Delhi was the distributor of FTL's "Financial Times" newspaper; extract from the Register of Export Details pertaining to the years 1955-1959 was tendered in evidence; in 1985, FTL appointed Mr. D. Mirchandani of Mirchandani & Co. Ltd., Mumbai as its All India Distributor for distribution and sale of FTL's newspaper "Financial Times" in India; (r) subsequently, FTL appointed Mediascope Bookhouse, Mumbai as its Indian distributor; (s) copies of shipping documents, invoices, remittance advises etc. evidencing supply of the newspaper "Financial Times" to the distributors by companies of FTL Group and remittances made therefor were tendered in evidence; (t) that in addition, FTL was selling and supplying its newspaper "Financial Times" and other products and services directly to subscribers in India; (u) that FTL's "Financial Times" newspaper enjoys immense popularity amongst subscribers in India; (v) that FTL's "Financial Times" newspaper was also subscribed by various business houses and governmental organisations such as Reserve Bank of India (RBI); (w) that upon the Registrar of Trademarks raising objection under Section 9(1) of the TMA, 1958 to the application of FTL for registration of the trademark "Financial Times" in Class 16, FTL furnished the user information on Form TM-16 supported by a statutory declaration of Mr. David James Hall along with Exhibits and written arguments to overcome the objection raised by the Registrar; (x) an affidavit dated 21st January, 1993 of Mr. David James Hall was also filed with the Trade Marks Registry and copy thereof with annexure thereto was tendered in evidence; (y) that FTL is not obliged to preserve accounting records for more than six years as per the extant companies legislation in UK and hence was not able to adduce documents substantiating the actual use of the trademark "Financial Times" since the year 1948 and 1977 by way of invoices, vouchers, vendor invoices etc.; (z) for the same reasons such documents could not be procured from entities/individuals in India as (Indian) Laws also do not mandate preservation of documents beyond a certain time; (za) in any case the Trade Marks Registry does not call for documents going back to the date of first use claimed in the application for registration of trademark but accepts illustrative documents demonstrating use primarily on account of there being no legal requirement to preserve documents beyond a certain period of time; (zb) that on the strength of the documents/written submissions of FTL, the Trade Marks Registry accepted FTL's application and advertised the same; no opposition was filed thereto; (zc) FTL has published several surveys and reports on a number of issues having global economic significance; copies of some of such surveys and reports dating back to the year 1963 were tendered in evidence; (zd) copies of few letters of appreciation received from subscribers of the "Financial Times" "India Survey" were also tendered in evidence; (ze) newspapers and other media companies enter into Syndication Arrangements with each other thereby permitting the other company to carry news, reports, analysis, articles and other content; the existence of a Syndication Arrangement is recognition of generally high reputation, merit and standing enjoyed by the grantor newspaper; (zf) having

regard to the goodwill and reputation of FTL's "Financial Times", several newspapers across the globe approached FTL for grant of Syndication rights and list of examples of Syndication Arrangements entered into by FTL was tendered in evidence; (zg) that an affiliate of TPHL namely Bennett Coleman & Co. Ltd. had also entered into Syndication Arrangement with FTL on 1st April, 1991 but on account of breach by Bennett Coleman & Co. Ltd., the said Syndication Arrangement was terminated by FTL vide its letter dated 11th February, 1994; copy of the said Syndication Arrangement dated 1st April, 1991 along with correspondence exchanged was tendered in evidence; (zh) advertisements of "Financial Times" newspaper of FTL in Indian newspapers including "Times of India" published by Bennett Coleman & Co. Ltd. were tendered in evidence; (zi) that in or about the year 1992 there were also proposals exchanged between Bennett Coleman & Co. Ltd. and FTL of a possible business tie-up though the same did not materialize; copies of the said correspondence were tendered in evidence; (zj) that in the newspaper industry FTL's newspaper under the title "Financial Times" has acquired statutory and common law rights to the exclusive use of the trademark "Financial Times"; (zk) that customers, advertisers and distributors and other members of the trade and public recognised "Financial Times" as distinctive of the business of FTL; (zl) TPHL in spite of being aware of the proposed tie-up and Syndication Arrangement between its affiliate Bennett Coleman & Co. Ltd. and FTL deliberately adopted identical trademark "Financial Times" with a view to grab the intellectual property of "Financial Times"; and, (zm) that TPHL on the one hand was contending that the trademark "Financial Times" is generic and cannot be registered but on the other hand sought registration thereof in its own name.

