

IN THE HIGH COURT OF SINDH AT KARACHI

MISC. APPEAL NO.26/2008

Appellant : Messrs Ahmed Tea Limited,
through Mr. Muhammad Ayub advocate.

Respondents : Messrs Ahmed Foods Industries (Pvt) Limited, and
Registrar of Trade Marks,
through M/s. Jawwad Raza and M.K. Shikho advocates
for respondent No.1.
Mr. Saleem Ghulam Hussain advocate for respondent
No.2.

Date of hearing : 02.10.2018.

Date of announcement : 17.01.2019.

J U D G M E N T

Salahuddin Panhwar, J: Appellants have assailed decision dated 28.07.2007 delivered by Registrar of Trade Marks (respondent No.2) whereby Opposition No.292/2004 filed by respondent No.1 was allowed and Appellants' Application No.149770 in class 30, dated 29.08.1998 for registration of Trade mark "Ahmed Tea London and device" was refused.

2. Brief facts of the case are that appellants/applicants M/s. Ahmed Tea Limited, England, Merchants and Exporters, applied for registration of trade mark Ahmed Tea vide application No.149770 in class 30 before respondent No.2, contending that they are internationally well established company and are engaged in the sale and export of tea for the last many years; that in order to promote the sale of tea, appellants 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 the said trade mark has been used in U. K., Canada and other countries around; that the tea sold under the said trade mark is known and recognized as of high quality and standard. As such the trade mark has acquired goodwill and reputation; that appellants obtained registration of said trade mark in Canada under Registration No. TMA542-603 claiming use of trade mark since 1988; the trade mark of appellants is also registered in U.K under No.1567279 in Class 30 for tea with effect from 31st March 1994; that they also own International Registration No. 599733 which includes Algeria, Austria, Germany, Benelux, Bulgaria, Hungary, Cuba, China, Egypt, Spain, Federation of Russia, France, Italy, Morocco, Monaco, Mongolia, Portugal Slovenia, Switzerland, Sweden, Yugoslavia, Romania, Democratic Republic of Korea; that in order to protect their rights in the above trade mark, they have applied for its registration in Pakistan under Application No. 149770 in Class 30 in respect of "Tea, coffee, jams, and others goods and included in class 30"; said application was advertised before acceptance in the Trade Mark Journal No.632 dated September 2003 at page 388; that by virtue of long and extensive use the Trade Mark "AHMAD TEA LONDON and device" of the appellants has acquired valuable goodwill and reputation in their favor and the tea sold under the above trade mark is exclusively associated with appellants; that each and every averments made in the Notice of Opposition is denied by appellants unless specifically admitted by them; they have conducted a search in UK, Australia and USA and have found that the trademark of the opponent's No.1520285 has been registered in UK but Registration No.1520285 and No.1520284 has been merged; this trade mark has been registered in Classes 29 and 30, but has not been registered for use of Tea; that in Australia AHMED's mark vide No.594184 is registered in Class 29, but 594188 is registered in Class 30 and this registration

does not cover Tea and gives no rights to the exclusive use of the word "AHMED"; that in U.S.A. AHMED is registered vide No.74/708454 in Class 29 and 74/708456 is registered in Class 30; this registration does not cover Tea; both the registrations appear to be "Dead" and are classified as abandoned; no proof of abandonment was provided; that respondent No.1 have failed to file any evidence in support of their averments regarding use and advertisement; it is denied that the trademark "AHMED" has become solely associated with respondent No.1; the trade mark "AHMED" of respondent No.1 is associated with goods other than TEA, which are the main goods in respect of which appellants have sought registration for their trade mark "AHMAD TEA - LONDON and device"; that respondent No.1 have not filed even a single piece of evidence in support of extensive publicity of their trade mark "AHMED". It was submitted that the public associate basically HALWA, Sweet meat etc. sold under the trade mark "AHMED" with respondent No.1 as respondent No.1 manufacture and sell items other than Tea; that appellant's Trade Mark "AHMAD TEA — LONDON" and the respondent No.1's mark "AHMED", are totally different and dissimilar visually as well as phonetically and furthermore goods covered by appellant's trade mark are also totally different from the goods covered by respondent No.1's trade mark without prejudice, the appellants are willing to register their Mark "AHMAD TEA - LONDON and device" in class 30 for TEA; that the trade mark of the appellants "AHMAD TEA LONDON and device" is not at all identical visually and phonetically with the mark of respondent No.1 and it is mainly in respect of TEA which is totally different description of goods; that general public in Pakistan will not refer the products of appellant as of respondent No.1 and will not be confused and the goods of appellants will not be passed off as the goods of respondent No.1 because the trade mark and description of goods of appellants are totally different from the respondent No.1's trade mark and

