

IN THE HIGH COURT OF SINDH, KARACHI

M.A No. 74 of 2008

Imperial Chemical Industries PLC.....V.....The Registrar of Trade Marks and another

ORDER

Date of hearing : 1st September, 2021
 Date of Judgment : 1st September, 2021.
 Appellant : Ms. Amna Salman, advocate.
 Respondents : Nemo for the Respondents.

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Kausar Sultana Hussain, J:- This Miscellaneous Appeal under Section 114 of Trade Marks Ordinance, 2001 assails decision dated 10.04.2008 passed by the learned Registrar of Trade Marks in opposition No. 660 of 2004 filed by the appellant/opponent against Registration of Trade Mark "MAXEL' under Application No. 158427 in class-2 submitted by the respondent No.2/applicant, before Trade Mark Registry.

2. A short factual background of the case is that the appellant/opponent is engaged in the manufacture and sale of diverse products such as paints, specialty chemicals, adhesive materials, glues, surfactants, specialty starches, flavours and fragrances for food drinks, cosmetics, perfumes and other consumer items in over 50 countries and sales and marketing offices in more than 150 countries; that the said business operates 60 manufacturing sites in 25 countries and the appellant sells its paint products in more than 120 countries. The appellant also conducting the said business in Pakistan for several decades, either itself or through its subsidiary ICI Pakistan Limited. The appellant's goods have been offered for sale and

sold in Pakistan, as described above and have been promoted through various media in Pakistan, either by the appellant itself or through ICI Pakistan Limited and goods under various trademarks of the appellant enjoy tremendous reputation and goodwill and are recognized by the trade and general public in Pakistan as originating from the appellant. It is further averred in the plaint, that amongst others, the appellant has used and is continuing to use the well known trademark "MAXILITE" since 1989 in Pakistan in relation to paints, varnishes, lacquers, preservatives against rust and against deterioration of wood; colouring ordants, raw natural resins; metals in foil and powder for painters, decorators, printers and arts etc. and in addition to Pakistan, appellant's 'MAXILITE marked products are currently sold in other countries like Indonesia, Malaysia, Veitnam, India, Thailand, China etc. In order to run the manufacture, distribution and sale of its products under the trademark "MAXILITE" more effectively in Pakistan the appellant has authorized ICI Pakistan Limited (a Pakistani company), to use the said trademark in Pakistan, by reason of which the goodwill generated by the use of the said trademark by its said subsidiary company has accrued to the appellant. The trademark MAXILITE is duly registered in Pakistan under the Trade Marks Act, 1940 (hereinafter referred to as Act, 1940, now repealed by Trade Marks Ordinance, 2001), details of which are as under:

Trademarks	Reg. No.	Class	Dated	TMJ
MAXILITE	100340	02	03.11.1988	528
MAXILITE (Label)	1008302	02	10.10.1990	532

3. Application for registration of trademark MAXEL in the name of respondent No.2 was advertised in the Trade Marks Journal No.639 of April, 01, 2004 with following details:

Application by respondent No.2

Trademarks	Appln. No.	Class	Dated	TMJ
MAXEL	158427	02	21.10.1999	639

4. The appellant opposed grant of registration of above trademark MAXEL, in favour of respondent No.2 through filing Opposition No. 660 of 2004. The respondent No.2/applicant filed its Counter Statement to the said Opposition alongwith the evidence for rejection of the said Opposition filed by the appellant; matter was heard and finally through order dated April 10, 2008, the respondent No.1/Registrar Trade Marks has dismissed the said Opposition filed by the appellant and has allowed Application No. 158427 of respondent No.2 for trademark MAXEL to proceed for registration, hence this miscellaneous appeal.

5. The learned counsel for the appellant/opponent has argued the matter, while none present on behalf of the respondents, in-spite of giving last chance to them for their appearance. Since the matter is pertaining to the year 2008, therefore, the learned counsel for the appellant/opponent was allowed to advance her arguments on the subject matter.

