

## *Original Paper*

# Review of Trademark and Its Enforcement Procedures of Pakistan under TRIPS and Paris Convention

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### ***Abstract***

*Enforcement of trademark law has been in evolution for decades in Pakistan. Pakistani laws dealing with trademark and its enforcement procedures are Trade Marks Ordinance 2001, Trade Marks Rules 2004, Intellectual Property Organization of Pakistan Act 2012 and relevant provisions of Pakistan Penal Code 1860 and Specific Relief Act 1877. Civil procedure is dealt in Pakistan as per Code of Civil Procedure 1908 and criminal procedure as per Code of Criminal Procedure 1898. This article is qualitative method of research analyses trademark and its enforcement procedures of Pakistan as per relevant trademark laws of Pakistan under the light of relevant provisions of Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS) and Paris Convention. Paris Convention is the first International Convention containing trademark and its enforcement provisions (6-9) as TRIPS is the first International Agreement containing exhaustive provisions on trademark and its enforcement procedures (15-21, 41-61). Part III of TRIPS deals with enforcement of trademark including civil procedure, administrative procedure, provisional measures, border measures and criminal procedure of trademark enforcement. Trademark Registry established under section 9 of Trade Marks Ordinance 2001 and works under Intellectual Property Organization of Pakistan (IPO-Pakistan) which is a statutory body established under section 3 of Intellectual Property Organization of Pakistan Act 2012. The registered trademark owner in Pakistan can avail civil procedure, criminal procedure, administrative procedure as well as provisional and border measures for enforcement of his registered trademark right in Pakistan. TRIPS and Paris Convention have been ratified by Pakistan, but ratification of International Convention and its implementation are two different things. Better*

*enforcement of trademark law may take years to achieve as per relevant provisions of International Conventions therefore designated authorities of Pakistan are required to establish more Trademark Registry branches, more IP Tribunals, appoint and induct more IP experts, examiners in-charge of registration and spread IP awareness throughout Pakistan for betterment of trademark law enforcement in Pakistan.*

**Keywords**

*intellectual property, trademark, Intellectual Property Organization of Pakistan (IPO-Pakistan), Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS), Paris Convention*

**1. Introduction**

Trademark is a mark, name, sign, smell or a sound which distinguishes goods and services of one undertaking from goods and services of other undertakings. Trademark is required to be distinctive and non-descriptive, it loses its distinctiveness when registered trademark owner does not take prompt action against its infringement. Therefore, enforcement procedures of trademark including civil procedure, administrative procedure, provisional measures, border measures and criminal procedure of trademark enforcement must be adequate, expedient, and must not be costly, complicated and time consuming.

Enforcement of trademark in Pakistan is under Trade Marks Ordinance 2001, Trade Marks Rules 2004, Intellectual Property Organization of Pakistan Act 2012, relevant provisions of Pakistan Penal Code 1860, Specific Relief Act 1877 and Customs Act 1969. Civil procedure is dealt in accordance with Code of Civil Procedure 1908 and criminal procedure in accordance with Code of Criminal Procedure 1898. Trade Mark Ordinance 2001 is the main statute of Pakistan dealing with trademark which is an addition to other related laws and does not bar implementation of other relevant laws for protection and implementation of trademark rights in Pakistan. Duration for the protection of registered trademark is 10 years and renewable after expiration of the duration as domain name is protected for 5 years.

Trade Mark Rules 2004 are made by the Federal Government of Pakistan under section 132 of Trade Marks Ordinance 2001 for smooth process of trademark registration and its enforcement in Pakistan. Intellectual Property Organization of Pakistan (IPO-Pakistan) established in 2005 under Intellectual Property Organization of Pakistan Ordinance 2005, which was later repealed by Intellectual Property Organization of Pakistan Act 2012. IPO-Pakistan is an autonomous body under control of the Cabinet Division of the Federal Government of Pakistan. IPO-Pakistan is required to work for strengthening IP laws, rules and regulations, take measures related to protection of IP rights and do all other works for smooth implementation of IP laws in Pakistan.

Trademark Registry works under IPO-Pakistan for registration and enforcement of trademarks throughout Pakistan. It works as an administrative body to register trademarks and to hear opposition applications as well as it is empowered to work as IP Tribunal. Appeal against decision of the Registrar lies before the High Court.

Keeping in mind Part III of TRIPS, aggrieved party of registered trademark can adopt and avail civil procedure, administrative procedure, provisional measures, border measures and criminal procedure of trademark enforcement in member states of World Intellectual Property Organization (WIPO) and World Trade Organization (WTO). Pakistan is a member state of WIPO as well as WTO, therefore Parliament has made changes in trademark laws of Pakistan as per relevant provisions of TRIPS and Paris Convention. Ratifying International Convention and applying it are two different things, better enforcement of IP including trademark may take years to achieve. Designated authorities of Pakistan are required to put more efforts for enforcement of trademark law in Pakistan. Trademark Registry only have one branch, therefore more branches are required for a country of more than 200 million people, more IP experts are required to be inducted, more IP Tribunals are required to be established and most importantly awareness of IP including trademark must be spread in public through workshops and seminars for giving trainings to public generally and executive authority specially for betterment of trademark and its enforcement procedures of Pakistan.

This article is qualitative method of research analyses trademark and its enforcement procedures of Pakistan including civil procedure, administrative procedure, provisional measures, border measures and criminal procedure of trademark enforcement under the light of relevant provisions of TRIP and Paris Convention.

## **2. Trademark**

Section 2 (xxiv) of Trade Marks Ordinance 2001 defines trademark as mark, device, brand, heading, label, ticket, name of natural or juristic person, abbreviation, signature, word, letter, numeral, figurative elements, color, sound, certification mark, collective mark, domain name, well known mark and service mark used to distinguish goods/services of one undertaking from goods/services of other undertakings (Trade Marks Ordinance of 2001 section # 2 and Deveci, 2003).

Article 15 of TRIPS defines trademark as any sign or combination of signs, capable to distinguish goods/services of one undertaking from those of other undertakings. Signs include words, personal names, letters, numerals, figurative elements and combination of colors/signs. Section 2 (xxiv) of Trade Marks Ordinance 2001 defines trademark comprehensively but without wordings: sign/signs and combinations of signs which is there under article 15 of TRIPS, it is therefore recommended that wordings: sign/signs and combination of signs should be added in the definition of trademark under section 2 (xxiv) of Trade Marks Ordinance 2001.

Subject matter of trademark includes certification mark, which is a mark certified by proprietor indicating goods/services in connection with which it is used and it is a mark which is certified by proprietor for its use with respect to goods/services as their characteristics given in certificate, it may be registered in respect of geographical indication and may be consisted of a sign or an indication designates geographical origin of goods/services protected under certified mark but it does not stop an entitled person to use it in industrial and commercial matters honestly and it must not be misleading to

mislead public in respect to character and significance and it should not be against public policy and principles of morality (Trade Marks Ordinance of 2001 section # 83 read with 2<sup>nd</sup> Schedule and Taylor, 1958).

In the case of *Tawakkal General Export Corporation and Tawakkal Garment Industries Limited v. Collector of Customs (Tawakkal General Export Corporation and Tawakkal Garment Industries Limited v. Collector of Customs, 1992)*, Sindh High Court held that the Central Government through the Ministry of Commerce is empowered to prohibit/restrict export of articles which do not bear standard certification mark under section 8 of Pakistan Standards Institution (Certification Marks) Ordinance 1961, under section 19 of Sea Customs Act 1878 and under section 3 of Imports and Exports (Control) Act 1950.

Subject matter of trademark includes collective mark, which is registered in respect of more than one person jointly as an association and it can be registered in respect of geographical indication to distinguish geographical origin of goods/services protected under collective mark and it should not be misleading to public at large (Trade Marks Ordinance of 2001 section # 82 read with 1<sup>st</sup> Schedule and Wong, 1986).

In *Taxpayer v. Department (Taxpayer v. Department, 2012)*, Appellate Tribunal Inland Revenue held that collective mark users have exclusive right collectively of a thing/equipment being used. It is immaterial whether use of that equipment results into service in return or relates to production of tangible thing.

Subject matter of trademark includes domain name under Trade Marks Ordinance 2001. Domain name is user friendly mark substitute to an internet address, may be registered if it is used as source identifier and if proprietor uses it to offer goods/services via internet, it may be registered in respect of geographical indication with respect to goods/services, it must not be misleading in respect of character and significance of mark. A mere directional reference like a telephone number or a business address cannot be registered as domain name (Trade Marks Ordinance of 2001 section # 84 read with 3<sup>rd</sup> Schedule and Mockapetris & Dunlap, 1988).

