

Original Paper

Civil Procedure of Trademark Enforcement in Pakistan: A Comparative Analysis with Malaysia and USA

Sohaib Mukhtar^{1*}, Zinatul Ashiqin Zainol¹ & Sufian Jusoh²

¹ Faculty of Law, National University of Malaysia, Bangi, Malaysia

² Institute of Malaysian and International Studies, National University of Malaysia, Bangi, Malaysia

* Sohaib Mukhtar, Faculty of Law, National University of Malaysia, Bangi, Malaysia

Received: February 18, 2019

Accepted: March 6, 2019

Online Published: April 3, 2019

doi:10.22158/jar.v3n2p95

URL: <http://dx.doi.org/10.22158/jar.v3n2p95>

Abstract

Civil procedure of trademark enforcement runs in Pakistan under Trade Marks Ordinance 2001, Code of Civil Procedure 1908 and Specific Relief Act 1877. Trademark is one of the components of Intellectual Property Law, it is a mark, name, sign, smell or a sound which distinguishes goods and services of one undertaking from goods and services of other undertakings. It is required to be distinctiveness and non-descriptive, it loses its distinctiveness when owner of registered trademark does not take prompt action against its infringement. The registered trademark owner may file civil suit against infringement of his registered trademark before the concerned District Court of Law for claiming damages and obtaining injunctions. The Trademark Registry works under Intellectual Property Organization of Pakistan (IPO-Pakistan) for registration and protection of trademarks in Pakistan. Similarly, Intellectual Property Corporation of Malaysia (MyIPO) is empowered agency of trademark registration and its protection in Malaysia. The United States Patent and Trademark Office (USPTO) is responsible for registration and protection of trademarks in United States of America (USA). Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS Agreement) is the only International Treaty which contains exhaustive provisions on trademark enforcement includes civil procedure, administrative procedure, criminal procedure, provisional and border measures. Important civil procedure of trademark enforcement issues need to be clarified in trademark law of Pakistan includes trademark infringement, trademark dilution and rectification of trademark register. This article is comparative analysis of civil procedure of trademark enforcement in Pakistan, Malaysia and USA.

Keywords

intellectual property, trademark, Trade Marks Ordinance 2001, Trade Marks Rules 2004, Code of

*Civil Procedure 1908, Specific Relief Act 1877***1. Introduction**

Civil procedure of trademark enforcement is required to be conducted in Pakistan under provisions of the Code of Civil Procedure 1908 and injunctions may be obtained under provisions of the Specific Relief Act 1877. The main special law of trademark in Pakistan is the Trade Marks Ordinance 2001, there under the Trade Marks Rules are made in 2004. Moreover Intellectual Property Organization of Pakistan (IPO-Pakistan) empowered under Intellectual Property Organization of Pakistan Act 2012. Trademark is one of the component of Intellectual Property Law, it 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 distinctiveness and non-descriptive, it losses its distinctiveness when owner of the registered trademark does not take prompt action against its infringement. The registered trademark owner may file civil suit against infringement of his registered trademark before the concerned District Court of Law for claiming damages, obtaining injunctions and compensation in Pakistan, Malaysia and USA. Appeal against decision of the District Court is required to be filed before the concerned High Court in Pakistan and Malaysia and before the United States Court of Appeal for the Federal Circuit in the United States of America (USA).

The Trademark Registry works in Karachi, Pakistan for registration and protection of trademarks in Pakistan under IPO-Pakistan which have been conducting its business under provisions of the Intellectual Property Organization of Pakistan Act 2012. The Intellectual Property Corporation of Malaysia (MyIPO) is responsible for registration and protection of trademarks in Malaysia and the United States Patent and Trademark Office (USPTO) is responsible for registration and protection of trademarks in United States of America (USA).

There is a Trademark Trial and Appeal Board at United States Patent and Trademark Office (USPTO) in USA where an appeal against decision of the Registrar of trademark may be filed before adopting judicial procedure of trademark enforcement thus it is recommended that the Trademark Trial and Appeal Board should be formed at the Trademark Registry in Pakistan for saving time of the Court of Law and parties. Furthermore, there is a requirement in USA under the Trademark Act 1946 that an accused infringer is required to file a written notice on oath about method and manner of implementation of injunction order of the Court of Law within 30 days thus this kind of requirement should be added in the trademark law of Pakistan for better enforcement of injunctive orders of the Court of Law which is important part of civil procedure of trademark enforcement. It is pertinent to mention here that if the accused infringer does not file or fails to file a written notice within 30 days, the registered trademark owner may start contempt of court proceedings against him before the concerned Court of Law.

Furthermore, there is a concept of trademark dilution in USA under the Trademark Act 1946 which states that infringement occurs when it impairs distinctiveness of the registered trademark which is

called dilution by blurring and infringement occurs when it harms reputation of the registered trademark which is called dilution by tarnishment. These concepts should be added in the trademark law of Pakistan.

There is a need of many specialized Intellectual Property Tribunals where specialized judges on Intellectual Property would be appointed which would help to protect trademark rights in a better way in Pakistan and which would save time and money of the people as they would be required to give decisions within 90 days.

2. Literature Review

Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS Agreement) is the only International treaty on Intellectual Property which contains exhaustive provisions on enforcement of intellectual property. TRIPS Agreement enforcement provisions include civil procedure, criminal procedure, administrative procedure, provisional and border measures. Commentaries of TRIPS Agreement are compiled by Antony Taubman, Hannu Wager, and Jayashree Watal (Taubman, Wager, & Watal, 2012), Daniel Gervais (Gervais, 2012), Peter Tobias Stoll, Jan Busche, and Katrin Arend (Stoll, Busche, & Arend, 2009), they illustrated provisions of TRIPS Agreement stating that relevant provisions of TRIPS Agreement dealing with trademark generally state that trademark is a sign capable to distinguish goods and services of one undertaking from goods and services of other undertakings. Intended use and nature of goods and services would not become obstacle in registration of trademark. Publication would take place before or after registration and if party fails to maintain usage for continuous 3 years, registration would be cancelled. Trademark owner may assign trademark with or without transferring his whole business with it. Term of protection for registered trademark at least 7 years and renewable indefinitely after expiration of initial time.

