

Stereo. H C J D A-38.

**JUDGMENT SHEET
IN THE LAHORE HIGH COURT, LAHORE
JUDICIAL DEPARTMENT**

C.R No.43193 of 2022

Nestle Pak Limited, Lahore etc.

Versus
Shehryar Kureshi etc.

JUDGMENT

Date of hearing: 18.10.2023.

Petitioners by: M/s Farooq Amjad Meer and Ahmad Farooq Meer, Advocates.

Respondents by: M/s Mudassar Raza Butt, Sajawal Javaid Butt and Muhammad Muazzam Akram, Advocates.

MUHAMMAD SAJID MEHMOOD SETHI, J.- Through instant revision petition, petitioners have assailed judgment dated 24.06.2022, passed by learned Addl. District Judge, Lahore, whereby respondents' appeal against order dated 08.02.2021, passed by learned Civil Judge, Lahore, returning plaint of their suit under Order VII Rule 10 CPC, was accepted, impugned order was set aside and the matter was remanded to learned Trial Court for decision afresh on merits.

2. Brief facts of the case are that respondents instituted a suit for recovery of damages of Rs.14 Million against petitioners, with the assertion that plaintiffs formed a musical collaboration, produced, wrote, composed, sang and arranged a song "Pyar Diyan Gallan" and throughout held all the rights and interests over the song's audio and recordings, the original music works as well as the literary / artistic work involved therein; that the musical video is available on Daily Motion, Facebook and YouTube; that song's basic melody and lyrics were composed and written by respondent No.1 in the year 1991; that the production was finalized at the residence of respondent No.3 in the year 1994; that composition and production was refined and lyrically improvised by respondent

No.2, who was also the producer and director of the original video of the song released in the year 1994; that respondent No.4 performed one of the rap parts of the song; that in February, 2019, petitioners collusively remade / reproduced the song with behind the scene footage performing the original song “Pyar Diyan Gallan”; that petitioners broadcasted the same on various television channels through satellite and other available modes; that the song was also marketed and broadcasted in Pakistan and rest of the world and then aired on YouTube, Daily Motion and Facebook; that petitioners used the names of original artists and collaboration for commercial gains without the consent of the original stakeholders / producer / composer / lyricist of the song; that petitioners also did not obtain any license, permission or consent from the collaboration expressly or impliedly despite the fact that they were fully aware of the fact that the song was not a solo project but was done in collaboration; that petitioners passed off the original creators and misused their names without any authority; that respondents approached petitioners who initially tried to wriggle out by suggesting their good faith and then illegally shifted burden on respondent No.4 despite the fact that said respondent was not stakeholder of the song rather he merely joined the collaboration as a Rapper and had very little role to play in the song; that the song seriously jeopardized the repute of the collaboration, which needs an apology on media and payment of damages by petitioners. Petitioners filed application under Order VII Rule 10 CPC for return of plaint due to want of jurisdiction, which was resisted by respondents by filing written reply. After hearing arguments from both sides, learned Trial Court accepted the application and returned the plaint under aforesaid provisions of law vide order dated 08.02.2021. Feeling aggrieved, respondents assailed said order in appeal before learned Additional District Judge, which was accepted, order of learned Trial Court was set aside and the suit was remanded to learned Trial Court for decision afresh in accordance

with law after obtaining written statement from petitioners, framing of issues and recording evidence of the parties vide judgment dated 24.06.2022. Hence, instant revision petition.

3. Learned counsel for petitioners submits that contents of the plaint clearly suggest that respondents claimed copyrights of the song, alleged copyrights infringement and demanded fringe benefits of the copyrights, losses and other damages, not in torts. He contends that the Intellectual Property Tribunal (“**IP Tribunal**”) has exclusive jurisdiction in matters regarding infringement of Intellectual Property Laws, which includes infringement of copyrights. He argues that as per section 18 of the Intellectual Property Organization of Pakistan Act, 2012, all suits and other civil proceedings regarding infringement of copyrights are to be exclusively triable by an IP Tribunal. He maintains that the allegations: *unauthorized reproduction of the song, use of behind the scene performance of original song; unauthorized broadcast and marketing; lack of permission or license from concerned authority* constitute infringement of copyrights and come under the definition of copyright provided under section 3(1) of the Copyright Ordinance, 1962, thus Civil Court has no jurisdiction in the matter. He has referred to Muhammad Multazam Raza v. Muhammad Ayub Khan and others (2022 SCMR 979), Messrs Tabaq Restaurant v. Messrs Tabaq Restaurant (1987 SCMR 1090) and Messrs Shaheen Chemist through Proprietors and 3 others v. Zahid Mehmood Chaudhry and another (2023 CLD 1).