In the case of *Alle'Nora Beauty Salon and Parlor v. Mrs. Qurat-ul-Ain Mansoor (Alle'Nora Beauty Salon and Parlor through Partner v. MrsQurat-ul-Ain Mansoor, 2016)*, Sindh High Court held that registered trademark including domain name is protected pursuant to procedure laid down in Trade Marks Ordinance 2001, for this reason, legal system is built to protect trademark of a person who is first one to use trademark, trade name or any other similar source identifier including domain name. The Court held that whenever rights in a trademark are attacked, wheel of legal system will spin in the direction of protecting honest and first adopter to safeguard his right as well as to save customers from such disguise.

Contrary to terms of protection for other subject matters of trademark, domain name is registered for 5 years and may be renewed at the end of that period under provision 6, 3<sup>rd</sup> Schedule of Trade Marks Ordinance 2001. As per article 18 of TRIPS, registration and renewal of registration of trademark shall

be for a term not less than 7 years. Sindh High Court held that legal system is built to protect trademark, trade name or any other similar source identifier including domain name and there is no provision in TRIPS and Paris Convention, and trademark laws of Pakistan dealing with domain name separately. It is therefore recommended that term of protection of domain name should be increased to at least for 7 years as per article 18 of TRIPS.

Subject matter of trademark includes well-known mark, which is recognized worldwide and in Pakistan without registration under article 6bis of Paris Convention and under article 16 (2) (3) of TRIPS. Well-known mark must have a distinct character and duration of use in Pakistan and worldwide made it well known because of its commercial value, geographical scope, quality, image and its exclusivity of use. It is protected in Pakistan under Paris Convention and TRIPS and there is no need to apply for its registration under Trade Marks Ordinance 2001 but if it causes confusion, its use may be restrained in Pakistan through an injunction. It is protected in Pakistan if proprietor is national of a convention country or domiciled in a convention country or has an established commercial establishment in one of the member states of Paris Convention (Trade Marks Ordinance of 2001 section # 85-86 and *Safro & Keaty*, 2004).

In the case of *HERO Motors Limited v. Babar Auto Trading and Manufacturing Company (HERO Motors Limited v. Babar Auto Trading and Manufacturing Company, 2011)*, HERO Motors Company Limited is manufacturer of motorcycles since 1997 under well-known trademark "HERO". It came to know in 2005 that Babar Auto Trading and Manufacturing Company started manufacturing and assembling motorcycles under identical trademark "ASIAHERO". HERO Motors Company Limited approached Sindh High Court for permanent injunction against Babar Auto Trading and Manufacturing Company for using "AISAHERO" as trademark.

Single member bench of Sindh High Court rejected plea of applicant hence HERO Motors filed an appeal before divisional bench of Sindh High Court. Justice Amir Hani Muslim and Irfan Saadat Khan rejected plea of appellant on a ground that word "HERO" is used as common parlance and used in number of varieties and cases, it is a general word which is used across the board hence appeal of HERO Motors Limited rejected by divisional bench of Sindh High Court.

When trademark is registered in the register of trademark, the owner of registered trademark may start legal proceedings of trademark infringement against infringement of his registered trademark and in case if trademark is not registered but protected as well-known trademark under article 6bis of Paris Convention and under article 16 (2) (3) of TRIPS, the owner of trademark may start legal proceedings of passing off to obtain damages and to obtain injunctions to prevent further infringement of well-known trademark (Trade Marks Ordinance of 2001 section # 86 and *Wadlow*, 2011).

In the case of *Mrs. Samreen Liaquat Malik v. M/s Aqmar Health Foods (Mrs. Samreen Liaquat Malik v. M/s. Aqmar Health Foods, 2009)*, plaintiff Mrs. Samreen Liaquat Malik affiliated with M/S Matrix Pharma Private Limited, introduced Nutritional Food Supplement to reduce Folic Acid necessary for healthy body. Sale of plaintiff product exceeds millions during 2006-2008. Plaintiff applied for

registration of trademark “Foreva Pearls” in 2008 and heard about identical trademark “Foliqam Pearls” which has been used by defendant’s ex-employees of plaintiff and have stolen trade secrets and using identical product in color scheme, calligraphy, label, packaging and design of capsules.

Plaintiff issued letter for defendant under section 27 of Trade Marks Ordinance 2001 on forged and subsequent application for registration of trademark “FOLIQAM”. Defendant reluctant to reply thus plaintiff filed civil suit of passing off against defendant for using identical trademark “pearl”. Defendant replied in written statement that he and other defendants never been employed by plaintiff and they have already applied for registration of trademark “FOLIQAM” and product “Foliqam Pearl” has been in market since April-2007.

Issue before Sindh High Court was while comparing both trademarks, point to be noted is that deceived persons are purchasers of goods and purpose of comparison is to determine whether essential features of plaintiff’s trademark is to be found used by defendant and when 2 trademarks are not identical, plaintiff would have to establish trademark used by defendant so nearly resembles with plaintiffs’ trademark that it is likely to deceive and cause confusion in relation to goods in respect of which it is registered and these factors consume much significance in cases of drugs sold on prescription by doctors, chemists and druggists, this is a well-established principle noted for deciding similarity question of 2 trademarks.

Sindh High Court held that plaintiff has emphasized much on the word “Pearl” which is commonly used throughout the world. Label and bottle used by defendant is strikingly different with dominating features and brightly colored therefore it will not affect mind of public and would not cause loss to business of plaintiff and not a single instance has been produced to substantiate that product caused any loss to plaintiff’s business therefore plaintiff’s plea was rejected by Sindh High Court (*Mrs. Samreen Liaquat Malik v. M/s. Aqmar Health Foods, 2009*).

The owner of trademark may use his trademark and take all its potential benefits as it is personal property of its owner and he may transfer it through assignment, testimony or it may be transferred by operation of law either fully or partially. Transfer of registered trademark may be made by act of parties which must be in writing with signatures of both parties. Article 21 of TRIPS prohibits compulsory licensing and allowing trademark owner to transfer his registered trademark with or without transferring business to which trademark belongs (Trade Marks Ordinance of 2001 provision # 8-9, 4<sup>th</sup> Schedule and Scafidi, 2001).

It is necessary to apply for entry in the register of trademark for recording relevant transactions otherwise transactions cannot be protected under Trade Marks Ordinance 2001. An application may be made before the Registrar of trademark for amendments in the register of trademark for adding record of an assignment, grant of license, grant of security interests, grant of an assent to make personal representative or transferring order of the Court. If license is for fixed time, modification part may be removed after expiration of such prescribed time and the Registrar removes it after giving notices to parties concerned. If the owner of trademark wants to give right of usage to a company which is not

registered yet in Pakistan, company must be registered within 6 months from the date of trademark registration application otherwise the Registrar may remove his entry from the register of trademark (Trade Marks Ordinance of 2001 section # 72 and Rana, 2013).

As per section 75 of Trade Marks Ordinance 2001, proprietor of registered trademark may issue limited license for a limited use as to some goods/services protected under registered trademark, limitation as to use it in a locality as well as unlimited license when there is no limitation subject to terms and conditions prescribed in Trade Marks Ordinance 2001. Section 75 (2) (b) of Trade Marks Ordinance 2001 states that license may be issued in relation to trademark use in a specified manner or in a particular locality which is against the requirement prescribed under article 20 of TRIPS which states that use of trademark during trade shall not unjustifiably be encumbered with special requirement. It is therefore recommended that unjustifiable special requirement while granting license for use in a manner within a locality should be removed.

Trademark owner may issue exclusive license where proprietor gives permission to licensee for exclusive use of his registered trademark and no one can interfere in his exclusive right even proprietor cannot interfere. License must be in writing and signed by the trademark owner or on his behalf by an authorized person. Licensee may issue sub license if proprietor authorizes him to do so. Apart from transfer of right, proprietor of registered trademark may surrender trademark in respect of all or any of goods/services it was registered (Trade Marks Ordinance of 2001 section # 74-79 and Calboli, 2005).

Registered trademark is personal property of registered trademark owner and nobody can use that trademark without prior permission of registered trademark owner. If anyone infringes his personal right, he may obtain remedies available under Trade Marks Ordinance 2001, Trade Marks Rules 2004, Intellectual Property Organization of Pakistan Act 2012, Pakistan Penal Code 1860, Customs Act 1969 and Specific Relief Act 1877. No trademark owner can start legal proceedings of trademark infringement in Pakistan unless trademark is registered under Trade Marks Ordinance 2001 except legal proceedings under passing off (Trade Marks Ordinance of 2001 section # 117 and Nair & Kumar, 1994). Detailed procedures of trademark enforcement in Pakistan including civil and administrative procedures, provisional and border measures and criminal procedure of trademark enforcement analyzed and reviewed under next heading.