TRIPS Agreement relevant provisions dealing with enforcement procedures of trademark specifically including civil, administrative, and criminal procedures, provisional and border measures state that enforcement of IP right is one of the part of enforcement of law in general and there is no requirement to separate them and to create special resources for enforcement of IP rights. Legitimate trade is required to be encouraged through adequate procedures of enforcement by discouraging abuse against it. Enforcement procedures of trademark must be fair, equitable, adequate, and expedient, must not be complicated, costly and time consuming (Article 41, TRIPS Agreement 1994).

TRIPS Agreement states about civil procedure of trademark enforcement that member states of WTO must provide opportunity of civil proceedings to right holder and defendant has right of notice before legal proceedings which must be made within a suitable time and contains adequate details based on claim. Personal appearances of parties must not be obligatory, and they may be represented through independent lawyers and present evidences. Trade of imported goods are required to be protected by preventing infringement of IP and infringer is required to pay damages to right holder as compensation for injury caused due to his infringement and he may also be required to pay expenses of attorney's fee

and profits generated through trademark infringement. Infringed goods may be disposed of or destroyed without causing injury to right holder if it is not contrary to provisions of the Constitution of member state (Articles 42 to 48, TRIPS Agreement 1994).

3. Trademark Infringement

Trademark infringement is unauthorized usage of registered trademark on goods or services at market place for trade and that infringement causes likelihood of confusion to consumer. Trademark infringement occurs when one party uses trademark which is similar to trademark owned by other party in relation to identical goods or services. Trademark owner can file a civil suit before the Court against infringement of his registered trademark. Trademark owner cannot bring infringement proceedings for claiming damages if his trademark is not registered. Instead, the owner of trademark may be able to commence proceedings under common law for passing off, misrepresentation or under a law prohibiting unfair business practices for claiming preventive relief (Corgill, 1996; McChesney, 1992).

In Pakistan, relevant section for trademark infringement suit before District Court is section 117 of Trade Marks Ordinance 2001 which provides that *No suit for the infringement of a trademark or otherwise relating to any right in a trademark shall be instituted in any court inferior to a District Court having jurisdiction to try the suit* (Section 117, Trade Marks Ordinance 2001).

According to section 117 of Trade Marks Ordinance 2001, no suit of trademark infringement or otherwise relating to any right in trademark shall be instituted in any court inferior to the District Court having jurisdiction to try it. Section 116 of Trade Marks Ordinance 2001 states that if proceedings relating to registered trademark is pending before the District Court or the High Court, application related to it may be made to that Court in which matter is pending and in case matter is pending before the Registrar, application is required to be made before the Registrar and he may refer application to the Court if so required (Sections 116, 117, Trade Marks Ordinance 2001; Hussain, 2011).

Section 40 of Trade Marks Ordinance 2001 states that a person shall infringe registered trademark if such person uses trademark during trade which is identical with trademark in relation to goods or services which are identical with those for which it is registered (Section 40, Trade Marks Ordinance 2001; Rierison, 2008).

The Supreme Court of Pakistan held in the case of *Messrs Mehran Ghee Mills Private Limited v Messrs Chiltan Ghee Mill Private Limited*, in this case, question was whether there has been an infringement of trademark or not is to be decided by comparing and placing two trademarks together and determining their similarities and distinctiveness (*Messrs Mehran Ghee Mills Private Limited v Messrs Chiltan Ghee Mill Private Limited*, 2001).

The Court held that if two trademarks are identical, infringement is established. Therefore, no further probe is required. Essential features of trademarks shall be considered for effectively deciding issue of infringement. To constitute infringement, it is not necessary that whole trademark be adopted, infringement would be complete if one or more dominating features of trademark are copied. If there is

striking resemblance, it would lead towards conclusion that trademark is infringed (*Vifor International Incorporation through Authorized Signatory v Me'mon Pharmaceutical through Sole Proprietor*, 2013).

The Sindh High Court held in the case of *Asian Consumer Care Pakistan Private Limited v Hilal Foods Private Limited*, that trademark infringement occurs when one party uses trademark that is identical to trademark owned by another party in relation to products or services which are identical to products or services of another party. Infringement of registered trademark can be addressed by civil litigation (*Asian Consumer Care Pakistan Private Limited v Hilal Foods Private Limited*, 2016).

When civil legal proceedings for infringement of registered trademark is brought in Pakistan with the name of more than one person, proceedings cannot undergo except if other co-owners are made plaintiffs or defendants in it and the co-owner not participated in legal proceedings would not be held liable to pay costs in action (Section 24, Trade Marks Ordinance 2001; Halbert, 2000).

Trademark infringement remedies are prescribed under section 46 of Trade Marks Ordinance 2001 which provides that: (1) *Save as otherwise provided in this Ordinance, an infringement of a registered trademark shall be actionable by the proprietor of the trade mark.* (2) *In an action for infringement all such relief by way of damages, injunctions, accounts or otherwise shall be available to the proprietor of the trademark as is available in respect of the infringement of any other property right.* (3) *Nothing in this Ordinance shall be deemed to affect rights of action against any person for passing off goods as the goods of another person or services as services provided by another person, or the remedies in respect thereof* (Section 46, Trade Marks Ordinance 2001).

According to section 46 (2) of Trade Marks Ordinance 2001, in case of an action for trademark infringement all such reliefs by way of damages, injunctions, accounts or otherwise shall be available to the proprietor of trademark as is available in respect to infringement of any other property right.

The owner can take civil legal action against infringer and would have all remedies prescribed under Trade Marks Ordinance 2001, e.g., damages, injunctions, accounts or otherwise. When an application is made for infringement, the Court shall 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 infringed trademark to such authority for erasure, removal, obliteration or destruction. Moreover, the Court may direct infringer to hand over material to the owner of trademark if the owner of registered trademark applies for occupation of infringed material within 3 years (Sections 46 to 48, Trade Marks Ordinance 2001; Wang, 2008).

