

## Original Paper

# Provisional Measures of Trademark Enforcement in Pakistan: A Comparative Analysis with Malaysia and USA

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### Abstract

*Trademark is mark, name, sign, smell or a sound distinguishes goods and services of one undertaking from goods and services of other undertakings. It is required to be distinctive and non-descriptive. It loses its distinctiveness when registered owner of trademark does not take prompt action against its infringement. Provisional Measures of trademark enforcement is a measure initiated by the owner of trademark during civil or administrative procedure of trademark enforcement to prevent further counterfeiting of his trademark and to protect evidence he relies upon during civil or administrative procedure of trademark enforcement. Provisional Measures of trademark enforcement in member states of World Trade Organization (WTO) must be expedient, adequate, fair, equitable, and must not be complicated, costly and time consuming. Provisional measures of trademark enforcement is a civil procedure where owner of trademark may ask the Court to prevent counterfeiter from trademark counterfeiting. This study is qualitative method of research a comparative analysis of provisional measures of trademark enforcement in Pakistan, Malaysia and USA. After a comparative analysis of provisional measures of trademark enforcement in Pakistan, Malaysia and USA, it is found that Lanham Trademark Act 1946 is comprehensive trademark law of United States of America (USA) prescribed grounds to grant and refuse to grant injunctions to prevent trademark counterfeiting. It is also found that there is a requirement in Lanham Trademark Act 1946 for a person against whom injunctive relief is passed to submit report in writing about manner and method of compliance with injunction order. These findings are required to be prescribed in trademark law of Pakistan for betterment of provisional measures of trademark enforcement.*

**Keywords**

*intellectual property, trademark, preventive relief, injunction*

**1. Introduction**

Provisional measures of trademark enforcement is very important procedure for effective enforcement of trademark, therefore it is required to be expedient, adequate, equitable, and must not be complicated, costly and time consuming. Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS Agreement) of World Trade Organization (WTO) is the first International Treaty which contains exhaustive enforcement provisions of Intellectual Property (IP) in member states of WTO from articles 41 to 61.

Article 50 of TRIPS Agreement states about provisional measures of trademark enforcement in member states of WTO that the Court of member state may order an injunction when there is a reasonable cause to believe that if injunction is not ordered, it may harm applicant or evidence may be destroyed. The Court of member state may ask plaintiff to provide security or surety before ordering injunction to prevent abuse and to protect defendant. Defendant's right of notice and right of hearing are required to be accorded before pronouncing injunction order and he may also have the opportunity of review upon decision of the Court within prescribed time. If injunction order is overruled on review application of defendant, the Court of member state may order plaintiff to give compensation to defendant for the loss he has suffered. The injunction order may be passed by administrative authority keeping in view principles laid down in TRIPS Agreement.

Injunction is preventive relief applied by the aggrieved party to prevent further harm if case is prima facie in his favor as well as balance of convenience and an irreparable harm will occur if injunction order is not passed by the competent authority. Temporary injunctions are awarded during proceedings for temporary time as permanent injunctions are awarded after final decision of the competent authority to prevent further harm and to protect evidence. Mandatory injunction is order of the competent authority to ask someone to do something which is obligatory upon him or ask him not to do something which he is bound not to perform it.

This research is qualitative method of research a comparative analysis of provisional measures of trademark enforcement in Pakistan, Malaysia and United States of America (USA). Important topics of provisional measures of trademark enforcement discussed in this treatise are (i) injunctions and types of injunctions in Pakistani, Malaysian, and USA laws, (ii) grounds to grant and refuse to grant injunctions in Pakistani, Malaysian, and USA Laws.

## 2. Injunctions and Types of Injunctions in Pakistani, Malaysian, and USA Laws

In Pakistan, Specific Relief Act 1877 deals with matter of injunctions. Aggrieved party of trademark infringement may apply before the Civil Court for obtaining injunctions to prevent further infringement or to protect evidence. Injunction is either temporary for specific time, perpetual for time immemorial or mandatory for directing party to do or refrain to do something (§52-57 Specific Relief Act, 1877; Fiss, 1978).

