

Judgment Sheet

**IN THE LAHORE HIGH COURT LAHORE
JUDICIAL DEPARTMENT**

Case No:FAO No.433/2014.

Muhammad Qasim Vs. Registrar of Trade Marks etc.

JUDGMENT

Date of hearing	30.10.2024
Appellant by	Mr. Raheel Ahmad Sheikh, Advocate
Respondents by:	Barrister Syed Sajjad Haider Rizvi, AAG-Pk. for Registrar of Trade Marks (respondent No.1). Respondent No.2 (in FAO No.433/2014) & Respondent (in RFAs No.1073 & 1074 of 2014) already proceeded against ex parte on 19.11.2020 and (in RFA No.1077/2014) on 22.11.2023.

ABID AZIZ SHEIKH, J. This judgment will also decide RFAs No.1073, 1074 and 1077 of 2014 being interconnected and common questions of law and facts raised in all these appeals.

2. Relevant facts are that the appellants (Muhammad Qasim) being proprietor of Registered Trade Mark No.210893 in Class 35 for the trade mark M/s “Hafiz Pipe Store” with Logo w.e.f. 25.06.2005 (**Trade Mark**) filed three separate suits against respondents (in RFAs No.1073, 1074 and 1077/2014) for the grant of permanent injunction etc. against

infringement of above registered trade mark as well as damages caused to the appellant for loss and injury due to sale and profit made by the defendants therein. The said suits were filed before the District Court Faisalabad on 07.10.2010 and during pendency of these suits, one Asghar Ali (respondent No.2 in this FAO No.433/2014) filed application on 09.04.2011 before the Trade Marks Registrar (**Registrar**) under section 73, 80 and 96 of the Trade Mark Ordinance, 2001 (**Ordinance**) read with rule 68 of the Trade Mark Rules, 2004 (**Rules**) for revocation, invalidation and rectification of the Trade Mark. The said application was *ex parte* allowed by the Registrar on 28.06.2014. After aforesaid order of the Registrar, the defendants (respondents in RFAs) in all three suits filed separate applications under Order VII Rule 11 of Code of Civil Procedure, 1908 (**CPC**) for rejection of plaints. Consequently through impugned orders dated 27.06.2014, the plaints in all three suits were rejected on the ground that trade mark of the appellant had been revoked by the Registrar on 12.05.2014. The appellant being aggrieved of the order passed by the Registrar dated 12.05.2014 and orders passed by the learned Addl. District Judge, Faisalabad dated 27.06.2014, has filed these four connected appeals.

3. Despite service, no one appeared on behalf of contesting respondents who have already been proceeded against *ex parte* in FAO No.433/2014, RFAs No.1073 & 1074 of 2014 on 19.11.2020 and in RFA No.1077 of 2014 on 22.11.2023.

4. Learned counsel for the appellant submits that the impugned order dated 12.05.2014 by the Registrar was passed *ex parte* without giving any proper notice of hearing to the appellant. He submits that the civil suits concerning Trade Mark in question being already pending before the District Court, Faisalabad, the revocation of trade mark application could not be entertained by the Registrar and he was required to refer the said application to the District Court, where the suits were already pending. Submits that the three suits of the appellant were not only for the infringement of the Trade Mark but they were also on the basis of claim of passing off the goods. Submits that even if the Trade Mark was revoked, the suits were still maintainable to the extent of passing off goods, hence plaints could not be rejected under Order VII Rule 11 CPC.

5. Learned Law Officer assisted on the legal questions raised and submits that after promulgation of The Intellectual Property Organization of Pakistan Act, 2012 (**Act of 2012**), the

jurisdiction in respect of intellectual property matters including the revocation, invalidation and rectification applications and trade mark infringement are with the Intellectual Property Tribunal (**Tribunal**) constituted under the Act of 2012.