4. Conversely, learned counsel for respondents submits that the judgments relied upon by petitioners are regarding infringement of a registered trademark and the remedy / forum available thereof. He adds that the referred cases discuss passing off action in relation to a registered trademark but do not discuss the passing off action for unregistered trademark. He argues that the passing off claim simpliciter – not related to a registered trademark – is not defined in referred cases, however respondents’ claim was based simpliciter

on passing off action and not on infringement of trademark, hence Civil Court has jurisdiction in the matter. He has relied upon Islamic Republic of Pakistan through Secretary, Ministry of Railways and others (2011 SCMR 1836), Mst. Zeeshan Nadeem v. Omer Aziz (2002 CLD 706), Messrs Fact Finders (Pvt.) Ltd. and others v. CNBC Pakistan and others (2022 CLC 1397), Reckitt and Colman Products Ltd. v. Borden Inc and others [(1990) 1 All ER 873] and judgment dated 15.10.2015, passed by the Supreme Court of India in Criminal Appeals No.258 & 259 of 2013 titled Krishika Lulla and Ors. V. Shyam Vithalrao Devkatta & Anr.

5. Arguments heard. Available record perused.

6. The prime question for determination by this Court is whether the suit in question is triable by the Civil Court or Intellectual Property Tribunal. First of all, factual perspective of the lis and averments made in the plaint are to be comprehended. Respondents' claim is that they created a song "Pyar Diyan Gallan" somewhere in the year 1994 and possessed all rights and interests with regard to its lyrics, production, melody, composition, audio & video recordings, and broadcasting on television and social media groups. However, petitioners remade / reproduced the song with behind the scene footage performing the original song "Pyar Diyan Gallan", broadcasted the same on various television channels and social media, marketed in Pakistan and other countries, used the names of original artists and collaboration without the consent of the original stakeholders / collaboration. The stance of respondents is that their claim was based simpliciter on passing off action and not on infringement of registered trademark or copyrights, thus, applicability of Intellectual Property Laws is misconceived. Whereas, version of petitioners is that actually the claim is regarding infringement of copyrights attracting Intellectual Property Laws and plea of passing off simpliciter is fallacious.

7. Infringement of trademark is actionable under section 46 of the Trade Marks Ordinance, 2001, however the parties are in

agreement that controversy at hand is not related to infringement of trademark. Sub-section (3) of section 46 provides that the Ordinance *ibid* would not *affect the action against any person for passing of goods as the goods of another person or services as services provided by another person, or the remedies in respect thereof*. Basically a trade mark owner receives protection against use of his mark by another in such a way as is likely to lead consumers to associate the others' goods with the trade mark owner. This protection against trade mark infringement, that is, against sale of another's goods as those of the trade mark owner by use of the owner's mark, may be described as protection against "passing off". However, passing off also includes any other method by which one person's goods are made to appear as if they originated from another, whether or not a trade mark is involved. Rule 11 of the Trade Marks Rules, 2004 deals with classification of goods and services, and provides that goods and services shall be classified in the manner specified in the Fourth Schedule. A comprehensive list containing 34 classes of vendible goods and 8 classes of services is available in the said Schedule, however *musical work* is not mentioned. Likewise, definition of "services" provided in Section 2(xliii) of the Trade Marks Ordinance, 2001 does not include *musical work* in the ambit of services.

