

ORDER SHEET
IN THE HIGH COURT OF SINDH, KARACHI
Suit No.226 of 2022

Date	Order with signature of Judge
------	-------------------------------

For hearing of CMA No.11623/2020.

22.03.2024.

Mr. Zain Shaikh, Advocate for the Plaintiff.

YOUSUF ALI SAYEED, J - The Plaintiffs claim to be the registered proprietors of the trademarks “CHOCOLATE SANDWICH” and “LEMON SANDWICH” in respect of biscuits and other goods of the same description in Class 30, and to have continuously used the same in Pakistan from the year 1980 to date, with it being alleged that the Defendants are infringing thereupon by selling ice cream under the marks “BISCUIT SANDWICH” and “BROWNIE SANDWICH”, bearing identical distinctive features so as to be deceptive and confusing. As they have brought this Suit seeking a permanent injunction to restrain the Defendants their servants, agents, representatives and dealers and all persons claiming through or under them from infringing the Plaintiffs’ trademarks or from passing off or attempting to pass off their goods as those of the Plaintiffs, as well as for rendition of accounts and payment of compensation.

2. That being said, it merits consideration that a jurisdictional point arises for consideration in view of the nature of the *lis*, as the provisions of the Intellectual Property Organization of Pakistan Act, 2012 (the “**2012 Act**”) confer the exclusive jurisdiction for the trial of all suits and other civil proceedings regarding the infringement of intellectual property laws upon the Intellectual Property Tribunals (“**Tribunals**”) constituted under Section 16 of that Act.

3. Section 2(h) of the 2012 Act defines "Intellectual Property Laws" as the laws specified in the Schedule to the Act, which includes the Trade Marks Ordinance, 2001, whereas Sections 17 and 18 thereof 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.”

(underlining added for emphasis)

4. As things stand, the Tribunal came to be established in this province vide Notification No.P.15(1)/2013-A-IV dated 02.12.2014 issued by the Law Justice and Human Rights Division, Government of Pakistan, whereafter Notification No. S.R.O 1330(I)/2015 dated 29.12.2015 was published, whereby Section 15 as well as sub-sections (2), (3), (8), (9), (10), (11) and (12) of Section 16 and sections 17, 18 and 19 of the 2012 Act were brought into force with immediate effect.

5. Furthermore, in the case reported as Muhammad Multazam Raza v. Muhammad Ayub Khan, 2022 SCMR 979, it was clarified by the Supreme Court that the 2012 Act covers and included an action for ‘passing off’, with it being observed as follows:

“It may also be relevant to note that what is described as a passing off action may either be a passing off action simplicitor or an action of infringement of trade mark coupled with passing off. Where the case of passing off action is based on infringement of trade mark, such suit shall necessarily require determination of the question whether there had been any infringement of the trade mark and where infringement of trade mark is alleged the suit must, in view of sections 17, 18 and 39 of the IPO Act, 2012, be instituted before the tribunal notwithstanding that the allegations in the suit were coupled with the allegation of passing off.”

6. In view of the foregoing, it is manifest that the jurisdiction in respect of the subject of the present Suit vests exclusively with the Tribunals

7. As such, the Plaint is ordered to be returned, with the office being directed to do the needful while retaining a copy of the pleadings for the record in the Court file.

MUBASHIR

JUDGE