

JUDGMENT SHEET

IN THE HIGH COURT OF SINDH AT KARACHI

Present:

Mr. Justice Muhammad Shafi Siddiqui, CJ

Mr. Justice Jawad Akbar Sarwana

High Court Appeal No.289 of 2024

Appellants: Perwaiz Ahmed Shaikh (Late) s/o
Muhammad Taqi through his legal
heirs (a) Muhammad Ali Shaikh, (b)
Rajia Ahmad through attorney
Muhammad Ali Shaikh (c) Nazneen
Pervaiz through attorney Muhammad
Ali Shaikh through M/s Ahmed Ali
Hussain and Shahryar, Advocates

and

Respondent No.1: Muhammad Tahir s/o Muhammad Taqi
through Mr Maaz Waheed, Advocate

Respondent No.2: The Registrar of Trade Marks. Nemo.

Date of hearing: 05.02.2025

Date of Decision: 10.02.2025

JUDGMENT

JAWAD AKBAR SARWANA, J.: This appeal arises from a family trademarks dispute between two brothers, Pervaiz Ahmed Shaikh and Muhammad Tahir, both sons of Muhammad Taqi.¹ On 11.10.2022, the Applicant of J. Miscellaneous (“JM”) Application No.34 of 2022 (“JM No. 34/2002”),² i.e. Respondent No.1 herein, Muhammad Tahir s/o Muhammad Taqi (“Respondent-MT”), filed in the first instance jurisdiction of the High Court of Sindh at Karachi the aforesaid JM application under Sections 80 and 14(4) of the Trademarks Ordinance (“TM Ordinance”), 2001, seeking invalidity of the registration of the trademark “TAHIR MASALA” bearing TM Application No.452158 in Class 30 against, his blood-brother,

¹ It transpires that during the proceedings of JM No.34 of 2022, on 16.02.2024, Mr. Perwaiz Ahmed Shaikh passed away. Hence, this appeal is filed by his legal heirs, the deceased's son, Muhammad Ali Shaikh; his daughter, Rajia Ahmed; and the deceased's spouse, Nazneen Perwaiz.

² Page 27-33 of the HCA.

Pervaiz Ahmed Shaikh (“Appellant-PAS”) and Respondent No.2/The Registrar of Trade Marks.³

2. During the pendency of JM No.34/2022 in the High Court, on 23.10.2023, the Appellant-PAS filed an application under Order VII Rule 10 CPC, 1908 (CMA No.16459/2023),⁴ seeking orders from the High Court for the return of the aforesaid JM on account of coming into force of the Intellectual Property Organization of Pakistan (“IPOP”) Act, 2012, and the establishment of the Intellectual Property Tribunal (“IP Tribunal”) under Section 16 thereof.⁵ After hearing the parties, the learned Single Judge dismissed the Appellant-PAS aforesaid application vide the impugned Order announced on 03.06.2024. Hence, this appeal.

3. Counsel for the Appellant-PAS argued that when Respondent-MT filed JM No.34/2022 in the High Court, no proceedings concerning the trademark in question were pending in the High Court or the District Court. He further argued that this position remains the same to this date, i.e. no proceedings concerning the trademark are pending in the High Court or the District Court. He further submitted that no IP-Laws-related proceedings concerning the trademark are pending in the Intellectual Property Tribunal (“IP-Tribunal”) established under Section 16 of the IPOP Act, 2012, either. For these reasons, he contended that the ingredients of Section 80(4)(a) of the TM Ordinance were not made out, and the JM application should have been returned to the applicant by the learned Single Judge to be filed before the appropriate forum. He

³ Page 37-61 of HCA

⁴ Page 501-509 of HCA

⁵ Although the IPOP Act, 2012 was enacted by Parliament on 06.12.2012, yet pursuant to Section 1(3) of the said Act, it did not come into force in the Province of Sindh until the Government of Pakistan, Law Justice and Human Rights Division published Notification No.P.15(1)/2013-A-IV dated 02.12.2014 when Section 16 was brought into force and by which notification IP Tribunals were established, and in particular a Tribunal was constituted inter alia having territorial jurisdiction for matters pertaining to the infringement of intellectual property rights within the city of Karachi. Thereafter vide the Government of Pakistan, Law Justice and Human Rights Division published Notification No.S.R.O 1330(I)/2015 dated 29.12.2015, the Federal Government was pleased to direct that 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 said Act shall come into force with immediate effect.