As per article 6ter of Paris Convention and sections 87 of Trade Marks Ordinance 2001, trademark consisted of national flag, state emblem, official mark, hallmark of convention countries cannot be registered in Pakistan without prior approval of concerned authority of convention country except if there is no requirement to such authorization. Any other kind of national images of convention countries only protected in Pakistan if convention country notifies to Pakistan for that purpose and notification remains enforced at the time of registration application (Trade Marks Ordinance of 2001 section # 87 and Zaheer, 2016).

Similarly, emblems, abbreviations and names of International Organizations cannot be registered in Pakistan unless it appears that there is no connection between them and International Organization or

registration does not mislead public at large. If authorization of International Organization is required for registration of trademark, International Organization can abstain any person to use that trademark in Pakistan through an injunction (Trade Marks Ordinance of 2001 section # 88 and Malik, 2010).

After general analyses of trademark, discussion is moving towards specific analyses of trademark enforcement procedures of Pakistan including: (i) civil procedure, (ii) administrative procedure, (iii) provisional measures, (iv) border measures, and (v) criminal procedure under the light of relevant provisions of TRIPS and Paris Convention.

### 3. Enforcement of Trademark

Enforcement procedures of trademark in Pakistan run are under different statutes viz Trade Marks Ordinance 2001, Trade Marks Rules 2004, Intellectual Property Organization of Pakistan Act 2012, Specific Relief Act 1877, Pakistan Penal Code 1860 and Customs Act 1969. Trade Marks Ordinance 2001 does not deal exhaustively with civil and administrative procedures, provisional and border measures and criminal procedure of trademark enforcement thus Trade Marks Ordinance 2001 should be amended in a way to clarify all procedures of trademark enforcement in Pakistan.

Enforcement provisions spread in different parts of Trade Marks Ordinance 2001 and there is no distinction for judicial and administrative procedures for enforcement of trademark law. Civil procedure can be adopted by aggrieved party for obtaining damages and injunctions under Trade Marks Ordinance 2001 and Specific Relief Act 1877. Administrative procedure of trademark enforcement may be adopted by aggrieved party under Trade Marks Ordinance 2001 and Trade Marks Rules 2004 to present his grievance before IP Tribunal or Trademark Registry under Intellectual Property Organization of Pakistan (IPO-Pakistan). Provisional measures governed by Specific Relief Act 1877 and Code of Civil Procedure 1908. Border measures prescribed in a separate chapter in Trade Marks Ordinance 2001 thus it is dealt under relevant provisions of Trade Marks Ordinance 2001 and Customs Act 1969 as borders measures enforced through customs authority of Pakistan. Criminal procedure of trademark enforcement may be adopted by registered trademark owner in Pakistan under relevant provisions of Pakistan Penal Code 1860 and Code of Criminal Procedure 1898.

**Table 1. Comparison of Trademark Statutes in Pakistan**

<b>Statutes</b>	<b>Civil Procedure</b>	<b>Administrative Procedure</b>	<b>Provisional Measures</b>	<b>Border Measures</b>	<b>Criminal Procedure</b>
Trade Marks Ordinance 2001	X		X	X	X
Trade Marks Rules 2004		X			



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Intellectual Property		X	
Organization of Pakistan Act 2012			
Specific Relief Act	X		X
1877			
Code of Civil	X		X
Procedure 1908			
Customs Act 1969			X
Pakistan Penal Code			X
1860			
Code of Criminal			X
Procedure 1898			

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### 3.1 Civil Procedure

TRIPS provisions dealing with civil procedure of trademark enforcement are articles 42-48 as per which civil procedure is required to be fair and equitable, right of notice must be timely and contains all sufficient details including basis of claim, parties may be represented through independent legal counsels, no compulsory requirement should be for personal appearance of parties and they must be allowed to substantiate their claim and present evidence, ask other party to produce evidence for proving claim of opposite party, right of hearing must be observed, judicial authority is required to pronounce judgment if any party to civil proceedings does not take part in proceedings and voluntarily use delaying tactics, provide mean to identify and protect confidential information. Remedies in civil proceedings must include: (i) injunctions, (ii) compensation, (iii) damages, (iv) expenses including attorney's fee, (v) profits, (vi) removal of trademark affixed unlawfully, (vii) goods disposed of outside channels of commerce, and (viii) infringer may be required to inform right holder identity of third person involved and channel of distribution. Applicant may be asked to pay indemnification to defendant in case abuse of civil procedure of trademark enforcement (TRIPS of 1994 article # 42-48).

All civil proceedings in Pakistan are required to be dealt in accordance with prescribed provisions of Code of Civil Procedure 1908. If aggrieved party wants civil infringement remedy in Pakistan, he may apply before the Civil Court under section 117 of Trade Marks Ordinance 2001 for obtaining civil remedies including injunctions, damages, compensation, costs or handing over trademark infringed material to applicant or authorized authority for destruction (Brown, 1992).

Injunctions are: (i) temporary, (ii) perpetual, or (iii) mandatory. Injunction is temporary when it is for a specific time until next order of the Court and injunction is perpetual when it is not limited for specific

time and mandatory injunction is to order defendant preventing illegal act or to order him to do legal act as per orders of the Court. The Court may award perpetual injunction based on presented evidence when it believes that: (i) defendant is trustee of property which is subject matter of issue, (ii) there is no parameter to determine loss of plaintiff, (iii) pecuniary relief can never be satisfactory relief for plaintiff, (iv) pecuniary relief cannot be taken, or (v) injunction is necessary for multiplicity of judicial proceedings (Arain, 2016 and Specific Relief Act of 1877 section # 53-54).

Sindh High Court held in the case of *M. Sikander Sultan v Masih Ahmed Sheikh (M. Sikander Sultan v Masih Ahmed Sheikh, 2003)* that trademark is not meant for benefits of trademark owner only as it is also used for benefits of public and its main purpose is to use it for secure and free enjoyment of manufacturing and marketing products of its owner and to prevent deceiving public through its infringement. Injunction in trademark is granted to prevent further infringement of trademark to protect the owner of registered trademark and consumer from consuming infringed trademark material.

Injunction may be refused to: (i) stay proceedings pending before the Court where injunction is sought except when it is necessary for multiplicity of proceedings, (ii) stay of proceedings against applicant, (iii) apply for relief before legal body, (iv) stay of criminal proceedings, (v) interfere in public duties of government department, (vi) prevent breach of contract whose performance cannot be specifically enforced, (vii) prevent nuisance when there is no clarity whether act is nuisance or not, (viii) prevent continues breach where applicant is acquiesced, (ix) avail another appropriate relief available except in breach of trust, (x) when conduct of applicant or his agent resultantly disentitle them from assisting the Court, and (xi) when applicant has no personal interest in issue (Specific Relief Act of 1877 section # 56).

No suit for infringement of registered trademark can be instituted inferior to the District Court. If civil proceedings related to registered trademark is pending before the District Court or the High Court, application related to it could be made to the Court in which matter is pending and in case if matter is pending before the Registrar, application is required to be made before the Registrar and he then is required to refer application to the Court if so required (Trade Marks Ordinance of 2001 section # 59-65).

In the case of *Pioneer Cement Limited v. Fecto Cement Limited (Pioneer Cement Limited through Company Secretary v. Fecto Cement Limited and Others, 2013)*, appellant Pioneer Cement Limited filed suit of declaration, infringement and passing off before the District Court and applied for interim injunction which was granted to him but later taken back because respondent no. 2 argued that two elephants' mark is also registered with his name in Afghanistan and respondent no. 3 is using "Ps" as trademark rather than "P". Appellant filed an appeal before Lahore High Court which held that appellant has right to use two elephants' trademark as it is not registered in favor of respondents in Pakistan. The Court held that appellant has made out prima facie case in his favor and is likely to suffer irreparable loss if respondents are restrained from using logo "P" and two elephants' trademark. Trademark rights are lifelines of businesses and unauthorized use of owner's trademark by third

parties' results in un-quantifiable loss and damage to its goodwill and business which is irreparable in nature thus appellant likely to suffer loss due to use of his trademark by third party and damages cannot be calculated in terms of monetary compensation and would be irreparable in nature.