Conversely, the term "copyright" defined in Section 3 of the Copyright Ordinance, 1962 ("the Ordinance of 1962"), does include *musical work* and provides authority / right to perform certain acts in connection therewith, which is reproduced hereunder for ease of reference:-

"3. Meaning of Copyright--- 1. For the purpose of this Ordinance, "copyright" means the exclusive right, by virtue of, and subject to, the provisions of this Ordinance:-----

- (a) in the case of a literary, dramatic or musical work, to do and authorize the doing of any of the following acts, namely:-
 - (i) to reproduce the work in any material form;
 - (ii) to publish the work;
 - (iii) to perform the work in public;

- (iv) to produce, reproduce, perform or publish any translation of the work;
- (v) to use the mark in a cinematographic work or make a record in respect of the work;
- (vi) to broadcast the work, or to communicate the broadcast of the work to the public by a loudspeaker or any other similar instrument;
- (vii) to make any adaptation of the work;
- (viii) to do in relation to translation or an adaptation of the work any of the acts specified in relation to the work in sub-clauses (i) to (vi);

8. Copyright in terms of section 3 of the Ordinance, 1962 is an exclusive right in relation to literary, dramatic, musical, artistic work, in any tangible medium of comprehension either audio or visual in any form that could be copied, reproduced, multiplied, communicated transmitted, repeated, broadcasted, telecasted, adopted in any form. "Copyright" from the scheme of the Copyright Ordinance appears to protect "copyright" in original work, by itself it is not relatable or associated with any vendible goods or services. The holder of such copyright in musical work has exclusive right to reproduce and multiply such work. From the scheme of the Copyright Ordinance, 1962 it appears that such Copyright work independently is capable of reproduction and reproduced copy is vendible independently and individually. It does not have any nexus with any other separate and independent vendible goods or services unless said work otherwise is also used as a trade mark under the Trade Marks Ordinance.

9. It is conspicuous from the contents of the plaint, duly enumerated in para 2 of this judgment, that respondents claimed all rights and interests in their musical work i.e. the song “Pyar Diyan Gallan”, which duly comes under the meaning of “copyright” provided in the afore-referred provision along with passing off. The averments of the plaint encompass copyright infringement provided in Section 56 and do not come within the exceptions detailed in Section 57 of the Ordinance of 1962. Section 13 of the Ordinance of 1962 provides that the author of a work – in terms of section

2(d)(ii) of the Ordinance of 1962, author is the composer –shall be the first owner of the copyright therein. Section 39 of the Ordinance of 1962 provides procedure for the registration of copyrights but the same is not mandatory to claim infringement of copyrights as evident from narration of the provision. Section 42 of the Ordinance of 1962 declares the Register of Copyrights and the indexes as *prima facie* evidence of the particulars entered therein and admissible in evidence in Courts suggesting that copyright subsists in the work and the person showed therein is the owner of such copyright. The aforesaid provisions read as under:-

39. Registration of copyrights, --(1) The author or publisher of, or the owner of or other person interested in the copyright in, any work may make an application in the prescribed form accompanied by the prescribed fee to the Registrar for entering particulars of the work in the Register of Copyrights.

(2) On receipt of an application in respect of any work under subsection (1), the Registrar shall enter the particulars of the work in the Register of Copyrights and issue a certificate of such registration to the applicant unless, for reason to be recorded in writing, he considers that such entry should not be made in respect of any work;

42. Register of Copyrights to be *prima facie* evidence of particulars entered therein, -- (1) The Register of Copyrights and the indexes shall be *prima facie* evidence of the particulars entered therein and documents purporting to be copies of any entry therein or extracts therefrom certified by the Registrar and sealed with the seal of the Copyright Office shall be admissible in evidence in all courts without further proof of production of the original.

(2) A certificate of registration of copyright in a work shall be *prima facie* evidence that copyright subsists in the work and that the person shown in the certificate as the owner of the copyright is the owner of such copyright.