Purpose of provisional measures is to permit effective and expeditious action against continuous illegal usage of registered trademark and protection of evidence which put light in favor of aggrieved party to prove his plea before the Court. Alleged infringement is that infringement which is not prima facie prove before competent authority as it is in process of proving or disproving. Right holder needs protection for himself and for evidence he relies upon to prove his claim beyond reasonable doubt before competent authority. Hence preventing infringement when there is likelihood that an irreparable harm may be caused to right holder and when there is a clear risk that evidence may be destroyed and to prevent infringed goods to come up during trade after customs clearance (Khan, 2010; Malik, 2010). According to section 46 of Trade Marks Ordinance 2001, an infringement of registered trademark shall be actionable by proprietor of trademark and have all such reliefs by way of damages, injunctions, accounts or otherwise available to the proprietor of trademark as available in respect to infringement of any other property right (s46 Trade Marks Ordinance, 2001; Maker, 2014).

Sindh High court held in the case of *Asian Consumer Care Pakistan Limited v Hilal Foods* that trademark infringement occurs when one party uses trademark that is identical to trademark owned by another party in relation to identical goods or services. Infringement of registered trademark can be addressed by civil litigation and in several jurisdictions under criminal law as well (CLD 2016, Sindh 804).

According to section 40 of Trade Marks Ordinance 2001, a person shall infringe registered trademark if such person uses it during trade a mark which is identical with another trademark in relation to goods or services which are identical with those for which it is registered (s40 Trade Marks Ordinance, 2001). According to section 53 of Specific Relief Act 1877, injunction is either temporary or perpetual. Temporary injunction continues until specified time or until further order of the Court granted at any time of the suit and are regulated by Code of Civil Procedure 1908 (s53 Specific Relief Act, 1877; Busuttil & McCafferty, 2010).

Where it is proved that any property in dispute is in danger of being wasted, damaged, alienated, wrongfully sold, defendant threatens to remove or disposes of his property, the Court may grant temporary injunction to restrain staying and preventing wasting, damaging, alienating, sale, removal or disposition of property. Plaintiff may apply to the Court for temporary injunction to restrain defendant from committing injury complained or breach of contract or injury of like kind arising out of same contract. In case of disobedience or breach, the Court may order property of a person to be attached for not more than 1 year and may also order that person be detained in prison for not more than 6 months.

If disobedience and breach continues, attached property may be sold out and its proceeds be awarded as compensation by the Court (r1-2 o39 Code of Civil Procedure, 1908; Foster, 1986).

An interim injunction passed in absence of defendant shall not ordinarily exceed 15 days except when there is failure of its service on to defendant and when defendant seeks time for defense of application to injunction. In any case, order of injunction shall cease to have effect on expiration of 6 months unless extended by the Court after hearing parties again and for reasons to be recorded for such extension and report be submitted before the High Court. Injunction order passed by the Court may be discharged, varied or set aside by the Court on application made by any party dissatisfied with such order (r4 o39 Code of Civil Procedure, 1908; Rendleman, 1973).

Applicant is required to apply early during civil proceedings before the Court as delay in applying may cause rejection. Sindh High Court held in the case of *Rexona Proprietary Limited v Majid Soap Work* that it is perfectly true that normal delay in applying for temporary injunction is fatal and reasons seems clear if person delays in coming to the Court, he himself confesses that case is not so urgent as to requires interim relief (PLD, 1956 Sindh 1).

Sindh High Court held in another case of *Sindh Madrasatul Islam Board Society v Shamim* that High Court Azad Kashmir held in the case of *Ismail and Other v Faleh Alam and Other*, where temporary injunction is issued ex-parte and notice is issued to opposite party, he has two remedies (i) come up in appeal against order issuing temporary injunction ex-parte, or (ii) apply before the Court issuing temporary injunction under Order 39, Rule 4 of Code of Civil Procedure 1908 and the Court may discharge, vary or set aside injunction (CLC, 1982; Sindh 2242).

According to Order 39, Rule 3, Code of Civil Procedure 1908, the Court may grant ex-parte injunction for 2 to 7 days for default in payment within stipulated time, injunction against the Government, Government servant, statutory authority, board or corporation set up and established by the Government (Thorup, 1984; r3 o39 Code of Civil Procedure, 1908).

According to section 53 of Specific Relief Act 1877, perpetual injunctions can only be granted by decree made at hearing and upon merits of suit. Defendant is thereby perpetually enjoined from assertion of right or from commission of act which would be contrary to rights of plaintiff (s53 Specific Relief Act, 1877; Smoot, 1956).