Civil procedure of trademark enforcement may be adopted by registered trademark owner by filing civil suit before the District Court. Thereafter appeal against decision of the District Court is required to be filed before the High Court under section 96 of Code of Civil Procedure 1908 and second appeal is required to be filed before the Supreme Court of Pakistan under section 100 of Code of Civil Procedure 1908. In the case of *Roznama Hamdard through Chief Editor v. Hamdard National Foundation (Roznama Hamdard through Chief Editor v. Hamdard National Foundation, 2015)*, trademark "Hamdard" was registered trademark of Hamdard National Foundation and there were two publications "Hamdard Naunehal" and Hamdard-e-Sehat". Roznama Hamdard published with trademark "Hamdard". Hamdard National Foundation filed suit for infringement of his registered trademark. The District Court gave a decision in support of Hamdard National Foundation and ordered Roznama Hamdard to stop using trademark "Hamdard" for its publications. Roznama Hamdard went to Lahore High Court and filed an appeal against decision of the District Court. On appeal, Lahore High Court upheld decision of the District Court and ordered appellant not to use trademark "Hamdard" for its publications. Thereafter, Roznama Hamdard filed second appeal before the Supreme Court of Pakistan which held that there is a clear-cut deception which leads to confusion in the mind of consumer at the market place hence Supreme Court of Pakistan upheld decisions of the District Court and Lahore High Court.

Appeal on decision of the Registrar lies before the High Court but no appeal can lie against extension of time decision and the Registrar is not required to hear parties before ordering extension of time and cost of the Registrar in proceedings is on discretion of the Court, but he cannot be held liable to pay costs to any party of the matter in issue (Trade Marks Ordinance of 2001 section # 114 and Trade Marks Rules of 2004 part # 1, chapter 12, rule 78).

In pending proceedings before the Court, it may require disputing parties to give written or oral evidence by submitting affidavit, copies of opposition letter, application of rectification, counter statement, other documents which are available at Trademark Registry and copies are obtainable by applying for it in a prescribed manner after paying prescribed fee. If any party of proceedings dies, his successor may join proceedings on his behalf if permitted by the Registrar or by the Court and if they think fit that there is no need for any successor to defend interests of deceased person, proceedings can be continued without any successor. The Registrar cannot be compelled to produce the register or any related document where required contents can be proved through certified copy or through oral statement, but the Court may require him to produce them in special cases (Trade Marks Ordinance of 2001 sections # 121-124 and Jennings, 1989).

In the case of *M/s National Tools Industries Registered v. M/s Azhar Enterprises (M/s. National Tools Industries Registered v. M/s. Azhar Enterprises, 2009)*, appellant National Tools Industries is

manufacturer of shovel with trademark “Single Camel” while respondent M/s Azhar Enterprises is manufacturer of shovel carrying trademark “Two Camels”. Appellant filed civil suit of trademark infringement for obtaining damages and permanent injunction to prevent further infringement of his registered trademark. The Court dismissed plea of appellant holding that trademark used by respondent is distinct having no similarity with trademark of appellant. The Court held that infringement of trademark cannot be proved by bringing buyers in witness box as each side of proceedings are required to lead evidence of its own choice and pass through tool of cross-examination. Thereafter, the Court is required to examine material and relevant evidence. In this case, Trial Court has not committed material irregularity while reaching conclusion but has neglected to follow law.

The Court held that appellant has failed to prove damages and his claim has rightly been declined by the Trial Court and appeal to that extent stood dismissed, but suit of appellant is decreed for permanent injunction restraining respondent from infringing appellant’s registered trademark thus appeal is partially allowed. The Court further held that claim of plaintiff for damages is permissible only when damages claimed used asserted in suit under each head separately and proved through evidence.

Apart from institution of civil suit by registered trademark owner, if registered user suspects that any person infringes his right of registered trademark, he can ask proprietor to take legal action against him within 2 months otherwise he can bring proceedings with his own name but he cannot proceed further if he does not add name of proprietor as joint plaintiff or defendant except if the Court permits him to proceed and proprietor cannot be held liable for costs except if he takes part in proceedings and registered user apply and proceed without adding proprietor for temporary relief (Trade Marks Ordinance of 2001 provision # 12, 1<sup>st</sup> schedule and Schechter, 1927).

Apart from registered user of trademark, licensee is also authorized to ask proprietor to take legal action against infringement of trademark which affects right of licensee and if proprietor does not reply within 2 months and refuses or fails to take legal action, licensee may institute civil proceedings with his name but he cannot proceed further unless the Court allows and licensee makes proprietor joint plaintiff or defendant in proceedings but in case of temporary relief, licensee can proceed alone without including proprietor. If proprietor is added as defendant but does not take part in proceedings, he would not be held liable for costs in action and if legal proceedings brought by registered trademark proprietor and licensee suffered loss due to proceedings, the Court would consider and may make such directions as it thinks fit and licensee holds right to apply in the Court for pecuniary relief (Trade Marks Ordinance of 2001 section # 41, 77 and Offner, 1958).

When civil proceedings is brought for infringement of registered trademark in the name of more than one person, proceedings cannot undergo except if co-owners are made plaintiff or defendant and if any co-owner does not participate in legal proceedings, he would not be held liable to pay costs in action (Trade Marks Ordinance of 2001 section # 24 and Trade Marks Rules 2004 6<sup>th</sup> schedule).

When application for infringement of trademark is made before the Court, it can make an order requiring infringer to erase, remove or obliterate trademark if it is reasonably practicable and may be

required to hand over material used under trademark to such authority for erasure, removal, obliteration or destruction or directs infringer to hand over material to the owner of trademark if he applies for occupation of infringed material within 3 years (Trade Marks Ordinance of 2001 clause # 12, 1<sup>st</sup> schedule and Trade Marks Rules of 2004 part # 1, chapter 7).

In the case of *Fawad Jan v. M/s Interlink Communication Private Limited (Fawad Jan v. M/s. Interlink Communication Private Limited, 2015)*, M/s Interlink Communication Private Limited is registered company under section 32 of Companies Ordinance 1984 for selling mobile accessories brought civil suit before District Court Peshawar for obtaining permanent injunction against Fawad Jan to stop him from using registered trademark, its design, getup, color, scheme and for grant of damages RS 10,00,00,000/- due to illegal usage of registered trademark. Respondent has a good trade reputation hence petitioner used similar trademark for selling its mobile accessories as well as packing of products with slight dissimilarity of letter N. Respondent M/s Interlink Communication Private Limited lodged First Information Report (FIR) at nearby Police Station against illegal practice of Mr. Fawad Jan under relevant sections of Code of Criminal Procedure 1898 and Pakistan Penal Code 1860 thus concerned authority raided on alleged premises and 165 pieces were recovered. Apart from criminal procedure of trademark enforcement, M/s Interlink Communication Private Limited also brought civil suit before the District Court hence Mr. Fawad Jan applied for rejection of plaint under Order VII, Rule XI of Code of Civil Procedure 1908 and for summoning documents from plaintiff to enable him to submit written statement but the District Court rejected both applications thus he filed a writ petition under article 199 of the Constitution of Pakistan 1973 against decision of the District Court before Peshawar High Court. Peshawar High Court held that plaintiff has right under section 117 of Trade Marks Ordinance 2001 to bring civil suit against infringement of his registered trademark before the District Court which is rightly performed by plaintiff as infringed logo is already registered under Trade Marks Ordinance 2001 and infringed trademark is in process of registration and section 33 of Trade Marks Ordinance 2001 states that date of registration of trademark is the date when application for registration of trademark is filed before Trademark Registry thus defendant/petitioner is an infringer of registered trademark and has not submitted written statement in the District Court yet and filed this petition thus it is dismissed.

Once civil suit is decreed in favor of registered trademark owner, he may apply for handing over infringed goods/article to him or to some authorized person within 3 years. Limitation time of 3 years does not apply if the owner of registered trademark has any type of disability or he is not aware of the fact due to fraud or concealment. Infringing goods are those goods which are used for trade in Pakistan under trademark which is identical to registered trademark for same classification of goods. Infringing article is that article which is made to make copies of registered trademark and it is in possession of a person who reasonably believes that this is to be used for production of infringed goods. The Court may order for compensation and destruction of infringed material and with order of destruction or feature of infringed goods, the Court may order for compensation to the owner/user/licensee if the Court thinks

reasonable for protection of their interests (Trade Marks Ordinance of 2001 section # 50-51 and Malik, 2010).

Lahore High Court held in the case of *Hafiz Muhammad Ramzan v. Hafiz Habib-ur-Rehman (Hafiz Muhammad Ramzan through Legal Heirs v. Hafiz Habib-ur-Rehman, 2006)* that plaintiff is manufacturer of sweet with description Multani Suhan Halva and tradename of his product has been in use since 1947 and registered as trademark in 1963. The defendant was one of plaintiff's employee and after leaving job, defendant started making identical sweet with tradename Hafiz Ka Multani Sohan Halva. Plaintiff filed civil suit of trademark infringement against defendant for infringing his registered trademark "Hafiz". Two trademarks are of same inscription, color and both goods are sold in a similar resembled packet too. The Court held that Hafiz means protector, preserver, guardian, governor and Hafiz is not a word which cannot be accepted as trademark. Acceptance of word Hafiz as trademark by Trademark Registry can by no stretch of imagination be taken as violation of any provision of Trade Marks Ordinance 2001 hence this word does not injure religious feelings of any sect of Muslims. The Court held that word Hafiz was rightly adopted by registered proprietor in 1963 hence he has been working since then continuously without interruption. The Court held that word Hafiz neither descriptive nor surname and found capable of being registered as trademark. Trial Court rightly decided in favor of plaintiff which is upheld by Appellate Court.