description of goods. Appellants/applicants prayed :-

- a) That opposition No.292/2004 may be disallowed.
- b) That applicant's application No.149770 in class 30 be allowed to proceed to registration
- c) That cost of these proceedings may be awarded.

3. Respondent No.1 (M/s. Ahmed Food Industries (Pvt) Limited) a company incorporated in Pakistan under the Companies Ordinance 1984, Manufacturers, Merchants, Importers and Exporters, opposed the registration of Trade Mark "AHMED TEA" advertised under application No.149770 Class-30 in the Trade Marks Journal No.632, on the grounds that they have for many years carried on a reputable business in Pakistan and outside the country as manufacturers, merchants, importer and exporters of wide range of products falling in Class-29, 30 and 32; that they are well known all over the country and in every part of the world due to huge exports of food items and other allied goods; having overseas offices, manufacturing companies in a number of countries and have local agents and distributors; that the trademark use by them in respect of its aforesaid business is AHMED which besides being its principal world famous trademark is also its house mark; that word Ahmed also forms a part of their corporate name Ahmed Food Industries (Pvt) Ltd; that trademark AHMED was first adopted and used by them in the year 1952 and is continuously in use since then and is presently used on a large number of foods items; that in view of the good quality of products and intensive publicity campaigns, the trademark AHMED has exclusively become associated with them throughout the world including Pakistan and in order to protect their rights and interest in that trademark they have applied for registration in almost all the territories of the

world and following registrations were secured in Pakistan:-

Trade Mark	Registration	Class
Ahmed	25502	32
Ahmed	19057	30
Ahmed	17083	29
Ahmed	25175	30
Ahmed	41185	30
Ahmed	41171	29
Ahmed	68159	29
Ahmed	88389	29
Ahmed	88369	32
Ahmed	88236	32
Ahmed	116793	29
Ahmed	116794	30
Ahmed	116797	30
Ahmed	116798	30
Ahmed	116799	32

that following is the list of countries where AHMED brand products are sold by them:-

Trademark	Class	Trademark No.	Country
Ahmed	30	1520285	UK
Ahmed	29	1520284	UK
Freshwel Ahmed	29	Pending	Saudi Arabia
Freshwel Ahmed	30	Pending	Australia
Freshwel Ahmed	29	594184	Australia

Ahmed	30	594184	Australia
Freshwel	29	74/708454	USA
Freshwel Ahmed	30	74/7048456	USA

However, the appellants had applied for registration of trademark AHMED TEA with prior knowledge of the popularity and reputation of the trademark AHMED of respondent No.1 and with a view to trade upon the goodwill and reputation of respondent No.1 in the above trademark; that respondent No.1 are of the definite opinion that the use of the impugned trademark AHMED TEA by appellants would lead to the two marks being confused with each other and would create confusion and deception amongst the consumers and would give monetary and goodwill loss to the respondent No.1; that the application filed by appellants before respondent No.2 was clearly an attempt to trade unfairly upon the reputation and goodwill of respondent No.1 and to deceive the public into believing that the goods bearing trademark AHMED TEA emanates from respondent No.1 or from person having business association with respondent No.1 and that likelihood of deception and confusion as to trade origin or trade connection is more serious because the goods are of the same description and are used and purchased by same class of purchasers through same trade channel; that appellants aforesaid trademark AHMED TEA is objectionable under section 10(1) and 8(a) of the Trade Marks Act 1940, by reason of its being likely to deceive or to cause confusion; also appellants mark if used would be disentitled to protection in a court of justice under section 8(a) of the Trade marks Act, 1940; that they are internationally well established company and are engaged in the sale and export of tea in International Class 30 for the last many years; respondent No.1 prayed :-

