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OPPOSITION AGAINST REGISTRATION OF TRADE MARK-APPEAL AGAINST THE DECISION OF REGISTRAR IN THE SINDH HIGH COURT

Appellant: M/s AHMAD TEA LIMITED

Respondent: M/s AHMED FOODS INDUSTRIES (PVT) LIMITED
through Secretary or Director or any Principal Officer
and another

Decision: Appeal Dismissed

In this case, the Appellant assailed the decision of the Registrar of Trade Marks (Respondent No.2) whereby the Opposition filed by Respondent No.1 was allowed and Appellant's application for registration of trade mark "Ahmad tea London and device" was refused registration.

The Appellant contended their international presence originating from England, engaged in the sale and export of tea for the going back a few years. The Appellant further contended that in order to promote the sale of tea, it adopted a trade mark consisting of words "Ahmad tea London" with an arch like device on the label in the year 1988 and since then it was being used in the UK, Canada and other countries around the world and that the tea sold under the said trade mark was known and recognized to be of high quality and standard as well as holding goodwill along with reputation. That the Appellant obtained registration in Canada and U.K and also had international registrations which included several countries of the world. That to protect its right they applied for registration of said mark in Pakistan in respect of goods "tea, coffee, jams, and other goods included in class-30". That by virtue of long and extensive use, the trade mark "Ahmad tea London and device" of the Appellant had acquired valuable goodwill and reputation in their favour and that the tea sold under the said trade mark was exclusively associated with the Appellant. That each and every averment made in the notice of opposition was denied by the Appellant. The Appellant also denied that the trade mark "AHMED" had become solely associated with Respondent No.1, it was instead associated with goods other than tea; public associated HALWA, sweet meat etc., sold under the trade mark "AHMED" with Respondent No.1, as Respondent No.1 manufactured and sold items other than tea. That the Appellant's trade mark "Ahmad tea London and device" and Respondent No.1's trade mark "AHMED" were different and dissimilar visually as well as phonetically and also the goods covered by the Appellant's trade mark were totally different from the goods covered by the Respondent's trade mark.

In response the Respondent No.1 contended that it was a company incorporated in Pakistan and opposed the registration of trade mark "Ahmad tea London and device" on the grounds that they had carried on a reputable business in Pakistan as well as outside the country as manufacturers, merchants, importers and exporters of wide range of products falling in classes 29, 30 and 32 and were well known all over the country and in every part of the world due to huge exports of food items and other allied goods. That the word "AHMED" besides its world famous trade mark was also its house mark and a part of its corporate name, which was adopted in the year 1952 and since then it was continuously being used in respect of large number of items and in order to protect its rights and interest, it applied for registration in almost all the territories of the world. Furthermore, Respondent No.1 argued that The Appellant had



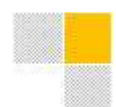
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applied for registration of “Ahmad tea London and device” with prior knowledge of the popularity and reputation of trade mark “AHMED” of Respondent No.1 and the Appellant’s mark would lead to the two marks being confused with each other which would create confusion and deception amongst the consumers to believing that the goods bearing trade mark “AHMAD TEA” emanated from Respondent No.1 or from someone having a business connection with RespondentNo.1 leading to monetary and goodwill loss to Respondent No.1.

The learned counsel for The Appellant argued that The Appellant had registration in more than 31 countries and in Pakistan The Appellant applied for registration of its trade mark in 1988 for “tea dust” that was opposed by The Respondent’s company on the single ground that they had been carrying on business in class-30 with mark “AHMED”, the Registry rejected the application with three wrong observations; That The Opponent’s mark was being used for food items; that the Applicant failed to prove its use in Pakistan and that goods being food items of classes 29 and 30, there was a chance of confusion. The Respondent company filed opposition in 2004 declaring its name “AHMED FOODS INDUSTRIES (PVT) LTD” and in its counter affidavit of 17-04-2013 it was disclosed that the name of Respondent company was changed to “AHMED FOODS (PVT.) LTD. in 2002 and since “AHMED FOODS INDUSTRIES (PVT) LTD” was not in existence at the time of the filing of the opposition, it was not entitled to file the same. It further argued that the Registry had previously registered the mark “AHMED” in class-30 to another entity, Ahmed Tea Company, Peshawar which was not opposed by the Respondent. In fact, the word AHMED became public juris. That the observation of Registry was wrong that Respondent’s company cited 15 registrations in different classes, there were four registrations in class-30 for hot spices and the Appellant on the other hand had been dealing in “tea dust” in more than 31 countries. The description, nature and class of goods, even the category of buyer/consumer with regard to goods were quite different and The Appellant’s mark was distinctive. Each business class was independent, but the Registry had seriously erred in merging class-29 with class-30. That decision of Registry was illegal, contrary to law and facts, arbitrary and defective. Learned counsel for Appellant prayed for setting aside impugned decision and for direction to Respondent No.2 to grant the application for registration.