### 3.2 Administrative Procedure

TRIPS provision dealing with administrative procedure of trademark enforcement is basically article 49. Articles 22-23 of TRIPS also contain requirements to be complied by administrative authority of member state. Administrative authority of member state is required to comply with civil procedure provisions of TRIPS (42-48). As per article 22 (2) (b) of TRIPS, registration of trademark may be invalidated if it contains geographical indication misleading public about its true place of origin. Similarly, article 23 (2) of TRIPS requires member states to invalidate registration of trademark consisted of wine/spirit wrongly indicated to the place which is not its origin by ensuring equitable treatment to producers and not misleading the consumer (TRIPS of 1994).

Administrative procedure of trademark enforcement runs in Pakistan before Trademark Registry during registration process as well as afterwards and before IP Tribunal. Once application for registration of trademark is filed before the Registrar, the Examination Section checks application and the Registrar accepts or rejects application. Opposition Letter can be filed within 2 months against trademark registration before the Registrar of trademark, he decides issue on presented evidence. Apart from opposition procedure during registration before the Registrar at Trademark Registry, administrative procedure runs through IP Tribunals in Pakistan, established under sections 15-16 of Intellectual Property Organization of Pakistan Act 2012. The Registrar of trademark at Trademark Registry works as the Presiding Office of IP Tribunal in Karachi and authority is designated to the Sessions Judge in Lahore. Only two IP Tribunals are not sufficient and there is requirement to establish more IP Tribunals throughout Pakistan (Adeni, 2015; Bently & Sherman, 2014).

IP Tribunals are established for settlement of IP issues in Pakistan and decisions of IP Tribunals are required to be made within 90 days. The Presiding Officer of IP Tribunal is appointed by the Federal Government of Pakistan after consultation with the Chief Justice of High Court. IP Tribunal is empowered to consult IP experts during proceedings between disputing parties and remuneration of experts are required to be paid by parties (Trade Marks Ordinance of 2001 section # 2 (xliv)).

Subject to any other law in Pakistan, IP Tribunal is authorized to hear all cases related to IP in Pakistan. Transferred cases from the Court to IP Tribunal is required to be heard from the point where the Court stops, there is no need to start case from beginning and record evidences again by calling witnesses. Once IP Tribunal announces its decision, appeal on decision of IP Tribunal can be filed by aggrieved party within 30 days before the High Court (Trade Marks Ordinance of 2001 section # 19 and Dutfield & Suthersanen, 2008).

In the case of *Well Aktineesellschaft v. Shamim Akhtar (Wella Aktineesellschaft v. Shamim Akhtar and Other, 2015)*, Wella Aktineesellschaft is manufacturing and exporting cosmetics company applied for registration of “WELAFORM”, “WELAFLEX” and “WELA with Device” in respect of manufacturing and exporting soap, perfume, oil, cosmetic, cleaning products, products in relation with hair and related products before Trademark Registry in Pakistan. The Registrar of trademark accepted his application of registration and registered trademarks “WELAFORM”, “WELAFLEX” and “WELA with Device”. Thereafter, the Ministry of Commerce, Government of Pakistan put a ban on exportation of cosmetics, cleaning and related products hence registered trademark owner did not able to use his registered trademarks within prescribed time of 3 years. Respondent Shamim Akhtar applied for registration of similar trademarks and simultaneously opposed registration of appellant before the Registrar of trademark on a ground that appellant has failed to use them in favor of registered goods within prescribed time.

The Registrar of trademark accepted application of respondent and removed entry of appellant’s trademarks “WELAFORM”, “WELAFLEX” and “WELA with Device” from the register. Appellant Wella Aktineesellschaft filed an appeal before Sindh High Court against decision of the Registrar as Sindh High Court upheld decision of the Registrar. Appellant filed second appeal before Supreme Court of Pakistan which held that trademarks “WELAFORM”, “WELAFLEX” and “WELA with Device” is personal property of appellant and rightly registered in his favor hence dismissed orders passed by the Registrar on ground that when appellant applied for registration of trademarks, it means that he wants to use it and hindrance was created in his way which was beyond his control thus his registered trademarks are validly registered and entries in trademark register should be kept intact in his favor.

IP Tribunal is less expensive, less formal and faster way of deciding disputes thus IP Tribunal saves time of disputing parties. IP Tribunals in Pakistan is beginning of new era which may lead nation to economic growth because IP Tribunal is required to decide cases within 90 days. Currently, there are 2 IP Tribunals established by the Federal Government of Pakistan in Lahore and Karachi and there is a

need of more IP Tribunals throughout Pakistan especially in Peshawar and Quetta (Jilani, 2013).

The Presiding Officer of IP Tribunal has powers as judge of the Civil Court to receive oral/written evidences through affidavit, administer oath, summons attendance of witnesses, summons production of document, issue commission, examine witnesses and issue certificate. He is also empowered requiring applicant to furnish security for costs of proceedings related to an opposition or an appeal. In case if he fails to provide security, his application would be treated as abandoned. He is also empowered to require the Registrar to appear before it or to submit written statement consisting record of proceedings related to matter in issue raised before him, grounds of decision given by him and any other matter relevant to concerned issue (Trade Marks Ordinance of 2001 section # 72 and Trade Marks Rules of 2004 part # 1, chapter 11, rule 63).

The Registrar of trademark has authority to decide ownership of trademark as in the case of *Cephalon France v. Himont Pharmaceuticals* (*Cephalon France v. Himont Pharmaceuticals, 2015*), appellant Cephalonia France entered agreement with respondent Himont Pharmaceuticals to import and sale products of respondent under trademark "SPASFON". Respondent applied for registration of trademark "SPASFON" with his own name under category of "Antispasmodic Pharmaceutical Preparation". Appellant filed application of opposition before the Registrar of trademark and respondent filed declaratory suit before Lahore High Court by adopting civil procedure of trademark enforcement. Both parties applied for stay of administrative proceedings before the Registrar of trademark hence the Registrar transferred matter to the Court which held that ownership of trademark is required to be decided by the Registrar of trademark and not by the Court thus matter is transferred to the Registrar for determination of ownership of trademark "SPASFON".

While deciding issue between parties, the Registrar of trademark must provide equal opportunities to both parties of proceedings which is also prescribed requirement under article 42 of TRIPS. In the case of *Messrs Gujranwala Food Industries v. Messrs Coral Enterprises* (*Messrs Gujranwala Food Industries (Pvt) Ltd v. Messrs Coral Enterprises (Pvt) Ltd, 2013*), appellant Messrs Gujranwala Food Industries opposed registration application of respondent Messrs Coral Enterprises and submitted application of opposition followed by counter statement by respondent who applied for registration of trademarks "ZOMBIE CHEWS", "SHERBET SHOCKERS" and "WICKED FIZZ". The Registrar of trademark disallowed opposition on a plea that appellant failed to provide prima facie evidence to prove his claim beyond reasonable doubt within a prescribed time and that time is not increased by the Registrar hence appellant went to Lahore High Court which held that right of hearing must be fulfilled during proceedings thus matter is remanded to the Registrar of trademark for resolution and the Court asked the Registrar to comply with right of hearing and parties should be duly entitled to substantiate their claims and present relevant evidence.

Once validity of registered trademark is decided in favor of proprietor by IP Tribunal and a final decree is issued in his favor as well as certificate to that effect. If any person objects on validity again in any legal proceedings with proprietor, the proprietor has a right to obtain full costs, charges and expenses of



proceedings which is also prescribed requirement under articles 46-48 of TRIPS (Dutfield & Suthersanen, 2008; Haseeb, 2014).

### 3.3 Provisional Measures

TRIPS provision dealing with provisional measures is article 50 which states that judicial authority is empowered to order prompt and effective provisional measures to prevent trademark infringement in future and to protect evidence required to be presented to prove claim of applicant before competent authority. Provisional measures may be invoked if delay in granting injunction may cause irreparable harm to applicant or evidence concerned may be destroyed. Injunction order passed by the Court will cease to have effect within 20 to 31 calendar days if aggrieved party applies for cancellation of injunction order because no legal proceedings has been initiated against the defendant (TRIPS of 1994).

