

IN THE HIGH COURT OF SINDH AT KARACHI

Suit No. 1758 of 2019

[Hilal Foods (Private) Limited *versus* Danpak Food Industries (Private) Limited]

Last Date of hearing: 03.05.2021.

Date of Decision : 16.08.2021.

Plaintiff : Hilal Foods (Private) limited, through M/s. Abdul Sattar Pirzada, Mamoon N. Chaudhry and Gibran Karim Pirzada, Advocates.

Defendant : Danpak Food (Private) limited, through Mr. Khalid Hidayat Khan, Advocate.

Case law cited by the Plaintiff's counsel

1. **PLD 2001 Supreme Court 14**
[*Messrs Western Brand Tea, Karachi versus Messrs Tapal Tea (Pvt.) Limited Lahore and another*] – **Tapal Case**;
2. **PLD 1983 Karachi 357**
[*Messrs Burney's Industrial and Commercial Co. Ltd versus Messrs Rehman Match Works*] – **Burney's Case**;
3. **2011 CLD 811 [Karachi]**
[*J&P Coats Limited & another versus Messrs Golden Thread Industries through Proprietor*] – **Golden Thread Case**;
4. **1986 CLC 2621**
[*Muhammad Rafiq versus Muhammad Ali*];
5. **1985 CLC 3015**
[*Syed Muhammad Maqsood versus Naeem Ali Muhammad*];
6. **PLD 1973 Karachi 289**
[*Abdul Jabbar and another versus Ahmad Jan*];
7. **2005 CLD 802**
[*Federal Mogul Products Inc. USA versus Taha Industries*];
8. **PLD 1993 Karachi 790**
[*Messrs Chas A. Mendoza versus Syed Tausif Ahmad Zaidi and 2 others*];
9. **2000 YLR 1376**
[*The Welcome Foundation Limited versus Messrs Karachi Chemical Industries (Private) Limited*];
10. **(1996) 5 Supreme Court Cases 714**
[*N.R. Dongre and others versus Whirlpool Corporation and another*] – **Whirlpool Case**;
11. **1994 CLC 2135 [Lahore]**
[*Telephone Soap versus M/s. Lever Brothers*] – **Telephone Soap Case**;

12. **2021 CLD 362 [Sindh]**
[*Jazaa Foods (Pvt.) Limited through Authorized Representative and another versus Junaid Jamshed (Pvt.) Limited through Chief Executive Officer and 2 others*];
13. **2016 CLD 1036 [Lahore]**
[*Messrs Shaukat Soap and Ghee Industries (Pvt.) Ltd., versus Messrs Shaukat Brothers Soap Manufactures (Pvt.) Ltd*] – **Shaukat Soap Case**; and
14. **2001 SCMR 967**
[*Messrs Mehran Ghee Mills (Pvt.) Limited and others versus Messrs Chiltan Ghee Mill (Pvt.) Limited and others*] – **Chiltan Ghee Mill Case**.

Case law relied upon by Defendnat’s counsel

1. **P L D 1973 Supreme Court 104**
[*Abdul Wahid versus Haji Abdur Rahim and another*] – **Abdul Wahid Case**; and
2. **2003 C L D 1531**
[*Pakistan Drug House (Pvt.) Limited versus Rio Chemical Company and another*] – **Rio Chemical Case**.

- Law under discussion:**
- (1) The Copyright Ordinance, 1962.
 - (2) The Trade Marks Ordinance, 2001.
 - (3) Civil Procedure Code, 1908 (“CPC”)

ORDER

Muhammad Faisal Kamal Alam, J:- Plaintiff has filed this action at law against Defendant, *inter alia*, for enforcing the intellectual property rights in respect of products manufactured and marketed by Plaintiff.

2. In the plaint, Plaintiff has sought permanent injunction, damages and directions that Defendant should deliver up all labels, packets, cartons, advertising materials, printing blocks and other material, which bear the (purportedly) infringed trademark ‘**GET FRESH**’.