A bare reading of section 39 shows that the use of expression "may" is permissive and does not make it obligatory for an author to get the copyright registered. The language of section 39, by any stretch of imagination, can be inferred to mean that the registration is compulsory for the enforcement of the copyright. The natural and ordinary meaning of the word "may" would make the registration optional and not compulsory. Moreover, the words "may" and "shall" in legal parlance are interchangeable, depending upon the

context in which they are used but legislative intent is to be seen and given effect to. The registration of copyrights in terms of 39 of the Ordinance of 1962 is not mandatory but optional with the author, publisher, owner or other person interested in the copyright. Similarly the phrase used in section 42 only raises a presumption that the person whose name is entered in the register is the author of the copyright. It certainly does not make the presumption conclusive. The very purpose of registration of copyright is to protect the interest of a person who has invented or prepared a particular work as against a person who wants to take undue advantage of the same in order to deceive the unwary public. Needless to say that mere failure to get the copyright registered does not invalidate or impair the copyright nor destroys the right to sue for copyright infringement. Reference can be made to Messrs Ferozesons Pvt. Ltd. v. Dr. Col. Retd. K.U. Kureshi and others (2003 CLD 1052), Rabia Bai v. Zeeshan Farooqi (2004 CLD 1163), Digital Medial Solutions Private Limited through Company Secretary v. Warid Telecom Private Limited through Faisal Saeed (2012 CLD 858) and Glaxosmithkilne Services Limited v. Anfords Pakistan (Pvt) Limited (SBLR 2017 Sindh 1537).

10. In India, the relevant provisions regarding the registration of copyrights are Sections 44 and 45 of the Copyright Act, 1957. Section 44 says that there shall be kept at the Copyright Office register in the prescribed form to be called register of copyright. Section 45, which is *pari materia* to section 39 of the Ordinance of 1962, reads as under:

45. (1) The author or publisher of, or the owner of or other person interested in the copyright in, any work may make an application in the prescribed form accompanied by the prescribed fee to the Registrar of Copyrights for entering particulars of the work in the Register of Copyrights.

(2) On receipt of an application in respect of any work under sub-section (1), the Registrar of Copyrights may, after holding such inquiry as he may deem fit, enter the particulars of the work in the Register of Copyrights.

While interpreting afore-referred provision, the Dehli High Court in the case reported as *Glaxo Operations UK Ltd., Middlesex (England), and others v. Samrat Pharmaceuticals, Kanpur (1984 AIR (Delhi) 262)* observed as under:-

21.... It is apparent from a plain reading of Section 45 that it is discretionary with any author of any work to apply for the registration of copyrights and that registration as such does not confer any rights. There is no other provision at all in the Copyright Act which confers rights on account of registration of a copy right. Therefore, copyrights exist whether the registration is done or not and the registration is merely a piece of evidence as to when a certain author started claiming copyrights in some artistic or some other work.

22. When the registration does not confer any rights it is to be seen as to how copyrights in favour of a person come into existence. Section 13 of the Copyright Act gives a clue as to how a copyright is acquired. It says that copyright shall subsist throughout India, inter alia, in case of original literary, dramatic, musical and artistic works. Therefore, emphasis is on the originality. It is, therefore, that artistic work which is original in which copyrights can vest. According to Section 17 of the author of the work shall be the owner of the copyright therein...."

Similarly, section 48 of Indian Copyright Act, 1957 corresponds to section 42 of the Ordinance of 1962, which reads as under:-

48. Register of Copyrights to be prima facie evidence of particulars entered therein.-The Register of Copyrights shall be prima facie evidence of the particulars entered therein and documents purporting to be copies of any entries therein, or extracts therefrom certified by the Registrar of Copyrights and sealed with the seal of the Copyright Office shall be admissible in evidence in all Courts without further proof of production of the original.

The Madras High Court in the case reported as *M/s. Manojah Cine Productions v. A. Sundaresan and another [1976 AIR (Madras) 22]*, while dealing with afore-referred provision rendered following observations:-

It may be seen from the provisions which we have just now noticed that the only effect of registration is what it stated in Section 48, to wit, that it shall be *prima facie* evidence of the particulars entered in the register. Hardly is there any indication in any of the provisions of the Act, read individually or as a whole, to suggest that registration is a condition precedent to subsistence of copyright or acquisition of ownership thereof.