a) That opposition No.292/2004 may be allowed.

b) That the applicant's application No.149770 in class 30 may be refused registration.

c) That cost of these proceedings may be awarded.

4. I have heard learned counsel for the parties and perused the record.

5. Learned counsel for appellant has argued that appellant is registered in more than 31 countries; that earlier, appellant applied for registration in 1988 in Pakistan (Application No.149770) only for "Tea dust" that was opposed by respondent company in May 2004 on single ground that they had been carrying on the business in Class-30 with the mark "AHMED"; the Registry rejected the application with 3 wrong observations: (1) opponent's mark AHMED is being used for food items; vide para 12, clause (a) of the Decision; (2) the applicant failed to prove its use in Pakistan and (3) goods being food items of Class-29 and 30 hence there was a chance of confusion. [vide para 13, clause (c) of the Decision]; that respondent company filed opposition in 2004 declaring its name "AHMED FOODS INDUSTRIES (PVT) LTD" and in its counter-affidavit dated 17.04.2013 it was disclosed that the name of respondent company had been changed to AHMED FOODS (PVT) LTD in 2002; that company never applied for change of title which was necessary under the law of Trademark and Companies Ordinance 1984 therefore at the time of filing of opposition at the Registry, AHMED FOODS INDUSTRIES (PVT) LTD was not in existence hence was not entitled to raise any opposition; that in the Memorandum of respondent company, there was no mentioning of dealing in "Tea", hence the business of "Tea" was not registered with SECP and they cannot undertake or carry on such business; that the Board of directors are duty bound to

follow the business clause of registered Memorandum per section 31 of Companies Ordinance, if unregistered business is carried on, that shall be ultra vires for which the Company has to suffer penal provisions per section 476 read with SRO. 230(1)/2001 dated 16.4.200, and 496; that imperative to say: the Registry had previously granted the mark AHMED in Class-30 to other entity Ahmed Tea Company, Peshawar (Regn No.145525) but the respondent company did not oppose that mark, in fact word AHMAD became *publici juris*. The respondent company itself shown several marks containing the word "AHMED"; about observation of the registry, respondent company has been dealing in fancy food items i.e. sweets, halwa, James, jellies, pickles, appellant company's goods is Tea dust" which is a beverage item and not food item. Food item means: food for human consumption for satisfying hunger and lifesaving, hence the observation of Registry was wrong; that Opponent's mark related to fancy food items (falling in Class-29) but there is no business in Class-30 for dealing in "Tea-dust". Law recognizes and protects TM in relation to goods and not independent of goods per section 22(3), 2(20) / 4(a), 4(b), that appellant applied for registration with the words "proposed to be used" i.e. bona fide intention section 22(3) TM Ordinance to use after registration, hence the observation of the Registry was wrong; that respondent company cited 15 registrations in different classes; there were 4 registrations in Class-30 (118484, & 116794 for hot spices, 116797, & 116798 for sweetmeat and halwa); the appellant on the other hand, has been dealing in "Tea-dust" (in Class-30) in more than 31 countries; the description, nature, and class of goods, even the category of buyers/consumers with regard to goods are quite different and appellant's mark was distinctive. Each business class is independent, but the Registry has seriously erred in merging Class - 29 with Class 30. It is emphasized that both the Marks (literarily, visibly, phonetically, and by look the packaging, size of container, color of