Plaintiff must prove his claim beyond reasonable doubt to adopt remedy of perpetual injunction. Peshawar High Court held in the case of *Qazi Sallah ul Din and Others v Roman* that plaintiff Roman opted for declaratory decree under section 42 of Specific Relief Act 1877 but failed to prove his possession therefore decree for perpetual injunction could not be granted to him as consequential relief. It is settled law that where plaintiff is not in possession of property, he cannot seek mere declaration of title without asking for possession as consequential relief (CR, 2017 Peshawar 898-P/2009).

In the case of *Syed Zahir Shah v Syed Muhammad Ali Shah Bacha*, facts of the case are that respondent Syed Muhammad Ali Bacha filed suit for declaration and perpetual injunction against Syed Zahir Shah and others to the effect that land falling situated in village Badraga, Tehsil Dargai is inherited by his

father through Mutation in 1946 which later came into the ownership of respondent as ancestral property in 1969. Respondent averred in his plaint that Dower Mutation allegedly executed by grandfather of respondent in favor of Mst. Khaista Bibi being fake, fictitious, illegal and ineffective upon his rights.

The Trial Court accepted contention of respondent and awarded perpetual injunction, which was challenged before Peshawar High Court by petitioner Syed Zahir Shah. Peshawar High Court held that learned counsel for petitioners failed to show any evidence to have been misinterpreted by both the Courts and any evidence in favor of petitioners without proper appraisal. Concurrent findings of both the Courts are based on sound reasons wherein no illegality or irregularity could be pointed out during arguments, hence same cannot be interfered with by this Court in exercise of its jurisdiction of revision. Resultantly, petition of revision in hand, being devoid of force stands dismissed with no order as to costs (YLR, 2017 Peshawar 630).

According to section 55 of Specific Relief Act 1877, the Court may in its discretion grants mandatory injunction to prevent breach of complained obligation and to compel performance of requisite acts (s55 Specific Relief Act, 1877; Klein, 1898).

Sindh High Court held in the case of *M. Sikander Sultan v Masih Ahmed Sheikh* that purpose of trademark 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 would be granted when there is likelihood of damage due to infringement of trademark (CLD, 2003, Sindh 26).

The Supreme Court of Pakistan held in the case of *Muhammad Ashraf v Muhammad Akram* that registration of trademark gives rise to prima facie case, balance of convenience and likelihood of irreparable loss for grant of injunction against infringement of registered trademark (C&TLR, 2015 Lahore 1425).

In Malaysia, application for grant of injunction may be made by any party of proceedings before or after trial by notice of application supported by affidavit. Granting injunctions by the Court is called preventive relief and injunctions include temporary injunctions which are interim stay orders of the Court applicable until specified time mentioned in order or when time is not mentioned until further order of the Court. Temporary injunctions can be awarded at any time of proceedings before the Court. Perpetual injunctions can be granted by the Court at the time of decree upon merits of the case to stop defendant perpetually from asserting right and to stop defendant from doing any other act perpetually. Mandatory injunctions awarded to prevent breach of performance and to stop breach of obligations as well as to compel someone to do or prevent to do some act (ss50-55 Specific Relief Act, 1950; Ahmad & Kamal, 2006).

Where case is of urgency may be made ex-parte and must contain (i) clear and concise statement of facts giving rise to claim, (ii) facts giving rise to application, (iii) facts relied on to justify application ex-parte, (iv) details of given notice to other party, (v) answer by other party, (vi) facts which may lead the Court not to grant application ex-parte, (vii) any similar application made to another Judge, and

(viii) precise relief sought. Interim injunction obtained on ex-parte application shall automatically lapse in 21 days from the date it was granted (r1 o29 ROC, 2012; Cohen, 1991).

According to section 70B of Trade Marks Act 1976, the proprietor of trademark is entitled to restrain use of trademark which or essential part of which is identical with or so nearly resembles with proprietor's trademark in respect of same goods or services and when use is likely to deceive or cause confusion (s70b Trade Marks Act, 1976; McCarthy, 2009).

According to section 50 of Specific Relief Act 1950, injunction is preventive relief which is granted at discretion of the Court temporarily or perpetually. According to section 51 of Specific Relief Act 1950, temporary injunction is granted at any time of suit, regulated by law relating to civil procedure and continues to apply until specified time or until further order of the Court. Perpetual injunction is only awarded at Decree of the case decided by the Court (McKenna, 2007; ss50-51 Specific Relief Act, 1950).