20. TPHL is found to have also filed rejoinder affidavit by way of evidence of one Mr. K.C. Jain who has deposed (i) that he was a witness on behalf of TPHL before the City Civil Court, Bangalore; (ii) that while the witnesses of FTL before the City Civil Court, Bangalore had deposed otherwise, Mr. Khozem Merchant of FTL in his affidavit by way of evidence before IPAB had deposed that the mark "Financial Times" is a distinctive mark; (iii) that similarly though the witnesses of FTL before the City Civil Court, Bangalore had deposed that the marks "Financial" as well as "Times" are common to the newspaper trade, Mr. Khozem Merchant in his affidavit by way of evidence before the IPAB had deposed that the marks "Financial" and "Times" are not common to the newspaper trade; (iv) that reliance in the affidavit by way of evidence on behalf of FTL upon publication or their circulation in other countries was misconceived and irrelevant for the purposes of any use or distinctiveness in India; (v) the depositions of the witnesses of FTL before the City Civil Court, Bangalore were tendered in evidence and the contradictions between them and the affidavit by way of evidence of Mr. Khozem Merchant of FTL filed before IPAB were pointed out; (vi) while Mr. Khozem Merchant had denied that there were no newspapers under the title "Financial Times" in Uganda, Canada, Sri Lanka and Philippines but the witnesses of FTL before the City Civil Court, Bangalore had admitted the same; (vii) the

capacity of Mr. Khozem Merchant of FTL to prove the documents tendered by him in evidence along with his affidavit was controverted and FTL was put to strict proof of all the statements in the said affidavit; (viii) that it was an admitted fact that FTL was not publishing the newspaper "Financial Times" outside UK till as late as 1995 whereas TPHL had obtained approval from the Registrar of Newspapers in India for publication of the newspapers titled "Financial Times" in the year 1984 itself; (ix) online publication is a recent phenomena and hence irrelevant; (x) that the credit given to the newspaper "Financial Times" of FTL for the news published in newspapers in India is a mere acknowledgment of the source from where the article had been taken and which is a copyright requirement and does not amount to use of the trademark "Financial Times" in India; (xi) it was denied that the "Financial Times" newspaper of FTL was exported to India since 1948 and distributed in India and Mr. Khozem Merchant of FTL in any case being not personally aware of the said fact is not in a position to prove the same; (xii) Mr. Khozem Merchant in his affidavit by way of evidence on behalf of FTL had not proved any document establishing the correct number of copies of its newspaper "Financial Times" actually circulated in India; (xiii) some of the documents tendered in evidence before the IPAB along with the affidavit by way of evidence of Mr. Khozem Merchant had been tendered by FTL before the City Civil Court, Bangalore also and had been either not admitted into evidence for having not been proved or were found to be grossly insufficient to establish any significant use of the trademark "Financial Times" of FTL in India; (xiv) FTL had not produced any evidence whatsoever of use of the trademark "Financial Times" in India for the period 1981-87 preceding the filing of the application in the year 1987; (xv) that there is no justification for FTL not to retain the documents for the period 1981-87 if they existed; (xvi) TPHL did not oppose the application of FTL for registration as it escaped its attention; (xvii) copies of the surveys pertaining to India tendered in evidence by Mr. Khozem Merchant of FTL were of subsequent to the date of institution of the cancellation petition and hence irrelevant; (xviii) that the averments in the affidavit of Mr. Khozem Merchant of FTL of Syndication Arrangements between Bennett Coleman & Co. Ltd. and FTL do not support any proprietary right/claim of FTL to the trademark "Financial Times" in India; (xix) it was denied that any advertisements of "Financial Times" newspaper of FTL appeared in the Indian newspapers and even if they appeared, they were so sporadic so as to go unnoticed; (xx) Mr. David James Hall of FTL when cross-examined before the City Civil Court, Bangalore admitted that advertisements were inserted and published subsequent to the filing of the suit; (xxi) no reliance was placed by the City Civil Court, Bangalore on the said documents produced before that Court also; (xxii) the discussion of business arrangement between FTL and Bennett Coleman & Co. Ltd. did not involve TPHL and have no bearing on TPHL's business and use of the trademark "Financial Times" in India; even otherwise, the said discussions are stated to be of the year 1992 whereas the trademark "Financial Times" had been adopted by TPHL much prior thereto in 1984; (xxiii) FTL's trademark "Financial Times" is not a well-known trademark; (xxiv) the right of TPHL to use the

trademark "Financial Times" in relation to newspapers in India has been upheld by the City Civil Court, Bangalore by dismissing the suit filed by FTL; (xxv) that the entire evidence by way of affidavit filed by Mr. Khozem Merchant is liable to be rejected for lacking veracity and containing false and fraudulent depositions; (xxvi) TPHL being holder of registration of the mark "Financial Times" under the PRB Act, was entitled to apply for registration of the same under the TMA; and, (xxvii) there are no contradictions in the stand of TPHL.

