

THE HIGH COURT OF SINDH, KARACHI

Suit No. [-] 1495 of 2024

[M/s. Dr. Mubib Akhtar Hospital & another v. Syed Muhammad Salahuddin & another]

Plaintiffs : M/s. Dr. Mubin Akhtar Hospital & Dr. Syed Abdur Rehman through Raja Qasit Nawaz Khan, Advocate.

Defendants : Nemo.

Dates of hearing : 14-01-2025

Date of decision : 14-01-2025

ORDER

Adnan Iqbal Chaudhry J. - The Plaintiffs, carrying on business in the name and style 'M/s. Dr. Mubin Akhtar Hospital', have brought this suit to challenge the registration of the trademark "M/s. Dr. Mubin Akhtar Hospital" registered in favor of the Defendant No.1. Simultaneously, the Plaintiffs have also filed a J.M. before this Court under sections 73 and 80 of the Trade Marks Ordinance, 2001, respectively for revoking and invalidating the registration of the same trademark, which J.M. is being dealt with by a separate order. Though, a suit to challenge the registration of a trademark is questionable in the presence of special remedies in sections 73 and 80 of the Trade Marks Ordinance, the foremost question is to jurisdiction of the High Court to entertain the suit given the exclusive jurisdiction of the Intellectual Property Tribunal [**IP Tribunal**] under sections 17 and 18 of the Intellectual Property of Pakistan Organization Act, 2012 [**IPOP Act**]. That is also the office objection.

2. Sections 17 and 18 of the IPOP Act came into effect from 29-12-2015 *vide* SRO No.1330(I)/2015. Thereafter, it was held by the Supreme Court in *Muhammad Multazam Raza v. Muhammad Ayub Khan* (2022 SCMR 979) that even where passing off is alleged along with trademark infringement, the exclusive jurisdiction to try such suit vests in the IP Tribunal. The argument of learned counsel for the Plaintiffs appears to be that the instant suit is not against trademark infringement, but against registration of the trademark, and hence maintainable before the High Court.

3. Section 18(1) of the IPOPOP Act stipulates: "All suits and other civil proceedings regarding infringement of intellectual property laws shall be instituted and tried in the Tribunal." The word 'infringement' is used with regards to 'intellectual property laws', not merely with the intellectual property itself. By the definition in section 2(h), those intellectual property laws are listed in the Schedule to the IPOPOP Act which includes the Trade Marks Ordinance, 2001. Therefore, section 18(1) of the IPOPOP Act does not limit the jurisdiction of the IP Tribunal to suits for 'infringement of trademark', rather expands it to matters that constitute infringement or violation of the Trade Marks Ordinance, 2001. That aspect has also been noted by the Islamabad High Court in the case of *Shaheen Chemist v. Zahid Mehmood Chaudhry* (2023 CLD 1).

4. Furthermore, section 117 of the Trade Marks Ordinance, after amendment by Act No. LVIII of 2023, now reads: "No suit for the infringement of a trade mark or otherwise relating to any right in a trade mark shall be instituted in any Court except an IP Tribunal having jurisdiction to try the suit." Therefore, even under the Trade Marks Ordinance, it is now the IP Tribunal that has exclusive jurisdiction to try a suit not only for trademark infringement, but also 'relating to any right in a trademark'.

5. It is averred by the Plaintiffs that they are prior users of the subject trademark, a fact within the knowledge of the Defendant No.1, and therefore its registration was unlawfully obtained by the Defendant No.1. In other words, the suit alleges infringement of the Trade Marks Ordinance; it relates to a right in a trademark, and thus falls within the exclusive jurisdiction of the IP Tribunal as per section 18(1) of the IPOPOP Act and section 117 of the Trade Marks Ordinance, 2001. The plaint is therefore returned under Order VII Rule 10 CPC for presenting it before the IP Tribunal.

JUDGE

Karachi
Dated: 14-01-2025