6. It is submitted by the learned counsel for the appellant/opponent that the respondent No.1 has failed to take into

consideration the facts of the case in general and law on the subject in particular in its true perspective therefore, the impugned order is liable to be set aside; that the respondent No.1 has decided the Opposition upon an extremely technical view of certain provisions available in the procedural law namely, Trade Marks Act, 1940 (**The Act, 1940**) as well as The Trade Marks Rules, 1963 (hereinafter referred to as **"The Rules, 1963"**). It is further argued that the respondent No.1 has committed serious illegality while firstly holding that Rule 6 of Rules, 1963 or Section 80 of the Act, 1940 were **"mandatory provision"** for the reason that these Rules and Section are merely procedural in nature and the same cannot be considered to be mandatory. It is further argued that respondent No.1 in an arbitrary manner rejected the Affidavit in an illegal and oppressive manner which was sworn and filed on behalf of the appellant/opponent by its duly constituted Attorney; that the respondent No.1/Registrar Trade Marks rejected the entire evidence and thus the Opposition merely on the ground that the person filing the Affidavit was not authorized to file the same; that the findings of respondent No.1 are clearly contrary to provisions of Section 80 of the Act, 1940, which excludes **"Affidavit"** from the purview of the acts to be performed by Trademark Agents; that it is an established principle of civil law that any Affidavit can be sworn, executed and filed by a person **"conversant with the facts of the case"** which person in this case was a lawful constituted Attorney of the appellant through Power of Attorney executed on September 19, 2002 by the appellant, duly notarized and legalized in United Kingdom

and thereafter registered in the records of Sub Registrar, Allama Iqbal Town, Lahore on November 04, 2002 as Document No. 681, Book No.4 and Volume No.7; that the Rules 6 which provides procedure for "Signing" of a "document" and not an "Affidavit" as also provided in Section 80, under law, any "document" can be executed by a lawfully constituted Attorney; that the impugned order, dismissing the Opposition mainly on the ground of authority of person filing the Affidavit on behalf of the appellant is a result of clear misinterpretation of provisions of Section 80 and Rule 6 which has resulted in seriously illegality rendering the impugned order mere nullity in the eyes of law. It is further argued that section 70(b) of the Act, 1940, provides that evidence has to be furnished through Affidavit whereas Section 80, by excluding act of filing of Affidavits from the functions to be performed by **Trademark Agents**, clearly permits filing of Affidavit by any person other than "Agent" or the category of persons mentioned in Rule 6 which relates to "**signature of documents**"; that the person filing Affidavit on behalf of the appellant/opponent fully qualified to swear an affidavit as lawfully constituted Attorney of the appellant. The learned counsel for the appellant drawn my attention towards Rule 31, that while upholding the objection with regard to absence of evidence, the respondent No.1 has purportedly relied upon the first part of Rule 31 of Rules, 1963 and has arbitrarily ignored the most significant and directly applicable part of Rule 31. It is further argued that one of the most important and basic ground of Opposition by the appellant as pleaded in the notice of Opposition has been that the appellant/opponent is

registered proprietor of trademark **MAXILITE**, the details of such registrations have also been provided in the Notice of Opposition therefore, the requirement of Rule 31 stood duly complied with and no other evidence was required to be filed by the appellant/opponent; that firstly, there is no document available on record for period from year 1985 till May 31, 1988 and further, the bank deposit receipt cannot be considered under law to be a document showing use of a trademark **MAXEL** for the reason that there is no document in support of this receipt corroborating that the specific amount of excise duty deposited by respondent No.2 on May 31, 1988, was specifically meant for products and trademark **MAXEL**. The first documenting allegedly showing production and clearance of products under trademark **MAXEL** pertains to year 2002 as also noted as Item No. (vi) of paragraph No.6 of the impugned order. It is further argued that in absence of any confidence inspiring proof of use of trademark **MAXEL** by respondent No.2 from 1985 up till 2002 and in presence of registered trademark **MAXILITE** since November 03, 1988, no justification was left for the respondent No.1 to dismiss the Opposition and allow the applied mark to proceed to registration and accordingly, the impugned order is liable to be set aside; that in above background, attention of this Court is drawn to the impugned order as a whole and it is respectfully submitted that the impugned order fails to decide this principal issue between the parties in a manner required by law; that consumers associate the word "**MAXILITE**" exclusively with the appellant; that the appellant had opposed registration of Trade Mark "**MAXEL**" in favour of respondent No.2 in terms of

section 8(a) of the Act, 1940, as the same is likely to cause confusion and deception in the course of trade. The learned counsel for the appellant finally argued that the respondent No.1 has decided the appellant's Opposition in a purely illegal manner therefore the impugned Decision is liable to be set aside.