21. TPHL, in MP 157/2010, sought cross-examination of Mr. Khozem Merchant who had filed affidavit by way of evidence on behalf of FTL before IPAB, pleading, (i) that the deposition of Mr. Khozem Merchant was contrary to the depositions of witnesses of FTL before the City Civil Court, Bangalore; (ii) Mr. Khozem Merchant had made palpably false statements on oath; that while witnesses of FTL in cross-examination before the City Civil Court, Bangalore had admitted that the marks "Financial" as well as "Times" are common to newspaper trade, Mr. Khozem Merchant had denied the same; (iii) that while witnesses of FTL before the City Civil Court, Bangalore had deposed that the newspaper titles have regional identification, Mr. Khozem Merchant had denied the same; (iv) Mr. Khozem Merchant had falsely denied that there were no newspapers under the title "Financial Times" in Uganda, Sri Lanka, Canada and Philippines; Mr. Khozem Merchant had falsely denied FTL did not have any agreement with "Financial Times" Canada when FTL's witness before the City Civil Court, Bangalore had admitted the same; (v) that while the witnesses of FTL before the City Civil Court, Bangalore had deposed that "Financial Times" is a descriptive mark, Mr. Khozem Merchant had deposed that "Financial Times" was a distinctive mark; in the light of the said contradictions depositions of Mr. Khozem Merchant was liable to be rejected; (vi) that the case of TPHL revolved around the depositions of FTL's witnesses before the City Civil Court, Bangalore and which Court has decided the suit in favour of TPHL; and, (vii) Mr. Khozem Merchant had with his affidavit by way of evidence produced voluminous documents running into thousands of pages and his cross-examination was also necessary to scrutinise the said documents.

22. Thus, the fulcrum of the demand of TPHL to cross-examine the witness of FTL is the contradiction in the testimonies of witnesses of FTL before the City Civil Court, Bangalore and before the IPAB. However, rather than examining the testimonies of witnesses of FTL before City Civil Court, Bangalore, I have proceeded to see the appreciation of evidence before it by the City Civil Court, Bangalore and the IPAB.

23. The reasons, which inter alia prevailed with the City Civil Court, Bangalore to, after trial, dismiss the suit of FTL, were as under:

(i) FTL had proved that it was the registered proprietor of the trademark "Financial Times" and it was not in the domain of the Civil Court and was in the domain of the rectification proceedings, whether the said registration was wrongly remaining on the register and was liable to be rectified;

- (ii) that the claim of FTL in the suit was that it has started exporting its newspaper "Financial Times" to India from the year 1948 and it had appointed its distributor in India in the year 1986;
- (iii) that from the evidence led by FTL, it emerged that FTL, on an average exported 500 copies per issue of newspaper "Financial Times" to India from 1986 onwards although the number of copies actually sold in India was around 300 copies per issue and the rest were returned as unsold;
- (iv) that sale of 300 copies per issue in a country like India having population of 1000 millions could not be construed to establish the goodwill and reputation of FTL's newspaper "Financial Times" in India;
- (v) that FTL had proved that it had established goodwill and reputation of its trademark in European countries but what was required in an action for passing off in India, was the establishment of goodwill and reputation of FTL's newspaper "Financial Times" in India and which FTL had failed to establish;
- (vi) that the witness of FTL acknowledged that there were number of business and financial newspapers with the word "Finance" or "Financial" being part of their title;
- (vii) that another witness of FTL admitted that the words "Financial" and "Times" are common words found in title of newspapers;
- (viii) that FTL's witness had also acknowledged of the newspaper "Financial Times" being circulated in Uganda, Sri Lanka, Canada and Philippines and which was not the publications of FTL;
- (ix) that from the evidence on record, it was concluded that commonality of newspaper titles is in vogue in newspaper industry, the words "Finance" and "Times", whether used disjunctively or conjunctively, are common titles in newspaper business, there was no dispute that the words "Finance" and "Times" are descriptive;
- (x) that the argument of FTL that the words "Finance" and "Times" read conjunctively was not descriptive and qualifies for distinctiveness could not be accepted and the mark "Financial Times" had not acquired distinctiveness so as to be associated with FTL exclusively in India;
- (xi) that FTL, from the evidence had failed to establish that the use of identical title by FTL and TPHL for their respective newspaper caused confusion or deception;
- (xii) that use of common title in newspaper industry had been recognised by the English Courts also;
- (xiii) that FTL had failed to establish that the mark "Financial Times" had acquired goodwill and reputation in India;
- (xiv) that FTL was thus not entitled to injunctive relief against TPHL in an action

