

REGISTRATION OF TRADE MARK - APPEAL BEFORE SINDH HIGH COURT

Appellant: GETZ PHARMA INTERNATIONAL FZ LLC through Authorized Attorney
Respondent: REGISTRAR OF TRADE MARKS and another
Decision: Appeal Allowed, setting aside the Registrar's decision.

The dispute pertains to the registration of the trademark "GLITZ," for which an application filed by Respondent No. 2 was allowed to proceed to registration by the Registrar of Trade Marks, and the opposition filed by the Appellant was disallowed.

The facts of this appeal, as claimed by the Appellant, were that it had been using the trademark "GETZ Pharma" under No. 210855 in Class 5 since June 25, 2005. The record demonstrated that the Appellant had been using its branding since 2008 and, to promote its goods under the trademark "GETZ," it had spent a substantial amount of money, time, and labor. As a result, the Appellant's products and services had earned goodwill and reputation and were allegedly in high demand.

The Appellant was concerned that, in the month of December 2016, the impugned mark "GLITZ" (Application No. 373851) filed by Respondent No. 2 was advertised in the Trade Marks Journal for the purpose of inviting opposition. The Appellant filed an opposition before Respondent No. 1 on the ground that the mark applied for was deceptively similar to the Appellant's trademark "GETZ" and was likely to cause confusion among consumers.

However, Respondent No. 1, through the impugned decision, disallowed the Appellant's opposition and allowed the impugned mark to proceed to registration which led to the Appellant filing the appeal.

Respondent No. 2 denied all allegations made in the appeal and supported the impugned decision. The stance taken was that the mark "GLITZ" had been continuously marketed since 2005 and was used globally. According to the Respondent, the marks "GLITZ" and "GETZ" differed in style and design; hence, there was no likelihood of confusion or deception.

The Appellant's counsel based his case on the argument that the trademark "GETZ" was a registered and well-known trademark in Pakistan, thereby entitled to protection under the Trade Marks Ordinance, 2001. He contended that the use of a deceptively similar mark by Respondent No. 2 was detrimental to the Appellant's interests—a fact allegedly overlooked by Respondent No. 1. He further submitted that the impugned mark "GLITZ" was opposed due to its deceptive similarity to the earlier



registered trademark “GETZ.” If registered, “GLITZ” would likely cause confusion and deception among consumers. Therefore, the impugned decision should be set aside, and the application for registration of the impugned mark “GLITZ” should be dismissed.

In response, learned counsel for Respondent No. 2 reiterated that “GLITZ” had been marketed globally since 2005. The marks differed in both style and design, eliminating the possibility of confusion or deception. He emphasized that the distinctive features of both marks were readily noticeable to consumers, including the star-shaped logo. These differences were also noted by Respondent No. 1 while issuing the impugned decision. Therefore, the appeal, in their view, should be dismissed.

After hearing the arguments of both counsels and examining the documentation, the Registry referred to the following aspects of the impugned decision:

- (i) The nature of medicinal products was distinct from that of ordinary consumer goods. The products were dispensed based on a doctor’s prescription, where typically only the drug name or generic name was specified, not the company’s house mark. Moreover, both “GETZ” and “GLITZ” were dictionary words and were distinguishable. Additionally, both marks were registered as domain names and had been used side by side.
- (ii) It was further observed that the logos, writing styles, and overall presentation of the marks “GETZ” and “GLITZ,” when compared side by side, were different from each other.

Keeping in view above facts and finding the Registry was of the opinion that there was no likelihood of confusion or deception between the marks and therefore the Application No. 373851 was allowed to proceed to register. The Court, in the appeal, held that the Appellant was the registered owner of the trademark “GETZ” and was therefore entitled to all rights and privileges associated with it, including those conferred by Section 39 of the Trade Marks Ordinance, which treated a registered trademark as the personal property of its holder.

The Court found that the impugned decision was passed without due regard to the peculiar facts and circumstances of the case, and that Section 17 of the Trade Marks Ordinance, 2001, had been misapplied by Respondent No.1. The Appellant’s trademark was not only distinctive but had been in use for a considerable time. The Court concluded that Respondent No. 2, acknowledged this fact, attempted to copy it through the use of the mark “GLITZ” to deceive consumers. Notably, the use of elements such as an emblem on the left and “Pharma” under the dominant feature “GETZ” also reflected an intention to mislead. Hence, the "totality of impression" and "average consumer" test recorded by Respondent No. 1 in its impugned decision was deemed to be misconceived and erroneous.

The Court held that the Appellant had provided sound reasons that justified the acceptance of the opposition and the rejection of the impugned application. Consequently, the Court allowed the appeal in the following terms:

“The appeal is allowed; the decision of the Registrar is set aside. However, Respondent No. 2 is granted six months to change the trade name ‘GLITZ Pharma’ to another name that is not deceptively similar to the Appellant’s trademark/trade name ‘GETZ’ or any third parties. Respondent No. 2 shall also make appropriate applications before the SECP, Drug Regulatory Authority, etc., to give effect to the change.”