wrapper or getup) are far different, if compared; opponent's mark was of single-word without any device whereas the appellant's mark is of 3-word with a device; that mark should be read and considered in one string, separation of word from the whole mark is not permissible; that the Registry wrongly deemed the mark AHMAD for the Appellant whereas the correct mark is AHMAD TEA LONDON (with a device of tea-pot within a border; respondent company was not an aggrieved person as it had no cause of action, or no similar goods for business; grant of registration would not cause any clash of interest, business loss, competition, deception, confusion, passing-off, infringement etc, from any angle; that decision of the Registry was illegal, contrary to law and facts, arbitrary, and defective. Learned counsel for appellant prayed for setting aside impugned decision and direction to respondent No.2 to grant the application for registration. Reliance was placed on PLD 1967 Karachi 637, PLD 1969 Karachi 278, CLD 2003 Karachi 463, PLD 1985 Karachi 630, 2011 CLD Karachi 193, PLD 1987 Karachi 199, PLD 1979 Karachi 83, PLD 1969 Karachi 376 and 2013 PTD Peshawar 372.

6. Learned counsel for respondent No.1 has contended that respondent No.1 in order to protect its right and interest in the trademark AHMED, have got registration in almost all the territories in the world; that appellant have applied for the registration of trademark AHMED TEA with prior knowledge of the popularity and reputation of the trademark AHMED of respondent and with a view to trade upon the goodwill and reputation of the respondent in the above trademark; that respondent No.1 is of definite opinion that the use of the impugned trade mark Ahmed Tea 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 respondent; that the likelihood of

deception and confusion as to trade origin or trade connection is more serious because the goods are of the same description (CLASS 30) and are used and purchased by the same class of purchasers through same trade channel; that appellant aforesaid trademark AHMED TEA is objectionable under section 10(1) and 8(a) of the trademarks Act, 1940 by reason of its being likely to deceive or to cause confusions; also the appellant mark if used would be disentitled to protection a court of justice under section 8(a) of the trademark Act, 1940; that as a matter of fact International classification of Class 30 covers entire goods of eatable nature including tea; that the products of the respondents being in the local market as well as exported, have attained goodwill, prestige, confidence, popularity within the country and abroad and the product of the appellant i.e. TEA brought in the market are copied, passing off as the goods of the appellant has damaged the respondent both in earning and prestige; that learned Registrar has rightly refused appellants application after thoroughly observing the matter on merit hence present appeal is also liable to be dismissed.

7. Learned counsel for respondent No.2 argued that appellant has stated they are registered proprietor of trade mark 'AHMAD TEA LONDON' and using and registered proprietor of said trade mark in different countries of the world; Respondent No.1's case is that they are registered proprietor of trade mark AHMED, the identical and confusingly similar trade mark AHMAD shall not be registered in accordance with Section 10 (1) and 8 (a) of the Trade Marks Act, 1940; section 10 (1) of the Trade Marks Act, 1940 prohibits the registration of identical or similar trademark. According to the said section, no trade mark shall be registered in respect of any goods or description of goods which is identical with a trademark belonging to a different proprietor on the Register in respect of same goods or

description of goods or which nearly resembles such trademark as to be likely to deceive or cause confusion; that test that has to be applied to consider an objection under Section 10 (1) of the Act is the test of identity or resemblance, if there was resemblance between the marks of appellant and that of Respondent No.1 and if there was likelihood of deception trademark the Appellant trademark could not be registered; that when a case is sought to be made out that a particular trademark 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 trademark and the public; per Section 8 (a) no trade or part of a trademark 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; respondent No.1 is the registered proprietors of trademark AHMED in class-30 in respect of halwa, sweet meat and other food items, as per the said Section no trademark shall be registered which is likely to deceive or cause confusion; that word AHMAD is phonetically similar to the registered trade mark AHMED, applied trademark is 'AHMAD' there is every possibility of confusion while buying the goods and the unwary purchasers are likely to be deceived while buying the goods; that purpose of the Act is to protect the consumer so they are not deceived or confused while buying the goods. He placed reliance on 2012 CLD 1465 relevant at page 1485, clause (a) of Section 8 of the Trade Marks Act, 1940, 2004 CLD 1383, PLD 1990 SC 13, 2012 CLD 1465 Supreme Court, PLD 1990 SC, PLD 1991 SC 27, PLD 1984 SC 8, PLD 2001 SCMR 967, PLD 1960 Karachi 355, 2004 CLD 1454, 1980 CLC 1268, AIR 1947 Lahore and prayed to uphold the impugned decision.