The owner of trademark may apply for order of the Court handing over infringed material to him or to some authorized person within 3 years in case of infringing goods or material from the date of application of trademark infringement and in case of an infringed article from the date when it was made. Limitation time of 3 years does not apply if the owner has disability or he is not aware of the fact due to fraud or concealment. With order of destruction or feature of infringed goods, the Court may order compensation to the owner or to licensee if it thinks reasonable for protection of their interests

and if authorized user suffers loss due to civil legal proceedings of trademark infringement taken by the proprietor, authorized user has a right to obtain pecuniary relief (Clause 14, 2nd Schedule, Trade Marks Ordinance, 2001). No trademark owner is eligible to threaten anyone upon his trademark, but mere information of trademark registration is not threat and if threat is made, aggrieved party may apply in the Court for declaration, injunction or damages (Sections 50 to 52, Trade Marks Ordinance 2001; Baroncelli, Krivonos, & Olarreaga, 2007).

One of the purposes of civil proceedings is to obtain injunctions to prevent further infringement and to protect evidence which is either temporary for specified time or perpetual for immemorial time and mandatory for preventing breach of obligation (Sections 52 to 57, Trade Marks Ordinance, 2001).

Registered users and licensees are not authorized to take legal action without informing registered proprietor of trademark except for a temporary relief where registered users and licensees may apply and proceed civil proceedings without informing and adding the proprietor (Clause 12, 1st Schedule, Trade Marks Ordinance, 2001; Nathanson, 1956).

In Malaysia, Trade Marks Act 1976 governs infringement proceedings for trademark. Section 38 of Trade Marks Act 1976 provides that: (1) *A registered trademark is infringed by a person who, not being the registered proprietor of the trademark or registered user of the trademark using by way of permitted use, uses a mark which is identical with it or so nearly resembling it as is likely to deceive or cause confusion in the course of trade in relation to goods or services in respect of which the trademark is registered in such a manner as to render the use of the mark likely to be taken either—(a) as being use as a trademark; (b) in a case in which the use is use upon the goods or in physical relation thereto or in an advertising circular, or other advertisement, issued to the public, as importing a reference to a person having the right either as registered proprietor or as registered user to use the trademark or to goods with which the person is connected in the course of trade; or (c) in a case in which the use is use at or near the place where the services are available or performed or in an advertising circular or other advertisement issued to the public, as importing a reference to a person having a right either as registered proprietor or as registered user to use the trade mark or to services with the provision of which the person is connected in the course of trade* (Section 38, Trade Marks Act 1976).

According to section 36 of Trade Marks Act 1976, registered trademark is infringed when it is used by a person who is not registered proprietor or user and does not use it by way of permitted use, uses trademark which is identical with or so nearly resembles as it likely to deceive or causes confusion during trade in relation to goods or services in respect of which trademark is registered. Infringement of trademark occurs when infringer uses identical trademark as registered trademark upon goods or services in physical relation thereto in an advertising circular in other advertisement issues to public (Section 38, Trade Marks Ordinance, 2001; Noerhadi, 2011).

In the case of *Oriental Motolite Marketing Corporation v Syarikat Asia Bateri*, plaintiff Oriental & Motolite Marketing is a company in Philippines to produce automotive batteries and trading it with

trademark “MOTILITE” since 1950. Plaintiff Oriental Motolite Marketing Corporation has been selling its products in Malaysia through defendant Syarikat Asia Bateri since 2000. Both parties signed deed of assignment by which all rights and interests of defendant in “MOTIOLITE” trademark are assigned to plaintiff. Parties signed memorandum of understanding by which defendant is appointed as local distributor of plaintiff in Malaysia for 5 years and continue to be in his position if distributorship agreement is signed afterwards between them. Thereafter, distribution agreement was not solemnized and defendant continued to distribute batteries with trademark “MOTIOLITE” which is the registered trademark of plaintiff *Oriental Motolite Marketing Corporation*. Plaintiff filed civil suit of trademark infringement before the Court where infringement claim proved in his favor with costs (*Oriental & Motolite Marketing Corp v Syarikat Asia Bateri Sdn Bhd*, 2012).

Section 82 of Trade Marks Act 1976 states that no person is entitled to initiate action to prevent or to recover damages for infringement of his unregistered trademark except right of action against any person for passing off goods or service of another and remedies in respect thereof (Section 82, Trade Marks Act, 1976; Huang, 2007).

In the case of *Plastech Industrial Systems v N & C Resources*, plaintiff Plastech Industrial System is manufacturer of plastic foam and defendant N & C Resources is also manufacturing plastic products. Defendants 2, 3 and 4 left plaintiffs and joined defendant N & C Resources in 2009. Defendants used confidential information of plaintiff and make similar kind of products for trading it at market place. Plaintiff filed claim of infringement and passing off. The Court held that act of defendants may damage good will of plaintiff by loss of sale at market place hence it is a clear-cut case of passing off in favor of plaintiff (*Plastech Industrial Systems Sdn Bhd v N & C Resources Sdn Bhd & Ors*, 2012).

Section 40 of Trade Marks Act 1976 states that trademark infringement does not occur if trademark is: (i) used as own name or name of business place in good faith, (ii) used by a person describing character and quality of goods or services in good faith, (iii) used of trademark for business purposes from an immemorial time, (iv) part usage of trademark with prior permission of trademark proprietor or user, (v) usage necessary to indicate facts that goods or services are adopted, or (vi) usage of trademark which is serious of registered identical trademarks (Section 40, Trade Marks Ordinance, 2001; Wolter, 2016).