for passing off;

(xv) that FTL was also not entitled to injunctive relief against TPHL on the basis of infringement of its registered trademark, as grant of injunctive relief was in the discretion of the Court and while TPHL had registration under PRB Act, which regulates newspaper in India, FTL had none; thus even though FTL was having registration under the TMA but was not entitled to injunctive relief;

(xvi) that FTL had not led any cogent evidence of damage or possible damage suffered from the action of infringement by TPHL;

(xvii) that newspapers have a regional identification and there is prevalence of common titles in the newspaper industry.

24. In comparison to the findings aforesaid of the City Civil Court, Bangalore and which were before the IPAB, IPAB in the impugned order:

(A) for allowing TRA/6/2005/TM/DEL inter alia held a) that there was no merit in the contention of TPHL of the registration in Class 16 of the mark "Financial Times" in favour of FTL being bad for the reason of being in violation of the PRB Act; b) that TPHL, independently of the findings of the Civil Court, was required to address the issue of validity of the registration of the mark "Financial Times" in the name of FTL; c) that FTL on the basis of evidence led had proved its trans-border reputation and its intention to enter India and that the mark "Financial Times" had become distinctive of FTL; and, d) however FTL on the basis of evidence led had failed to prove user of the mark "Financial Times" from the year 1948 as claimed at the time of obtaining the registration and hence the registration was bad.

(B) for allowing ORA/112/2006/TM/DEL inter alia held that TPHL being in the same business as FTL knew about the existence of "Financial Times" of FTL and its circulation in India and the adoption of TPHL of the mark "Financial Times" thus did not warrant the continuance of the registration of the mark "Financial Times" in favour of TPHL and TPHL had circulated "Financial Times" as a complimentary copy along with Economic Times and the circulation figures could be a matter of celebration for Economic Times as a mark but not for Financial Times.

(C) for allowing ORA/64/2007/TM/DEL inter alia observed that both the counsels had stated that the result of other applications would follow the decision in TRA/6/2005/TM/DEL and no evidence of user for "Financial Time" in Class 9 had been produced and thus the FTL's mark "Financial Times" in Class 9 did not merit survival on the register.

(D) for dismissing ORA/67/2007/TM/DEL inter alia reasoned that the registration of the mark "FT" sought was on the proposed to be used basis and in the light of the evidence filed by FTL, it could not be denied that the reading public in India especially those who read financial news and magazines were aware of the reputation of FTL and the association of the mark "FT" with FTL and that FTL had

proved reputation of the mark "FT" in India.

25. There indeed appears to be a dichotomy in the conclusions drawn by the City Civil Court, Bangalore and IPAB. While City Civil Court, Bangalore held sale of 300 copies per issue of "Financial Times" of FTL to be not establishing goodwill and reputation of FTL's newspaper "Financial Times" in India, IPAB held FTL to have by evidence established its transborder reputation. Similarly, while City Civil Court, Bangalore held that the mark "Financial Times" had not acquired distinctiveness so as to be associated with FTL exclusively in India, IPAB held the mark "Financial Times" had become distinctive of FTL. Thus the application of TPHL to cross-examine witness of FTL before IPAB. TPHL thinks, given the opportunity to cross-examine, it will perhaps make the said witness also sing its tune or demonstrate from his cross-examination that no inference as drawn by IPAB from his evidence by way of affidavit can be so drawn.