3. Both learned Advocates representing Plaintiff and Defendant made submissions on the injunction application – **C.M.A. No.14581 of 2019**.

4. Facts as averred in the plaint and Injunction Application are, that Plaintiff – company is a renowned manufacturer and merchant of

confectionery and food items and at present exporting its products to more than twenty countries around the world. In order to distinguish one of the products of Plaintiff viz. Bubble Gum (chewing gum), which is the subject dispute of present *Lis*, from chewing gums of other traders, Plaintiff has adopted several distinctive trademarks during the course of trade. One of its trademarks is 'FRESH UP', which was adopted in the year 1997 and is continuously being used in respect of 'Bubble Gum' since then. It is claimed that this trademark is extremely popular and Plaintiff has invested colossal amount towards advertisement and marketing of this product. The complaint of Plaintiff is that Defendant in order to deceive public at large and capture the market share through deceptive tactics has started manufacturing, packing and marketing bubble gum, under the trademark 'GET FRESH'.

It is stated that the marks 'FRESH UP' and 'GET FRESH' are nearly identical, confusingly and deceptively similar to each other, visually as well as phonetically, besides the design, getup and colour scheme of both the marks are identical, hence, deceiving customers.

5. Plaintiff has alleged that Defendant is guilty of violating Section 40 of the Trade Marks Ordinance, 2001 (the "**Ordinance 2001**"), relating to infringement of trademark and Section 67, which relates to unfair competition.

6. Mr. Abdul Sattar Pirzada along with Mr. Mamoon N. Chaudhry and Gibran Karim Pirzada, Advocates, has referred to Section 42 of the Copyright Ordinance, 1962 (the "**Ordinance 1962**"), to fortify arguments that Certificate of Registration is a *prima facie* evidence that copyright subsists in the work and the person shown in the certificate as the owner of the copyright is the owner of such copyright. Legal Team of Plaintiff has referred to Section 56, relating to infringement of copyright and the case of

Defendant falls within the ambit of this. Section 60 provides remedy for infringement of copyright, *inter alia*, for injunction and damages.

It is next argued that Defendant has illegally passed off the subject goods. It is stated that except for one product of Plaintiff, viz. 'Fresh up Spearmint', all the products are registered. He has referred to page-411 (of the case file) to show that the application for 'Fresh up Spearmint' is pending, but the period of use is clearly mentioned as December, 1997. Learned counsel for Plaintiff has cited the case law mentioned in the opening part of this order.

7. Mr. Khalid Hidayat Khan, Advocate representing Defendant, has controverted the claim of Plaintiff, by referring to the Certificate of Registration in favour of Defendant, granted by the Trademarks Registry at Karachi (Government of Pakistan), at page-175 (*part two of the Court file*), which is one of the annexures filed with Written Statement, and states that Defendant has not infringed the intellectual property rights of Plaintiff, because it is selling the product under the name 'GET FRESH', which is completely different from product of Plaintiff, and it is neither phonetically similar nor its appearance is deceptive and it cannot mislead any unwary buyer, which is one of the basic criteria for bringing an action of infringement. While responding to the alleged same getup and colour scheme, he averred that colour scheme of packaging co-relates with flavour of products inside the packets. He has demonstrated that the blue pack of product of Defendant by the name 'GET FRESH' since is a peppermint flavour and has blue bubble gum inside, therefore, the wrapper is blue. Similarly, the pink packing of the product 'GET FRESH' contains strawberry flavour bubble gums in pink colour. To augment this argument, learned Advocate for Defendant has produced images / pictures

of products under a document having caption 'References'. The first picture is of Indian origin chewing gum, in pink wrapper containing strawberry flavour liquid filled gum. One image is of Turkish product, showing that lemon flavoured bubble gum is wrapped in greenish wrapping, representing the lemon colour. It is also pointed out that all these images / pictures bear the common name 'Fresh' in combination with different prefix.