Apart from trademark infringement proceedings by registered trademark owner, common law marks and well known marks are also protected without registration under International Convention in common law countries. In the case of *PELITA Samruda Pertama v Venkatasamy a/l Sumathiri*, appellant PELITA is the owner of hotel and has right to sale food and related things at its premises under trademark PELITA as well as PELITA oil lamp a common law trademark which is protected under International Convention. The Respondent Venkatasamy applied for registration of same trademark PELITA before the Registrar of trademark. The owner of PELITA replied on application of respondent before the Registrar of trademark that he already has ownership of trademark PELITA, but the Registrar rejected his contention and registered subsequent application of PELITA in favor of respondent. Appellant filed appeal before the High Court against decision of the Registrar and

contended that registration of subsequent trademark PELITA causes confusion and deception at market place and it damages goodwill and reputation of appellant. The High Court held that this case is a clear-cut case of common law mark protection under International Convention and Malaysia is a common-law country thus case is decided in favor of appellant with costs RM 10,000/- and the Registrar is directed to expunge entry of respondent from trademark register (*PELITA Samruda Pertama v Venkatasamy a/l Sumathiri*, 2012).

In a case between *Yong Sze Fun & Anor v Syarikat Zamani Hj Tamin*, Mr. Hj. Mohd Tamin bin Wahi used trademark "TAMIN" in 1951 for sale of his food products which was later on taken by plaintiffs as per decision of the Registrar in favor of Yong Sze Fun. Defendant Syarikat Zaman Haji Tamin used same trademark "TAMIN" for sale of their food products. The plaintiff applied before the Court against use of identical trademark "TAMIN" by defendant. The defendant counter claimed against plaintiff and stated that the Enforcement Division under the Ministry of Domestic Trade and Consumer Affairs raided on premises of plaintiff and seized products.

The High Court held that "TAMIN" is well known trademark associated with defendant and plaintiff did not have right to apply for identical trademark therefore the Registrar wrongly registered trademark "TAMIN" in favor of plaintiff which is required to be removed from the register of trademark. Plaintiff Yong Sze Fun filed appeal against decision of the High Court before the Court of Appeal which upheld decision of the High Court and asked the Registrar to expunge entry of plaintiff from trademark register as trademark "TAMIN" is personal property of the defendant who has full right to use it, takes all its potential benefits and gives it to another partially or fully (*Yong Sze Fun & Anor v Syarikat Zamani Haji Tamin*, 2012).

Section 51 of Trade Marks Act 1976 states that registered user is entitled to call upon registered proprietor to take up proceedings for infringement of trademark and if registered proprietor refuses or neglects to do within 2 months after being so called upon, registered user may institute proceedings for infringement with his own name as registered proprietor and shall make registered proprietor defendant. The registered proprietor added as defendant would not be held liable to pay costs unless he enters, appears and takes part in infringement proceedings (Section 51, Trade Marks Act, 1976; San, 2007).

In USA under Lanham Trademark Act 1946, any person uses, reproduces, counterfeits or copies registered trademark during trade in connection with sale, offers to sale, distributes or advertises goods or services which are registered under registered trademark at United States Patent and Trademark Office (USPTO) would be considered an infringer. The owner of registered trademark may institute civil suit against infringer but applicant may not have right of damages and profits unless he uses sufficient description of trademark registration or has given written notice of trademark registration to infringer. When there is innocent infringement where infringer relates to business of printing, publishing and broadcasting and infringed material without knowing the fact that material in hand is infringed, applicant may only attain injunction against him to stop printing, publishing and broadcasting and may not claim damages (Sheff, 2012).

Civil procedure of trademark enforcement for trademark infringement proceedings in USA elaborates things which are yet to be elaborated in trademark law of Pakistan viz trademark owner can only claim and obtain damages through civil procedure of trademark enforcement if his registered trademark is sufficiently described and notice of his trademark registration is given to infringer. Furthermore, the owner of trademark may only obtain remedy of injunction if infringement is innocent and done by person associated with the business of printing, publishing and broadcasting. Moreover, damages cannot be claimed against innocent infringement.

Title 15 of United States Code 1926 deals with commerce and trade, its chapter 22 deals with trademark which states that in trademark infringement proceedings before the Court, the defendant may invoke defense of fair usage that trademark has been used otherwise than as trademark, not used during trade which is descriptive and used fairly in good faith. Fair usage must be done in a way that trademark must not be used as trademark, usage is for description of goods or services and trademark must be used fairly in good faith (Section 115, United States Code, 1926; Beebe, 2006). These defenses of trademark infringement are recommended to be prescribed in trademark law of Pakistan for better civil procedure of trademark enforcement.

In the case of *Jeffrey Sorensen v WD-40 Company*, Jeffrey Sorensen is the owner of trademark which he thinks is infringed by respondent WD-40 Company. The Respondent used word “CORRISON INHIBITOR” as trademark but not during trade. Applicant is registered owner of trademark which he thinks is identical to trademark of respondent and he uses that during trade at market place. Matter went to the Civil Court which held that there is no confusion of both trademarks usages as both are different and trademark of respondent is not used during trade as well and applicant has failed to prove his claim through evidence that respondent is in use of similar trademark in bad faith (*Jeffrey Sorensen v WD-40 Company*, 2015).

In another case of *Bridgestone Americas Tire Operations v Federal Corporation*, defendant Federal Corporation used similar kind trademark of plaintiff’s three trademarks ending with NZA: POTENZA, TURANZA and MILANZA. Plaintiff Bridgestone Americas Tire Operations brought civil suit of trademark infringement before the Trial Court as the Court decided matter in favor of defendant. Plaintiff filed appeal before the United States Court of Appeal for Federal Circuit where the Court gave decision in favor of plaintiff. The Court gave three findings in the instant case, first is that Bridgestone established commercial strength through evidence of prolonged exclusive use, extensive promotion and marketing and billion dollars of tire sales bearing trademarks.

The second is that where goods are identical and there is similarities of sound, appearance and connotation, would more likely to cause confusion than where goods are significantly different. The third is that MILANZA is likely to cause confusion, deception and mistake hence plea of Bridgestone Americas Tire Operations is accepted against Federal Corporation by the United States Court of Appeal for Federal Circuit (*Bridgestone Americas Tire Operations v Federal Corporation*, 2012).