26. I have however wondered whether the mere existence of parallel proceedings before Civil Court makes it incumbent on IPAB to accede to the request for cross-examination whenever made. I may in this regard notice that as per my experience at the Bench, in most of the cases before IPAB, there are parallel proceedings in the Civil Court. If this were to be the ground for allowing cross-examination, it would indeed frustrate (i) Section 92 of the TMA laying down that the IPAB shall not be bound by the procedure laid down by CPC and shall have power to regulate its own procedure; (ii) Section 93 of the TMA barring the jurisdiction of the Courts in matters with respect where to jurisdiction has been conferred in the IPAB; (iii) Section 100 of TMA providing for transfer of all proceedings for rectification of Register pending in the High Courts to the IPAB, and convert the IPAB from a Tribunal to a Civil Court and the proceedings before IPAB into civil proceeding and frustrate the purpose of speedy disposal of cases with which IPAB was established. IPAB has been constituted, vide Section 91 of TMA, to adjudicate appeals against the order or decision of Registrar of Trade Marks. Per Section 129 of TMA, evidence before the Registrar is to be given by affidavits though the Registrar, if he thinks fit, has been empowered to take oral evidence in lieu of or in addition to evidence by affidavit. The procedure, in the matter of taking evidence, to be followed by IPAB as an appellate authority cannot be different from that before Registrar against whose orders and decisions it is to hear appeals. Also, the power of rectification of Register is concurrent, i.e. exercisable both by the Registrar and the IPAB and the procedure, in the matter of taking evidence, before the two cannot be different. Moreover, it is not as if the conclusion drawn by City Civil Court, Bangalore from the evidence before it have attained finality. Just like the conclusions drawn by IPAB from the evidence before it are at large in these proceedings (as contended by senior counsel for FTL also), similarly the conclusions drawn by City Civil Court, Bangalore from evidence before it are subject matter of appeal there against, in which the said evidence is to be appreciated and on appreciation of evidence it will be adjudicated whether the inferences drawn by City Civil Court, Bangalore and IPAB from the evidence respectively before them, are justified.

27. I have however wondered the parameters of appreciation of evidence by way of affidavits.

28. It is the settled position in law (Indian Evidence Act, 1872) that affidavits are not evidence within the meaning of Section 3 of the Evidence Act. Supreme Court in *Sudha Devi v. M.P. Narayanan* (1988) 3 SCC 366 held that affidavits are not included in the definition of "evidence" in Section 3 of the Evidence Act and can be used as evidence only if for sufficient reason, court passes an order under Order XIX Rule 1 or 2 of the Code of Civil Procedure, 1908. Similarly, in *Ayaubkhan Noorkhan Pathan v. State of Maharashtra* (2013) 4 SCC 465 it was held that affidavit is not evidence and can be used as evidence only if for sufficient reasons the Court passes an order under Order XIX of the CPC and the filing of an affidavit of one's own statement in one's own favour, cannot be regarded as sufficient evidence for any Court or Tribunal on the basis of which it can come to a conclusion as regards a particular fact situation. With reference to the proceedings under the Industrial Disputes Act, 1947, Section 11 whereof is *pari materia* to Section 92 of the TMA, it was reiterated that the application of principles of natural justice does not imply that what is not evidence can be acted upon and it was explained that what it means is that no material can be relied upon to establish a contested facts which are not spoken to by the persons who are competent to speak about them and are subjected to cross-examination by the party against whom they are sought to be used. *Needle Industries (India) Ltd. v. Needle Industries Newey (India) Holding Ltd.* (1981) 3 SCC 333 where in the context of proceedings under the Companies Act, 1956, it was held that it is generally unsatisfactory to record a finding involving a grave consequence to a person on the basis of affidavits and documents alone without asking for person to submit to cross-examination was reiterated and it was held that the conduct of the parties in showing their willingness to get the situation determined on the basis of affidavits was relevant. It was further laid down that in a case where deponent is available for cross-examination and an opportunity is given to cross-examine him, the affidavit may be relied upon. Mention may also be made of *Standard Chartered Bank v. Andhra Bank Financial Services Ltd.* (2006) 6 SCC 94 where in the context of a proceeding under the Special Court (Trial of Offences Relating to Transactions in Securities) Act, 1992, it was observed that the affidavit has no meaning, as the deponent thereof refused to submit himself to cross-examination and the evidence given in the affidavit was not tested by cross-examination.