argued that the IP Tribunal, under the IPOP Act, 2012, alone under Section 18 of the said Act,⁶ had exclusive jurisdiction to decide all “IP Laws” matters,⁷ including Respondent-MT’s application under Section 80(4) filed in the High Court. He relied on the observations of the Supreme Court of Pakistan in Muhammad Multazam Raza v. Muhammad Ayub Khan and Others, 2022 CLD 615, an unreported High Court of Sindh judgment dated 01.11.2021, in Mahile Engine Components Japan Corporation v. Azam Autos and Others (Suit No.2058 of 2019),⁸ and the Islamabad High Court judgment Messrs. Shaheen Chemist v. Zahid Mehmood Chaudhry, 2023 CLD 1.

4. Counsel for Respondent-MT opposed the appeal and submitted that JM No.34/2022 is liable to be maintained before the High Court and ultimately decided by the said Court as Sections 80 and 14 of the TM Ordinance 2001 allow it to do so. Therefore, the appeal may be dismissed with costs, and Respondent-MT should be allowed to prove his claim as contended in JM No.34/2022 filed in the High Court.

5. We have heard the learned Counsels and perused the record.

6. It is pertinent to note that this appeal concerns the impugned Order passed in a JM application filed under Sections 80(4) and

⁶ **“Section 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.”

⁷ Section 2(h) of the IPOP Act, 2012 defines “Intellectual Property Laws” / “IP Laws”, as the laws specified in the Schedule to the Act, which include the following:

- (1) The Trade Marks Ordinance, 2001 (XIX of 2001)
- (2) The Copyright Ordinance, 1962 (XXXIV of 1962)
- (3) The Patents Ordinance, 2000 (LXI of 2000)
- (4) The Registered Designs Ordinance, 2000 (XLV of 2000)
- (5) The Registered Layout-Designs of Integrated Circuits Ordinance, 2000 (XLIX of 2000).
- (6) Sections 478, 479, 480, 481, 482, 483, 485, 486, 487, 488 and 489 of Pakistan Penal Code (XLV of 1860).

⁸ On 17.01.2025, this Division Bench set aside the Order dated 01.11.2021 in Suit No.2058/2019 in High Court Appeal No.264/2021 titled “MECJC v. Azam Autos and Another.” The High Court restored Suit No.2058/2019 to proceed along with J.Misc.No.23/2022 concerning the invalidity of registration under Section 80(4) of the TM Ordinance, 2001, both the lis currently pending in the High Court.

14(4) of the TM Ordinance filed on 11.10.2022. Sections 80 and 14 read as follows:

“Section 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 sub-section (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.”

“Section 14. Absolute grounds for refusal of registration.- (1) The following shall not be registered, namely:-

- (a) mark which do not satisfy the requirement of clause (xlvii) of section 2;
- (b) trade marks which are devoid of any distinctive character;

- (c) trade marks which consist exclusively of marks or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services; and
- (d) trade mark which consist exclusively of marks or indications which have become customary in the language or in the bona fide and established practices of the trade;

Provided that a trade mark shall not be refused registration by virtue of clause (b), (c) or (d) if, before the date of application for registration. it has in fact, acquired a distinctive character as a result of the use made of it or is a well known trade mark.

(2) A mark shall not be registered as a trade mark if it consists exclusively of-

- (a) the shape which results from the nature of the goods themselves;
- (b) the shape of goods which is necessary to obtain a technical result; or
- (c) the shape which gives substantial value to the goods.

(3) No trade mark nor any part thereof in respect of any goods or services shall be registered which consists of, or contains, any scandalous design, or any matter the use of which would-

- (a) by reasons of its being likely to deceive or to cause confusion or otherwise, be disentitled to protection in a High Courts or District Court;
- (b) be likely to hurt the religious susceptibilities of any class of citizens of Pakistan, per se, or in terms of goods or services it is intended to be so registered; or
- (c) be contrary to any law, for the time being in force or morality.

