

**IN THE HIGH COURT OF SINDH, KARACHI**

M.A.No.64 of 2017

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Aman Ellahi

v/s.

The Registrar of Trade Marks and another

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***Before: Justice Mrs. Ashraf Jahan.***

Appellant : Through Khwaja Shoaib Mansoor,  
Advocate

Respondent No.1 : Through Mr. Sultan Ahmed Sheikh,  
Advocate

Respondent No.2 : Through M/s. Moeen Qamar and  
Zia-ul-Haq Makhdoom, Advocates

Date of Hearing : 27.11.2017

Date of Order : 12.01.2018

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**ORDER**

**Mrs. Ashraf Jahan, J.:-** The Appellant by way of present appeal under section 114 of the Trade Mark Ordinance, 2001 (hereinafter referred to as (“**the Ordinance, 2001**”)) has challenged the order dated 20.09.2017 passed by Respondent No.1, the Registrar of Trade Marks, Trade Marks Registry, Karachi.

2. The facts leading to the present appeal as per case of the Appellant are that they are proprietor of “Moonlite Trading Company”, (hereinafter referred to as (“**the Appellant Company**”)), which is a merchant, importer and marketer of self-designed consumer goods and other items. Since last several

decades the Appellant Company is carrying the business of merchant and import of consumer goods including lotions, toiletries, perfumes, deodorants, air-fresheners, diapers and insecticides in Pakistan. The products imported by the Appellant Company are being marketed and sold under various Trade Marks, which include Cobra, Lotion Cobra, Soft Touch, Ku Ku, Lotion Saffire, Mascot, etc. They have also developed distinctive designs, logos or artwork for use in connection with the aforesaid brands including Appellant's current and long standing Trade Mark "COBRA". Therefore, in its pursuance, the Appellant Company obtained registration of the Trade Mark "COBRA" under Registration No.99323 in international class 05 since 11.08.1988 under the Ordinance, 2001, which registration is valid and intact for all intents and purposes till today. In order to further strengthen its proprietorship, the Appellant either directly or through their company has also secured copyright registration under the Copyright Ordinance, 1962. The Appellant's product bearing "COBRA" has been and continued to be sold and promoted extensively throughout Pakistan since year 1988 without any hindrance from any quarter and thus they had invested substantial amount in the promotion and publicity of the product bearing "COBRA" mark and therefore, the Appellant company enjoys an enviable reputation and goodwill in the said Trade Mark in Pakistan.

3. It is further the case of the Appellant that on or about 31.03.2010, Respondent No.2 applied for the Registration of trade mark "FASTER BLACK COBRA", which was accepted for publication in the Trade Mark Journal in order to invite Opposition and was advertised in Trade Mark Journal No. 733 in the month of February, 2012. Immediately upon becoming aware of such publication, the

Appellant filed a Notice of Opposition bearing Opposition No.455/2013 against the grant of Registration of Mark “FASTER BLACK COBRA” on the ground, *inter-alia*, that the Trade Mark applied for is identical to the Appellant’s trade mark “COBRA” and is likely to deceive or cause confusion amongst the consumers. In reply to the Appellant’s Notice of Opposition, Respondent No.2 filed its counter statement contending that the mark “FASTER BLACK COBRA” was adopted in 2009 in order to distinguish its goods from other competitors and Notice of Opposition is liable to be dismissed on the ground that the mark “FASTER BLACK COBRA” is quite distinguishable from the Appellant’s mark “COBRA”, thus, qualifies for registration.

4. Subsequently, in January, 2014 it came to the Appellant’s knowledge that Respondent No.2 in connivance with others had commenced their illegal activities of importing, manufacturing, marketing, advertising and selling their goods in Karachi under the name and style of “FASTER BLACK COBRA”, therefore, immediately upon becoming aware of such illegal activities, the Appellant filed Suit No.192/2014 against Respondent No.2 for infringement of rights, passing off, unfair competition, declaration and permanent injunction. In these proceedings vide order dated 03.02.2014 interim injunction was also passed, restraining Respondent No.2 from using mark “FASTER BLACK COBRA”. During the pendency of above suit and proceedings in Opposition No.455/2013, Appellant came to know that Respondent No.2 in the present appeal illegally obtained Trade Mark Registration of “FASTER BLACK COBRA”, thereafter a detailed order was passed on 06.06.2014 in Suit No.192/2014, whereby the Appellant was required to file an application for invalidation of registration of “FASTER BLACK

COBRA”. Meanwhile, Respondent No.2 filed HCA No.220/2014 against the order dated 06.06.2014 passed by the Single Bench in SuitNo.192/2014 and the said order of Single Judge was suspended by the Division Bench vide its order dated 25.09.2014. The appeal was dismissed and the matter was remanded to the learned Single Judge to decide the injunction application in Suit No.192/2014. On 13.03.2017, an order was passed, whereby the registration of “FASTER BLACK COBRA” was held as null and void and Respondent No.1 was directed to proceed with Opposition No.455/2013 and to pass a speaking order within thirty days. As a result thereof, the cancellation of the illegal registration of “FASTER BLACK COBRA” bearing application No.280917 in class 5 was confirmed in Trade Marks Journal No.794 dated 01.03.2017. Opposition No.455/2013 came up for final hearing on 04.05.2017 before Respondent No.1 and subsequently on 10.08.2017 short order dated 07.08.2017 was communicated to the Appellant, disallowing the Opposition of the Appellant and allowing the application bearing No.280917 in class 5 of Respondent No.2 to proceed with registration with the disclaimer of word “Cobra” and all descriptive words/letters/device appearing on the label.