Learned counsel for Respondent No.1 contended that Respondent No.1 protected its right and interest in the trade mark “AHMED” after having it registered in almost all territories in the world and that The Appellant had applied for registration of trade mark “AHMAD TEA” with prior knowledge of popularity and reputation of Respondent No.1’s trade mark “AHMED” with a view to trade upon the reputation and goodwill of the Respondent’s trade mark. The counsel went on to claim that use of impugned mark by Appellant would lead to two similar marks being confused with each other and would create deception among the consumers and would give monetary and goodwill loss to the Respondent. That likelihood of deception and confusion as to trade origin or trade connection was more serious because the goods were of the same description and were used and purchased by the same class of purchasers through same trade channels. That the products of The Respondent being present in the local market as well as the international market, had attained goodwill, prestige, confidence, popularity within the country and abroad and the product of the Appellant i-e “TEA” were copied, passing-off as the goods of The Respondent and damaged the Respondent both in earning and prestige and that Registrar had rightly refused The Appellant’s application on merits and the Appeal was also liable to be dismissed.

The learned counsel for Respondent no.2 argued that The Appellant’s case was that they were using the registered proprietor of trade mark “AHMAD TEA LONDON” in different countries of the world. Whereas the Respondent was the registered proprietor of trade mark “AHMED” in Pakistan and according to provisions of the Trademarks law in Pakistan, no trade mark shall be registered in respect of any goods or description of goods which is identical with a trade mark belonging to a different proprietor on the Register in respect of same or same description of goods or which nearly



resembles such trade mark as to be likely to deceive or cause confusion and when a case is sought to be made out that a particular mark is likely to deceive and create confusion, the contest is not so much between the parties to the litigation, as it is a contest between a party defending his right to a particular trade mark and the public and according to law, no such trade mark or part of the trade mark shall be registered, the use of which by reason of its being likely to deceive or to cause confusion or otherwise, be disentitled to protection in a Court of Justice. Since, the applied mark "AHMAD" was phonetically similar to the registered mark "AHMED" there was every possibility of confusion to an unwary purchaser where the purchaser was likely to be deceived while buying the goods. He prayed to uphold the impugned decision.

After hearing the arguments of the counsels The Appeal Court observed that the Trade Marks Ordinance fell within an exception to Article 18 of the constitution which, otherwise ensured and protected the rights of every citizen to enter upon any lawful profession or occupation and to conduct any lawful trade or business. The purpose of registration was nothing but to ensure a protection to the goodwill, name and reputation of a trade mark so as to avoid any malafide move of other competitors to come and take the benefit of such name and reputation of the mark which undoubtedly, was not established in a day nor could it be achieved over-night. This had been the object and purpose of getting a mark registered under the law where; one chooses a name including personal name for registration thereof for a particular class, the intention and object thereof could be nothing but that the authorized user wants to have its goods under particular class to be distinctively known recognized with such mark, therefore in such eventuality, such mark shall be principal or dominative mark. An ordinary man while purchasing a product/brand was not supposed to minutely examine the product/brand handed over to him so as to find out the difference(s) into a product in his hand or the one which he intended to purchase. Therefore, such trader intended to invite consumers to ask for the particular goods with such name/mark and not necessarily with label/package, if goods of same class are being sold from same counter targeting consumers/customers of particular class of general public.

The court taking up the merits of this case observed that prima facie following facts were not disputed i-e:-

- i) The respondent No.1 was the authorized user of the mark 'AHMED';
- ii) The respondent No.1 had been using the mark 'AHMED' since 1952;
- iii) The respondent No.1's trade mark 'AHMED' was registered in both classes-29 and 30;
- iv) Dealing with goods of such classes both nationally and internationally;

As regards the case of Appellant, it was a matter of record that:

- a) The Appellant had applied for registration of 'AHMAD' as its mark;
- b) The registration of such mark was for class-30;

The Honourable Court further observed that a bare look at mark of Appellant could not be said to be dissimilar to that of trade mark of the Respondent No.1 for reading and even being phonetically identical. Further, since the 'tea', was to be sold from the same counter where goods of Respondent No.1 were to be sold because it was not claimed anywhere by the Appellant where Respondent No.1 would sell its goods. Further it was also not the case of the Appellant that the goods of the Appellant i.e. tea would be offered /sold to some other class of public therefore, prima facie, the Registrar was quite right in refusing the registration of the mark of Appellant in class-30. Consequently, the court held that the order impugned was/is in line with Respondent No.1 with all settled principles and is not open to any exception. Accordingly, same was maintained, Appeal was dismissed.