Purpose of provisional measures is to permit effective/expeditious actions against continuous illegal use of registered trademark, protect evidence which put light in favor of party to prove his plea before the Court, stop alleged trademark infringement when there is likelihood that an irreparable harm may be caused to right holder and when there is a clear risk that evidence would be destroyed and prevent infringed trademark goods to come up during trade after customs clearance. Alleged trademark infringement is that infringement which is not prima facie proved before competent authority as it is in process of proving or disproving hence right holder needs some protection for himself and for evidences he relies upon to prove his claim beyond reasonable doubt before competent authority (Reichman, 1995; Schankerman & Scotchmer, 2001).

In the case of *Dollar Industries Private Limited v. Nisar Traders Stationery and General Order Suppliers (Dollar Industries Private Limited v. Nisar Traders Stationery and General Order Suppliers, 2011)*, plaintiff Dollars Industries Private Limited is engaged in business of manufacturing, trading marketing, selling, supply and exporting large variety of high quality stationery items and writing materials including ball points, pens, fountain pens, pencils, markers and other allied goods since 1954 under trademark "DOLLAR". Dollars Industries Private Limited filed civil suit against defendant for using trademark "SCOT" with similar design of product as of plaintiff and applied for grant of temporary injunction to prevent defendant from further usage of identical trademark and design of plaintiff's products.

Sindh High Court held that both designs in question are like each other and capable of creating confusion and deception in the mind of public. Furthermore, resemblance in two designs would be sufficient to establish infringement but similarity thereof to each other in all respects would not be necessary thus there is a prima facie case in favor of plaintiff to justify grant of injunction and balance of convenience also appeared to be in favor of plaintiff who would suffer irreparable loss if injunction is refused thus temporary injunction is granted.

Provisional measures come under the ambit of judicial procedure as well as under administrative procedure but separate from trademark infringement proceedings as plaintiff may apply for grant of

injunction any time during trademark infringement proceedings and the Civil Court or administrative authority required to deal both matters separately. In the case of *Leo Pharmaceutical Products v. Shaigan Pharmaceutical (Leo Pharmaceutical Products v. Shaigan Pharmaceutical (Pvt) Ltd, 2013)*, Leo Pharmaceutical Products and Shaigan Pharmaceutical are manufacturer and exporter of an antibiotic cream under trademark “FUDIC”. Leo Pharmaceutical Products filed suit of trademark infringement against Shaigan Pharmaceutical and asked for grant of temporary injunction before the District Court which was rejected. Leo Pharmaceutical Products filed appeal before Lahore High Court which held that Supreme Court of Pakistan has laid down principle that when suit is fixed for arguments on an application for grant of temporary injunction, the Court only decides application for grant of injunction and would not proceed to reject suit. Lahore High Court remanded matter to the District Court again and ordered parties to appear and record evidences before the District Court for final decision.

In another case between *Muhammad Ashraf Alias Makhan v. Muhammad Akram (Muhammad Ashraf v. Muhammad Akram, 2015)*, Supreme Court of Pakistan held that registration of trademark gives rise to prima facie case, balance of convenience and likelihood of irreparable loss for grant of injunction against an infringement of already registered trademark and if applicant fails to prove his claim prima facie, his petition would be dismissed.

Once provisional relief is granted by the Court and application of injunction is decided in favor of plaintiff, applicant has a right to go for civil legal action or adopt criminal procedure or administrative procedure to prevent defendant from using his registered trademark. In the case of *Malik Muhammad Rafiq Awan v. Javed Iqbal (Malik Muhammad Rafiq Awan v. Javed Iqbal and Others, 2012)*, Malik Muhammad Rafiq Awan owned “Dera Restaurant” and “Fazl-e-Haq Family Restaurant” is owned by Javed Iqbal, located side by side near Qadafi Stadium, Lahore, Pakistan. Later, name of “Fazl-e-Haq Family Restaurant” was changed to “Fazl-e-Haq Dera” due to success of “Dera Restaurant”. The owner of “Dera Restaurant” Malik Muhammad Rafiq Awan filed suit of declaration before the District Court in Lahore and applied against infringement of his trademark “Dera” against the owner of “Fazl-e-Haq Dera” restaurant Javed Iqbal and asked the Court to provide preventive relief of injunction immediately stopping defendant to use trademark “Dera”. The Court denied provisional relief to plaintiff thus plaintiff went to Lahore High Court which held that word “Dera” either be used in similar font size with “Fazal-e-Haq” or be dropped from the name otherwise appellant has a right to go for penal action against respondent.

In another case between *M/s Golden Thread Industries Karachi v. J & P Coats Company UK (M/s. Golden Thread Industries Karachi v. J&P Coats Limited Company U.K., 2013)*, appellant Golden Thread Industries packed their products in a packing which is almost identical in appearance to that of respondent and in this way, appellants deceived ordinary purchasers of products. The Court rightly awarded temporary injunction in favor of respondents and prevent appellant from identical packaging of products. Golden Thread Industries filed appeal before Sindh High Court which held that there is no

doubt that color per se cannot be trademark, however where colors have been formed into device or devices or where device or devices are used in backdrop of any color combination, trademark as a whole may form distinctive trademark and in this case, though trademarks of appellant “GOLDEN (S)” and “BUTTERFLY” are phonetically and visually quite different and distinct from respondents’ registered trademark “ANCHOR”.

However, when packets are kept side by side, an ordinary purchaser would not be able to distinguish them because identical size of packs in backdrop of yellow color with typical rectangular border running across packing, they would tend to cause confusion in the mind of unwary purchaser. Trademark is not meant to protect rights of right holder only as it is also made to protect consumer to distinguish source of goods and to differentiate between goods/services of one undertaking from goods/services of other undertakings. The Court prevented appellant to use identical packaging to deceive consumer at market place.

In the case of *Hamdard Laboratories (Waqf) Pakistan v. Muhammad Fahim (Hamdard Laboratories (Waqf) Pakistan v. Muhammad Fahim, 2016)*, appellant Hamdard Laboratories (Waqf) Pakistan is registered trademark owner of “Rooh Afza” while respondent Muhammad Fahim is registered trademark owner of “Rooh-e-Samar”. Appellant filed application for grant of temporary injunction against use of identical trademark which was declined by the Court. Hamdard Laboratories (Waqf) Pakistan filed appeal before divisional bench of Sindh High Court consisted of Chief Justice Sajjad Ali Shah and Justice Zulfiqar Ahmad Khan. Sindh High Court held that one could see clear resemblance including identical caps, ribs at bottom of bottle, word “ROOH” as predominant feature of respondent’s label, devices of fruits and placement of wrapper at same place that on appellant’s products thus overall impression left in the mind of unwary purchaser is nearly same thus it is reasonable to grant injunction and prevent respondent to use identical trademark to protect rights of registered trademark owner and to protect consumer.

#### 3.4 Border Measures

TRIPS provisions dealing with border measures are articles 51-60 as per which right holder of trademark should be allowed to make an application in writing administratively or judicially for seizure of suspected counterfeit trademark goods by providing evidence and adequate detail description of goods. The competent authority may ask applicant to provide security/equivalent assurance to protect defendant. The Customs authority is required to give notice of suspension as well as release of counterfeit trademark goods to right holder and give him time at least 10 days to start legal proceedings against importer/owner/consignee of seized counterfeit trademark goods. The competent authority may destruct or dispose of counterfeit trademark goods and may not allow re-exportation of such goods except in exceptional circumstances (TRIPS of 1994).

If the owner of registered trademark suspects that infringed goods are about to arrive in Pakistan through importation of trade, he may apply before the Customs Officer in a written form to treat goods as infringed and the owner of registered trademark must mention time and place of arriving goods. The

owner must furnish undertaking with notice acknowledging if his apprehension is not correct, he would compensate the owner, importer and consignee of goods for their loss and for that purpose he is required to furnish security or an equivalent assurance (Cychosz, 2003).

Complaint against infringed trademark goods are required to be made in accordance with statutory requirements. In case of *Collector of Customs v. Messrs Decent Autos (Collector of Customs v. Messrs Decent Autos, 2015)*, Messrs Reckitt and Colman Limited appointed Messrs Reckitt and Benckiser as its sole agent for import, distribute and sell its products. Mortein brand of insecticide spray being shipped by Reckitt and Colman Overseas to Reckitt and Benckiser Pakistan. Messrs Reckitt and Benckiser issued letter to the Collector of Customs to stop parallel imports of Mortein brand. Matter went to the Appellate Board which held that letter issued by respondent is not in accordance with sections 53-55 of Trade Marks Ordinance 2001. Notice must accompanied by undertaking to indemnify customs authorities and section 54 of Trade Marks Ordinance 2001 states that trademark owner would compensate importer, consignee and the owner of goods in case of damage due to wrongful suspension and customs authority may ask the owner of registered trademark to provide adequate security which would not be as such to deter recourse of border measures under section 55 of Trade Marks Ordinance 2001. Complaint by respondent is out of statutory requirements which are required to be fulfilled. Customs authority cannot invoke section 15 of Customs Act 1969 against complaint made in contradiction with sections 53-55 of Trade Marks Ordinance 2001 hence there is no case of trademark infringement.