In another case between *Nola Spice Designs v HAYDEL Enterprise*, plaintiff Nola Spice Designs claimed that it is the owner of trademark “Mardi Gras Bead Dog” and defendant HAYDEL Enterprises has infringed his IP right. The Trial Court and the Court of Appeal for Federal Circuit decided matter against him on a ground that traditional dog made from grass is not protected under Lanham Trademark Act 1946 (*Nola Spice Designs v HAYDEL Enterprise*, 2015).

Any person uses false trademark, false designation of origin, false description or false representation of facts during trade is liable to trademark infringement civil action by an aggrieved party in USA. The owner of registered trademark has right to obtain injunctive relief against any person who is likely to use resembling trademark during trade and which is likely to cause damage to right of registered trademark owner (Paradise, 1999).

In the case of *3M Company and 3M Innovative Properties v Pradeep Mohan*, defendant Pradeep Mohan used and intended to use “3M’s” trademark for his products and took a plea that trademark of plaintiff 3M Company has become generic and plaintiff has abandoned trademark, but he does not prove that before the Court with evidence. Plaintiff applied for infringement of trademark before the Court, the Trial Court and the Court of Appeal for Federal Circuit gave decision in favor of plaintiff on a ground that Pradeep Mohan has failed to prove his claim beyond reasonable doubt hence his plea is rejected (*3M Company and 3M Innovative Properties v Pradeep Mohan*, 2012).

If violation of any right occurs under Lanham Trademark Act 1946, aggrieved party may attain pecuniary relief against infringer and amount of pecuniary relief must not be excessive and it must be just, fair and equitable (Sections 33 to 35, Lanham Trademark Act 1946; Tushnet, 2012).

4. Trademark Dilution

Trademark dilution involves unauthorized use of another’s trademark on goods or services that do not compete with and have little connection with registered trademark. Trademark dilution is basis of trademark infringement. Trademark dilution gives the owner of famous trademark right to prevent others from using his famous trademark that would lessens its uniqueness and it is dealt under civil procedure of trademark enforcement (Butters, 2007; Klieger, 1996).

Trademark dilution is classified into blurring and tarnishing. Blurring impairs distinctiveness of famous trademark and tarnishing harms reputation of famous trademark (Martino, 1996).

Although trademark dilution originated from USA, it has been accepted in Pakistan. Section 2 (xiii) of Trade Marks Ordinance 2001 states that dilution means lessening capacity of well-known trademark to identify and distinguish goods or services regardless of presence or absence of competition between the owner of well-known trademark or other parties or likelihood of confusion or deception (Section 2, Trade Marks Ordinance, 2001; Tony, 1996).

Section 29 (4) (b) of Trade Marks Ordinance 2001 states that registration of trademark may be opposed on a ground that it harms reputation of another trademark, causes dilution and likely to deceive or causes confusion (Section 29, Trade Marks Ordinance, 2001; Farley, 2005). Section 88 (3) (a) of Trade

Marks Ordinance 2001 states that the owner of trademark which is entitled to protection under Paris Convention as well-known trademark shall be entitled to restrain use of trademark in Pakistan by injunction where such use causes lessening quality of well-known trademark (Section 86, Trade Marks Ordinance, 2001; Lee & Allenby, 2006).

In the case of *Aldo Group International v Aldo Shoes*, Sindh High Court gave reference of Professor J. Thomas McCarthy as he stated that no part of trademark law has created so much doctrinal puzzlement and judicial incomprehension then the concept of dilution as form of intrusion on trademark. It is a daunting pedagogical challenge to explain even basic theoretical concept of dilution to students, attorneys and judges. Few can successfully explain it without encountering stares of incomprehension or worse nods of understanding which mask and conceal wilderment and misinterpretation. Dilution occurs normally by blurring or by tarnishing. Dilution is useful concept to bear in mind, it does not necessarily follow that every case of infringement will necessarily involve dilution, nor does it follow that proprietor of trademark will necessarily succeed in establishing trademark infringement in every case where he establishes dilution (*Aldo Group International v Aldo Shoes*, 2016).

Word trademark dilution in Malaysia is not specifically mentioned under Trade Marks Act 1976, Trade Marks Regulations 1997 and Trade Descriptions Act 2011. According to section 14 (1) (d) of Trade Marks Act 1976, trademark cannot be registered in Malaysia if it is identical with or so nearly resembles with well-known mark for same goods or services of another proprietor (Section 14, Trade Marks Act, 1976; Regulations 13A, 13B, Trade Marks Regulations, 1997).

In the case of *McCurry Restaurant v McDonald's Corporation*, McDonald's Corporation is global franchise of hamburger fast-food, it has more than 30,000 outlets around the world and it has been in business since 1982 in Malaysia. Prefix of "Mc" is used in conjunction with other words to name various foods available at restaurant such as "McChicken", "McNuggets", and "McMuffin". McCurry Restaurant commenced business in 1998 selling Indian and Malaysian food. In 2001, McDonald's commenced action against McCurry Restaurant before the High Court on ground that "Mc" prefix is distinctive to McDonald's alone and McCurry Restaurant misrepresenting and deceiving public, commits passing-off, misuse and abuse which would cause damage and harm to goodwill, reputation and commercial advantage of McDonald's Corporation during trade. McCurry Restaurant replied that McDonald Corporation does not have monopoly and exclusive right over "Mc" prefix. McCurry" is created based on abbreviation "Malaysia Chicken" and "Curry".

Issue before the Court was whether McCurry Restaurant has passed off McDonald's goods or services as its own, by its use of "Mc" prefix and color scheme it used in its restaurant. Both parties put forward consumer witnesses whether there had been any confusion between McCurry Restaurant and McDonald's restaurant. The High Court held that McDonald's Corporation had proven all elements to show existence of passing-off both under traditional and extended form of passing-off. It found that McDonald's owned goodwill and reputation developed out of usage "Mc" prefix and McCurry Restaurant should not be allowed to take unfair advantage of goodwill and reputation of McDonald's.