6. Arguments heard. The record shows that the appellant's three suits for permanent and mandatory injunction, damages for the infringement of Trade Mark and on account of sale and profit made by the respondents in RFAs No.1073/2014, 1074/2014 & 1077/2014 (defendants) were filed on 07.10.2010. The relief sought in all three suits was same, however to better appreciate the proposition in hand, the prayer clause of one of the suits titled "Muhammad Qasim vs. Hafiz Muhammad Arshad" is reproduced hereunder:-

"Under the circumstances, it is therefore, respectfully prayed that a decree for

- (a) *Permanent injunction restraining the defendant, their servant agents, employees and all persons claiming through or under defendants jointly/ and or severally from infringing the plaintiff's registered Trade Mark/Trade Name and copy righted word 'Hafiz' (حافظ) in any manner whatsoever by using the said Trade Mark>Title 'Hafiz' (حافظ) for their goods and services.*
- (b) *For a decree directing the defendant to furnish accounts of sales and profits made by the defendant through use of Trade mark>Title 'Hafiz' (حافظ) and to make payment to the plaintiff of all such sum as may be found due upon taking of such accounts.*
- (c) *To direct the defendant to make payment of damages to the plaintiff for loss and injury caused to the plaintiff.*

- (d) *A decree directing the defendant to deliver up to the plaintiff all the advertising material, promotional material, goods, blocks, plats and all other materials bearing the infringing Trade Mark and Service Mark 'Hafiz'.*
- (e) *For the cost of suit.*
- (f) *Any other relief which this honourable Court deems fit may also be granted."*

7. In the above said suits, the issues were framed on 11.11.2013 and the matters were pending for recording of evidence. During pendency of the suits, one Asghar Ali (respondent No.2 in FAO No.433/2014) filed application under section 73, 80 and 96 of the Ordinance for revocation, invalidation and rectification of Trade Mark on 09.04.2011 before the Registrar. For convenience section 73(4) of the Ordinance prevailing at the relevant time is reproduced hereunder:-

"73(4). An application for revocation may be made by an interested party to the Registrar, except that-

(a) if proceedings concerning the trade mark in question are pending in the High Court or a District Court, the application shall be made to the High Court or as the case may be; and

(b) in case the application is made to the Registrar, he may at any stage of the proceedings refer the application to the High Court or a District Court."

Provisions of section 80(4) and 96(2) of the Ordinance are similar to section 73(4) above.

8. Section 73 relates to the revocation of trade mark, section 80 relates to the invalidation of trade mark whereas section 96 of the Ordinance relates to the rectification of Registered Trade Mark. Under sections 73(4), 80(4) and 96(2) of the Ordinance, if the proceedings concerning the Trade Mark in question are pending in High Court or District Court, the application shall be made to the said Court for revocation, invalidation or rectification. In case the application is made to the Registrar, he may at any stage of the proceedings refer the application to the said Court. The legislative intent emanating from the above provisions is that there ought not be piecemeal adjudication of intellectual property claims in relation to the same trade mark. The purpose is to avoid conflicting decisions and to encourage consistency of views on proceedings concerning the trade mark in question.

9. In present case, admittedly suits concerning Trade Mark were already pending before the District Court, Faisalabad since 07.10.2010, therefore the revocation/invalidation/rectification application under section 73, 80 and 96 of the Ordinance was required to be filed before the District Court or when the same was filed before the Registrar, the Registrar was required to refer the same to the District Court where the suits were already pending. Perusal of the impugned

order dated 12.05.2014 passed by the Registrar shows that this fact was neither brought to the notice of the Registrar by the respondent nor this question was even discussed in the impugned order dated 12.05.2014. The appellant was also not heard before passing of the impugned order though he was duly represented as evident from various emails on behalf of his counsel (Mr. Raheel Ahmad Sheikh, Advocate).

10. From prayer clause of the suits reproduced in para 6 above, it is manifest that the suits filed by the appellant were based upon infringement of registered Trade Mark of the appellant at the relevant time, therefore, the suits will fall within the term “proceedings” under section 73(4), 80(4) and 96(2) of the Ordinance. The term “proceedings” has been elaborated by the Supreme Court in The State through Advocate General, N.W.F.P., Peshawar vs. Naeemullah Khan (2001 SCMR 1461) as under:-

“Keeping in view the literary meaning and the interpretation of the word ‘proceedings’ as interpreted in various pronouncements given above, we are of the opinion that the word ‘proceedings’ is a comprehensive expression which includes every step taken towards further progress of a cause in Court or Tribunal, from its commencement till its disposal. In legal terminology the word “proceedings” means the instituting or carrying on of an action of law. Generally, a ‘proceedings’ is the form and manner of conducting judicial business before a Court or judicial officer, including all possible steps in an action from its commencement to the execution of a judgment and in a more particular sense it is any

application to a Court of justice for aid in enforcement of rights, for relief, for redress of injuries, or damages or for any remedial object. It in its general use comprehends every step taken or measure adopted in prosecution or defence of an action.”