(4) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

14. Before we apply the facts of the case to the applicable statutory and case law precedents concerning this trademark matter, this bench is cognizant that the judicial determination in each trademark or IP action must be examined in light of its unique facts. At present, even the issue under challenge in this appeal regarding whether the High Court retains jurisdiction to hear an application under Sections 80(4) and 14(4) of the TM Ordinance, 2001, is to be decided on its own the facts and applicable sections of the TM Ordinance, 2001 and IPOP, 2012, etc. No hard and fast rule can be laid down. This is even more so relevant after the coming into force

of the Trade Marks (Amendment) Act, 2023 (“the 2023 TM Amendment Act”), which received the assent of the President of Pakistan on 11.08.2023 and was published in the Gazette of Pakistan on 16.08.2023. The 2023 TM Amendment Act has significantly amended the TM Ordinance, 2001.

15. It may be noted that the Counsel for the parties confirmed that prior to Respondent-MT filing JM No.34/2022 in the High Court, no proceedings concerning the trademark in question were pending in the High Court or a District Court concerning the determination of Intellectual Property Laws (IP-Laws) rights between the parties and this position remains the same to this date. Further, it was/is common ground that no IP-Laws-related proceedings concerning the trademark were earlier filed or are pending between the parties in the Intellectual Property Tribunal (“IP-Tribunal”), either. This position is also confirmed by the record available in the appeal file. The facts are critical as we examine the impugned Order in appeal.

16. Section 80 of the TM Ordinance, 2001, which relates to grounds for invalidity of registration, provides under sub-section (4) of Section 80 that an application for a declaration of invalidity may be made by an interested party to the Registrar of Trademarks or the High Court or the District Court. The central (primary) limb/portion of Section 80(4) provides the applicant with the option to pick and choose and decide its forum to agitate its application in the case of a declaration of invalidity of registration. Under Section 80(4), the applicant has three forums to choose from. He can apply either (i) to the Registrar of Trademarks, (ii) to the High Court, or (iii) to the District Court. Thus, in the case of Section 80(4), the Legislature has created the option of parallel tribunals for the applicant even though, based on the Court hierarchy, the High Court ranks higher, yet the applicant can skip the lower judicial forum of the District Court and directly approach the High Court and apply to the latter for a declaration of invalidity of registration. Conversely, in other words, the Legislature has

vested jurisdiction to the High Court in deciding an application filed under Section 80 within the scope of the said section. The High Court can hear such lis, even if the applicant has not exhausted its remedy before the lower forum, i.e. the applicant may not have applied to the District Court seeking a declaration for invalidity of registration and instead elected to apply to the High Court directly. Alternatively, suppose the applicant is aggrieved by the decision of the District Court rejecting his application for invalidity of the registration. In that case too, he can agitate his grievance against the decision of the District Court in the High Court even though he could have also approached the same court, i.e. the High Court for the same relief in the first instance, directly. It is entirely in the applicant's discretion to decide which forum to pursue. Yet, this “forum shopping”, as it were, is not entirely unregulated. It has its’ contours, as much as Section 80(4) is qualified by Sections 80(4)(a) and (b), which regulate that if proceedings concerning the trade mark in question are pending in the High Court or the District Court, then the application shall be made only to that High Court or that District Court. Under the scheme of Section 80(4) (a) and (b), the applicant is neither at liberty to go forum shopping between the two Courts, i.e. the High Court and the District Court nor the applicant can seek any relief under Section 80(4) to any other forum except the High Court or the District Court when the proceedings concerning the trademark in question are pending in the said Courts, respectively. When Section 80(4) (a) and (b) are triggered, the applicant must comply with the provisions of Section 80(4)(a) and (b). It cannot be, and Section 80(4) does not allow, an applicant to file an application for a declaration of invalidity in the High Court, say if a proceeding for infringement of the trade mark is pending against the applicant in the District Court. In such an event, the applicant can only apply for a declaration of invalidity before the same District Court where the proceedings concerning the trade mark in question are pending and not the High Court that has no lis pending concerning the trade mark in

question.⁹ In the present facts and circumstances of the case, as no proceedings are pending in the High Court or the District Court, the applicant (Respondent-MT) is/was at liberty to file an application for a declaration of invalidity with the High Court, such as JM No.34/2022, and the same is maintainable.