He has relied upon the case law mentioned in the opening part of the judgment, *particularly*, relating to the issue of phonetically similar products and colour scheme. He has also relied upon Section 15 of the Ordinance 2001 with regard to colour scheme. It would be advantageous to reproduce Section 15, herein under_

“15. Limitation as to colour.- (1) *A trade mark may be limited wholly or in part to one or more specified colours, and any such limitation shall be taken into consideration by any tribunal having to decide on the distinctive character of the trade mark.”*

8. Arguments heard and record perused.

9. The undisputed factual aspect of the case for deciding the present interlocutory application is, that the above product of Plaintiff is also registered with Central Copyright Office at Karachi. Certificate of Registration is at page-429 dated 13.09.2001, mentioning that 'HILAL FRESH UP' as mentioned in Annexure 'B' has been registered as artistic work / label design.

10. It is also mentioned in the said registration document that the above has been continuously used since 1997 by the Plaintiff. At page 397 and 401 are the Registration Certificates issued by Trademark Registry that the above product 'Fresh Up Peppermint' is registered since 27.12.1997 in clause 30 category, relating to, *inter alia*, chewing gum, bubble gums. At page-407, the mark 'Fresh Up' is registered in clause 43, *inter alia*, relating

to services for providing food and drinks. At pages-439 to 461 are the Certificates of Registration issued by IPO – Copyright Office (Government of Pakistan) in respect of following products_

- i. 'FRESH UP SPEARMINT'
- ii. 'FRESH UP PEPPERMINT'
- iii. 'FRESH UP ICEMINT'
- iv. 'FRESH UP STRAWBERRY'

11. Their respective use is also mentioned in these official documents as being continuously published since 2011.

12. Learned counsel for Plaintiff has also filed a **Statement** (dated 31.03.2021) showing the colour images of the two products of Plaintiff and Defendant, viz. 'FRESHUP' and 'GETFRESH', respectively, in order to fortify his arguments, *inter alia*, relating to the adoption of similar colour scheme and name. For reference, one such image of both the alleged infringed and infringing products are reproduced herein under_



13. Précis of the case law cited by learned counsel for the Plaintiff_

The first judgment of Tapal Case (*supra*) is handed down by the Honourable Supreme Court, maintaining the decision of Trial Court and the Appellate Court against the appellant on the basis of latter's undertaking that it will not violate the trademark of respondents, who filed their separate suits. The learned High Court dismissed the appeals on the ground that no

appeal is maintainable against a consent order as from the statement of appellant (of the reported case), it was evident that it undertook in clear terms that it will not indulge in passing of the products in the similar trademarks and wrappers. The Honourable Supreme Court came to the conclusion that deceptive measures should not be adopted to adversely affect goodwill and recognition earned by other organizations trading in specific commodity. It was held that bare visual look on the wrappers, wherein the petitioner (of the reported case) packed their tea, reflects complete resemblance providing similarity of design, scheme and colour, which can certainly affect the product of respondents. It is held, “the illiterate customers with particularity can be conveniently misled on looking at wrappers.”

The two judgments of this Court given in the Burney's and Golden Thread Cases (*ibid*) have laid emphasis on the fact that, *inter alia*, for granting injunctive relief, it is to be seen that whether an unwary purchaser would be deceived by the general getup, design and similarity of colour scheme of packaging of the two products, one belonging to plaintiff, and other one of defendant. In Burney's Case (*supra*), the suit was decreed after an exhaustive discussion; that no doubt several dissimilarities between the two match boxes exist if the two are placed side by side, and even an unwary purchaser will notice the difference, but the test is whether a person will be deceived when he sees one trade mark in the absence of another mark. In Golden Thread Case (*supra*), although this Court has observed that trademark 'ANCHOR' and trademark "S Golden" (of defendant of the reported case) are phonetically and otherwise different from each other, but since there is close similarity in the overall getup of both trademarks, colour scheme and other features, hence injunction was granted in favour of plaintiff.