7. After hearing arguments of the learned counsel for the appellant/opponent and a thorough reading of the impugned "**Decision**" depicts that the learned Registrar disallowed the Opposition No.660 of 2004 filed by the appellant/opponent on the point of law without touching the merits of the case. He laid emphasis on section 80 of the "**The Act, 1940**" and Rule 6 of the Revised Trade Mark Rules, 1963 ("**The Rules, 1963**"). For the purpose of convenience Section 80 of **The Act, 1940** and Rule 6 of **The Rules, 1963**, are reproduce hereunder:-

Section-80: Agents: Whereby or under this Act any act, **other than the making of an affidavit**, is required to be done by any person, the act may, subject to prescribed conditions or in special cases with the consent of the Federal Government, be done, in lieu of by that person himself, by duly authorized agent, being either a legal practitioner or a person registered in the prescribed manner as a Trade Mark Agent.

Rule-6: Signature of documents: (1); A document purporting to be signed by a partnership shall be signed by at least one of the partners and a document purporting to be signed by a body corporate shall be signed by a director or by the secretary or other principal officer of the body corporate. A document purporting to be signed by any other association of persons shall be sign by the President, Chairman or Principal Secretary

of the Association or by any other person who appears to the Registrar to be duly qualified. The capacity in which an individual signs a document on behalf of a partnership or a body corporate or other association of persons shall be stated below his signature.

8. It is evident from the plain reading of Section 80 of "The Act, 1940, that this section specifically deals with agents, to further elaborate if I read this phrase of the said section "*be done, in lieu of by that person himself, by a duly authorized agent being either a legal practitioner or a person registered in the prescribed manner as a Trade Mark Agent*" there appears no ambiguity that an agent cannot make an affidavit, which rightly infers that person other than agent can make an affidavit. Rule 6 further clarifies that " a document purporting to be signed by a body corporate shall be signed by a Director or by the Secretary or other principal Officer of the body corporate"

9. In instant matter the affidavit was shown and filed by one Naveed Afzal Qari, who was made attorney besides three more persons on the strength of Power of Attorney executed by one Walter Paul Johnston, duly authorized representative on and for the behalf of M/s. Imperial Chemical Industries PLC / appellant, such Power of Attorney has been notarized in United Kingdom and attested by the official of High Commission of Pakistan in London in accordance with the "Hague Convention of 5th October, 1961. This very document was also registered with the relevant Sub-Registrar in Lahore, Pakistan. There is no doubt that any person having Power of Attorney from Executants can perform all or any act(s) as are authorized to be

acted upon or performed as may be stipulated in such deed of Power of Attorney.

10. In the present case, being authorized by virtue of Power of Attorney executed by one Walter Paul Johnston, the Attorney Naveed Afzal Qari was quite competent to file affidavit.

11. Furthermore, there is also another Affidavit available in the case file titled as "**EVIDENCE IN SUPPORT OF OPPOSITION**", which has been filed by Ms. Caroline Anne Davies, in the capacity of Senior Trade Mark Advisor of Imperial Chemical Company/appellant incorporated in United Kingdom and authorized by the company to make affidavit. Such affidavit which comprises seven pages is also duly notarized from the United Kingdom and was filed by the Attorney of the company/appellant in Pakistan through a cover letter. It appears that learned Registrar misinterpreted section 80 of "**The Act, 1940**" and Rule 6 of "**The Rules, 1963**" defying the very spirit of the Opposition filed by the appellants as the prime concern while adjudicating such sensitive matters, foremost consideration should have been assigned to the merit of the case, so that consumers at large should be prevented from any probable deception, confusion and misunderstanding, after all this is what required from his office, who has been mandated to alleviate such complexities of consumers. It is also worthwhile to mention that chapter XI of "**The Act, 1940**" titled as "Miscellaneous" provides procedures in varied conditions. In this chapter section 70 of **The Act, 1940**, provides procedure before Registrar, which is transcribed below for ready reference:-

In all proceeding under this Act before the Registrar.

