

IN THE SUPREME COURT OF PAKISTAN

(Appellate Jurisdiction)

Present:

Mr. Justice Mian Saqib Nisar

Mr. Justice Mushir Alam

Civil Petitions No.2066 to 2068 of 2013

Against judgment dated 12.09.2013 of High Court of Sindh at Karachi, passed in Miscellaneous Appeals No.1, 2 & 3 of 2011.

M/s Farooq Ghee & Oils Mills (Pvt) Ltd

Petitioner *(in all cases)*

VERSUS

Registrar of Trade Marks, Trade Mark Registry & others

Respondents *(in all cases)*

For the Petitioner(s):

Syed Arshad Hussain Shah, ASC
(in all cases)

For the Respondent(s):

Mr. Munawar Ghani, ASC
(in all cases)

Date of Hearing:

20.01.2015

ORDER

Mushir Alam, J.- Petitioners, Farooq Ghee & Oil Mills (Pvt.) Ltd. have impugned the Judgment dated 12.09.2013, passed by a learned Single Judge of Sindh High Court, in Chambers, in Miscellaneous Appeals No.01, 02 and 03 of 2011 respectively, whereby consolidated order dated 29.9.2009 passed by the learned Registrar of Trade Marks, in the matter of registration of trade mark "HAYAT", favouring respondent No.2 was maintained and Miscellaneous Appeals were dismissed.

2. Facts in brief, appear to be that M/s International Foodstuff Company of UAE, (*hereinafter abbreviated as IFFCO*) the Respondent No.2 herein, through Application No.140853 dated 11.04.1997 applied for the registration of Trade Mark "HAYAT" for the goods in Class 29, which *inter-alia* included "*edible oils, and fat; ghee; margarine*". Application inviting opposition for the said trade mark was advertised in Trade Mark Journal dated 1.2.2003 published on 14.6.2003, to which the Petitioner filed Opposition No.481/2003.

3. IFFCO, through yet another Application No. 189056 dated 01.8.2005, applied for the registration of trade mark "*HAYAT*" in Class 29, which was advertised in Trade Mark Journal dated 01.08.2005, published on 21.8.2005 to which also the Petitioner filed opposition No.835/2006.

4. Petitioner adopted for itself Trade Mark styled as "*FAROOQ'S Hayat*", for the goods in Class 29 and applied for its registration through Application No. 179894, dated 24.8.2002, which was advertised in Trade Mark Journal dated 01.01.2005, published on 11.11.2005, registration of which was challenged by the Respondent No.2 through opposition No.01/2006 on the strength of their earlier Application for registration No. 140853 dated 11.04.1997

5. All the Applications for the Registration of the competing mark and oppositions thereto, filed by the rival claimants under Section 14(1) of the Act, 1940 were taken up, heard and decided by the learned Registrar of Trade Marks, through common order dated 29.9.09. The Registrar of Trade Marks, in consideration of facts that the IFFCO through evidence has established to the satisfaction of Registrar that they are the originator, proponent and prior user of the Trade Mark "*HAYAT*", which mark is not only registered in various jurisdictions but is also used in Middle Eastern and various other countries since 1990. In Pakistan, they started import of its goods (*Oil and Ghee*) under said brand name or Trademark since 1996, which was supplemented by various invoices evidencing import and use into Pakistan ever since, whereas, the Petitioner adopted the competing mark and applied for its registration on 24.8.2002, after more than a decade of its adaption by the IFFCO. Consequently, both the Applications for the Registration of the Trade Mark "*HAYAT*" in Class 29, made by the IFFCO and their opposition to the Registration of the Trade Mark "*FAROOQ'S Hayat*" filed by the Petitioner were allowed and the Application for registration of impugned mark "*FAROOQ'S Hayat*" filed by the Petitioner and their Opposition Applications were also dismissed.

6. Learned ASC for the Petitioner contended that both the marks are quite distinct. It was argued that thorough search was

made in the Trade Marks Registry, and as per search report dated 23.10.2002 it was revealed that registered mark is "nil" and two applications in class 29 were pending for different products, and in market search, according to learned counsel for the Petitioner, similar products were not available, therefore, bonafide and in good faith petitioner had adopted the mark "*FAROOQ'S Hayat*" for Banaspati Ghee, Cooking Oil, Edible Oil, and Palm Oil.

7. Contentions of the learned ASC for the Petitioner are not substantiated from the record. The official search report (Memorandum) dated 23.10.2002 discloses that IFFCO's Application No.140853 for the trade mark *HAYAT*, was already pending in class 29 for "*Meat, fish, country and games; meat extracts, preserved dried and cooked fruits and vegetables; jellies; jam; fruit sauces; eggs, milk product; edible oils and fats; ghee; margarine; being goods included in class 29*" (page 41 in CPLA in 2067/13) (*emphasis supplied*), therefore, it cannot be urged that the petitioners were not aware of the adoption and use of Trademark 'HAYAT' by IFFCO.