17. We further disagree with the Appellant Counsel's contention that as the provisions of Section 80(4)(a) are not met, therefore, the applicant (Respondent-MT) could not file the JM application in the High Court. As explained above, Section 80(4) provides parallel forums to the Applicant and is worded differently from Sections 73(4) (Revocation of registration) and Sections 96(2) (Rectification or Correction of Register). Sections 73(4) and 96(2) of the TM Ordinance, 2001, do not provide parallel jurisdiction as in Section 80(4). In the case of Sections 73(4) and 96(2), the jurisdiction of the High Court and/or the District Court is qualified to the extent that an application for revocation (Section 73(4)) and for rectification/correction (Section 96(2)) may only be filed to the Registrar of Trademarks unless proceedings concerning the trademark in question are pending in the High Court or a District Court. For ease of reference, and comparative analysis, the three sections are summarized hereinbelow.

- (i) Revocation of registration:¹⁰ An application for revocation under Section 73(4) of the TM Ordinance, 2001, may be made by an interested party to the Registrar of Trademarks, 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 as the case may be, the District Court; and
 - (b) in case the application is made to the Registrar, he may at any stage of the proceedings refer the application to the High Court or a District Court.

(Section 73(4)(a)&(b) of TM Ordinance, 2001)

⁹ This view is also articulated by the learned Single bench of the Lahore High Court in *Italfarmaco S.P.A. v. Himont Pharmaceuticals (Pvt.) Ltd. and Another*, 2017 CLD 1382. The applicant had filed an Application under Section 80(4) in the Lahore High Court when proceedings concerning the trade mark in question were pending in the District Court. The Lahore High Court held that such an application would be returned to the District Court.

¹⁰ Section 73 of the Trade Marks Ordinance, 2001 provides that the registration of a trade mark may be revoked on any of the grounds stated therein.

(ii) Grounds for invalidity of registration:¹¹ An application for declaration of invalidity under Section 80(4) of the TM Ordinance, 2001, may be made by an interested party to the Registrar of Trademarks, 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.

(Section 80(4)(a)&(b) and (5) of TM Ordinance, 2001)

(iii) Rectification or correction of Register:¹² An application for rectification may be made to the Registrar 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 case the application is made to the Registrar, he may at any stage of the proceedings refer the application to the High Court or a District Court.

(3) Except where the Registrar or the High Court or a District Court directs otherwise, the effect of rectification of the Registrar shall be that the error or omission in question shall be deemed never to have been made.

(Section 96(2)(a)&(b) and (3) of TM Ordinance, 2001)

18. As seen from the two sections above, i.e. Sections 73(4) and 96(2), the central (primary) limb/portion of these sections, unlike Section 80(4), does not give an unqualified option to the applicant to approach the High Court directly. Instead, under these two sections, the application must be made to the Registrar of Trademarks, in the first instance, except that if proceedings concerning the trade mark in question are pending in the High Court, then the applicant need not approach the Registrar of Trademarks, and in such situations file the application for Revocation (Section 73(4)) and Rectification or Correction of Register (Section 96(2)) directly with the High Court or the District Court, depending on where the proceeding concerning the trade

¹¹ Section 80 of the Trade Marks Ordinance, 2001 provides that 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. Section 14 sets out the absolute grounds for refusal of registration as stated therein.

mark in question is pending. Thus, when no trademark action is pending either in the High Court or the District Court, concerning the trademark, the applications for revocation and/or rectification is to be filed before the Registrar of Trade Marks and not in the High Court.¹³

19. There is another aspect of the matter. Section 116 of the TM Ordinance, 2001, provides the procedure, in certain cases, an option for an interested person or otherwise, to apply directly to the High Court where any suit or proceedings concerning the trademark is pending. These cases under the TM Ordinance, 2001, include, but are not limited to, the aforementioned Sections 73(4), 80(4) and 96(2) of the TM Ordinance, 2001. Therefore, on this score too, the Legislature has provided an enabling mechanism in terms of Section 116 to sustain direct actions to be filed before the High Court. Yet, as mentioned earlier, this is not a technical matter alone, and one cannot adopt a cut-and-dry mechanical approach when adjudicating the proposition concerning the exercise of jurisdiction vesting in the High Court in a trademark matter. The outcome of such adjudication will entirely depend on the facts of the case. For example, let's say, in a matter concerning the exercise of jurisdiction of the High Court concerning an application under Section 80(4) of the TM Ordinance, 2001 before the High Court, say, in "Scenario A", if a suit for infringement concerning the trademark is pending before the IP-Tribunal and an application under Section 80(4) is subsequently filed in the High Court, or conversely, say in "Scenario B" an application is pending under Section 80(4) before the High Court, and a suit for infringement of trademark or proceedings concerning the trade mark in question is subsequently filed in the IP Tribunal, the adjudication of the application under Section 80(4) in either Scenario "A" or "B" may

¹² Section 96 of the Trade Marks Ordinance, 2001 states that any person having a sufficient interest may apply for the rectification of a trade mark.