29. However the legislature by law, i.e. the TMA, has mandated evidence in the proceeding under the said Act, before the Registrar and IPAB, to be by affidavit. Supreme Court in *Delhi High Court Bar Association* supra cited by the senior counsel for FTL, while setting aside the judgment of the Division Bench of this Court holding *The Recovery of Debts Due to Banks and Financial Institutions Act, 1993* to be unconstitutional, held that to expedite the disposal of claims of Banks, the Parliament thought it proper only to require the principles of natural justice to be the guiding factor for the Tribunals and that it was not mandatory

for witnesses to be examined and that there is no absolute right in anyone to demand that his dispute is to be adjudicated upon only by a Civil Court (and I may add, by following the procedure thereof). I may in this regard also notice that per Section 1 of the Evidence Act, the applicability thereof extends to all judicial proceedings in or before any "Court" but not to the affidavits presented to any Court or officer nor to proceedings before an Arbitrator. Supreme Court, as far back as in *Union of India v. T.R. Varma*, AIR 1957 SC 882 held that Evidence Act has no application to enquiries conducted by Tribunals, even though they may be judicial in character.

30. I have thus wondered that if that is the position in law, what weightage is to be given to evidence by affidavit and what are to be the parameters of appreciation of such evidence i.e. (i) whether whatsoever is deposed in such affidavit, is to be treated as gospel truth; (ii) that if not, if the opposite party has sought right to cross-examine and the same has been opposed, whether adverse inference has to be drawn and resultantly evidence by affidavit ignored; (iii) that if the opposite party, though has not sought opportunity of cross-examination but has also led diametrically opposite evidence by affidavit, which of the two affidavits is to be preferred and believed.

31. To gauge the answers to the aforesaid questions, I have seen the provisions of the TMA to find out the nature of the proceedings before the Registrar for which Section 129 has provided for evidence to be given by affidavit, unless the Registrar thinks fit to take oral evidence and which procedure, I have herein above held, to be applicable to IPAB also.

32. The Registrar (a) vide Section 21 of the TMA has been empowered to adjudicate the objections to registration of a trademark and vide Section 23 has been empowered to register the trademark; (b) vide Section 25 has been empowered to remove registration of trademark; (c) vide Section 45 has been empowered to register assignment and transmission of trademarks; (d) vide Section 47 has been empowered to remove the trademark from the register for non-user; (e) vide Section 50 has been empowered to vary or cancel the registration; (f) vide Sections 57 to 59 has been empowered to cancel or vary the registration on the ground of contravention or failure to observe a condition entered on the register in relation thereto or on the ground of the mark wrongly remaining on the register or by any error or defect in any entry in the register. The nature of the proceeding before the Registrar/Tribunal is thus inquisitorial, i.e. of an "enquiry", though such enquiry may at times be adversarial in nature.

33. An examination into the nature of the enquiry which the Registrar is required to conduct in discharge of the aforesaid powers shows the Registrar being required to (i) under Section 9 decide whether the mark proposed to be registered is devoid of any distinctive character or whether the mark merely designates the kind, quality, quantity, intended purpose or value or geographical origin of the goods or services with respect to which its registration is sought or whether the mark has become customary in the practise of the trade or whether

the mark is likely to deceive the public or cause confusion or is likely to hurt the religious susceptibilities or contains scandalous or obscene matter or is prohibited or consists merely of the shape of goods with respect where to it is to be used; (ii) under Section 11 decide the similarity if any of the mark to earlier trademark registered with respect to the said goods or whether registration thereof would amount to passing off the goods of another or infringe the copyright of another and whether the mark has been used as claimed; (iii) under Section 12 decide whether the mark has been honestly and concurrently used; (iv) under Section 13, decide whether the mark is a commonly used and accepted name of any chemical element or compound or has been declared as an international nonproprietary name; (v) under Section 14, decide whether the mark falsely suggests a connection with any living person; (vi) under Section 47, whether the mark is required to be removed from Register for the reason of non-use; (vii) under Section 50, whether registration was sought by misrepresentation; and, (viii) under Section 57, whether the conditions of registration have been contravened etc.

34. It would thus be seen that the enquiry, in exercise of all the powers which the Registrar is required to exercise is, whether the mark satisfies the conditions laid down in the TMA of registration. However the proceedings before the Registrar have been held in *Intellectual Property Attorneys Association v. Union of India* (DB) 2014 SCC Online Del 1912 and earlier in *Radha Kishan Khandelwal v. The Assistant Registrar of Trade Marks* AIR 1969 Del 324 to be quasi-judicial and/or adjudicatory and not administrative.