8. It may be observed that section 8(a) of the Trade Marks Act, 1940 forbids registration of trade mark and or a part of the trade mark that may comprise of or embraces, any scandalous design or any matter the use of which would by reason of *its being likely to deceive or cause confusion or otherwise*, be disentitled to protection in a Court of justice (*emphasis added*) Likewise section 10(1) of the Trade Marks Act, 1940, puts a clog on the registration of trade mark in respect of any goods and or description of goods which is identical with a trade mark belonging to a different proprietor and either already registered in any of the acceding state in respect of same goods or descriptions of goods or "*which so nearly resembled such trade mark as to be likely deceive or cause confusion*". The exception to this general restriction is provided under various provisions of the Act of 1940. Sub-section (2) to section 10 *ibid* is extended to "*honest and concurrent use*" or if there exist "*other special circumstances*" that too is subject to such conditions and or limitations as may be imposed by the Registrar or where in terms of section 13 (b) *ibid*; the trade mark applied for is "*common to trade or otherwise of a non distinctive use*" and or that the petitioner is in

terms of Section 25 (2) *ibid*; is a prior user of the competing mark. Petitioner has not been able to demonstrate that his case falls under any of the exception clauses catered for under such statutory exceptions provided under the Act 1940.

9. As regards contention of learned ASC for the Petitioner that both the marks are quite distinct and dissimilar and there is no likelihood of confusion and or deception. According to him, use of prefix FAROOQ'S, the trading name of the Petitioner to the word 'Hayat', distinguishes petitioners good from that of IFFCO. He placed reliance on the case reported as *Uniliver Ltd v. Sultan Soap Factory (PLD 1991 SC 939)* and *Ekhlik Ahmed v. Dae Health Laboratory limited London 1980 SCMR 625*). It may be observed that, registration of trade mark is not restricted to one word, but it may comprise of composite and or composition of common to use and or invented words, coupled with numerical, device, diagram, picture and or any image etc. and or any combination thereof. Certain trademarks do carry one or more prominent feature that clearly distinguishes goods of one proprietor from their competitors dealing in similar goods, such distinguishing feature in parlance of intellectual property is termed as 'dominant feature'. In instant case the trade mark "HAYAT" in Arabic/Urdu and English as is adopted and used by IFFCO since 1990 in overseas market and also in Pakistan since 1996 is displayed on its goods with pictorial of vegetables, poultry etc laid in a peculiar fashion. Petitioner has adopted the mark Hayat for same class of goods, by adding "FAROOQ'S" printed in small script as a prefix to the striking and or dominating feature "HAYAT". It may be observed that merely adding a prefix and or suffix to already existing trademark will not save the Petitioner from the clutches of Section 8 of the Trade Marks Act 1940, which prohibits registration of a trade mark or a part of trade mark, which is "*likely to deceive or cause confusion*". Trade Marks Act, 1940 (as succeeded by Trade Marks Ordinance 2001, which came into force on 12.4.2004 per SRO No.212(I)/2004) not only protect consumers, but also traders who adopt a particular trademark, which distinguishes their goods, products and services from other competing traders, producers and service providers. The Act 1940/Ordinance, 2001, provides mechanism, to protect such trademark and forbid anyone attempting to appropriate to itself and

or to thrive on the goodwill and reputation created by another and or to deceive customer in assuming and or believing that the goods, merchandise and or services reputed to belong or associated with some one else are his or associated therewith, it is of no consequence that such representation and or assumption is fraudulent or not. Law protects honest traders, encourages due observance of fair play, moral and ethical values in trade and business practices. Courts of law always frown on unfair trade and business practice, that may tend to encourage malpractice, and or usurpation of goodwill and market created by some one else, such wrongdoing cannot be termed any thing short of robbing some one of his hard earned goodwill and or rights in (intellectual) property. In the case of Uniliver Ltd (PLD 1991 SC 939), use of the mark LIGHT was opposed by the proprietor of the trade mark "SUNLIGHT, on the ground that LIGHT is part of the Appellant mark SUNLIGHT. This Court considering all aspects of the case and taking into consideration effect of trade marks comprised of two syllable, took note of the words "create striking effect and cause confusion or deception". It was held that mere use of the word "LIGHT" will not automatically be taken as SUNLIGHT or the product of the appellant. The Court also took note of the fact that many trade marks were already registered with prefix "SUN" This court allowed respondent the use of LIGHT within certain territorial bound and by adding its trade name SULTAN before LIGHT. Case of *Ekhlq Ahmed 1980 SCMR 625*, is of no help to the Petitioner rather goes against the Petitioner. In the cited case, this Court itself examined the competing mark by examining the copy of carton of "VEST" applied for registration, with that of the trade mark "VEET" of the foreign based company and found visual and phonetic similarity between both the mark and declined to interfere in the finding recorded by High Court.