5. As the above order was received to the Appellant on 10.08.2017, they applied for certified copy of the decision, but the same was not communicated, hence they filed appeal only on the basis of short order communicated to them. However, subsequently, in compliance of Court’s order dated 20.11.2017 detailed order was supplied to the parties, which is impugned by way of present appeal.

6. Respondent No.2 has filed Counter Affidavit to this appeal and denied all the allegations/averments/statements made in the memorandum of titled appeal and supported the impugned order.

7. It is further stated that Respondent No.2 is the proprietorship concern working under the name and style of M.F. Enterprises and is engaged in business of import, manufacturing, promotion, supply, distribution and sale of variety of goods including but not limited to disinfectants, preparations for destroying vermin and fungicides etc. For one of the products namely insecticide, the Respondent No.2 is using trade mark "FASTER BLACK COBRA".

8. It is the case of Respondent No.2 that prior to adoption of trade mark "FASTER BLACK COBRA" they confirmed and verified from market that no product with the same trade mark was being sold or otherwise available in the market. With this background, they started using trade mark since 2009 and therefore, applied for registration of its trade mark; their trade mark application was accepted for registration through letter dated 25.11.2011. After availing various opportunities, on 04.02.2013, the Appellant filed their Notice of Opposition No.455/2013 to the Respondent's application with the Registrar of Trade Marks. Meanwhile, multiple litigations were filed in this Court between the parties and finally Suit No.192/2014 was filed before this Court and lastly the Registrar of Trade Marks after hearing both the parties ordered the contesting Respondent regarding "FASTER BLACK COBRA", to proceed for registration in terms of the impugned order referred to above.

9. I have heard the arguments advanced by the learned counsel for the parties. It is contended by learned counsel for the Appellant that the impugned order has been passed, ignoring the peculiar facts

and circumstances of the case and the provisions of Trade Marks Ordinance, 2001; in particular Section 17 of the Ordinance, 2001 has been wrongly applied by Respondent No.1 while passing the order. Per learned counsel, the product bearing mark "COBRA" continued to be in use in Pakistan by the present Appellant since 1987 and the Appellant is the proprietor of the mark "COBRA" bearing Registration No.99323 and 106208 in classes 5 and 16 respectively; the earliest registration was obtained in the year 1988. Respondent No.1 failed to take into account the imitative nature of the marks and confusing similarity in between the impugned mark "FASTER BLACK COBRA" and Appellant's prior owned mark "COBRA". Respondent No.1 has failed to consider that the goods marketed and sold by the Appellants and the goods of Respondent No.2 are of identical nature being insecticide and thereby incorrectly allowed the confusing similar mark "FASTER BLACK COBRA" in favour of Respondent No.2 to proceed for registration. Not only this, the Respondent No.1 for arriving at the decision in respect of Opposition No.455/2013 has ignored and misconstrued the orders dated 13.02.2017, 20.02.2017 and 13.03.2017 passed by this Court in J.M.No.34/2014, wherein learned Judge clearly observed in the order that the trade mark registration was nearly identical, therefore, was in violation of the trade mark laws. This being the position, impugned decision passed by Respondent No.1 is liable to be set aside.

10. On the other hand, it is contended by learned counsel for Respondent No.2 that Respondent No.2 is engaged in the business of import, manufacture, promotion, supply, distribution and sale of variety of products including but not limited to disinfectants, insecticides etc. and for its products of insecticides had used trade

mark "FASTER BLACK COBRA", since year 2009. The Respondent No.2's trade mark application for "FASTER BLACK COBRA" was accepted for registration by the Registrar of Trade Marks after following all required formalities through letter dated 25.11.2011. Per learned counsel, the Respondent's products under the Ordinance, 2001 referred to above are sold in Pakistan since 2009 onwards and expenditure of millions of rupees is incurred upon the advertisement of such products and it was well in knowledge of the Appellant since 2009, but they remained silent; neither objected nor otherwise filed any suit to restrain Respondent No.2 from using trade mark "FASTER BLACK COBRA" and it is only in the month of February, 2014 after a delay of almost five years, they filed Suit No.192/2014 and obtained ex-parte ad-interim injunction order in the suit, whereby Respondent No.2 was restrained from using its proprietor trade mark "FASTER BLACK COBRA". The above suit is being contested by Respondent No.2, who filed written statement, denying the case of present Appellant.