Applicant/Complainant is required to submit security but when applicant submits an insufficient security and compensation amount is higher than that, remaining amount is due as debt upon the applicant and may be recovered by the Federal Government of Pakistan as per prescribed procedure under section 202 of Customs Act 1969. The Federal Government of Pakistan is not liable to loss, damage, delay due to seizure, failure to seize or release of goods (Customs Act of 1969 section # 202 and Trainer, 2008).

If the Collector of Customs reasonably believes that there are sufficient grounds to suspect that imported goods are counterfeit trademark goods, he is required to seize them and put them in a secured place. He is required to notify the owner of trademark: identity of goods and provide full name and address of importer. Thereafter, applicant is required to start legal proceedings against importer within 10 days from the day of receiving notice or within such other time as extended by the Collector of Customs otherwise seized goods would be released to importer/consignee/owner of goods (Trade Marks Ordinance of 2001 section # 56-58 and Grossman & Lai, 2004).

Customs authority of Pakistan is required to act against goods bearing counterfeit trademark under section 15 of Customs Act 1969, if there is a prima facie evidence. In the case of *Mian Ziauddin Shaikh v. Federation of Pakistan (Mian Ziauddin Shaikh v. Federation of Pakistan, 2014)*, the Deputy Collector of Customs issued show cause notice to Zia Uddin Sheikh stating goods bearing alleged infringed trademark "Ahmad" would be confiscated followed by penal action. Mr. Ziauddin Shikh filed

writ petition against show cause notice before Sindh High Court asserting that though trademark “Ahmad” is registered with the name of Ahmed Foods Private Limited but he has been authorized importer of goods bearing trademark “Ahmed” for 16 years and Customs Authority do not have right to commence proceedings against him under section 15 of Customs Act 1969. Ahmed Foods Private Limited replied that petitioner’s authority of importation is revoked in 2012.

Petitioner further asserted that respondent is not empowered to revoke his authority of importation as who holds affairs of Ahmed Foods Private Limited is pending question before the Court thus Sindh High Court held that show cause notice issued by customs authority should be withdrawn as there is no prima facie evidence against petitioner thus he should be allowed to import goods bearing trademark “Ahmed”.

The Collector of Customs may release goods if applicant does not start legal proceedings within prescribed time, withdraws legal proceedings, consents in writing that he does not suspect seized goods anymore, legal proceedings have been started and the Court orders for release of seized goods or the Collector of Customs reasonably believes that there is no sufficient ground to believe that goods are infringed goods (Trade Marks Ordinance of 2001 section # 59 and Khan, 2014).

The Court may order release or forfeiture of seized goods, but the Court is not empowered to order exportation of seized goods, removing trademarks which are affixed on counterfeit trademark goods, local sale of seized goods but if the Court decides matter in favor of defendant, orders plaintiff to compensate the owner of seized goods for losses he has suffered due to seizure. If the Court orders for disposal of forfeited goods, the Collector of Customs must not facilitate exportation of seized goods or their local sale or removal of trademark from counterfeit trademark goods which is also prescribed requirement under article 59 of TRIPS (Tanwiri & Qamar, 2011).

After seizure of counterfeit trademark goods, registered trademark owner starts legal proceedings and if decision of the Court is announced in favor of registered trademark owner, he is required to apply for execution of decision within 3 weeks and if the owner of trademark does not apply for execution order of the Court within 3 weeks, the Collector of Customs releases goods to importer/consignee/owner of goods. The Collector of Customs may apply in the Court for retaining control over counterfeit trademark goods if release, disposal or any other action against seized goods is required (Trade Marks Ordinance of 2001 section # 62-63 and Lakshmi & Patro, 2009).

In the case of *Messrs Akhtar Muhammad and Brother v. Haji Muhammad Nabi (Messrs Akhtar Muhammad and Brother through Proprietor v. Haji Muhammad Nabi and Brother, 2011)*, Haji Muhammad Nabi claimed that he has been using trademark “FRUTTI” for a long time thus he has right to use it during trade and no one has right to infringe his trademark right. Akhtar Muhammad started using trademark “FRUTTI” for his product of juice powder. Haji Muhammad Nabi applied against importation of counterfeit trademark goods of Akhtar Muhammad before the Collector of Customs. Application was duly rejected by the Collector of Customs thus appellant Akhtar Muhammad could legally import his product of juice powder under trademark “FRUTTI”. Thereafter, Haji Muhammad

Nabi applied against infringement of his trademark “FRUTTI” before the District Court and prayed for temporary injunction to prevent further infringement of his trademark. The District Court issued interim injunction and ordered to stop Akhtar Muhammad from further usage of trademark “FRUTTI”. Mr. Akhtar Muhammad appealed before Lahore High Court hence the Court dismissed orders passed by the District Court on a ground that trademark “FRUTTI” is registered in favor of Akhtar Muhammad thus importation of goods containing legal registered trademark cannot be stopped and no border measures can be taken against goods containing registered trademark.

The Collector of Customs is eligible to make regulations for notification in respect to process of seizure, forfeiture, disposal and release, require applicant to furnish evidence of his ownership and require applicant to pay fee to cover administrative costs (Trade Marks Ordinance of 2001 section # 66 and Chiang, 2004). Customs authority may ask importer to provide all necessary information about his imported goods. In the case of *Kashif Naseem v. Federation of Pakistan (Kashif Naseem v. the Federation of Pakistan, 2008)*, petitioner Kashif Naseem is an importer of goods, filed writ petition before Sindh High Court against customs authority that his products are protected under IP laws and he is not under obligation to disclose information of his goods. Chief Justice of Sindh High Court Sabihuddin Ahmad and Justice Faisal Arab held that protection of imported goods under IP laws cannot be used as a shield to resort under-invoicing and deprive ex-chequer of customs duties and charges at actual transaction value.

The Court further held that it is the duty of an importer to provide information of his imports so that customs authority may proceed smoothly with their obligation to ascertain actual transaction value. The Court further held that petitioner instead of providing necessary information unduly rushed to the High Court and filed instant petition thus his petition is dismissed, and he is ordered to furnish information to customs authority.

### 3.5 Criminal Procedure

TRIPS provision dealing with criminal procedure of trademark enforcement is article 61 as per which member states are required to apply penalties at least in willful counterfeiting of trademark and occurred on commercial scale. Remedies must include imprisonment, fine, seizure, forfeiture and destruction of infringing goods (TRIPS of 1994).

Apart from adopting administrative and civil procedures of trademark enforcement, an aggrieved party may adopt criminal procedure of trademark enforcement by filing First Information Report (FIR) at the nearest Police Station where offence of trademark infringement is committed. Thereafter, Police Officer is required to start investigation as per procedure prescribed in Code of Criminal Procedure 1898. Later, case is required to be presented before authorized officer and either charge is framed or not and if charge is framed trial would follow and resultantly accused would either be acquitted or be punished as per prescribed provisions of Pakistan Penal Code 1860 (Blakeney, 2009; Khan, 2010; Christopher, 2012).

There is distinction under Pakistan Penal Code 1860 between trademark and property mark. Trademark

is a mark which signifies manufacture or merchandise goods of trade. Property mark is a mark which signifies property of a person. Person uses another person's registered trademark with a purpose to signify it with his manufacture or merchandise goods is an infringer and would be punished with one year imprisonment or fine or both except if he used trademark without intent to defraud however a person counterfeits registered trademark in Pakistan is punishable with imprisonment for 2 years or fine or both but a person counterfeits trademark of a public servant for entitlement of any exemption is punishable with imprisonment for 3 years or fine or both (Pakistan Penal Code of 1860 sections # 478-484 and Gaur, 2009).

Any person possesses things which are used for making counterfeiting mark or possesses counterfeiting mark is punishable with imprisonment for 3 years with fine or both. Any person sells, exposes or possesses goods, having counterfeiting trademark is punishable with imprisonment for 1 year or fine or both except if he acted innocently. Tampering or removing registered trademark from goods/services is punishable offence for 1-year imprisonment or fine or both (Mahmood, 1981; Miceli, 1991).

Sindh High Court held in the case of *Haji Danu Mian Saudagar v. Shaikh Muhammad Idris (Haji Danu Mian Saudagar v. Shaikh Muhammad Idris and Another, 1969)* that a person is considered counterfeiting trademark only when two prerequisite conditions occur: (i) accused use trademark resembling registered trademark for his products as both trademarks are same or of similar description, and (ii) accused intends by that resemblance to practice deception or is saddled with knowledge that while causing resemblance, is likely that deception would thereby be occasioned.