10. From the record it is sufficiently established that the Petitioners have adopted the trade mark "*FAROOQ'S Hayat*" it encompasses the mark "HAYAT", which is the striking or dominating feature of the trade mark of IFFCO such trademark was already in use and associated with IFFCO since 1990. In instant case adoption of dominant feature being "HAYAT" is not only strikingly similar but is identical as noted above, merely adding prefix of "*FAROOQ'S*" in inconspicuous manner to the dominant or striking feature of the

existing trademark HAYAT is of no consequence. The prefix "FAROOQ'S" as used by the Petitioner in instant case does not eclipse, overshadows or obscures the dominating mark HAYAT in a way that may distinguish his goods with that of the goods of the IFFCO. If the competing trade mark of the Petitioner is allowed registration, it would not only be encouraging unscrupulous traders to steal some one else's goodwill and (intellectual) property, but at the same time unwary purchaser would be exposed to more than reasonable probabilities of confusion and deception. It is not only the registered trademark but the trademark proposed to be used is given statutory protection under sections 8(a) & 10(1) of the Trademarks Act, 1940.

11. It was next argued that the artistic work in the name of "FAROOQ'S Hayat"; has found favor under the Copyright Act, 1962, therefore the Petitioner has perfected his right being registered under the Copy Right Act 1962; thus should have been given preference to use the mark "FAROOQ'S Hayat" for its goods as against IFFCO.

12. Arguments are fallacious on more than one counts, firstly the 'Registration of Copyrights' work is dated 12, April 2004 (page 48 of the CPLA/2068/13), which is much after the date of adoption of the mark and application for registration of the Mark by the IFFCO and, secondly at the foot of such certificate it is boldly mentioned that

" PLEASE NOTE THAT TITLE/ NAME/ BRAND/MARK GIVEN BY THE APPLICANT IN APPLICATION FORM OR APPEARING ON "WORK" IS NOT REGISTERED BUT ONLY THE EXPRESSION/ STYLE/ GETUP OF THE "WORK" IS REGISTERED/ PROTECTED UNDER COPYRIGHT LAW."

13. It is not very uncommon that unscrupulous traders or the manufacturers tend to confuse and or mislead consumers of goods of known or popular brands by taking shield and protection under various other laws governing intellectual property rights namely Patent, Merchandise, Designs, Trade Marks and or Copy Rights. There is growing tendency of using such terms interchangeably or treating such terms synonymously. It may be observed that there may be some similarities and overlapping in

intent and purport of such rights, but rights of a proprietor/owner in each namely trademark, merchandise mark, Patent and Design and or Copyrights govern different category of intellectual properties and recognize host of different and special rights, obligations and remedies in their respective domain. There is growing tendency of misappropriating rights in one type of intellectual property by seeking protection under different statute governing altogether different intellectual property. Most abused are rights in trade marks under the garb of copyrights, later aims to protect original works of art or creative articulation may be of a trademark in any tangible medium of expression, whereas, trademarks is associated with the goods for the purpose of indicating or so to indicate a connection in the course of trade between the goods and some person having the rights, either as a proprietor or as registered user, to use or apply the trade mark on his goods. Trademarks Act, 1940 protects the proprietor to use the trademark on his goods, and prevent others competitors from using and applying identical and or confusingly similar trade mark on their goods of similar class or description. There is no prohibition under the Trade Marks Act, 1940, for the competitors/traders from making, producing or marketing same or similar goods; only restriction placed is on the use and or adoption of same or deceptively and or confusingly similar trade mark. A trader may make or market or sell same or similar category of goods falling in same class but under different brand name or trademark that clearly distinguishes its goods from same category or class of goods. Petitioner may continue to manufacture, produce and market its competing and similar goods under class 29, but under different brand name or trademark.

15. A copyright material cannot be allowed to be used as an alternate and or in substitution for the trademark, unless, of course, such copyright in the artistic work was also registered under the Trade Marks Act, 1940. It may be noted that Practice of using copyright as a substitute for the trademark was deprecated and defence of the infringer resting on registration of copyright was sternly rejected in large number of cases including cases reported as *Tapal Tea (Pvt) Ltd. Shahi Tea Co. (2002 CLD 1113)*, *Pak Drug House v. Rio Chemical (2003 CLD 1531)*, as upheld by a learned Division Bench in the case reported as *Pak Drug*

House v. Rio Chemical (2003 CLD 1531), M/s ADT Services AG v. ADT Pakistan (Pvt.) Ltd (2005 CLD 1546), Muhammad Wahid v. Adnan Memon (2010 CLD 450). In most of the reported cases, the Courts have rightly desired amendments to protect valuable rights and obligations in intellectual property under various statutes regulating such rights and obligation and arrest, misuse and abuse of such statute to the detriment of honest and truthful traders and entrepreneurs.

15. No other grounds were urged. For what has been discussed above, order dated 29.09.2009 passed by the learned Registrar of Trademarks and the impugned order dated 12.09.2013 passed by High Court in appeals, could not be interfered with. Consequently, the listed Civil Petitions are dismissed and leave to appeal is refused.

Judge

Judge

ISLAMABAD, THE
20th of January, 2015
Zubair