11. It is contended by learned counsel that the word "COBRA" per-se is descriptive, suggestive and common to trade in relation to insecticides and herbicides; therefore, provisions of section 17 subject to provision of section 14 of the Ordinance, 2001 are not applicable to the present case. They have got only registered their label and have not obtained any registration for the word "COBRA". Presently a larger number of competitors of the Appellant and Respondent No.2 are selling their insect killing products in various parts of the world including Pakistan using descriptive, suggestive and common to trade word "COBRA" and no confusion and deception has been caused to any person, therefore, in the light of above factual and legal position, Respondent No.1 has rightly passed

the order, which has been impugned before this Court with wrong perception and ulterior motives. In support of his contentions, he has relied upon the following case law:

- 2013 CLD 330 (Tillotts Pharma AG v/s. GETZ Pharma (Private) Limited.
- 1989 SCMR 361 (Formica Corporation v/s. Pakistan Formica Ltd.)
- 2007 CLD 991 (Messers Master Textile Mills Ltd. v/s. Master Fabrics)
- 2007 CLD 997 (Abid Aziz Khan and 2 others v/s. Bank of Punjab).

12. Learned counsel appearing for Respondent No.1 submitted that the order passed by Respondent No.1 has been passed after considering the facts and circumstances of the case. Therefore, the impugned order is valid and needs no interference at this stage.

13. I have considered the arguments advanced before me by both the sides and have perused the case record.

14. To commence with, the material placed on record shows that so far as the claim of the Appellant as regards registration of trade mark "CBORA" and its prior use, disclosed in paragraphs two to five of the memo of appeal is concerned, it is an undeniable reality established on record; therefore, it needs no further discussion. Moreover, from the contents of earlier order dated 13.03.2017 in J.M.No.34/2014 it is also established that earlier certificate for registration of "FASTER BLACK COBRA" bearing No.138268 dated 24.02.2014 in relation to trade mark No.280917 was issued by Respondent No.1 in favour of Respondent No.2 in blatant violation of the scheme of trade mark laws and thus declared null and void, which position was conceded before the Court by Respondent No.1 and not much disputed by Respondent No.2. In this background now

it is to be seen that how far the subsequent impugned order dated 07.08.2017 passed by Respondent No.1 in favour of Respondent No.2 once again affirming the earlier stance (reasons recorded on 20.09.2017) is legal and within the frame work of the Ordinance, 2001. In this context firstly it is to be noted that purported prior use of trade mark "COBRA" by Respondent No.2 on the strength of earlier order of Respondent No.1, which was set aside by this Court vide order dated 13.03.2017 in J.M.No.34 of 2014 was nullity and void thus such period could not be considered by the Respondent No.1 as valid ground to justify the subsequent impugned order; observations of Respondent No.1 for this purpose are therefore ill-founded and perverse. Based on these facts there is no difficulty for me to hold that on one side the claim of Appellant regarding registration and use of trade mark "COBRA" is fully established and on the other side the subsequent claim of Respondent No.2 for registration of trade mark "FASTER BLACK COBRA" in the same category of goods is on weak footings, unless the Respondent No.2 could satisfy that use of prefix 'faster black' in their label before "COBRA" is sufficient to dislodge the opposition No.455 of 2013 filed by the Appellant. I have called for the samples of both the respective products from the learned counsel for the appellant and Respondent No.2 and by placing them in juxtaposition carefully examined the same, with reference to labels of "COBRA" and "FASTER BLACK COBRA", and also the package material, size, shape, colour scheme and overall printed text. For ready reference their picture is placed below, which depicts similarities in the two products, sufficient to cause confusion among the ordinary customers.



The main guiding principle to examine the genuineness of the subsequent claim of Respondent No.2 for the registration of its trade mark “FASTER BLACK COBRA” is that upon comparison of the two, the Court is to be satisfied that there are sufficient features to differentiate between the two trade marks phonetically as well as visually, so that an unwary buyer of the same product, as in the instant matter, is genuinely not confused and misguided due to the feature of similarities between the two. In my considered opinion, the concept of totality of impression, test of average consumer etc. recorded by the Respondent No.1 in its order dated 20.09.2017 is misconceived and erroneous. As observed by me there are sound reasons disclosed by the Appellant in his Opposition No.455/2013,

which justify grant of such opposition and consequent rejection of Application of 280917 in class 5 of registration of Trade mark “FASTER BLACK COBRA” in favour of Respondent No.2. This view of the matter is supported from the following judgments of Honourable Supreme Court of Pakistan, which are of binding nature:

- PLD 1984 Supreme Court 8 (Jamia Industries Ltd. v/s. Caltex Oil (Pak) Ltd. And another).
- PLD 1990 Supreme Court 313 (Seven-Up Company v/s. Kohinoor Thread Ball Factory and 3 others).
- 2012 SCMR 1504 (Shan Food Industries v/s. Eastern Products (Pvt.) Ltd. And others).
- 2015 CLD 1245 (Messrs Farooq Ghee and Oils Mills (Pvt.) Ltd. v/s. Registrar of Trade Marks, Trade Mark Registry and others).

15. For the above reasons this appeal is allowed. The impugned order of Respondent No.1 is set aside and the Opposition No.455/2013 filed by the appellant is allowed. The application of Respondent No.2 bearing No.280917 is rejected.

Judge