(a) the Registrar shall have all the power of a Civil Court for the purposes of receiving evidence, administering oaths, enforcing the attendance of witnesses compelling the discovery and production of documents and issuing commissions for the examination of witnesses;

(b) evidence shall be given by affidavit, provided that the Registrar may, if he thinks fit, take oral evidence in lieu of , or in addition to, such evidence by affidavit.

(c) the Registrar shall not exercise any power vested in him by this Act or the rules made there under adversely to any party duly appearing before him without (if required in writing within the prescribed time so to do) giving such party an opportunity of being heard;

(d) the Registrar may, save as otherwise expressly provided in this Act, and subject to any rules made in this behalf under, section 84, make such orders as to costs as he considers reasonable, and any order shall be executable as a decree of a Civil Court.

12. It is evident from the above that Section 70 provides a departure for evidence by affidavit and makes available provision for taking oral evidence in lieu of, subject to the condition that, if he thinks fit; here words if he thinks fit infers "exercise of judicious discretion for the furtherance of very spirit of "The Act, 1940" and public interest not personal like and desire."

13. It is an admitted fact that trademark "**MAXILITE**" was registered with the registration authority on 3rd November, 1988 in accordance with "**The Act, 1940**" and "**The Rules, 1963**" made there under and products under such mark are saleable in consumer

market, however, word mark "MAXEL" is phonetically quite close to "MAXILITE". Similarly in written form too it may cause confusion to a common person. In these conditions, section 8 and 10 of "The Act, 1940" prohibits registration of such trademarks, relevant sections are copied as under :-

8- No trade mark not part of a trade mark is shall be registered which consists of, or contains, any scandalous design, or any matter the use of which would-

(a) by reason of its being likely to deceive or to cause confusion or otherwise, be disentitled to protection in a Court of justice; or

(b) be likely to hurt the religious susceptibilities of any class of 1 [the citizens of Pakistan] ; or

(c) be contrary to any law for the time being in force or to morality.

10- (1) Save as provided in sub-section (2), no trade mark shall be registered in respect of any goods or description of goods which is identical with a trade mark belonging to a different proprietor and 1 [either already on the register or already registered in any 2 [Acceding State or a non-Acceding State] to which section 82A for the time being applies] in respect of the same goods or description of goods or which so nearly resembles such trade mark as to be likely to deceive or cause confusion.

(2) In case of honest concurrent use or of other special circumstances which, in the opinion of the Registrar, make it proper so to do he may permit the registration by more than one proprietor of trademarks which are identical or nearly resemble each other in respect of the same goods or description of goods, subject to such conditions and limitations, if any, as the registrar may think fit to impose.

(3) Where separate applications are made by different persons to be registered as proprietors respectively of trademarks which are identical or nearly resemble each other, in respect of the same goods or description of goods, the Registrar may refuse to register any of them until their rights have been determined by a competent Court.

14. Essentially no trademark shall be registered which is likely to deceive or to cause confusion or otherwise, be disentitled to protection in a Court of justice. In this case in all probability trademark "MAXEL" being nearly resemble is bound to cause deception and confusion and there is likelihood that similar products of "MAXEL" are passed off as of "MAXILITE" which is already on the register. As such there is specific bar on registration of such trademarks. Section 14(1) empowers the Registrar to refuse such applications, subject to exercising his discretion albeit in judicial manner and after recording reasons thereof.

15. Upshot of above discussion is that the learned Registrar erred while interpreting the essence of section 80 read with Rule 6 and so also not referring to other relevant enabling provisions of "The Act, 1940" more particularly section-8, section-10, section-14, section 70 and Rule 34; thus seems not to have applied his judicial mind and instead of deciding the case on its own merits opted to adjudicate on the point of law, doing away with the very intricacy of the issue which is the subject matter of the case which could have far reaching effects from the perspective of consumers of such products. Since the learned Registrar of Trademark did not make observation on merits, hence this Court is unable to make discussion in this matter on

merits. Accordingly, "Decision" dated 10th April, 2008 is set aside, as I find no rationale in allowing application of trademark "MAXEL" filed under No. 158427 in class-2; consequently, the case is hereby remanded to the learned Registrar for denovo consideration. The learned Registrar (respondent No.1) is further directed to decide the subject Opposition on merits within three months after providing fair opportunity to the parties and their counsel to argue their matter before him for its decision on merits. Appeal is allowed with no order as to cost.

J U D G E

Faheem/PA