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SUIT FOR INFRINGEMENT OF TRADE MARK IN THE SINDH HIGH COURT

Plaintiff: HILAL FOODS (PRIVATE) LIMITED through Group Head Legal and Company Secretary.
Defendant: DANPAK FOOD INDUSTRIES (PRIVATE) LIMITED through Director.
Decision: Application for temporary injunction dismissed.

The Plaintiff filed suit against Defendant for enforcing the intellectual property rights in respect of products manufactured and marketed by it, seeking permanent injunction, damages and directions that the Defendant should deliver all labels, packets, cartons, advertising materials, printing blocks and other material, which bear the infringed trade mark "GET FRESH" along with an application for grant of temporary injunction. According to averments made in the plaint and injunction application, the Plaintiff, a renowned manufacturer and merchant of confectionary and food items exports its products in more than twenty countries around the world. The Plaintiff claimed having adopted several distinctive marks during the course of trade, one of which is the trade mark "FRESH UP" adopted in the year 1997 and is continuously being used in respect of "Bubble Gum" since then and the trademark is extremely popular having investment of colossal amount towards its advertisement and marketing. The complaint of Plaintiff is that Defendant in order to deceive the public at large and to capture the market share through deceptive tactics started manufacturing, packing and marketing bubble gum, under the trade mark "GET FRESH", being nearly identical, confusingly and deceptively similar to trade mark "FRESH UP", visually as well as phonetically, besides the design, get up and colour scheme of both the marks are also identical. Plaintiff alleged that Defendant is guilty of violating section 40 and 67 of the Trade Marks Ordinance, 2001 relating to infringement of trademark and unfair competition respectively.

The counsel for the Plaintiff also referred to section 42 of the Copyright Ordinance, 1962 to fortify arguments that registration certificate is a prima facie evidence that copyright subsists in the work and the person shown in the certificate is the owner of the work, and sections 56 and 60, which relate to infringement of copyright and remedy for infringement, inter alia, for injunction and damages respectively.

The counsel for the Defendant controverted the claim of Plaintiff stating that Defendant did not infringe the intellectual property rights of the Plaintiff because Defendant was the registered proprietor of the mark "GET FRESH" under which it was selling its product, being completely different from Plaintiff's mark, and neither phonetically similar nor its appearance being deceptive to mislead any unwary buyer, which is one of the basic criteria for bringing an action of infringement. Responding to the alleged same getup and colour scheme, he averred that colour scheme of packaging correlates with flavor of products inside the packets such as the blue pack of Defendant's product under "GET FRESH" is a peppermint flavor and has blue bubble gum inside, therefore, the wrapper is blue. Similarly, the pink packing contains strawberry flavour bubble gums in pink colour. To augment his arguments, he produced some images/pictures of such products as References. The first picture was of Indian origin chewing gum, in pink wrapper containing strawberry flavor liquid filled gum. Other image is of Turkish product, showing that lemon flavoured bubble gum is wrapped in greenish wrapping, representing the lemon colour, all bearing the common name 'fresh' in combination with different prefix.





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The court held that in a shop if different bubble gums/chewing gums of different manufacturers are displayed, including that of the Plaintiff and Defendant, prima facie, an unwary buyer/consumer(s) of an average intelligence would not be confused between the chewing gum (product) of Defendant as that of the Plaintiff. The colour of the wrapper is correlated with flavor of chewing gum contained in the packet/wrapper therefore, the similarity of colours between the two products is of no consequence, considering the sufficiently distinctive features, which would ensure that the same colours of the wrappers would not cause any confusion in the mind of a consumer. Thus, the Defendant is not passing-off its products as those of Plaintiff's and the fact that Defendant also holds a registered trade mark for its product (Chewing gum) weighs in favour of Defendant and balance of convenience, which is one of the basic ingredients for grant of injunction, is not in favour of Plaintiff, rather leans towards Defendant. Thus, injunction application was dismissed.