In Chiltan Ghee Mill Case (*ibid*), the Honourable Supreme Court laid down the guiding principle for determining infringement of trademark. It is held that “. *To constitute infringement it is not necessary that whole of the mark be adopted. The infringement will be complete if one or more dominating features of a mark are copied out. If there is a striking resemblance, ex facie, it would lead towards the conclusion that the mark has been infringed. There is mark degree of similarity between two marks of this case. Mark/Label of respondent No.1 has virtually been adopted by petitioner in same colour scheme, design and get-up to pass off its (petitioner's) goods, as that of the respondent No.1.*” The Apex Court expressed its view that “. *It is not necessary that the mark, ex facie, shall deceive or confuse, but what is important is the total impact upon a common purchaser.*”

In the Telephone Soap Case (*supra*), although mark of appellant was registered, but Trial Court granted the injunction, and the same was maintained by the learned High Court in appeal, by holding that if a trademark of a competitor / defendant / appellant is also registered, it does not mean that the trademark of claimant / plaintiff can be infringed. It was reiterated that dispute has to be decided considering overall getup of both the trademarks. Wrappers of both the products / soaps were examined and it was observed that there was close similarity in colour scheme and other features of both the trademarks; though, the packing / wrapper of appellant's product bears a picture of telephone and phonetically it is different from that of respondent.

Plaintiff's counsel has referred to the Whirlpool Case (*ibid*) handed down by the learned Supreme Court of India, in support of his plea about passing off, as it is argued, that the overall getup and colour scheme of packing of product of Defendant is such, that it is deceiving consumer, who would be buying the bubble gum of Defendant as product of Plaintiff. In

the Whirlpool Case (*supra*), the concept and principle of passing off action has been reiterated in the following words_

“ that a man is not to sell his own goods under the pretence that they are the goods of another man. A trader needs protection of his right of prior user of a trade mark as the benefit of the name and reputation earned by him cannot be taken advantage of by another trader by copying the mark and getting it registered before he could get the same registered in his favour. We see no reason why a registered owner of a trade mark should be allowed to deceive purchasers into the belief that they are getting the goods of another while they would be buying the goods of the former which they never intended to do. In an action for passing off it should not matter whether misrepresentation or deception has proceeded from a registered or an unregistered user of a trade mark. He cannot present his own goods as the goods of somebody else.”

In the above judgment, it is held, that even if product of defendant has a registered trade mark, but, still he will not be allowed to deceive purchasers, by misrepresenting his goods as those of plaintiffs, *inter alia*, by adopting deceptively similar getup, packing and other features.

Learned Judge of the Lahore High Court in its judgment in the Shaukat Soap Case (*supra*) while summarizing the principles of infringement of trademark as laid down in the various judgments, after comparison of the two products (soaps in question) granted the injunction on the ground that the appellant's trademark “SHAUKAT” was wholly adopted by respondents and mere addition of prefix ‘CRYSTAL’, has not made the two products sufficiently dissimilar to each other. It was also observed that the respondent (of the reported case) has also adopted the colour scheme of packaging / wrapper identical to that of the appellant's, which can have an additional affect and public might assume that the product of respondent ‘CRYSTAL SHAUKAT’ is yet another product of the appellant.

14. Summary of the case law of Defendant is as follows_

The first judgment is of Abdul Wahid Case (*supra*). Dispute between appellant and respondent reached the Honourable Supreme Court in respect of rectification proceedings. The respondents (of the reported case) moved an application before the concerned Registrar for removal of the trademark of appellant viz. 'DAIGON' and 'DRAGON', said to have registered either fraudulently or by mistake, because the said marks were very close to the registered trademark of the appellant, namely, 'SAIGON', which was in use since 1949. Apex Court agreed with the conclusion of the Registrar Trademark and disagreed with the decision of learned High Court and it was held that *'it is an accepted principle that words having a common suffix but if earlier portion of these words are different, and if they do not conflict they are held to be distinctive.'*

The other judgment is of Rio Chemical Case (*ibid*), wherein, after discussing both trademarks and copyright laws, it was held that using a registered copyright material as a substitute for the trademark is not the intent and purpose of the copyright law, and such copyright material independently cannot be used or associated with vendible and saleable goods, unless of course such copyright is registered under the trademarks law. It is also necessary to mention that one of the defence put forth by the defendant (of the reported case), was the disclaimer in respect of the product in question (a pharmaceutical product) of the plaintiff. In this regard, this Court ruled that due to disclaimer, plaintiff cannot claim exclusive right to the use of the name of the product – "Aletirs Cordial" or device of bottle used in the mark as such mark was registered subject to disclaimer.