The Court of Appeal of Malaysia overturned Malaysian High Court's decision by permitting McCurry Restaurant to use "Mc" in the conduct of its business as the Court found no evidence to suggest appellant McCurry Restaurant had passed-off. The Trial Courts' decision to acknowledge dilution of trademark "McDonald's" was overturned by tide of totality in comparison of get-up, types of food and target market of two businesses to rule out possible confusion (*McCurry Restaurant v McDonald's Corporation*, 2009; Mirandah & Samuel, 2009).

Trademark dilution is prescribed under section 43 of Lanham Trademark Act 1946. The concept of trademark dilution was inserted into Lanham Trademark Act 1946 under Federal Trademark Dilution Act 1995 and amended under Trademark Dilution Revision Act 2006. Dilution is either by blurring or by tarnishing. Dilution by blurring is whipping out selling power and market value of product through illegal use of registered trademark. It is similarity of trademark with famous trademark which impairs distinctiveness of famous trademark. Dilution by tarnishing is similarity of trademark with famous trademark which harms reputation of famous trademark (Trademark Dilution Act 1995; United States Code, 1926; Section 43, Lanham Trademark Act, 1946).

In the case of *Starbucks Corporation v Wolfe's Borough Coffee Incorporation*, defendant Wolfe's Borough Coffee Incorporation used word "CHARBUCKS" for selling its coffee items. Plaintiff Mr. Char-bucks from Starbucks Corporation sued defendant by adopting civil procedure of trademark enforcement in USA. Plaintiff asserted that use of word "CHARBUCKS" diluted trademark of plaintiff "STARBUCKS" through dilution by blurring and dilution by tarnishing. The Court held that there is no confusion between both trademarks and plaintiff is not successful to make his point clear and there is no dilution of trademark by defendant against plaintiff thus suit is dismissed (*Starbucks Corporation v Wolfe's Borough Coffee Incorporation*, 2013).

While deciding question of dilution by blurring and tarnishing, the Court would consider degree of similarity, distinctiveness, recognition between trademark and famous trademark and extent usage of famous trademark by its owner whether user of similar mark wants to create an association between famous mark and similar mark (Trademark Dilution Revision Act, 2006; Welkowitz, 1991). These conditions for establishing trademark dilution by the Court required to be prescribed in trademark law of Pakistan for betterment of civil procedure of trademark enforcement.

Dilution by blurring and dilution by tarnishing do not occur when user uses similar trademark as fair usage or facilitation of fair usage, uses it for comparative advertising or promotion, uses it for news reporting and commentary, uses it for identifying or criticizing upon famous trademark or upon its owner or uses it for non-commercial purposes (Lando, 2004; Oswald, 1995). These exceptions of trademark dilution required to be prescribed in trademark law of Pakistan for betterment of civil procedure of trademark enforcement.

Burden of proof in trade dress dilution civil action for trade dress not registered in principal register is upon a person who institutes civil suit to prove non-functionality and famousness of trademark. User of famous trademark can obtain remedies available under Lanham Trademark Act 1946 if there is a

willful impairment or harm is occurred on famous trademark (Section 1125, United States Code, 1926; Jacobs, 2004).

Trademark dilution concept exhaustively prescribed in USA under Lanham Trademark Act 1946. Classification of trademark dilution, conditions to establish trademark dilution by the Court and exceptions to trademark dilution are required to be prescribed in trademark law of Pakistan for betterment of civil procedure of trademark enforcement.

5. Entry in Trademark Register

Entry in trademark register is attached with civil procedure of trademark enforcement as the owner of trademark may apply before the Court for removal of wrong entry of infringed trademark from the register. Aggrieved party is required to apply before the Registrar of trademark for rectification of the register but if Registrar is biased and acting in bad faith in favor of trademark infringer and adding his entry in trademark register, the owner may adopt civil procedure before the Court for rectification of trademark register.

In Pakistan, rectification application is required to be made before the Registrar under section 96 of Trade Marks Ordinance 2001 as well as an aggrieved party of trademark registration is required to make an application for revocation of entry from the register of trademark before the Registrar under section 73 of Trade Marks Ordinance 2001 (Section 73, Trade Marks Ordinance, 2001; Rule 42, Trade Marks Rules, 2004).

In the case of *Royal Pvc Private Limited v the Registrar of Trademark*, Sindh High Court held that application for rectification of trademark register should have been filed before the Registrar of trademark under section 73 of Trade Marks Ordinance 2001. The Court is bound to act in accordance with procedure provided by law, deviation therefrom may result in refusal to exercise jurisdiction or exercise jurisdiction not vesting in the Court. It is duty of the Court to interpret law as it stands, yet it is well recognized principle of interpretation that statute must be interpreted in such a manner as would make it workable. It is cardinal principle of interpretation that redundancy must not be attributed to legislature.

Each word used in statute is to be read as integral part thereof, carrying meaning if in circumstances not impracticable which is assigned to it in ordinary parlance. Where general obligation is created by statute and specific statutory remedy is provided, statutory remedy is only remedy. It is also well settled principle of interpretation that where legislature has a special law laid down conditions for exercising powers by the Court. The Court is not justified in disregarding conditions and holding reference to a general law that it has powers beyond those given by special law (*Royal Pvc Private Limited v the Registrar of Trademark*, 2011).

In Pakistan, rectification of trademark register is either administrative matter before the Registrar of trademark or criminal matter where punishment is prescribed under section 101 of Trade Marks Ordinance 2001. Section 96 of Trade Marks Ordinance 2001 states that any interested person may

apply for correction of entry in the register before the Registrar except if proceedings concerning trademark in question pending before the District Court or the High Court. The Registrar may transfer pending matter of rectification to the Court at any time (Section 96, Trade Marks Ordinance, 2001; Rule 9, Trade Marks Rules, 2004).

