

HELLO



Bharucha & Co.
Intellectual Property Attorneys

Series of brief newsletters released by Bharucha & Co. on latest development of IP predominantly in Pakistan.

TRADE DRESS –DISTINCTIVE FEATURE OF A MARK – APPEAL BEFORE THE DIVISIONAL BENCH, SINDH HIGH COURT

Appellant: HAMDARD LABORATORIES (WAQF) PAKISTAN, through Director
Respondent: MUHAMMAD FAHIM
Decision: Appeal Allowed

The appellant preferred an appeal before a Divisional Bench of the Sindh High Court, against the decision of the Single Judge having dismissed the injunction application of HAMDARD DAWAKHANA (WAQF) PAKISTAN (the Appellant) against MUHAMMAD FAHIM (the Respondent). It was held that it should not be a mere claim of similarity but claim of similarity should qualify the test that it (similarity), overall, should be to resemble that an ordinary consumer may not differ between what he intended to purchase or is presented to him. A bare look does not lead to any confusion because not only the colour scheme but also the calligraphy and its manner are quite different from each other. Merely having photograph/picture of different fruits is not sufficient to believe the plea of the plaintiff/Appellant that label of the defendant's/Respondent's product 'Rooh-e-Samar' shall cause 'confusion' or 'deception' to its customers of 'Sharbat Rooh Afza'. The color scheme(s) of these two are entirely different with considerable distinction to an ordinary eye; the calligraphy is also differently posed and even picture of fruits is different from that of 'Sharbat Rooh Afza'. Consequently, he concluded that plaintiff has no prima facie case in its favour so as to deprive the defendant from doing/continuing the lawful business or trade

Referring to the impugned order, the counsel of the Appellant contended that though the order admits concept of similarity comparisons between the two marks, however, the learned single Judge's observations were on a microscopic level by suggesting "...mere having photograph/picture of different fruits is not sufficient to believe the plea of the plaintiff that label of the defendant's product 'Rooh-e-Samar' shall cause 'confusion' or 'deception' to its customers of 'Sharbat Rooh Afza'. The color scheme(s) of these two are entirely different with considerable distinction to an ordinary eye; the calligraphy is also differently illustrated and even picture of fruits is different from that of 'Sharbat Rooh Afza'. The counsel further submitted that such conclusion reached by the learned Single Judge is not founded on the legal principles and it negates the remedies provided by the trademark law, the counsel prayed that being one of the most popular trademark of Pakistan filed and protected since 1942, courts must come forward to grant protection to the Appellant's well-known trademark.

The counsel for the Respondent, on the other hand placed heavy reliance on the grounds leveled in the impugned order and tried to show minute difference between rival marks' (e.g. colour of grapes being green in the Appellant's mark, while grapes of red colour appear in the Respondent's mark). Furthermore, the learned counsel contended that the calligraphy used by the Respondent is of different style as compared to that of the Appellant.

After hearing both the learned counsels and perusal of the record, the Appellate Court relying on most famous tests "Moron in a Hurry" and "Lapp" tests arising out of Morning Star Cooperative Society v. Express Newspapers Limited (1979 FSR 113) and Interpace Corp. v. Lapp, Inc., 721 F.2d 460 (3d Cir. 1983) respectively and the famous age-old "Classic



© Bharucha & Co., all rights are reserved.



Bharucha & Co.
Intellectual Property Attorneys

Trinity" test held that use of the intended trademark, trade dress and get-up by the Respondent infringed common-law right of the Appellants as well as its statutory rights provided pursuant to its registration and continuous use of its Rooh Afza trademark and trade dress, thus the instant appeal was allowed, the impugned order was set aside and the Respondent, its servants, agents, representatives and all persons claiming through it, were restrained from infringing the Appellant's registered trademark Rooh Afza and Label in any manner by selling, marketing, offering for sale, advertising or otherwise using on its syrup trade mark Rooh-e-Samar either alone or in conjunction with any other mark, words, figures or devices.