35. An analysis of the conditions prescribed in the TMA of registration would show that evidence, on the anvil of which adjudication, whether the conditions of registration having been satisfied or not depends, has to be mostly documentary and appreciation thereof by the Registrar. I am unable to fathom any situation in which the decision of the Registrar, whether conditions prescribed in the TMA for registration are satisfied or not, would depend on oral testimony and appreciation/evaluation thereof. It appears to be for this reason that the Legislature has provided for evidence to be taken by way of affidavit, for the limited nature of enquiry which the Registrar is required to conduct. Though the evidence would be documentary as aforesaid but the said documents are required to be proved by affidavit, to bind the party producing the documents to genuineness and authenticity thereof.

36. The need to further empower the Registrar to, if he thinks fit, take oral evidence in lieu of or in addition to evidence by affidavit appears to have been felt to provide for the contingency, where a doubt having relevance to adjudication arises with respect to authenticity or genuineness of the document or on some other matter.

37. The next question which arises is, as to how the affidavit evidence is to be appreciated, whether whatever is stated in the affidavit is to be believed.

38. In my opinion, no. The evidence by affidavit does not compel the Registrar to, even in the absence of a request for cross-examination, believe all that is stated therein. It would still be open to the Registrar to adjudge the truthfulness thereof, including on the parameter, whether the deponent was in the position of deposing about the genuineness and authenticity of the document and/or the fact deposed and the weightage to be given thereto in the light of the remaining evidence of that party and the evidence led by the other party and if a request for cross-examination has been made, the willingness of the party to produce the witness for cross-examination. Reference may be made to *Gograj v. State of U.P.* (1971) 27 Fact LR 248 where the Supreme Court observed that if the appellant desired to challenge the averments made in the affidavit of the opponent, he should have filed an affidavit in reply and then the High Court could have considered the matter on affidavits or evidence viva voce, if the High Court thought that evidence viva voce should be ordered to be recorded in the case and on the basis of the facts sworn on the affidavit before it held that it could not be held that the evidence was not sufficient to justify the findings recorded by the High Court.

39. Mention may also be made to *Debi Prasad Jalan v. The State of Uttar Pradesh* 1970 RCJ 839 where the High Court of Allahabad held that affidavit evidence can be controverted even by documents, without even filing a counter affidavit. Reference may further be made to the judgment of this Court in *Gursharan Kaur v. H.B. Singh* 78 (1999) DLT 333 holding that even in proceedings before the Civil Court, in situations where affidavit evidence can be taken, viz. for passing interim orders, the proposition that wherever cross-examination is sought, it should be allowed in an ordinary course as affidavit may not be sufficient to form a basis of final decision, cannot be accepted as if such a proposition was accepted it would require cross-examination for disposal of each and every application in a proceeding and which is not possible. It was held that in proceedings which are essentially summary, even though power to allow cross-examination of the affidavit witness exists, it has to be used very sparingly, where after reading the affidavit and documents on record, no conclusion could be arrived at. It was held that allowing cross-examination at each and every stage of the proceedings where the Court is permitted to act on affidavit evidence would frustrate the proceedings.

40. I am unable to accept the contention of the counsel for TPHL that, the IPAB being required to observe the principles of natural justice, the said principles make it mandatory to allow cross-examination. If it were to be held so, it would defeat the provision in the same legislation requiring the evidence to be by affidavit and leaving discretion to require viva-voce evidence (i.e. cross-examination) in the Registrar/IPAB. A Division Bench of this Court in *J&K Cigarettes Ltd. v. Collector of Central Excise* held that though it cannot be denied that right of cross-examination in any quasi-judicial proceeding is a valuable right given to the accused/noticee as the proceedings may have adverse consequences to the accused, at the same time under certain circumstances the

right of cross-examination can be taken away by Parliament. Reference may also be made to *State Bank of Patiala v. S. K. Sharma* (1996) 3 SCC 364 holding that it would not be correct to say that for every violation of a facet of natural justice or of a rule incorporating such facet, the order passed is void and that justice means justice between both parties ? interests of justice equally demands that technicalities do not occasion failure of justice and are not allowed to defeat ends of justice. It was further held that principles of natural justice cannot be perverted to achieve the very opposite and that would be a counter-productive exercise.