11. Being proceedings concerning Trade Mark were already pending before the District Court, Faisalabad, the respondent Asghar Ali was required to file application before the District Court instead of Registrar and even if the application was filed before the Registrar, he was required to transfer the same before the Court where proceedings concerning the Trade Mark were already pending. The similar view was also expressed by this Court in ITALFARMACO S.P.A. vs. HIMONT PHARMACEUTICALS (PVT.) LTD and another (2017 CLD 1382) where this Court returned the application for declaration of invalidation of Trade Mark under section 80(4) of the Ordinance for placing it before the Court where proceedings were pending. The same view was also expressed in Royal PVC (Pvt.) Ltd. through Authorized Officer vs. Registrar of Trade Marks and another (2011 CLD 833), Messrs H&B, General Trading company through Director vs. Messrs International Marketing Company through Proprietor and 2 others (2009 CLD 1028), Messrs H&B General Trading Company through Director vs. Messrs International Marketing Company through Proprietor and 2 others (2009 CLD 318)

and Messrs H & B General Trading Company through Director vs. Messrs International Marketing Company through Proprietor and 2 others (2009 CLD 354). In view of above discussion, the impugned order dated 12.05.2014 of the Registrar (subject matter of FAO No.433/2014) is not sustainable on this ground alone and the application is required to be referred and decided by the Court where suits were pending.

12. The perusal of the impugned orders dated 27.06.2014 by Additional District Court, Faisalabad (subject matter of RFAs) shows that plaints were rejected under Order VII Rule 11 CPC on the sole ground that *prima facie* Trade Mark registration was cancelled by Registrar on 12.05.2014. However this fact was not considered that the appellant case was not only for the infringement of trade mark but also damages on the basis of passing off goods. Further once the Registrar's order dated 15.05.2014 is found to be without jurisdiction by this Court, the impugned orders dated 27.06.2014 for rejection of plaint on the basis of Registrar's order dated 12.05.2014 are also not sustainable.

13. Before parting with the Judgment, it is relevant to note that presently the matters relating to intellectual property rights are governed under the Act of 2012. The purpose of the

said Act of 2012 as per its preamble is to provide institutional arrangement for taking up exclusively and comprehensively all steps and matters regarding the intellectual property rights in integrated manner. Section 2(h) of the Act of 2012 defines the intellectual property laws as the laws specified in the schedule to the Act of 2012 which include the Ordinance. Section 16 of the Act of 2012 provides for creation of Intellectual Property Tribunals and under section 17 and 18 of the Act of 2012, the Tribunals will have exclusive jurisdiction in respect of matters under which the jurisdiction of the Tribunal extends under the Act of 2012. In this regard reliance is also placed on Muhammad Multazam Raza vs. Muhammad Ayub Khan and others (2022 SCMR 979) and Messrs Shaheen Chemist through Proprietors and 3 others vs. Zahid Mehmood Chaudhry and another (2023 CLD 1). Therefore, now the instant matters on remand are to be dealt with by the Tribunal instead of District Court mentioned in sections 73, 80 and 96 of the Ordinance at the relevant time.

14. In view of above discussion, **all these appeals are allowed**, the impugned order dated 12.05.2014 passed by the Registrar and impugned orders dated 27.06.2014 passed by the Additional District Judge, Faisalabad are set aside and the matters are remitted back to the Tribunal where the application

filed by the respondent (Asghar Ali) under sections 73, 80 and 96 of the Ordinance and suits filed by the appellant shall deem to be pending and will be decided afresh through reasoned and speaking order.

**(Abid Aziz Sheikh)
Judge**

Approved for reporting.

Judge

*Riaz Ahmad**