The High Court of Malaya held in the case of *Muhammad Hilman bin Idham v Kerajaan Malaysia* that an order for temporary injunction can be sought only in aid of prospective order for perpetual injunction. If in event of plaintiff's success, he cannot obtain decree for perpetual injunction, it is not competent for him to ask for temporary injunction. Temporary injunction will not be granted in cases where permanent injunction is not available under sections 52-54 of Specific Relief Act 1950 (MLJ, 2011 HC Malaya 565; MLJ, 1968 FC Putrajaya 283).

The High Court of Malaya held in another case between *Tidalmarine Engineering Sdn Bhd v Kerajaan Malaysia* that Specific Relief Act 1950 recognizes distinction between temporary and perpetual injunctions issued by the Court. Judicial views are however divided as to whether temporary injunction or as is commonly referred to interlocutory injunction as opposed to permanent injunction can be issued against government (MLJ, 2011 HC Malaya 400).

According to section 53 of Specific Relief Act 1950, mandatory injunction is granted to (i) prevent breach of obligation, and (ii) compel performance of certain acts (s53 SRA 1950; Dogan, 2010). The High Court of Malaya held in the case of *Jasmine Food Corporation v Leong Wai Choon* that the High Court is clearly empowered and have jurisdiction to grant summary judgment for trademark infringement even if it involves a claim for permanent mandatory injunction (MLJ, 2011 HC Malaya 812).

The Court of Appeal Putrajaya held in the case of *Credit Guarantee Corporation Malaysia v SSN Medical Products* that the Court recognizes force of argument that defendant should not be compelled to apologize against his will as very spirit of apology is that it must come from heart, something which defendant wishes to do because wrong he has done to plaintiff. On other hand, order compelling defendant to merely withdraw or correct offending statement after trial seems to be of different character or genre from that of an apology. In same way that the Court compels defendant to pay damages for defamation, there is no reason or principle why it cannot compel issue of correction. Of course, cases where the Court should think that justice requires grant of mandatory injunction to issue

either letter of withdrawal or correction must be quite exceptional (MLJ, 2017 COA Putrajaya 629).

In USA, according to section 34 of Lanham Trademark Act 1946, the Court vested with jurisdiction of civil actions have powers to grant injunctions as per principles of equity and upon such terms as the Court may deem reasonable to prevent violation against rights of registered trademark owner. The Court in which civil infringement proceedings is instituted can pass injunction against infringer and require him to file report in writing under oath, manner and form of compliance order of injunction within 30 days. In case if defendant does not comply with order on injunction, plaintiff may file contempt of court application against him (s34 Lanham Trademark Act, 1946; s1116 USC, 1926).

This type of requirement should be added in provisional measures under trademark law of Pakistan where alleged infringer should be required to submit a report in writing under oath within 30 days about manner and method of compliance order of injunction announced by the Court otherwise contempt of court proceedings could be commenced against him.

In case of civil action with respect to violation consists using counterfeit trademark for sale, offer to sale or distribution of goods or services, the Court may grant injunction order upon ex parte application for seizure of goods and counterfeit trademarks involved in such violation and means of making such trademarks, records documenting manufacture, sale or receipt of things involved in such violation. Application must base on affidavit consisted of (i) verified complaint establishing facts sufficient to support findings of fact and conclusions of law required for such injunction order, (ii) description of matter to be seized and description of place at which such matter is to be seized, (iii) time period which shall end not later than 7 days after the date on which such order is issued, (iv) amount of security required to be provided by applicant, and (v) date for hearing parties (Cohen, 1991).

The Supreme Court of United States held in the case of *Park N' Fly Incorporation v Dollar Park and Fly Incorporation* that power of the Court under section 34 of Lanham Trademark Act 1946 is to grant injunctions as per principles of equity which does not encompass substantive challenge to validity of incontestable trademark on grounds that it lacks secondary meaning. Otherwise, meaning of equity would be expanded to point of vitiating more specific provisions of Lanham Trademark Act 1946 (469 US 185, 1985).

The United States Court of Appeal for the Sixth Circuit held in the case of *Tandy Corporation v Malone & Hyde Incorporation* that substantive and remedial doctrines of trademark law draw upon legal principles developed both at law and in equity. Although trademark litigation began as early as 1600's as law of trademark did not undergo significant development until 19<sup>th</sup> Century when use of trademarks increased to symbolize and market products created need for defining and protecting owners' rights (769 F.2d 362, 1985).