11. Having established that respondents' claim is based on infringement of copyright and irrespective of registration of the

copyright, they are entitled to all remedies, provided in Chapter XIII of the Ordinance of 1962, by adopting procedures provided therein – in contrast to simpliciter passing off actionable in tort before the Court of first instance. A designated forum i.e. Intellectual Property Tribunal (section 16 of the IPO Act of 2012) has been provided, replacing the Court of District Judge earlier provided by the Ordinance of 1962. Section 17(4) of the IPO Act of 2012 specifically provides that *no court other than a Tribunal shall have or exercise any jurisdiction with respect to any matter to which the jurisdiction of the Tribunal extends under this Act.* Section 18 of the IPO Act of 2012 talks about jurisdiction of the Tribunal and says that *all suits and other civil proceedings regarding infringement of intellectual property laws shall be instituted and tried in the Tribunal.* Moreover, the intent of legislature regarding exclusive jurisdiction of the tribunal in all matters of intellectual property rights can also be inferred from section 18(2), which contain a *non-obstante clause*, and clearly bars the jurisdiction of all other courts regarding offences pertaining to intellectual property laws which was otherwise available to a court of Magistrate of the first class under section 72 of the Copyright Ordinance, 1962. Section 18 (2) is reproduced as under:

(2) Notwithstanding anything contained in any other law for the time being in force, the Tribunal shall have exclusive jurisdiction to try any offence under intellectual property laws.

Before pondering further upon the matter of jurisdiction in cases pertaining to intellectual property disputes, this Court has to first look into the intent of the legislature by taking into consideration the preamble of the IPO Act of 2012 to determine the scope of the IP Tribunal. The relevant portion of the preamble is reproduced as under:

AND WHEREAS it is expedient to establish the Intellectual Property Organization of Pakistan to provide for the institutional arrangement in the state setup for taking up exclusively and comprehensively all subjects and matters relating to intellectual property rights in an integrated manner and for matters connected therewith or incidental thereto;

The preamble makes it crystal clear that the very purpose of the IPO Act of 2012 is to consolidate the intellectual property regime by establishment of Intellectual Property Organization along with establishment of Intellectual Property Tribunal having exclusive jurisdiction in adjudication of all civil as well as criminal matters arising out of or in relation to the intellectual property laws in Pakistan. Moreover, there is no indication of even a slightest degree which can lead to the inference that any matter pertaining to intellectual property rights or matters connected therewith or incidental thereto is either excluded from the jurisdiction of the tribunal or that some restriction is imposed by the legislature for the exercise of said exclusive jurisdiction.

Even otherwise, a Court which is specialized and exclusive on a particular subject would be more equipped and focused to deal with special subject which may involve interpretation of specialized legal terms and concepts, as compared to an ordinary Court of civil jurisdiction. This stance also finds its support from the latest amendment regarding jurisdiction of civil courts in the Code of Civil Procedure, 1908 (“CPC”). As per Province of Punjab Amendment brought in section 9 of CPC (inserted by Punjab Act XIV of 2018, dated 20th March, 2018), the jurisdiction of Courts provided in the CPC is barred where a general or special law is in force. From this perspective also, respondents cannot insist to pursue their claim before the Civil Court.

12. The term “Intellectual Property Laws” has been defined in section 2(h) of the IPO Act of 2012 to mean that *the laws specified in the Schedule*. Entry 2 of the Schedule duly mentions “The Copyright Ordinance, 1962 (XXXIV of 1962)”. Needless to say that where the legislature has created a special Court that would deal with all matters relating to Intellectual Property Laws including matters relating to intellectual property rights along with matters concerned therewith or incidental thereto notwithstanding that the suit may involve other non-IP related matters. Reference

can be made to cases of Muhammad Multazam Raza and Messrs Shaheen Chemist supra.

13. The reliance on case-law by learned counsel for respondents is misplaced as the referred cases are on quite distinguishable set of facts, thus inapplicable to the peculiar facts and circumstances of this case.

14. In view of the above, instant petition is allowed and judgment dated 24.06.2022, passed by learned Addl. District Judge, Lahore, is set aside. Consequently, plaint of respondents' suit shall stand returned for its presentation before concerned Intellectual Property Tribunal, if so advised.

(Muhammad Sajid Mehmood Sethi)
Judge

APPROVED FOR REPORTING

Judge

Sultan