8. To my understanding the Trade Marks Ordinance 2001 falls within an exception to Article 18 of the Constitution which, otherwise, ensures and protects

the right of every citizen to enter upon any lawful profession or occupation and to conduct any lawful trade or business. Therefore, it would be conducive to refer the *preamble* of the Ordinance which reads as:-

“**WHEREAS** it is expedient to amend and consolidate the law relating to trademarks and unfair competition and to provide for registration and better protection of trademarks and for the prevention of the use of fraudulent marks, and for matters ancillary thereto or connected therewith;”

From above, it is quite obvious that the purpose of **registration** is 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 competitor to come and take the benefit of such name and reputation of the ‘**mark**’ which, *undoubtedly*, is not established in a day nor can it be achieved over-night. This has been the object and purpose of getting a ‘**mark**’ registered under the law.

I would also add that there can also be no denial to legal position that ‘**trade-Marks**’ , once registered, becomes the property of the person in whose favour it is registered. Reference is made to the case, reported as M. Sikandar Sultan vs. Masih Ahmed Shaikh (2003 CLD 26), wherein it is held as:-

“Placitum-C. Under section 21 of the Trade Marks Act 1940 (hereinafter referred to as the Act), the registration of person in the register of proprietor of a trade mark in respect of any goods shall give to that person the exclusive right to the use of the trade mark in relation of those goods and that right shall be deemed to be infringed by any person, who not being the proprietor of the trade mark of a registered user thereof using by way of the permitted use, uses a mark identical with it or so nearly resembles it as to likely to deceive or cause confusion in the course of trade, in relation to any goods in respect of which it is registered.”

Now, the question could be that whether a **registration** under the law *alone* is sufficient to take a control over such **trade** ?. The answer could be nothing but a **big No** else the guarantee, provided by Article 18 of the Constitution shall loose its

significance. Therefore, a balance has been ensured in such law (s) that such law (s), no where, restricts one to enter upon a lawful business or to do a lawful trade but only demands that such, otherwise, lawful trade or business, should not be at the cost of the goodwill or reputation of other registered '**mark**'. It, nowhere, speaks about trade but '**the trade-mark**' under which one is; or intending to continue his business. In short, it is aimed to protect the *goodwill* of one (*trader*) which one, while dealing in a particular goods or *services* earns.

9. To further *limit* such, *otherwise*, earned right (**registration**) alone *normally* shall never be sufficient to deprive all from using such **registered mark** for other classified **goods & services** except for those for which **mark** has been **registration**. This has been the reason because of which the **goods & services** have been classified in '**classes**'. The Rule 11 of Trade Marks Rules, 2004, being relevant, is referred hereunder:-

"11. Classification of goods and services.—For the purposes of the registration of a trade mark and of these rules, goods and services shall be classified in the manner specified in the Fourth Schedule, which sets out the current version of the classes of the International Classification of goods and services"

The above discussion and reference to relevant provisions make it clear that when a *particular 'mark'* stood registered in favour of one he earns the status of '**authorized user**' which is defined by Section 2(iii) of Ordinance as:-

"authorized user" means a person authorized to use a trade mark in relation to goods or services under the control of the owner of the trade marks and includes a licensee".

hence, I would be safe in saying that *authorized user* shall have every right to oppose an *subsequent registration application* for a '**trade-mark**' if there is any of the grounds, so detailed in the Section 29 of the Ordinance.