According to section 34 of Lanham Trademark Act 1946, injunctive relief is allowed as per principles of equity. Both equity and law courts decided trademark cases in England during early stages of trademark development, but equitable principles seem to have dominated that process because injunctive relief was generally considered first and most effective step for courts to take in redressing

trademark infringement. American Courts also stressed equitable relief and principles in their responses to trademark disputes. Prior to statutory protection for trademarks, Courts determined rights and liabilities primarily based on equitable theory, treat damages portion of such suits as an equitable action in nature of accounting consistent with the history of trademark law.

### 3. Grounds to Grant and Refuse to Grant Injunctions in Pakistani, Malaysian, and USA Laws

General grounds to grant and refuse to grant injunctions are prescribed in Pakistan under Specific Relief Act 1877 and in Malaysia under Specific Relief Act 1950 which are almost the same. Contrary to Pakistani and Malaysian laws, specific grounds to grant and refuse to grant injunctions in trademark infringement matters are prescribed in USA under section 43 of Lanham Trademark Act 1946.

In Pakistan, according to section 54 of Specific Relief Act 1877, the Court would award perpetual injunction when (i) there is a need to prevent breach of obligation arisen from contract existing in favor of applicant whether expressly or by implication and defendant invades or threatens to invade plaintiff's right, (ii) defendant is trustee of property for plaintiff, (iii) there exists no standard for ascertaining actual damage caused or likely to be caused by invasion, (iv) invasion is such that pecuniary compensation would not afford adequate relief, (v) it is probable that pecuniary compensation cannot be acquired for invasion, and (vi) injunction is necessary to prevent multiplicity of judicial proceedings (s54 Specific Relief Act, 1877; McLeod, 2005).

Sindh High Court held in the case of *M/s Maxim Advertising Company Private Limited v Province of Sindh* that no injunction can be issued unless all required ingredients including prima facie case, balance of convenience and irreparable loss to aggrieved party were found to subsist. Irreparable loss would mean and imply such loss which is incapable of being calculated on yardstick of money. Contracts involving collection of monetary benefits having been obtained on specific monetary consideration, could not involve irreparable loss (MLD, 2007; Sindh, 2019).

Sindh High Court held in another case between *Shahzad Trade Links through sole Proprietor v Mtw Pak Assembling Industries Private Limited* that relief of injunction is discretionary and is to be granted by the Court as per sound legal principles of justice. Existence of prima facie case is to be judged or made out based on material evidence on record at time of hearing injunction application and such evidence of material should be of nature that by considering same, the Court should or ought to be of the view that plaintiff applying for injunction was probably to succeed in suit by having decision in his favor. Prima facie case is not specifically defined in Code of Civil Procedure 1908. Judge made law or consensus is that to satisfy existence of prima facie case, pleadings must contain facts constituting existing right of plaintiff and its infringement at hands of opposite party.

The Court held that balance of convenience means if an injunction is not granted and suit is ultimately decided in favor of plaintiff, inconvenience caused to plaintiff would be greater than that would be caused to defendant if injunction is granted. It is for plaintiff to show that inconvenience caused to him would be greater than that which may be caused to defendant. Irreparable loss would mean and simply



such loss which is incapable of being calculated on yardstick of money (CLC, 2016, Sindh 83).

According to section 56 of Specific Relief Act 1877, interim, perpetual or mandatory injunctions would not be granted if (i) plaintiff applies for stay of pending judicial proceedings except if restraint is necessary to prevent multiplicity of judicial proceedings, (ii) restraint person to apply before any legislative body, (iii) interfering in public duties of the Federal, Provincial or Foreign Governments, (iv) stay of proceedings in any criminal matter, (v) preventing breach of contract, (vi) performance of which would not be specifically enforced, (vii) preventing ground of nuisance when it is not reasonably clear whether it is nuisance or not, (viii) prevent continuing breach in which applicant has acquiesced, (ix) when equally efficacious relief can certainly be obtained by any other usual mode except in breach of trust, (x) when conduct of applicant or his agent is as such to disentitle him to assist the Court, or (xi) applicant has no personal interest in the matter (s56 Specific Relief Act, 1877; Smith, 1987).

