

name and its registration done vide certificate dated 22.3.2012 is void, unlawful, having been done with mala fide (*mala fide*) to the detriment of the principals is liable to be cancelled.”

2. Learned counsel for plaintiff contends that plaintiff is having registered trade mark of POWER SONIC in the name of Javed Akhter Chauhan Trading as “**Javedan Resources Corporation**” since then plaintiff is carrying business, under that title whereas defendants have no right to continue their business on the same trade mark, such trade mark is only registered in the name of the plaintiff. Albeit, defendant No.3 is claiming the same trade mark as registered in USA but such certificate is not appended with the written statement or the counter affidavit. He contends that there is no issue of authorization of agency but in instant suit issue of trade mark is involved. He also refers section 73, sub-section (3) of 80, 86 and 96 of the Trade Marks Ordinance 2001. It is also contended that defendant 2&3 have not sought permission to run their business in Pakistan hence their application is without any substance and grounds taken in their application are not falling within the parameters of section 86 of the Trade Marks Ordinance 2001. He relied upon PLD 2000 Karachi 139, 2007 CLC 1610 and 2003 PLC 26.

3. In contra, learned counsel for defendants No.2 and 3 contends that plaintiff was agent of defendants No.2 and 3 up-to 2009/2010 and thereafter on same trade mark he got registration in Pakistan hence under **Paris Convention of Intellectual Property 1833** rights of the defendants are protected; while referring emails and documents submitted with counter affidavit emphasis that

plaintiff was their agent and continuously remained in contact with defendants with regard to such business.

4. Heard, perused the record.

5. Since name and style of trade mark is not disputed but question, *before this Court as raised by respective parties*, appears to be confined to the extent of registration of same trade mark in Pakistan in favour of plaintiff with reference to '**Paris convention**' and applicability thereof within object of Chapter-X of Trade Marks Ordinance, 2001. A proper respond to the issue, would require a reference to paragraph 13, 14 and 15 of the plaint which are as under:-

13. That defendant No.3 is a company carrying on business at California, U.S.A. It gets the batteries and battery cells manufactured from the Peoples Republic of China & Vietnam and import them to the U.S.A. The batteries and battery cells are labeled under the trade mark **POWER SONIC Label** and **thereafter they are shipped to Pakistan.** The goods were also shipped from Republic of China & Vietnam to Pakistan. *The plaintiff was carrying on business with it and was their representative in Pakistan until the year 2009-2010.*

14. That thereafter the relations between them became strained and **the defendant No.3 started exporting its goods to defendants No.1 & 2 under the trade mark POWER SONIC Label.**

15. That the marks **POWER SONIC Label of the plaintiff and POWER SONIC Label of the defendants are identical with each other, visually as well as phonetically. Besides this, the design, get up and colour scheme of both the marks are identical, thus causing confusion and deception during the course of trade.**

From bare reading of the above paragraphs of the pleadings of the plaintiff himself (itself) following facts are *prima facie* admitted i.e:

- i) *defendant no.3 continuously has been exporting its product under marks 'POWER SONIC' from California e.t.c;*
- ii) *plaintiff has been in active knowledge and notice that defendant no.1 is carrying its business under such mark;*
- iii) *plaintiff has been selling product of the defendant no.1 as 'agent' of defendant no.3;*
- iv) *mark of plaintiff , though got registered,is identical to that of defendant no.3 with each other visually as well as phonetically;*

Thus, it is safe to say that it is not disputed that plaintiff was agent of defendants with regard to same business and even under the trade mark "Power Sonic" labels he was carrying out by receiving shipments. Now, to examine the applicability of Chapter-X of the Ordinance would require reference to sections 85, 86 and 92 of the Trade Marks Ordinance 2001 which are reproduced hereunder:-

85. Meaning of "Paris Convention" and "Convention country".-In this Ordinance-

(a) "Paris Convention" means the Paris Convention for the Protection of Industrial Property of the 20th March, 1883, as revised or amended from time to time; and

(b) a "Convention country" means a country other than Pakistan which is a party to the Paris Convention.

86. Protection of well known trade mark.

(1) References in this Ordinance to a trade mark which is entitled to protection as a well-known trade mark shall be to a mark which is so entitled under the Paris Convention and which is **well-known in Pakistan as being the mark of a who-**

(a) is a national of a Convention country; or

(b) is domiciled in, **or has a real and effective industrial or commercial establishment in, a Convention country.** whether or not **that person carries on business, or has any goodwill, in Pakistan and references to the proprietor of such a mark shall be construed accordingly.**

(2) For the purposes of this Ordinance, the tribunal while determining a **trade mark is well-known, without having to require registration or actual use in the form of sales of goods or services under the trade mark in Pakistan**, shall consider the following factors as relevant criteria for establishing the well known status of the trade mark, namely:-

- (i) the amount of Pakistan or worldwide recognition of the trade mark;
- (ii) the degree of inherent or acquired distinctiveness of the trade mark;
- (iii) the Pakistan or worldwide duration of the use and advertising of the trade mark;
- (iv) the Pakistan or worldwide commercial value attributed to the trade mark;
- (v) the Pakistan or worldwide geographical scope of the use and advertising of the trade mark;
- (vi) the Pakistan or worldwide quality and image that the trade mark has acquired; and
- (vii) the Pakistan or worldwide exclusivity of use and registration attained by the trade mark and the presence or absence of identical or deceptively similar third party trade marks validly registered or used in relation to identical or similar goods and services.