According to section 10 of Trade Marks Ordinance 2001, the register would be kept at Trademark Registry under control and management of the Registrar containing all registered trademarks with names, addresses, descriptions of proprietors, users and licensees, notifications of assignments and transmissions, disclaimers, conditions and limitations. Section 11 of Trade Marks Ordinance 2001 states that written, printed and computer generated copy of entry in trademark register signed and sealed by the Registrar is admissible evidence before the District Court and the High Court in Pakistan (Sections 10, 11, Trade Marks Ordinance, 2001; Davis Jr., 1988).

According to section 100 of Trade Marks Ordinance 2001, a person makes or causes to make false entry in the register, writing falsely purporting to be a copy of an entry in the register, produces, tenders or causes to be produced or tendered evidence of such writing and knowing such entry or writing to be false would be punished with imprisonment for 3 months to 2 years with fine not less than 50 thousand rupees (Section 101, Trade Marks Ordinance, 2001; Marquez, 2011).

In Malaysia, the Registrar may alter and amend the register of trademark on a request made by registered trademark owner under section 43 of Trade Marks Act 1976. The Court may order the Registrar of trademark to expunge entry of registered trademark or to enter entry of trademark under section 45 of Trade Marks Act 1976. In Malaysia, rectification of the register is either an administrative matter before the Registrar or a civil matter before the Court. An interested party may apply before the Court against any wrong entry in the register of trademark which remains there without sufficient cause. The Registrar can also apply before the Court against assignment, transmission or registration of trademark. If the Court decides matter in favor of plaintiff, issues notice to the Registrar for rectification of trademark register.

The Court may also ask the Registrar of trademark to remove trademark from trademark register if trademark is registered in bad faith or if it has not been in use for continuous 3 years. If trademark is removed from the register, it cannot be used in relation to any trade or service at market place (Sections 45, 46, 47, Trade Marks Act, 1976; Stanberry, 1991). Application for rectification of entry in the register of trademark should allowed to be made before the Court in Pakistan and amendment in this regard should be made in trademark law of Pakistan for betterment of civil procedure of trademark enforcement.

In the case of *Wieland Electric GMBH v Industrial Automation*, plaintiff Wielant Electric GMBH Company founded in 1920 for manufacturing Electrical Connection Technology, entered contract to be part of Wieland Group which has subsidiaries in more than 70 countries of the world. Wielant Electric entered an agency agreement with defendant Industrial Automation, which is appointed as sales agent of Wieland in Malaysia. Defendant Industrial Automation applied for registration of trademark which

is identical with trademark of plaintiff Wieland Group. Plaintiff requested him not to do so but defendant undertook that it may assign it to plaintiff after its registration, but defendant failed to accomplish his promise.

Plaintiff relinquished agency agreement and applied in the Court for expunging registered trademark from the register of trademark. The High Court held that it is a clear-cut case of deception, fraud and infringement thus the Court decided matter in favor of plaintiff with costs and ordered the Registrar of trademark to expunge false entry from trademark register (*Wieland Electric GMBH v Industrial Automation*, 2014).

The Court may order modification in entry of registered trademark in respect of certification of trademark upon application of aggrieved party if (i) the owner of trademark does not remain competent to certify goods or services, (ii) has failed to observe provisions of deposited rules, or (iii) registration of trademark is no longer in public advantage and variation is required to be made in public advantage (Section 56, Trade Marks Act, 1976; Sangal, 1999).

In the case of *A K Koh Enterprise v A1 Best One Food Industry*, appellant A K Koh Enterprise is manufacturer and merchant of Bak Kut spices in Malaysia since 1983 and uses A1 sign for trade of its products. The Registrar of trademark allowed registration of Bak Kut spices in favor of respondent A1 Best One Food Industry. A K Koh Enterprise appealed against decision of the Registrar of trademark before the Court. The High Court held that respondent has failed to prove his claim prima facie hence the Court ordered the Registrar of trademark to expunge entry of respondent from trademark register and add entry of plaintiff (*A K Koh Enterprise v A1 Best One Food Industry*, 2015).

The Registrar of trademark may be ordered by the Court to expunge illegal entry from trademark register. The Registrar of trademark may expunge entry of registered trademark from trademark register if registered trademark is not used by owner or by his assignee for consecutive 3 years. Entry of trademark may also be expunged if proposed corporation does not start its business and does not use registered trademark for consecutive 6 months after registration of trademark (Gee, 2009).

In the case of *Ho Tack Sien & Ors v Rotta Research Laboratorium*, viartil drug and its packaging registered as trademark in 1976 in favor of plaintiff Ho Tack Sien. It was later used by defendant Rotta Research Laboratorium in 2013 for same packaging of Artril-250 drug which was registered in 2002. Plaintiff went to the Court against infringement of his registered trademark and prayed for expunging entry of defendant from trademark register. The Trial Court decided issue in favor of plaintiff and ordered the Registrar to expunge entry of defendant from trademark register. Defendant filed appeal against decision of the Trial Court. The Appellant Court upheld part decision of the Trial Court in favor of plaintiff that entry of registered trademark of defendant should be expunged from the register of trademark.

The defendant filed appeal before the Federal Court of Putrajaya hence the Federal Court of Putrajaya rejected decision of the Court of Appeal and upheld decision of the Trial Court in favor of plaintiff and ordered the Registrar of trademark to expunge entry of defendant's trademark from the register (*Ho*

Tack Sien & Ors v Rotta Research Laboratorium, 2015).

The Court asks the Registrar to expunge entry of trademark from trademark register and sometimes asks the Registrar to register trademark. In the case of *Yong Teng Hing v Walton International Limited*, appellant Yong Teng Hing and respondent Walton International applied for registration of trademark “GIORDANO” for trade of their leather garments. The Registrar of trademark refused to register trademark of both parties until their claim is to be decided by the Court. Appellant claimed that he has been using “GIORDANO” trademark since 1986. Respondent claimed that this trademark was first used at Hong Kong in 1982 and it was assigned to him by GIORDANO Limited. Respondent also claimed that he is registered owner of similar trademark since 1982 and started using objected trademark in 1990. The Court held that contention of respondent is true as appellant failed to prove his claim before the Court hence matter is decided in favor of respondent with costs. The Court ordered the Registrar of trademark to register “GIORDANO” trademark in favor of respondent (*Yong Teng Hing v Walton International Limited*, 2012).