Sindh High Court held in the case of *Sayyid Yousaf Husain Shirazi v Pakistan Defense Officers' Housing Authority* that injunction is writ framed as per circumstances of case commanding an act which the Court regards as essential to justice or restraining as act which it esteems contrary to equity and good conscience. An injunction is an equitable remedy and accordingly conform well-known Law of Equity maxim that "he who seeks equity must do equity". Law as contained in Specific Relief Act 1877 is governed by this principle, therefore, plaintiff asks for an injunction must be able to satisfy the Court that his own acts and dealings in matter have been fair, honest and free from any taint or illegality. If in dealing with person against whom he seeks relief has acted in unfair and un-equitable manner, he cannot obtain this relief (MLD, 2010 Sindh 1267).

In Malaysia, according to section 52 of Specific Relief Act 1950, perpetual injunction can be granted at time of decree on merits of the case by the Court when (i) preventing breach of expressed or implied obligation which is in existent in favor of plaintiff through contract, (ii) defendant is trustee of property of plaintiff, (iii) damage of an invasion cannot be ascertained, (iv) pecuniary relief of damages is not adequate, (v) pecuniary compensation cannot be granted, or (vi) injunction is required to prevent multiplicity of legal proceedings (Mohamed, 2016).

The High Court of Malaya stated in the case of *Jothi Impex Sdn Bhd v Yashree Store Sdn Bhd* that purpose of injunction is to protect plaintiff against injury by violation of his right for which he could not be adequately compensated in damages recoverable in action if uncertainty were resolved in his favor during trial. The Court must determine balance of convenience unless material available to the Court fails to disclose that plaintiff has real prospect of succeeding in his claim for permanent injunction at trial. The Court should go on to consider whether balance of convenience lies in favor of granting or refusing to grant preventive relief (MLJ, 2006 HC Malaya 742).

Governing principle is that the Court should first consider whether plaintiff succeeds at trial in establishing his right to permanent injunction, he would be adequately compensated by an award of damages for loss he would have sustained as result of defendant's continuing to do what was sought to be enjoined between time of application and time of trial. If damages would be adequate remedy and

defendant would be in financial position to pay them, no injunction should normally be granted. If damages would not provide an adequate remedy to plaintiff in event of his succeeding at trial, the Court should consider whether defendant were to succeed at trial in establishing his right to do that which was sought to be enjoined. He would be adequately compensated under plaintiff's undertaking as to damages for loss he would have sustained by being prevented from doing so between time of application and time of trial.

The High Court of Malaya gave reference of House of Lord case between *American Cyanamid Company v Ethicon Limited*, that based on salutary principles established by House of Lords in *American Cyanamid Company v Ethicon Limited*, it becomes duty of the Court to consider following matters when deciding grant of injunction (i) whether there are any bona fide serious questions to be tried, (ii) balance of convenience lies, (iii) damages an adequate remedy for plaintiff in circumstances, (iv) plaintiff has given adequate undertaking as to damages, and (v) there has been full and frank disclosure of all material facts on plaintiffs' part (1975 AC 396).

According to section 54 of Specific Relief Act 1950, temporary, perpetual or mandatory injunctions can be refused if (i) required to stay judicial proceedings except if required to stop multiplicity of judicial proceedings, (ii) required to stop judicial proceedings pending before the Court, (iii) required to stop any person to apply before any legislative body, (iv) required to stop public authorities of Malaysian government to perform their public duties, (v) required to stay criminal proceedings before the Court, (vi) required to prevent breach of contract whose performance is not specifically enforced, (vii) required to stop nuisance when it is not clear whether it comes under definition of nuisance or not, (viii) required to prevent continuing breach of contract, or (ix) any other effective relief available to be obtained through normal procedure of law except in case of breach of trust, required to disentitle applicant or his agent to assist the Court or personal interest of applicant is not attached with the matter (s54 Specific Relief Act, 1950; Kandiah, 2004).

The Court of Appeal Kuala Lumpur held in the case of *Keet Gerald Francis Noel John v Mohd. Noor bin Abdullah* that judge hearing application for granting injunction should ask himself whether (i) totality of facts presented before him disclosed bona fide serious issue, (ii) identify issues raised whether they are serious enough to merit a trial, (iii) found that raised issue requires further investigation, (iv) consider where justice of case lies, (v) consider all relevant matters including practical realities of case before him. The judge must have in forefront of his mind that remedy he is asked to administer is discretionary, intended to produce just result for period between date of application and proper trial and to maintain status quo. It is a judicial discretion capable of correction on appeal. A judge should briefly set out in his judgment several factors that weighed in his mind when arriving at his conclusion (MLJ, 1995 COA KL 193).