But at the same time, *"the holder of the mark may claim monopoly in the manner in which mark, device, word or any combination thereof is put to use to distinguish his goods from others"*. It is held that defendant

could use the above named product in some other combination, but cannot copy the same.

15. The packaging of the two subject Products/chewing gums of the Plaintiff and that of the Defendant is compared.

16. Plaintiff uses distinctive get-up and packaging for the sale and marketing of its product “Fresh up”. Upon an observation of the Plaintiff’s product, the essential features of the get-up and packaging of the Plaintiff’s product comprise of the following:

- A packaging in different colours including green, pink and blue with the mark “Fresh up”, printed in a white font with black outline in English language, however the mark “Fresh up” has been printed on an angle;
- The top left corner of the packaging includes a triangular red device with the company name ‘Hilal’ printed on it in a white stylized font;
- Underneath the mark “Fresh Up”, the description of the flavour of the product is given;
- The right side of the packaging includes a picture of a bitten chewing gum along with mint leaves or strawberries or a depiction of any other fruit or condiments affixed with it, according to the flavour of the product, while underneath such picture the words ‘Center Filled Refreshing Gum’ are also included;
- A logo resembling a sprout with two devices is affixed above the mark “Fresh up”, and a lighter coloured circle is affixed behind the word “up”;
- Moreover, the packaging is overall shaded in tones of either green, pink or blue with the centre being a lighter shade and the outer corners of the packaging being a darker shade of the same colour.

Whereas, upon an observation of the Defendant’s product, the essential features of the get-up and packaging of the Defendant’s product comprise of the following:

- A packaging in different colours including green, pink and blue with the mark “Getfresh”, printed in a stylized white font in English language;
- The left side of the packaging includes a yellow oval shaped device with the company name ‘DANPAK’ printed on it in a red font in capital letters, with the words ‘7 Pieces’ written below it;
- Underneath the mark “Getfresh”, the words ‘REFRESHING SPEARMINT GUM’ have been printed, such words may differ according to the flavour of the product;
- A logo resembling a sprout with three devices is affixed on the right side of the packaging;

17. In a shop if different bubble gums / chewing gums are displayed of different manufacturers, 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. As far as the same colour scheme is concerned, the arguments of Defendant’s learned counsel has substance- that the colour of the wrapper is co-related with flavour of chewing gum contained in the packet / wrapper; therefore, the similarity of colours between the two products, in my view, is of no consequence, considering the sufficiently distinctive features, which would ensure that the same colour of the wrapper would not cause any confusion in the mind of a consumer. Moreso, the afore-referred colour images as placed on record by Defendant’s counsel, also show that the colour of wrapper corresponds to the taste of chewing gum packed inside. Notwithstanding the above, in view of the distinctive features discussed herein above, the consumer in any case would not be misled or deceived by the product of the Defendant as the product of the Plaintiff.

18. Case law cited by the learned Advocates representing the Plaintiff is distinguishable for the aforementioned reasons.

19. In view of the above discussion, since the Defendant is not passing off its products as those of Plaintiff's, thus, in these circumstances, this fact cannot be ignored that Defendant also holds a registered trade mark for its product (Chewing gum), which factor weighs in favour of Defendant and balance of convenience, which is one of the basic ingredients for grant of injunction, at present is not in favour of Plaintiff, rather leans towards Defendant. In this peculiar situation, question of irreparable loss cannot be determined now but is to be decided at the later stage of the trial. Since all the basic elements for grant of injunction are not present, thus, injunction application is dismissed.

20. However, any observation made hereinabove is tentative in nature and shall not influence the trial of the suit and the judgment.

Judge

Karachi,
Dated: 16.08.2021.

Riaz / P.S.