Person is considered an infringer if he uses trademark in the course of trade for goods/services identical with registered trademark, uses registered trademark as his trade name or domain name without prior consent of proprietor, uses any property under infringed trademark without authorization of proprietor/licensee, uses trademark after alteration and obliteration except if he does not have knowledge of fact and he has used trademark in good faith, sells, offers to sell, exposes or takes in possession goods having an infringed trademark except he acted innocently and had reason to believe that it was a genuine trademark or the owner of registered trademark uses some part of his registered trademark he already disclaimed (Trade Marks Ordinance of 2001 section # 40 and Vardag, 2012).

The Supreme Court of Pakistan held in the case of *Mehmood Raza v. the State (Mehmood Raza v. the State, 2006)* that allegations against petitioner Mehmood Raza are that he is not only blending, refining and marking fake oil but also using forged seals, cans, tapes, stickers and trademark having monograms of Pakistan State Oil Company (PSO). Petitioner is not only causing wrongful loss to company but also wrongly gaining from their illegal acts. PSO is directly aggrieved by illegal and wrong act of petitioner. Petitioner deliberately using registered trademark of PSO with fake stickers which amounts to direct threat and attacked on property owned by PSO. In such circumstances, criminal action can be taken under sections 478-486 of Pakistan Penal Code 1860 to protect property and right of PSO. Deliberate violation is punishable under law hence sections 468-469 and 471 of Pakistan Penal Code 1860 are applicable in the instant case as petitioners forged monograms, sticker's, tapes of PSO with an intent to

cause damage or injury which is liable to be punished under relevant provisions of Pakistan Penal Code 1860.

Person cannot be considered an infringer if he uses registered trademark in good faith, registered trademark as his name, name of his predecessor, place of business name or place of predecessor's business name, subject to restrictions prescribed under Trade Marks Ordinance 2001 (Trade Marks Ordinance of 2001 section # 42 and Carmen, 2013).

False trade description, false registry in trademark register, falsely representing trademark as registered and using government emblem and place as Trademark Registry are considered criminal offences under Trade Marks Ordinance 2001 and are dealt as per criminal procedure of trademark enforcement in Pakistan. Any person applies false trade description or makes false entry in the register is punishable with imprisonment for 3 months to 3 years and can also be liable to 50 thousand rupees fine. In case of repeat false trade description offence, imprisonment is for 6 months to 3 years and fine is 1 hundred thousand rupees. Any person falsely represent trademark as registered is punishable with imprisonment for 1 to 6 months and can also be liable to 30 thousand rupees fine (Trade Marks Ordinance of 2001 section # 98-100 and Vardag, 2012).

Using place as Trademark Registry is offence and punishable with imprisonment for 2 years, fine or both. Up to 15% fine can be deducted as compensation for aggrieved party if they have suffered losses due to infringement of trademark. If a person does an abetment of trademark infringement, he may be tried for that offence at any place in Pakistan as if he has done that trademark infringement in Pakistan. Company's head is responsible if trademark infringement is occurred by company and if he is unaware of trademark infringement and other authoritative persons of company like the Secretary or the Manager have done trademark infringement, they are responsible for their offences (Trade Marks Ordinance 2001 section # 101-107 and Christophe, 2012).

In the case of *Riasat Ali v Asad Rafi* (*Riasat Ali v Asad Rafi, 1987*), civil suit about trademarks "POLKA" and "SALVA" is pending adjudication in the Civil Court and matter is also under consideration with the Registrar of trademark at Trademark Registry. Simultaneously, petitioner Riasat Ali was prosecuted by Asad Rafi for counterfeiting trademark "POLKA" and "SALVA" but was acquitted from charges by 1<sup>st</sup> Class Magistrate as per presented evidence. The respondent challenged acquittal order through revision under section 439-A of Criminal Procedure Code 1898 before the Additional Sessions Judge who accepted same hence set aside acquittal order of Riasat Ali and remanded case for fresh decision as per law. Riasat Ali filed petition before Lahore High Court for quashing remand order of the Additional Sessions Judge.

Lahore High Court held that a person is said to use false trademark if he indicates goods, case, package or other receptacle containing goods, case, package or other receptacle in a manner reasonably calculated to cause it to believe that goods so marked, or goods contained in any such receptacle so marked are manufacture or merchandise of a person whose manufacture or merchandise they are not. Lahore High Court further held that respective rights of parties of this case are subject-matter of dispute in the Civil



Court and under consideration before the Registrar of trademark at Trademark Registry hence criminal proceedings before the Magistrate is required to be stayed when administrative proceedings are already going on and civil proceedings are also carried out by the Civil Court.

#### **4. Conclusion and Recommendations**

TRIPS provisions dealing with trademark are articles 15-21 and dealing with enforcement of trademark are articles 41-61 as relevant provisions of Paris Convention are articles 6-9. TRIPS and Paris Convention have been ratified by Pakistan, but ratification of International Treaty and its implementation are two different things. Effective enforcement may take years to achieve by positive steps taken by Pakistan under the light of relevant provisions of TRIPS and Paris Convention for betterment of trademark and its enforcement procedures. Trademark enforcement procedures must be adequate, expedient, and must not be complicate, costly, and time consuming.

Trademark definition is prescribed under section 2 (xxiv) of Trade Marks Ordinance 2001 which does not contain wordings: sign/signs and combination of signs which is there under article 15 of TRIPS, it is therefore recommended that wordings: sign/signs and combination of signs should be added in the definition of trademark under section 2 (xxiv) of Trade Marks Ordinance 2001.

Applicant may apply before Trademark Registry at Karachi/Lahore Pakistan for registration of trademark on prescribed application form providing his details and details of his agent, description of trademark and statement of goods/services for which trademark is required and pay prescribed fee. Trademark Registry only have one branch in Lahore which is not sufficient for a country of more than 200 million people. Therefore, more Trademark Registry branches are required to be established throughout Pakistan for betterment of trademark registration process. Moreover, there is lack of IP Tribunals therefore more IP Tribunals are required to be established throughout Pakistan and more IP experts and examiners in-charge of registration are also required to be hired for betterment of trademark enforcement procedures in Pakistan.

Registered trademark can be opposed within 2 months before the Registrar of trademark after its publication in a prescribed journal. Opposition party is required to send notice of opposition to the Registrar. The owner is required to provide counter statement and opposition is required to give rejoinder. Thereafter, evidences would be recorded before the Registrar and he decides matter finally after giving full opportunity of hearing to parties.

Trademark infringement takes place when unauthorized person uses registered trademark as his own property for exhibition of his goods/services. The owner of registered trademark may take an action against trademark infringement and he can inform infringer about ownership of his trademark, but he cannot threat infringer without adopting due process of law. The owner of trademark may avail civil or administrative procedures for enforcement of his registered trademark and can also take help from provisional and border measures and avail criminal procedure of trademark enforcement for protection of his registered trademark in Pakistan.

The registered trademark owner may institute civil suit at the District Court under section 117 of Trade Marks Ordinance 2001 for claiming damages under section 28 of Trade Marks Ordinance 2001 or for obtaining preventive relief under sections 52-57 of Specific Relief Act 1877. Trademark owner may apply against trademark registration application before the Registrar under sections 28-29 of Trade Marks Ordinance 2001 and may also apply before IP Tribunal under section 15 of Intellectual Property Organization of Pakistan Act 2012. IP Tribunal is required to pronounce its decision within 90 days and appeal against it may be filed before High Court within 30 days under section 19 of Intellectual Property Organization of Pakistan Act 2012. Customs authority may seize counterfeit trademark goods under section 56 of Trade Marks Ordinance 2001 and sections 15-17 of Customs Act 1969. Criminal procedure runs under Code of Criminal Procedure 1898. If accused proved guilty in a trial would be punished under sections 478-489 of Pakistan Penal Code 1860 and sections 98-107 of Trade Marks Ordinance 2001.

TRIPS provisions dealing with trademark are articles 15-21 and dealing with enforcement of trademark are articles 41-61 as relevant provisions of Paris Convention are articles 6-9. TRIPS and Paris Convention have been ratified by Pakistan, but ratification of International Convention and its implementation are two different things as better enforcement of trademark may take years to achieve. Pakistan needs more Trademark Registry branches as only 1 branch for a country of more than 200 million people is not sufficient. More IP Tribunals are required to be established throughout Pakistan for betterment of trademark enforcement procedures. IPO-Pakistan and Trademark Registry are required to appoint and induct more IP experts and examiners in-charge of registration for betterment of trademark enforcement procedures in Pakistan.

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