The Supreme Court held in the case of *Tinta Press Sdn Bhd v Bank Islam Malaysia Bhd*, that discretionary power of the Court to grant injunction is prescribed under Specific Relief Act 1950. Power is extended to grant of mandatory injunction before trial. Such discretion must be exercised, and

an injunction should be granted only in exceptional and extremely rare cases. Case must be unusually strong and clear. The Court must feel assured that similar injunction would probably be granted during trial on ground that it would be just and equitable that plaintiff's interest be protected by immediate issue of an injunction, otherwise irreparable injury and inconvenience would result (MLJ, 1987 SCKL 192).

In USA, the owner of famous trademark has a right to obtain injunctive relief from the Court against infringement of his legitimate right. Trademark is famous when it is recognized by public in USA. The Court while awarding preventive relief is required to take into consideration requisite degree of trademark recognition by considering duration, extent, geography, advertisement, publicity, amount volume and geographic extent of sale of goods or services protected under trademark and entry of registration whether in principal register, supplemental register or registered under previous enactments of trademark in USA (Bible, 1995).

This is very important development made under Trademark Dilution Act in 1995, while deciding injunctive relief application, the Court is required to consider degree of trademark recognition, entry of trademark registration, duration, extent, geography, advertisement and publicity of trademark, as well as amount, volume and geographic extent of sale of goods or services. It is therefore recommended that this type of requirement should be added in trademark law of Pakistan and Malaysia for betterment of provisional measures of trademark enforcement.

To claim injunctive relief before the Court, applicant is required to prove prima facie trademark infringement and for proving trademark infringement, plaintiff must prove ownership of valid trademark, likelihood of confusion between registered trademark and alleged infringing use by defendant and an irreparable loss will occur to applicant if injunction is not granted. In the case of *TY Incorporation v Jones Group Incorporation*, the Court held that plaintiff Toy Company sought preliminary injunction in its trademark infringement claim against defendant. Plaintiff had better than negligible chance to prove its trademark was not generic because plaintiff prevented other competitors from using trademark. Plaintiff had not used trademark generically and dictionary definition of trademark and media's use of term indicated it was not generic (LLC 17-C7872 USDC).

Plaintiff's use of trademark combined with widespread publicity high sales volume and result of plaintiff's consumer survey clearly rendered chances of establishing that name had acquired secondary meaning better than negligible. Weighing necessary factors, plaintiff had better than negligible chances of showing likelihood of confusion with defendant's product. Since plaintiff established had a better than negligible chance of success on merits, had no adequate remedy at law, and would suffer an irreparable injury in absence of preliminary injunction, therefore preliminary injunction was issued.

In another case between *Coca Cola Company and Others v William S. Purdy and Others*, defendants William S. Purdy and Others registered over 60 internet domain names that incorporated plaintiffs' famous trademarks. Websites for domain names displayed content that did not originate from and was not sponsored by plaintiffs including color pictures that purported to be dismembered aborted fetuses

and links to fund-raising appeals. Defendants sought to permanently enjoin plaintiffs from using domain name that incorporated was identical to and confusingly like plaintiffs' famous protected trademark. The Court granted plaintiffs' motion and issued permanent injunction while referring to reasoning in its prior orders and the Court of Appeals' opinion, which were analyzed on strength of plaintiffs' claim. Additionally, the Court found that plaintiffs are entitled to relief on their trademark infringement claim as there is likelihood of confusion between registered trademarks and alleged infringing use by defendants (U.S. Dist. LEXIS, 1226).

#### 4. Conclusion and Recommendations

Provisional measures can be acquired by registered trademark owner in Pakistan, Malaysia and USA to acquire injunctive relief to prevent further infringement of registered trademark and to protect evidence which would be beneficial to prove his claim before competent authority. The Court while ordering injunctive relief is required to consider recognition, registration, duration, extent, geography, advertisement and publicity of trademark as well as amount, volume and geographic extent of goods or services. A person against whom injunctive relief is passed by the Court, is required to submit written report under oath within 30 days about manner and method of compliance with injunctive order of the Court, otherwise registered trademark owner may start contempt of court proceedings against him as per prescribed provision of Lanham Trademark Act 1946. These requirements should be added in trademark law of Pakistan for better implementation of provisional measures of trademark enforcement.

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