If relief of an alteration or rectification of the register is granted, the Registrar of trademark is required to appear before the Court. The Registrar may also be directed to submit similar nature cases presented before him and that can be taken as evidences in civil proceedings before the Court (Sections 61, 62, 63, Trade Marks Act, 1976; Chong, 1998).

In the case of *Mesuma Sports v Majlis Sukan*, Majlis Sukan Negara Malaysia is statutory body established under National Sports Council of Malaysia Act 1971 to prepare clothes carrying tiger stripes’ design to be wearied by Malaysian Athletes. Defendant Majlis Sukan assigned work to one of the manufacturer and later it was assigned to plaintiff Mesuma Sports. After sometimes, plaintiff applied for registration of tiger stripes’ design and later defendant applied for same before the Registrar of trademark.

The Registrar of trademark objected application of defendant. Later, defendant filed civil suit in the Court. The Court decided matter in favor of defendant and ordered the Registrar of trademark to register tiger stripes’ design in favor of defendant and make its entry in official trademark register. The decision of the Trial Court upheld by the Federal Court Putrajaya in favor of defendant Majlis Sukan (*Mesuma Sports v Majlis Sukan*, 2015).

In USA, United States Patent and Trademark Office (USPTO) may alter entry of registered trademark in principal or supplemental register after approval by the Director or by order of the Court. The Clerk of the Court may require the Director of USPTO to submit details of parties and description of trademark registration in the Court within 1 month of civil suit institution related to infringement of registered trademark in USA. After decision of the Court, the Clerk is required to send authorized copies to the Director of USPTO for an endorsement. The Court may issue notice to Attorney for participation in civil proceedings and require applicant to submit security which may be attained by defendant in case of damages and loss due to institution of civil suit by plaintiff and wrong claim accusation in USA (Abbott, 1999; Gilbert, Ludwig, & Fortine, 1986).

In civil legal proceedings related to trademark in relation to determination of rights of registration, the Court may order (i) registration of trademark in part or whole, (ii) cancellation of registration, (iii) rectification of the register and the Court may direct the Director of USPTO all related decrees and orders for all necessary actions on his part (Section 37, Lanham Trademark Act, 1946; Section 1119, United States Code, 1926).

The District Court in USA has original jurisdiction and the Court of Appeal has appellate jurisdiction with respect to legal actions taken under Lanham Trademark Act 1946. Person obtained registration of trademark due to fraud may be liable to civil legal action taken by any person effected by that fraud. Section 7 of Lanham Trademark Act 1946 states that upon registration of trademark, the Director would issue certificate of registration which contains (i) date of its first use generally and in trade, (ii) description of goods for which it has been registered, (iii) date of registration, (iv) date of application for registration, and (v) any condition or limitation imposed on registration. Certificate of registration, original documents and their certified copies issued by USPTO would be admissible evidence before the Court. In case any mistake occurred during registration in good faith, the Director may correct it on application of the owner and issue certificate of correction or new certificate of registration (Section 7, Lanham Trademark Act, 1946; Burge, 2007).

According to section 38 of Lanham Trademark Act 1946, a person acquires registration of trademark in the register of trademark at USPTO due to oral or written false statement, declaration or representation or any false means would be liable to civil action by any person injured thereby for damages sustained in consequence thereof (Section 38, Lanham Trademark Act 1946; Section 1120, United States Code, 1926).

No authority is given immunity to violate prescribed provisions of Lanham Trademark Act 1946 in USA whether governmental, national, international or non-governmental except USA authority acted in its official capacity. The Director of USPTO may make rules and regulations consistent with provisions of Lanham Trademark Act 1946 for smooth implementation of Lanham Trademark Act 1946 (Sections 40, 41, Lanham Trademark Act, 1946; Halliday, 1950).

6. Conclusion and Recommendations

The owner of registered trademark may file civil suit against infringement of his registered trademark before the Court under section 117 of Trade Marks Ordinance 2001 in Pakistan, under section 51 of Trade Marks Act 1976 in Malaysia and under section 32 of Lanham Trademark Act 1946 in USA. Trademark infringement occurs if infringed trademark is clearly being advertised and infringer having notice of trademark registration. Trademark infringement is innocent if infringer does not have notice of trademark registration or if infringer is associated with business of printing, publishing and broadcasting. The owner of registered trademark can only claim preventive relief in innocent infringement and cannot claim damages which is not clearly prescribed in trademark law of Pakistan. According to section 43 of Lanham Trademark Act 1946, infringer cannot be held liable to pay

damages if he does not have sufficient notice of trademark registration, associated with business of printing, publishing and broadcasting. These requirements are required to be prescribed in trademark law of Pakistan. Unregistered trademark owner can only claim preventive relief and cannot claim damages according to section 82 of Trade Marks Act 1976 in Malaysia which is also required to be prescribed in trademark law of Pakistan. Damages can only be claimed if trademark is sufficiently described and its notice is delivered to all and only injunction can be claimed if infringement is innocent done by person associated with business of printing, publishing and broadcasting according to section 32 of Lanham Trademark Act 1946. These requirements are also required to be prescribed in trademark law of Pakistan.

Trademark dilution is an act when identical trademark usage lessens uniqueness of famous trademark, when infringement harms reputation of trademark and lessens quality of associated goods or services. Trademark dilution with its classification, conditions and exceptions exhaustively prescribed under section 43 of Lanham Trademark Act 1946 in USA but not exhaustively described under Trade Marks Ordinance 2001 in Pakistan therefore required to be prescribed under trademark law of Pakistan.

Application for entry in trademark register may only be made as a rule before the Registrar in Pakistan under sections 73 and 96 of Trade Marks Ordinance 2001. Contrary to that, application for entry in trademark register can be made before the Registrar under section 43 and before the Court under section 45 of Trade Marks Act 1976 in Malaysia thus aggrieved party should be allowed to make an application for entry in trademark register before the Court in Pakistan.

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