(3) ***The owner of a trade mark which is entitled to protection under the Paris Convention as a well-known trade mark shall be entitled to restrain by injunction the use in Pakistan of a trade mark which, or the essential part of which, is identical or deceptively similar to the well-known trade mark-***

- (a) in relation to identical or similar goods or services, where the use is likely to cause confusion; or
- (b) where such use causes dilution of the distinctive quality of the well-know trade mark.

(4) Rights conferred under sub-section (3) shall be subject to the provisions of section 81 and nothing in the said sub-section shall effect the continuation of any bona fide use of a trade mark begun before the commencement of this Ordinance.

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92. Trade name.-A trade name shall be protected without the obligation of filing or registration under this Ordinance whether it forms part of a trade mark or not.

6. Perusal of section 85 categorical suggests that Pakistan is the signatory of Paris Convention and is a Convention country. Definition of "*Paris Convention*" means that "Paris convention for the

protection of industrial property of the 20th March, 1833". Let me add here that since the advancement of the technology has *literally* turned the **world into a globe** which has materially changed the meaning, object and purpose of the **'trade-mark/patent'** as boundaries in the field of trade have become immaterial. The **'Paris convention'** was also a step to ensure protection to **'well-known marks'** in all signatory countries even if they (trade-marks) are not *literally* registered in all countries. The inclusion of Chapter-X in the Trade Marks Ordinance, 2001 is itself an admission to vitality of such aspect particularly when it assures protection but to **'well known marks'**. At this juncture, I would insist that the bare reading of the Section 86(1)(b), *in existence of admitted positions*, is sufficient to bring the mark of the defendant no.3 as **'well known in Pakistan'**. Once it is *prima facie* established that a **'mark'** is qualifying the meaning of **'well-known in Pakistan'** it shall be entitled to all protections available to such **'mark'**. Since name and style is not disputed and question of registration is categorically defined in section 92 with regard to trade name, which provides that "**A trade name shall be protected without the obligation of filing or registration under this Ordinance whether it forms part of a trade mark or not.**" I am equally conscious with object of the Section 90 of the Ordinance but such plea is not taken by the plaintiff that plaintiff got the registration of mark of defendant no.3 in his (plaintiff's) favour within notice and knowledge of the defendant no.3 or that defendant no.3 has acquiesced such registration of its **'mark'** in favour of the plaintiff. On the other hand, the plaintiff himself admitted that on becoming relations strained between plaintiff and defendant no.3, the defendant no.3 started shipping its product to defendant no.1 & 2. Needless to add that even while

resorting to procedure of Section 90, the plaintiff was legally required to have make this fact clear within notice and knowledge of the 'Registrar' so as to allow an opportunity of hearing to defendant no.3 to oppose such registration of its mark because the provision of Section 90(a) leaves the Registrar with no discretion to register such '**mark**' where proprietor opposes such registration. The admission of plaintiff that defendant no.3 has been continuing its business under same **mark** is sufficient to indicate its intention to enjoy privileges, *available to such mark*, under Convention of 1833. At this moment, it would be noteworthy to add here that if such practice is allowed then in every country any agent or other person would start that practice by getting registration from that area by taking the benefits of good-will *attached with such* well-known mark. If so, it would mean nothing but a negation of the Convention which *otherwise* provides protection to the creator and such scheme as enshrined is to save the rights of intellectual property. Not only this but such agent shall become entitled to the fruits of the name and good-will attached with such '**mark**' which cannot be allowed to happen because the name and good-will are not earned/established over-nights by mere preparing a product alone but the efforts and finance which make that '**mark**' to stand in the market with its own name.

7. Thus, in view of above discussion, it is quite safe to say that no *prima facie* case or balance of convenience is available to the plaintiff, rather application, so filed by the plaintiff, is devoid of substance which accordingly is dismissed. On the other hand since, the mark of the defendant no.3 is '**well known mark in Pakistan**', and is protected by Chapter-X of the Ordinance hence application of the defendant no.3 is allowed which *otherwise* is within scope and

object of Section 86(3). However, plaintiff is at liberty to approach Registrar for fresh registration of its independent mark.

Imran/PA

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