At this juncture, it would be appropriate to refer the definition of '**mark**', provided by the Ordinance itself as:

Section 2 (xxiv):

“‘**mark**’ includes, in particular, a device, brand, heading, label, title, **name including personal name**, signature, word, letter, numeral, figurative element, colour, sound or any combination thereof;”

From so far discussion and referral to relevant provisions of law, it could safely be concluded that while choosing a '**trade**' one (trader) can competently choose any '**particular**' mark so as to *distinctively* deal in specified class of goods or services which, once registered, would be protected and *legally* registration of same mark or '**deceptively similar mark**' shall not be registered because the same may result into a '**deception**' or '**confusion**' to an ordinary eye while purchasing a particular product/ brand.

Here, I would add that 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 is 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**' intends to invite consumers to ask for the particular *goods* with such **name/mark** and not necessarily with '**label/packaging**' if goods of same class are being sold from same counter targeting **consumers / customers** of particular class of general public. In reaching to such conclusion the guidance is taken from the cases:-

Monsters Rolex S.A. v. Asstt. Registrar T.M (PLD 1987 Karachi 199).

It may be stated here that section 10 of the Trade Marks Act relied by the appellant before the Tribunal prohibits registration of a trade mark which is identical with another marks belonging to a different proprietor in respect of the same goods or description of goods or which so nearly resemble to such trade mark as is likely to deceive or cause confusion. A careful reading of section 10 *ibid* will show that in order to attract the application of this section it is necessary to establish firstly, that the mark applied for registration is identical to another registered mark of a different proprietor and secondly, the goods in respect of which the registration of the mark is applied for is of the same class and description in respect whereof an identical mark or a mark so nearly resemble that of another person. ...

“The acquisition of an exclusive right to a mark or name in connection with a particular article of commerce cannot entitle the owner of that right to prohibit the use by others of such mark or name in connection **with goods of a totally different character**, and that such use by others can as little interfere with his acquisition of the right”. ..

Seven up Company v. Kohinoor Thread Ball Factory (PLD 1990 SC 313).

“Our statute law recognizes and also protects trade mark in relation to goods, and not independently of the goods. **Therefore, one is justified in claiming protection for a particular trade mark only if it is related to a particular good or class or category of goods.** The generality of clause (s) of section 8 of the Act cannot be given the meaning and the content so wide as to embrace all registered and widely used trademarks so as to exclude their adoption and use for any and every class or category of goods, howsoever different and dissimilar. The generality advocated is limited by clause (a) of section 8 of the Act. The test provided therein is not the identity of the trade mark or of the goods but likelihood of deception or confusion such as to entitle protection in a Court of law. **The test of the likelihood of deception or confusion is dependent on the nature of goods, marketing methods, consumer awareness etc., all variables differing from place to place, country to country and commodity to commodity.** Even in Clatex’s case where the goods were totally different the Court proceed to examine the first requirement and found it amply satisfied by holding that “The potential market for them is, therefore, similar to that of the existing market of the opponents, in the sense that the goods of both the parties are not special goods. They are goods which would be purchased by the common man,” and finally holding that “The opponents are a large company known by many as having large resources, and therefore, capable of starting any new industry or trade”. **It has to be noted further that the likelihood of deception or**

confusion is tested not by the reactions of the immediate vendee but by those of the ultimate consumer.”

