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Bharucha & Co.
Intellectual Property Attorneys

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

DATE OF FILING OF SUIT – MARK NOT REGISTERED – DIFFERENT BUSINESSES

Plaintiff: Rupali Polyester Limited – through Attorney Authorized Person
Defendant: Baba China Builders & Developers and 6 others
Decision: Injunction Refused

The plaintiff was seeking interim injunctive relief for alleged infringement of its trade mark “Rupali” by the defendants. The defendants riposte an application under s.80 of the Trade Marks Ordinance 2001 for invalidation of the plaintiff’s trade mark in Classes 16, 36 and 37. The counsel for the plaintiff submitted that the plaintiff is a flagship company of the well known Rupali Group which comprises of companies in the business of manufacturing, exporting, indenting, banking and trade financing. The plaintiff had applied for registration of its mark in 42 classes, which have either been registered or accepted for registration. He particularly referred to applications in Classes 36 and 37 in which he stated the mark was registered. He submitted that defendants were engaged in the business of developers and builders, which are the services, classified in classes 36 and 37. The projects they were developing, incorporated the word Rupali, as “Rupali Twin Tower”, “Rupali Shehar” and “Rupali Twinkle Tower” and that in relation to “Rupali Shehar” the plaintiff had also issued a public notice in the year 2004 for intimation of the public that “Rupali” was the trade mark of the plaintiff’s group of companies and they have nothing to do with the defendants’ project.

The defendants’ counsel opposed the grant of any relief to the plaintiff, contending that defendants had been in construction business since 1995, duly registered with the Sindh Building Control Authority (SBCA), the relevant trade body – Association of Builders and Developers (ABAD) – and had undertaken a number of projects, many or all of which used the word “Rupali” as part of the name. There was honest or concurrent use of the trade mark by the defendants hence they could not be enjoined as prayed by the plaintiff. The business of the plaintiff is wholly unrelated to the business of the defendants and therefore there could not possibly be any confusion between the plaintiff’s business on the one hand and that of the defendants on the other. There had been no infringement of the trade mark as alleged. The learned counsel relied on the defendants’ application under ss. 80 and 81 and contended that not only the plaintiff is not entitled to interim injunctive relief but, its trade mark registrations in Classes 16, 36 and 37 merited being invalidated.

The plaintiff’s counsel exercising his right of reply, on query from court conceded that plaintiff is not engaged in construction business but submitted that it does not mean that it could not have registrations in other classes. The distinctiveness of the trade mark “Rupali” had to be protected as long as the trademark was registered and could not be infringed. Any act in violation of the proprietor’s right is liable to be enjoined. He further submitted that in the absence of any material on record, bare statements and averments, do not constitute any defense to the plaintiff’s claim of infringement. Acquiescence within the meaning of s. 81 was also strongly denied.

The court observed that prima facie, the plaintiff’s trademark has been infringed. Ordinarily, this would entitle the plaintiff to interim injunctive relief. However, after considering the matter, the learned judge, was of the view that it was a fit case in which the court, in its discretion, withheld the grant of such relief due to the factors that there is lack of any



material to establish that that the plaintiff's trade mark was in fact registered on the date of institution of the suit as required by law or it was even subsequently registered, especially in the relevant classes. Another factor was the submissions of the defendants' counsel that the plaintiff was not and had never been in the construction business, which was far removed from the plaintiff's actual areas of business and commercial activity. Consequently, the court held that the plaintiff was not entitled to interim injunctive relief and the same ought to be refused in the discretion of the court and as such the application for grant of interim injunction was dismissed. It further held that the defendants have been unable to make out a case in terms of their application for invalidation of registrations of the plaintiff's trade mark in Classes 16, 36 and 37 hence, that application failed and accordingly dismissed.

The court also ordered to send a certified copy of the decision to the Registrar of Trade Marks, who was directed to ensure that he and his office acts conformably with the decision in respect of all pending and future applications for registration of trade marks, especially when the applicant is a juridical entity established, created or registered by or under any law, whether in force in this country or elsewhere. The Registrar of Trade Marks was also directed to ensure that the decision was to be published immediately in the trade marks journal.