¹³ See *Royal PVT (Pvt.) Ltd. v. the Registrar of Trade Marks and Another*, 2011 CLD 833, Muhammad Ali Mazhar, J.

or may not lead to the same result based on the facts and circumstances of each case. At this point, this is not the lis before us. We are dealing with neither Scenario “A” nor “B,” and the appropriate forum may decide on this when seized of such matter.

20. The interpretation of Section 80(4), based on the facts and circumstances in play in this appeal, as articulated in this judgment, is further confirmed by the 2023 TM Amendment Act, which has retained references to “the High Court” in Section 80(4) of the TM Ordinance, 2001. The retention of references to “the High Court” in the TM Ordinance, 2001, after the 2023 TM Amendment Act suggests that the Legislature, while well aware of the provisions of the IPOP Act, 2012 and the statute’s bias towards the IP Tribunals dealing with “IP Laws” matters, still decided to retain references to “the High Court” in the 2023 amended TM Ordinance, 2001, including, inter alia, the reference to “the High Court” in Section 80(4) and Section 14, to continue to keep open the option available to an interested party in certain conditions expressed in the said section to apply for a declaration of invalidity of registration directly in the High Court. The two versions of Section 80(4), before and after amendment, in juxtaposition to each other in tabular format, are reproduced as hereinunder.

<p style="text-align: center;">TM Ordinance 2001 (Before the 2023 TM Amendment Act) (16.08.2023)</p>	<p style="text-align: center;">TM Ordinance 2001 (After the 2023 TM Amendment Act) (16.08.2023)</p>
<p>Section 80(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</p> <p>(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</p> <p>(b) in any other case, if the application has been made to the Registrar, he may at any stage of the proceedings refer the</p>	<p>Section 80(4). An application for declaration of invalidity may be made by an interested party either to the Registrar or to the High Court {OMITTED}, except that</p> <p>(a) if proceedings concerning the trade mark in question are pending in the High Court {OMITTED}, the application shall be made to the High Court or a District Court; and</p> <p>(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</p>

<p>application to the High Court or a District Court.</p> <p>(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.</p>	<p>{OMITTED}.</p> <p>(5) OMITTED.</p>
<p>Section 14 (3) (a). by reasons of its being likely to deceive or to cause confusion or otherwise, be disentitled to protection in High Courts or District Courts.</p>	<p>Section 14 (3) (a). by reasons of its being likely to deceive or to cause confusion or otherwise, be disentitled to protection in {the High Court}.</p>

21. As already discussed above, the 2023 TM Amendment Act has removed from several sections of the TM Ordinance, 2001, the references to “the District Court” and substituted them with “the High Court” and/or the “IP Tribunal”. This is significant as Section 6 of the TM Ordinance, 2001 states that the provisions of this Ordinance shall be in addition to and not in derogation of any other law for the time being in force. Further, Section 39 of IPOP, 2012 states that the provisions of IPOP, 2012 shall have effect notwithstanding anything inconsistent therewith contained in any other law for the time being in force. Thus, arguably, on the one hand, it appears that the provisions of the IPOP, 2012, trump the TM Ordinance, 2001 provisions. Yet, at the same time, on the other hand, the 2023 TM Amendment Act has also modified the definition of “Tribunal” under Section 2(li) of the TM Ordinance, 2001 and continued to maintain the reference to “the High Court”. In the amended definition of Section 2(li), “Tribunal” means the Registrar, as the case may be, the High Court or IP Tribunal before which the proceedings concerned are pending. The consequence/significance of retaining the reference to “the High Court” (underlined by us above) in Section 2(li) of the TM Ordinance, 2001, even after the creation of the “IP Tribunal” under the IPOP, 2012, in the TM Ordinance, 2001, and in particular Section 116 of the said Ordinance,¹⁴ remains subject to judicial determination as and when

¹⁴ See tabular comparison of Section 116 of the TM Ordinance, 2001 post 16.08.2023 below.