Now, I would take up the merits of the instant case. *Prima facie*, following facts are not disputed i.e:-

- i) the respondent No.1 is authorized user of the mark **'AHMED'**;
- ii) the respondent No.1 has been using the mark **'AHMED'** since 1952;
- iii) the respondent No.1's mark **'AHMED'** is registered in both classes i.e **'29 & 30'** of fourth schedule;
- iv) dealing with goods of such classes both nationally and internationally;

As regard the case of the appellant, it is also a matter of record that:

- a) the appellant has applied for registration of **'AHMAD'** as its **'mark'**;
- b) the registration of such **'mark'** is for class **'30'**;

A *bare* look at **mark** of appellant cannot be said to be *dissimilar* to that of trade mark of the respondent no.1 i.e **'AHMED'** for reading and *even* is phonetically identical. Further, since the **'tea'** will be sold from one and same counter wherefrom goods of the respondent no.1 shall be sold because it has, *no where*, been claimed by the appellant that respondent no.1 sells its *goods* at its own **'outlet'**. Further, it is also not the case of the appellant that the *goods* of appellant i.e **'tea'** shall 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 the appellant in **'class-30'**.

The Registrar was quite right in not giving much weight to the plea of the appellant that **'tea'** is a different kind of **product** from that wherein the respondent no.1 is dealing because it is not the **product** but the **class/category** for which a **'mark'** is registered.

10. As regard the plea, of the appellant that their 'mark' consists of three words i.e 'Ahmad Tea London' while that of respondent No.1 is of one word i.e 'Ahmed' , it would suffice to say that principal / dominant mark, applied for registration by appellant, is 'Ahmad' and *undeniably* respondent No.1 has been dealing with mark of 'Ahmed', therefore, there is every possibility that such 'tea' may be sold while referring that of a product of 'AHMED' (respondent no.1) hence the Registrar was quite right in letting the **principal / dominating** mark of the respondent No.1, already registered, to prevail. Such conclusion was also quite in line with the principles, so enunciated in the cases of :-

M. Sikandar Sultan vs. Masih Ahmed Shaikh (2003 CLD 26)

"Under section 21 of the Trade Marks Act 1940 (hereinafter referred to as the Act), the registration of person in the register of proprietor of a trade mark in respect of any goods shall give to that person the exclusive right to the use of the trade mark in relation of those goods and that right shall be deemed to be infringed by any person, who not being the proprietor of the trade mark of a registered user thereof using by way of the permitted use, **uses a mark identical with it or so nearly resembles it as to likely to deceive or cause confusion in the course of trade, in relation to any goods in respect of which it is registered.**"

M/s. Mehran Ghee Mills vs. M/s. Chiltan Ghree Mills (2001 SCMR 967)

"15. The question that whether there has been an infringement or not is to be decided by comparing and placing the two marks together and then to determine about their similarity or distinctiveness. **If the two marks are absolutely identical no further probe is needed and infringement is established.** Essential features of the marks shall be looked into for effectively deciding the issue of infringement. 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."

The cases of 7-up as well that reported as 2012 CLD 1465 (trade mark Shan); PLD 1990 SC (trade mark PHILIPS); PLD 1991 SC 27 (trade mark Toshiba) were / are applicable in support of such view / conclusion.

11. I would also add that since registration of a mark is always for a particular class / category therefore, by getting such registration the *authorized user* does earn a right to deal in with all such **products / goods** , even if not dealing with such product at relevant time. Such right, *however*, shall be subject to completion of other requirements, if any. Therefore, the plea of the appellant that since presently the respondent no.1 is not dealing in **'tea-product'** hence registration of its mark **'AHMAD LOND TEA'** shall cause no harm to respondent no.1 is *misconceived*.

12. As regard another plea of the appellant that since respondent no.1 has not objected / opposed to grant of mark **'AHMED'** in class-30 to other entity **'AHMED TEA COMPANY, PESHAWAR'** hence respondent no.1 cannot object / oppose the application of the appellant, it would suffice to say that such *plea* alone cannot prevail over the rights, created by Section 29 (4) of the Ordinance to every such application nor *legally* mere negligence in making proper opposition to some earlier application can be a ground to deprive the *authorized user* from those rights and privileges which are the creation of the law *itself*.

