

# HELLO



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Intellectual Property Attorneys

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## Trade Mark “LUNIMARC” Deemed Infringement of “LUMINARC”

**Plaintiff:** ARC INTERNATIONAL through authorized signatory

**Defendants:** AHMER MANSOOR and 2 others

**Decision:** Injunction Granted

The plaintiff, a French company was the owner of the trade mark “LUMINARC” with an Archer Device and letters ARC which was in use in France since 1948. The plaintiff also held copyright registration under the Copyright Ordinance, 1962 in Pakistan. The plaintiff asserted that it has been marketing its products by extensive sale promotions and advertisements through multimedia in numerous countries including in Pakistan. It also stated that its trademark had acquired substantial reputation and goodwill throughout the world including in Pakistan and it is well known in the field of glassware and utensils. The case of the plaintiff was that the defendants by using the trade mark “LUNIMARC” with an Archer Device in reverse position, were committing infringement of its well-known trade mark, as well as infringement of its copyright in the artistic works, causing deception and confusion to common consumers and amounts to an act of unfair competition under the provision of Section 67(f) and (g) of the Trade Marks Ordinance, 2001. The court held that the test of prima facie case has been achieved by the plaintiff, the peculiar embodiment of Section 86 of the Ordinance is quite liberal when it comes to be gauged from the plaintiff’s point of view and accordingly confirmed the ex-parte injunctive orders.

In this case, the plaintiff claimed to have used its trade mark “LUMINARC” continuously since 1948 in France and held a copyright registration in the artistic representation of its trade marks LUMINARC, ARC and Archer Device. Therefore, any unauthorized use of its artistic and literary works by a third party constitutes copyright infringement of the plaintiff’s rights. That trade mark LUMINARC, ARC and the Archer Device are leading, famous and well known brands in almost all the countries of the world including Pakistan, it is marketing its products by extensive sale promotions and advertisements through multimedia in numerous countries including Pakistan and it is a popular household name in the field of glassware and utensils and allied products. The plaintiff further contended that reputation and goodwill of a trade mark and company are no longer territorial and cannot be confined to national borders of the country, which in fact travels across international borders and has become of international character. That use of the said or similar mark shall deceive and cause confusion in the consumers and that such act having been committed by the defendants without permission or consent of the plaintiff has fallen within the meaning of Section 67 of the Trade Marks Ordinance, 2001, which speaks about unfair competition and the plaintiff’s mark is protected under Section 86 of the Ordinance, being well known.

The plaintiff also submitted that defendant No. 1 has also applied for registration of imitated trade mark “LUNIMARC” by simply replacing letter M with letter N in the earlier part and letter N for M in the later part of the plaintiff’s reputed and well-known trade mark “LUMINARC”. Also imitated is the Archer Device in reverse position with little variation, as in the case of the plaintiff the archer is running while in defendant No. 1’s case, it was standing with the change of weapon to falsely suggest that defendant’s products originate from France, as being manufactured and imported from China.



Rebutting the stand of the plaintiff, the defendant No. 1 asserted that suit is not maintainable as the person/company importing goods from China has not been made party and that the suit is not maintainable under Section 86 of the Ordinance which came into effect in 2004 and that plaintiff is also not entitled protection under subsection (3) in view of subsection (4) which provides that right conferred under subsection (3) of Section 86 is subject to provision of Section 81 of the Ordinance and denied that the trade mark "LUMINARC" of the plaintiff is a well known trade mark, which is neither registered nor used in Pakistan while, the mark of defendant No.1 "LUNIMARC" with device of swordsman is in use by the defendants for more than a decade. It was also asserted that even the Archer Device is registered or applied for registration by the plaintiff while, defendants swordsman device is registered and the device with the word "LUNIMARC" having applied for registration is being opposed by the plaintiff is under adjudication before the Registrar of Trade Marks and requested for dismissal of injunction application as well as rejection suit filed under Civil Procedure Code.

After hearing both the parties, the court after having discussed in detail the provisions relating to well known trade marks observed that the Trade Marks Ordinance in many cases introduces new legal concepts based on the TRIPS Agreement and Paris Convention which were not to be found in the previous trademarks Act and made references to Sections 67 and 86 of the Ordinance. After having discussed in details all the provisions pertaining to well known trade marks and having relied upon the Soneri Travel & Tour case wherein a Division Bench of High Court held that the 2001 Ordinance in many cases uses new and different language. Thus, even in respect of facts and circumstances which may be the same as, or similar to, those as arose under the 1940 Act, the application of the 2001 Ordinance may yet yield different results. Cases decided under, or in relation or with to, the 1940 Act must therefore be reread and reappraised carefully before they are applied to the provisions of the 2001 Ordinance, even if those provisions may appear at first sight to be equivalent to those under the former enactment.

Consequently, the court held that the plaintiff prima facie is not registered proprietor in Pakistan is of no force if gauged from the language of subsection (2) of Section 86 of the Ordinance, which specifically says that the Tribunal while determining whether a trade mark is well known would look into it as such, without having to require registration or actual use in the form of sales of goods or services under the trade mark in Pakistan and shall consider only the factors as relevant criteria to come close whether the trade mark was well known. It would be seen from the seven factors mentioned in subsection (2) of Section 86 of Ordinance 2001 that such are to be seen either in relation to mark of such well known product in Pakistan or worldwide. The plaintiff, for the purposes of injunction, has shown prima facie that their trade mark is well known worldwide. Hence, the ex-parte orders passed by the Court earlier were confirmed.