41. There is another reason for which I am of the view that the power vested in the Registrar and IPAB to allow cross-examination in such matters is to be sparingly exercised. The enquiry before them, in the matter of grant/refusal of registration or cancellation of registration is more in the nature of formation of opinion (and which in turn is more in the nature of "perception" on well defined parameters which have been developed over the years) on the basis of the trade mark and other documentary material on record. Even in actions for infringement and passing off where there clearly is a lis between adversaries, the evidence of witnesses generally plays a subordinate role in the court's final determination. For the test of "deceptive similarity" the courts are never swayed by and do not surrender or yield to the testimony of witnesses and which are but an opinion. The testimonies of witnesses in such cases merely provide information which the courts use to form their own opinion. Supreme Court, in *Mahendra & Mahendra Paper Mills Ltd. v. Mahindra & Mahindra Ltd.* (2002) 2 SCC 147 followed by Division Bench of this Court in *Larsen & Toubro Ltd. v. Lachmi Narain Trades* (2008) 149 DLT 46 and by me recently in *Staar Surgical Company v. Polymer Technologies International* (to dismiss a suit in limine) held that whether there is a likelihood of deception or confusion arising, is a matter for decision by the Court and no witness is entitled to say whether the mark is likely to deceive or cause confusion. This position which obtains in infringement/passing off proceedings, must equally apply to proceedings before Registrar/IPAB including in formation of opinion of "descriptive", "distinctive" and "reputation". The cross-examination of deponents of affidavit evidence thus does not serve much purpose in such proceedings.

42. I add, affidavits can be evidence only of facts stated therein and which the deponent is competent to depose of and not of inferences drawn or opinions formed and expressed or submissions recorded/made therein ? all such contents even if contained in affidavit evidence are to be disregarded and ignored, being inadmissible in evidence. Axiomatically, opportunity sought to cross-examine the deponent of the affidavit on such contents of affidavit which do not constitute evidence, is to be declined. Opportunities sought to cross-examine are mostly found to be falling in this category, not realising that by subjecting the deponent of affidavit evidence to cross-examination, opportunity to prove what was not proved in affidavit is being given. Opportunities sought to cross-examine deponent of affidavit evidence on the erroneous premise that all that is contained

in affidavit is evidence which will be used against the party seeking to cross-examine have to be declined. Even Order 18, Rule 4 introduced in CPC in the year 2002 permitting examination-in-chief to be by affidavit provides that the proof and admissibility of documents sought to be proved thereby "shall be subject to the orders of the court". It is thus not as if in the absence of cross-examination the entire affidavit will be read in evidence. Only that part of it which constitutes evidence for the subject matter of enquiry will be read as evidence.

43. If we see the findings returned by the City Civil Court, Bangalore and the findings returned by the IPAB in the aforesaid light, what is found is that while the evidence before the two was the same, the differences is on account of appreciation by the two of the same evidence and inferences drawn by the two from the same evidence.

44. The same is also not a strange phenomenon. It is often on difference in appreciation of evidence that the judgments of the Civil Court are reversed in appeal. Cases are also not unknown of, on nearly the same facts and evidence two different courts not reaching the same conclusion. The said difference however cannot constitute a ground for allowing cross-examination as is sought by TPHL.

45. I however refrain from making any further observations in this respect as counsels are yet to be heard on the merits of the petitions. Suffice it is to state that I, on a perusal of the affidavits by way of evidence led by both FTL and TPHL before the IPAB, am not able to find any error in the order of IPAB disallowing cross-examination sought by TPHL.

46. I have for this reason only i.e. to avoid making any observations qua the evidence on merits, set out the contents of the affidavits in detail herein above. It will be open to the counsels at the time of hearing to make their submissions as to which part of the affidavits constitute evidence and which do not, as herein above observed.

47. Qua the query made by me during the hearing and as recorded herein above, with respect to the practise and procedure followed by the High Courts when the proceedings for rectification/cancellation of Register were filed before them, need to say anything further is not felt in the light of Section 100 of the TMA which while providing for the transfer of pending proceedings confers discretion in the IPAB to proceed with the matter either de novo or from the stage it was so transferred. Once IPAB was empowered to proceed with the transferred matter de novo, the procedure prescribed before the IPAB would apply.

48. Before parting with the subject, I may also state that this Court is exercising supervisory jurisdiction over the order/decision of IPAB and the parameters of exercise of which jurisdiction are materially different from the parameters of appellate jurisdiction. For this reason also, in the light of what I have held herein above, the scope of interference in the order of IPAB allowing or disallowing

cross-examination, especially when it is made along with the final order would be very limited, confined may be to situations where this Court finds itself, on the evidence on record before the IPAB, to return any finding and requires further information to be elucidated from the witness.

49. I thus hold that there is no merit in the challenge by TPHL to the order dated 4th April, 2012 of IPAB to the extent it dismisses MP No.157/2010 filed by TPHL in TRA/6/2005/TM/DEL.