

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

J.M. No.34 of 2022

Applicant : Muhammad Tahir, through
Maaz Waheed, Advocate.

Respondent No.2 : Pervaiz Ahmed Sheikh, through
Ahmed Ali Hussain, Advocate.

Date of hearing : 24.01.2024

ORDER

YOUSUF ALI SAYEED, J. - The captioned Petition has been preferred by the Applicant under Section 80 of the Trademarks Ordinance 2001 (the **Ordinance**), seeking that Trade Mark No. 45215 registered in favour of the Respondent No.2 under Class 30 in terms of a Certificate dated 24.03.2017 be revoked and cancelled so as to be expunged from the Trade Marks Register.

2. CMA 16459/23 has been filed by the Respondent No.2 in that backdrop under Order 7, Rule 10 CPC, seeking that the matter be returned on the ground that the Intellectual Property Tribunals ("**Tribunals**") constituted under Section 16 of the Intellectual Property Organization of Pakistan Act, 2012 (the "**2012 Act**") have exclusive jurisdiction in the matter in terms of Section 18 of the 2012 Act.
3. The Ordinance falls within the ambit of the term "Intellectual Property Laws", as defined in Section 2(h) of the 2012 Act read with the Schedule thereto, whereas Sections 17 and 18 determine the powers and jurisdiction of the Tribunals while providing that:

“17. Powers of the Tribunals. (1) Subject to the provisions of the Act, the Tribunal shall,

(a) in the exercise of its civil jurisdiction, have all the powers vested in a civil court under the Code of Civil Procedure, 1908 (Act V of 1908);

(b) in the exercise of its criminal jurisdiction, try offences made punishable under this Act and shall, for this purpose have the same powers as are vested in a Court of Sessions under the Code of Criminal Procedure, 1898 (Act V of 1898);

(2) The Tribunal shall in all matters with respect to which the procedure has not been provided for in this Act, follow the procedure laid down in the Code.

(3) All proceedings before the Tribunal shall be deemed to be judicial proceedings within the meaning or sections 193 and 228 of the Pakistan Penal Code (Act XLV of 1860).

(4) Subject to subsection (5), no court other than a Tribunal shall have or exercise any jurisdiction with respect to any matter to which the jurisdiction of the Tribunal extends under this Act.

(5) Nothing in sub-section (4) shall be deemed to affect any proceedings pending before such court immediately before the coming into force of this Act.

(6) All suits and proceedings pending in any court instituted under intellectual property laws shall stand transferred to, and be heard and disposed of by, the Tribunal having jurisdiction under this Act. On transfer of proceedings under this subsection, the parties shall appear before the Tribunal concerned on the date previously fixed.

(7) In respect of proceedings transferred to the Tribunal under subsection (6), the Court shall proceed from the stage which the proceedings had reached immediately prior to the transfer and shall not be bound to recall and re-hear any witness and may act on the evidence already recorded or produced before a court from which the proceedings were transferred.”

“18. Jurisdiction of the Tribunals. (1) All suits and other civil proceedings regarding infringement of intellectual property laws shall be instituted and tried in the Tribunal.

(2) Notwithstanding anything contained in any other law for the time being in force, the Tribunal shall have exclusive jurisdiction to try any offence under intellectual property laws.”

4. As stated, the present proceeding is not one for infringement *per se*, and has been brought under Section 80 of the Ordinance, which envisages that:

“80. Grounds for invalidity of registration.-

(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 14 or any of the provisions thereof.

(2) Where the trade mark was registered in breach of clause (b), (c) or (d) of subsection (1) of section 14, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registered acquired a distinctive character in relation to the goods or services for which it is registered.

(3) The registration of a trade mark may be declared invalid on the ground that there is-

(a) an earlier trade mark in relation to which the conditions set out in sub-section (1), (2) or (3) of section 17 obtain; or

(b) an earlier right in relation to which the condition set out in sub-section (4) of section 17 is satisfied. unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(4) An application for declaration of invalidity may be made by an interested party either to the Registrar or to the High Court or a District Court, except that-

(a) if proceedings concerning the trade mark in question are pending in the High Court or a District Court, the application shall be made to the High Court or a District Court; and

(b) in any other case, if the application has been made to the Registrar, he may at any stage of the proceedings refer the application to the High Court or a District Court.

(5) In the case of bad faith in the registration of a trade mark, the Registrar may apply to the High Court or a District Court for a declaration of the invalidity of the registration.

(6) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(7) Where the registration of a trade mark has been declared invalid to any extent, the registration shall to that extent be deemed never to have been made provided that this shall not affect the transactions past and closed.

5. The question of jurisdiction in respect of a proceeding under Section 80 of the Ordinance came up for consideration before this Court in JM 34 of 2020, which was taken up on the Original Side in tandem with various other matters, with the lead case being Suit No. 200 of 2020. There, vide an Order dated 10.01.2024, and the learned Single Judge was pleased to hold *inter alia* that:

“...it is also apparent that the Legislature, enacting the Trademarks (Amendment), Act 2023, has not entirely removed references to the High Court from the Trademarks Ordinance, 2001. To this end, the amended Section 116 of the Trademarks Ordinance, 2001, provides an option in some instances to apply to the High Court where any suit or proceeding concerning the trademark is pending. Such action may be invoked under Section 73(4) [an application for revocation], Section 80(4) [an application for declaration of invalidity], Section 96(2) [an application for rectification], etc. In all such instances, an action in the High Court will be maintainable.”

6. In view of the foregoing, it is manifest that CMA 16459/23 is misconceived, which stands dismissed accordingly.

JUDGE