

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

M.A No.30 of 2024

Order with signature of Judge(s)

Fresh case

1. For orders on office objection a/w reply as at 'A'
2. For orders on CMA No.2389/2024 (Exemption Application)
3. For orders on CMA No.2390/2024
4. For hearing of main case

27.03.2024

Mr. Muhammad Hashim Anhar Memon, Advocate for the appellant

1. Deferred.
 2. Exemption granted subject to all just exceptions.
- 3&4. Through this appeal, order passed on an application made by the respondent under order XXXIX Rules 1 and 2 read with Section 151 CPC is challenged. Counsel for the appellant states that the appellant has acquired registration in Trademark bearing No.557667 in class-3 after complying with all the formalities and having the mark advertised in the journal after making an application dated 09.01.2020 and the mark was registered on 26.08.2021. Counsel adds that amongst the description of goods the appellant chose to use the word "Baby Go-Rash", whereas, the respondent, who had filed an application bearing No.554012 on 12.09.2019 *in fact* claimed those words "Go-Rash", as their main trademark, which application was also registered on 08.06.2022. Counsel states that the appellant did not oppose the said application as the dominating feature of the trademark used by the respondent was dissimilar with that of the appellant, however just on the grounds that the description of the goods of the appellant's mark had the words "Baby Go-Rash" notwithstanding that both the wrappers/labels were completely different, the respondent chose to file Civil Suit No.05 of 2023 before Intellectual Property Tribunal, where the aforementioned application under order XXXIX Rules 1 & 2 CPC was also filed. Counsel

states that whilst the respondent failed to file any rectification of the word “Go-Rash” present in the specifications of goods of the appellant’s registration however at the same time, through the said application a prayer was also made that the appellant be restrained from using their mark or their own products. Counsel states that these are two distinctive prayers, one with regard to description of goods for which remedy only available to the respondent is to file appropriate rectification application before the Trademark Registry, which the respondent has failed to do so. With regard to the second prayer, where in the existence of dissimilar labels, the Tribunal has chosen to restrain the appellant from using their own trademark, counsel states that both the trademarks are completely different with different shapes of the containers and color schemes. He states that the established tests used by the courts to decide infringement being classical trinity as well as LAPP test also fails. Counsel states that serious illegality has been committed by the impugned order, where *in fact* the Tribunal has failed to consider above tests. Counsel states that serious prejudice is caused to the appellant, who has been restrained from using their own trademark.

Contentions raised merit considerations, issue notice to the respondents for **16.04.2024**. In the meanwhile, operation of the impugned order dated 23.01.2024 passed in Suit No.05 of 2023 by the Intellectual Property Tribunal Sindh and Balochistan to remain suspended.

JUDGE