<p>TM Ordinance 2001</p> <p>(Before the 2023 TM Amendment Act) (16.08.2023)</p>	<p>TM Ordinance 2001</p> <p>(After the 2023 TM Amendment Act) (16.08.2023)</p>
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it is triggered based on the facts and circumstances of the case too. Therefore, once again, these matters may be addressed as and when the appropriate forum is confronted with such questions. In the appeal before us, no proceedings concerning the trade mark in question are pending in either the High Court or the IP Tribunal.

22. We now turn to the reported case law heavily relied upon by the Counsel for Appellant-PAS, i.e. the Single Bench Judgment of the Islamabad High Court in 2023 CLD 1. At the outset, the facts of the case at hand and the trademark laws applied/interpreted in light of such facts as discussed in this appeal are entirely different/distinguishable from the observations made in the reported Judgment. The reported case law no doubt sets out relevant principles of law but is anchored to its unique set of facts and cannot operate across the board in all trade mark cases. The learned Single Judge of the Islamabad High Court returned to the Applicant for filing an Application in the IP Tribunal, simultaneously invoking Sections 73(4) and 80(4) in one single application filed in the Islamabad High Court. In the present Appeal, the applicant (Respondent-MT) filed an application under Section 80(4) alone in the High Court, and we have discussed in detail that there is a difference between filing an application in the High Court under Section 73(4) and Section 80(4). Further, when the learned Single Judge of the Islamabad

<p>Section 116. Procedure in certain cases of option to apply to the High Court, a District Court or the Registrar. Where under this Ordinance, an applicant, has the option of making an application either to the High Court or a District Court or to the Registrar</p> <p>(a) if any suit or proceedings concerning the trade mark in question are pending before the High Court or a District Court, the application shall be made to the High Court or, as the case may be, the District Court: and</p> <p>(b) in any other case, if the application is made to the registrar, he may at any stage of the proceedings refer the application to the High Court or a District Court.</p>	<p>Section 116. Procedure in certain cases of option to apply to the High Court, {an IP Tribunal} or the Registrar. Where under this Ordinance, an applicant, has the option of making an application either to the High Court or {an IP Tribunal} or to the Registrar</p> <p>(a) if any suit or proceedings concerning the trade mark in question are pending before the High Court or {an IP Tribunal}, the application shall be made to the High Court or, as the case may be, the {IP Tribunal}: and</p> <p>(b) in any other case, if the application is made to the registrar, he may at any stage of the proceedings refer the application to the High Court or {an IP Tribunal}.</p>
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High Court heard the matter, the latest law was the IPOP Act, 2012 and the unamended TM Ordinance, 2001, whereas, as discussed in this Appeal, on 16.08.2023, the Legislature amended the TM Ordinance, 2001 by way of the 2023 TM Amendment Act, and retained the several references to “the High Court” notwithstanding Section 18(1) of the IPOP Act, 2012. The textual interpretation of Section 18(1) as articulated in the case law due to the 2023 TM Amendment Act requires review. Finally, the Islamabad High Court judgment refers to the Order dated 01.11.2021 passed in Suit No.2058/2019, except that this Order was set aside by this Division Bench in HCA No.264/2021 on 17.01.2025. As mentioned earlier, the principles of exercise of jurisdiction are anchored and entrenched in their set of facts. The principles laid down in trademark cases cannot be mechanically applied in rem as each case involves its own medley of facts and law. For the above reasons, we disagree with Appellant-PAS Counsel that - as the trade mark law stood in the year 2022 - the applicant (Respondent-MT) should have applied to the IP Tribunal for relief under Section 80(4) and 14(4) of the TM Ordinance, 2001.

23. Given the above, and for the reasons articulated and discussed herein, we confirm that the learned Single Judge has not fallen into any error. The impugned Order dated 03.06.2024 does not suffer from any illegality that calls for interference. Accordingly, this Appeal is dismissed along with all listed applications, and the parties are left to bear their own costs.

JUDGE

CHIEF JUSTICE