

# HELLO

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## INVALIDATION OF THE REGISTERED TRADEMARK ENTRY IN THE TRADE MARKS REGISTER

**Petitioner: U.B. CHEMICAL INDUSTRIES COMPANY LIMITED.**

**Respondent: AHMAD NAWAZ and OTHERS.**

**Decision: C.O Application allowed- Trade mark registration No. 247291 dated 03-03-2008 declared invalid.**

In this case, the Applicant filed an application in the Lahore High Court, for invalidation of the entry in the Trade Marks Register of the trade mark "Arche (Label)" registered in class-3 in the name of respondent No-1 (trading as Hamza Cosmetics), on the grounds that the trade mark was registered in breach of section 14 of the Trade Marks Ordinance 2001. Primarily the declaration of invalidity was sought on the grounds of section 80(3) (a) and (b) read as under:

80(3) The registration of a trade mark may be declared invalid on the ground that there is;

- (a) an earlier trade mark in relation to which the conditions set out in subsection (1), (2) or (3) of section 17 obtain or
- (b) an earlier right in relation to which the condition set out in subsection (4) of section 17 is satisfied, unless the proprietor of that earlier trade mark or other earlier right has consented

The Applicant contended that Hamza's trade mark was identical to its earlier trade mark, as it contained the name of the petitioner's brand ARCHE in English and Thai language as mentioned in the Applicant's earlier registered trade mark. Furthermore, the Applicant also claimed that respondent No-1's mark contained the mark which was the exclusive intellectual property of the Applicant by virtue of its registered trade mark and resembled it in respect of the goods marketed by the petitioner. That the meaning of the term 'earlier trade mark' had been elucidated in section 18 of the Ordinance, 2001 and defined to mean a registered trade mark as per the Paris Convention which has a date of application for registration earlier than that of the trade mark in question. The trade mark of Respondent contained the name of the Applicant's brand 'Arche' in English as well as its transliteration in Thai language, the distinctive trade mark of the Applicant which was the exclusive intellectual property of the Applicant and above the word 'Arche' ( had a hand curled in a distinctive style with three fingers pointing upwards and the index finger making a loop with the thumb) the same was also seen in the mark of Respondent.

The Applicant took strong objection to the registration of the trade mark in the name of Respondent who imitated the trade mark of the Applicant and its use in respect of identical cosmetics as that of the Applicant which resulted in the infringement of the trade mark of the Applicant and the proprietary rights in the earlier trade mark. The trade mark was deceptive and designed purportedly to deceive the public and was an attempt in bad faith to reap the benefits of reputation and goodwill of the Applicant and consequently to harm the business interest of the Applicant. This had been done knowing well that the trade mark 'Arche' was the property of the Applicant and was a dishonest attempt to taint the proprietorship of the 'Arche' brand owned and marketed by the Applicant.

The learned counsel for Respondent-1 argued its case and relied on the contents of the written statement filed by the Respondent, which was unable to bring forth any substantial defense having been put up by Respondent-1, so as to stunt challenge made by the Applicant to the issuance of the trade mark in favor of Respondent-1. Hence, the estimation that pronunciation of the word 'Archie' is 'Archoo' in Thai language and on this basis the claim of the Applicant to be discarded absolutely, had no merits in its assertion and it was not discernible as to how this gave a license to it to use the trade mark 'Archie'.

The Honorable learned Judge, observed that there was no doubt in the mind of the court that the marks of both, the Applicant as well as of Respondent-1 resembled each other to such an extent that they were likely to deceive the mind of an unwary customer who would have to rely upon the leading characteristics of the mark of the Applicant which characteristics were also comprised in and were part of the mark registered in the name of Respondent-1 in respect of similar goods as that of Applicant.

It was further observed that the real question to decide in such cases was to see how a purchaser of ordinary intelligence would look to a particular trade mark and what impression he would form by looking at the trade mark. Applying this principle to the instant case, not only were visual appearances of the two marks similar but they also related to the same products and thus an average mind of ordinary intelligence would consider the goods of Respondent-1 as that of Applicant. Thus, the registration in the name of Respondent-1 was likely to deceive or confuse the customers.

Consequently, the application was allowed and trade mark registration no. 247291 dated 3-3-2008 was declared invalid under the provisions of section 80(1) read with sections 14 and 14(4) of the Ordinance, 2001 and was struck off the Register of Trade Marks.