13. Here, I would also add that the registration of the trade-mark of the appellant in other countries was / is not under dispute but registration whereof *here* where undeniably the mark of the respondent no.1 is **already** registered and it (respondent no.1) is dealing in products, classified in classes 29 and 30, thus, such dealing *internationally* in such class was / is also of no help for the appellant to deny

the rights of the respondent no.1, earned by getting its 'trade mark' as 'AHMED' registered.

14. I would avoid in going deep into the *plea*, so raised by appellant with reference to memorandum, because such *issue* is not before us nor same could appropriately be taken in instant matter where legality or illegality of order of Registrar in refusing application.

At this point, it would be appropriate to refer relevant portion of *impugned* order so as to find whether there has been any *departure* to settled principles. Same reads as:-

- "i) That Opposition No.292/2004 is allowed on the basis of following:-
- a) That Opponent's trademark AHMED is being used in Pakistan since 1952 and is also registered for food items.
 - b) That Opponent's trademark AHMED has acquired distinctive by its continuous use in Pakistan and abroad.
 - c) That the applicant has claimed user since 1988 as against the opponent's genuine and continuous user claim since 1952.
 - d) That the applicant has failed to prove user in Pakistan. In this connection reliance is placed on PLD 1962 (W.P) Karachi 335 NABISCO case wherein it has been observed at page 360 that "it seems to me that the whole contention rests on a misapprehension. For the purpose of seeing whether the mark is distinctive, it is to the market of this country alone that one has to have regard. For that purpose foreign markets are wholly irrelevant, unless it be shown by evidence that in fact goods have been sold in this country with a foreign mark on them, and that the mark so used has thereby become identified with the manufacturer of the goods. If a manufacturer bearing a mark abroad has made goods and imported them into this country with the foreign mark on them, the foreign mark may acquire in this country these characteristics, that it is distinctive of the goods of the manufacturer abroad. If that be shown, it is not afterwards open to somebody else to register in this country that mark, either as an importer of the goods of the manufacturer or for any other purpose. The reason of that is not that the mark is a foreign mark registered in a foreign

country, but that it is something which has been used in the market of this country in such a way as to be identified with a manufacturer who manufactures in a foreign country".

e) That the goods being food items of class 29 and 30 are sold from the same outlet/ counter as such chances of confusion and deception are very much there. In this context I rely on the following cases.

➤ In *Kabushi ki Kaisha Toshiba (also trading as Toshiba Corporation) v. Ch. Muhammad Altaf trading as Murad Industries, and another* (NLR 1991 SCJ 41), the Court held that the adoption of the trade mark TOSHIBA in respect of "electric fans" falling in class 11 by the respondent was bound to create confusion and deception and it was against public interest to register such a trade mark in view of the prior registrations for TOSHIBA which was invented by and registered in the name of Toshiba Corporation in respect of a variety of electronic items and other goods falling in classes 8, 9, 10, 11, 12, 14 and 16.

➤ In *Alpha Sewing Machine Co. v. Registrar of Trade Marks and another* (PLJ 1990 SC 499), the Court refused registration by a local company of the mark "Philip" for "sewing machines" on an opposition by N.V. Philips based on its registrations for the same mark in respect of "machines, machine tools and motors (except for vehicle) including magneto electric welding machines, goods belonging to class 7" on the basis that there was a trade connection between those goods. It was held that even though Philips N.V. did not manufacture sewing machines, "*the question of deception and confusion to the general public could not be ignored*".

➤ In *Montgomery Flour and General Mills Ltd. v. Registrar of Trade Marks and another* (PLD 1973 Karachi 567), the appellant's trade mark "7 Up" in class 30 for "hard boiled sweets, candies and drops" was refused registration in view of the earlier registrations for the trade marks "7Up" and "Seven Up" in classes 30 and 32, on the basis inter alia that the goods in question were of the same description.

ii) That the applicant's application No.149770 in class-30 is refused registration."

Prima facie, the order impugned was / is in line with all settled principles and is no open to any exception. Accordingly, same is maintained. Appeal is dismissed.

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