

# IN THE HIGH COURT OF SINDH AT KARACHI

M.A. No. 63 of 2022

[M/s. Getz Pharma International FZ LLC .....v..... the Registrar of Trade Marks & another]

Date of Hearing : 14.02.2024  
Applicant through : Mr. Zain Shaikh, Advocate for applicant  
Respondents through : Mr. Salim Ghulam Hussain, Advocate for respondent No.1.  
Mr. Zulfiqar Ali, Advocate.  
Mr. Sarmad Khan Azad, Advocate for respondent No.2 a/w Mr. Qasim Iqbal, Advocate.  
Mr. Alqamah Bin Mehmood, Advocate.

## JUDGMENT

**Zulfiqar Ahmad Khan, J:-**The Appellant by way of present appeal under section 114 of the Trade Mark Ordinance, 2001 (“Ordinance, 2001”) has challenged the Decision dated 13.06.2022 (“Impugned Decision”) passed by Respondent No.1, the Registrar of Trade Marks.

2. The facts leading to the present appeal as per case of the Appellant are that the Appellant claims to have been using trademark “GETZ Pharma” since June 25, 2005 under registration No.210855 in class 05. The record demonstrates that the appellant has been using its branding since 2008 and so as to promote its goods under the trademark “GETZ” it has spent substantial amount of money, time and labour and as a result whereof the products and services of the appellant earned goodwill and reputation hence its products under the tradename “GETZ” is allegedly in great demand. The anxiety of the appellant is that in the month of December 01, 2016 the respondent No.2’s impugned mark “GLITZ” was advertised in the

trademarks journal under application No.373851 in class 5 dated 11<sup>th</sup> November, 2014 for the purpose of inviting third party opposition to the registration of the said impugned mark, thereafter, appellant filed Opposition before the respondent No.1 to the registration of impugned mark which was numbered as Opposition No.2245/2017 on the ground, inter alia, that the Trade Mark applied for is identical to the Appellant's trade mark "GETZ" and is likely to deceive or cause confusion amongst the consumers. The learned respondent No.1 having observed the facts and circumstances through impugned decision disallowed the opposition filed by the appellant and application for registration of the impugned mark was allowed, hence this appeal.

3. Respondent No.2 has filed objections to this appeal and denied all the allegations made in the memorandum of titled appeal and supported the impugned decision. The stance taken by the respondent No.2 in its objections is that the impugned mark "GLITZ" is continuously being marketed by respondent No.2 since 2005 and the same is being used by the respondent No.2 globally. Marks "GLITZ" & "GETZ" are different in style as well as design, therefore, no chance of any confusion or deception by using both marks can arise.

4. Mr. Zain Sheikh advocated the case of the appellant and premised his case on the arguments that trademark of the appellant "GETZ" is registered mark and has now become well-known trademark in Pakistan hence protected under the prescriptions of the Trade Marks Ordinance, 2001 and any use of the mark or any

deceptively similar representation by the respondent No.2 are detrimental to the interest of the appellant which fact was not considered by the respondent No.1 in the impugned decision. He next contended that the impugned mark “GLITZ” was opposed on the basis of its deceptive similarity with the earlier registered mark “GETZ”. Mr. Sheikh further articulated that the impugned mark “GLITZ” if registered would create deception and confusion amongst the consumers of the trademark “GETZ”, therefore, the impugned decision is liable to be set aside and the application for registration of the impugned mark “GLITZ” be dismissed.

5. In contra, Mr.Sarmad Khan Azad, Advocate set forth the case of the respondent No.2. Per learned counsel the impugned mark “GLITZ” is continuously being marketed by respondent No.2 also since 2005 and the same is being used by the respondent No.2 globally. That marks “GLITZ” & “GETZ” are different in style as well as design, therefore, no chance of confusion or deception by using both marks can arise. He further submitted that the distinctive features of both marks cannot be overlooked by consumers which are manifested from the Star Shapped logo, therefore, there is much difference between the two marks which fact was also observed by the learned respondent No.1 while rendering the impugned decision, therefore, the appeal is liable to be dismissed.

6. I have heard the respective learned counsel and have carefully considered the documentations arrayed before me. It is considered expedient to initiate this deliberation by referring to the respective

constituent of the impugned decision and the same is reproduced hereunder:-

“c). The nature of medicinal products are different from ordinary consumer goods as they are given to the consumer on the prescription of qualified Doctors, who always prescribe the drug name or generic name only and not house mark of the company. Also, both marks GETZ and GLITZ are dictionary words and are distinguishable. Moreover, both are registered as a domain name being used side by side.

d) Notwithstanding the above, it has been further observed that the logo writing style and the whole scheme of both marks i.e. Getz and GLITZ, when compared side by side, can be found different to each other.

e). In the circumstances, I am of the opinion that there is no chance of any confusion or deception by using both marks as a house mark with their respective drug names.

Keeping in view the above facts and finding, I hereby pass the following orders:

1. That Opposition No. 2245/2017 is disallowed having no merits;
2. That applicant’s application No.373851 in class-05 is allowed to proceed to registration;
3. That there is no order as to cost;
4. That this order shall take effect after the expiry of statutory appeal period.”

7. It is patently evident that the appellant herein is the registered owner of trademark “GETZ”, hence, entitled to all the rights and privileges appurtenant thereto inclusive without limitation of the rights conferred by section 39 of The Ordinance, which inter alia demarcates a registered trademark to be the personal property of its holder. It is contended by learned counsel for the Appellant that the impugned order has been passed, ignoring facts and circumstances of the case and the provisions of Trade Marks Ordinance, 2001, in particular section 17 of the Ordinance, 2001 has been wrongly applied by Respondent No.1 while passing the order.


Per learned counsel, goods bearing mark “GETZ” have been in use in Pakistan by the present Appellant since June, 2005 under registration No.21085 in class 5 and under registration No.264862 as of April, 2009. With such a long use and taking into account the imitative nature of the marks and confusing similarity in between “GLITZ” and “GETZ” in my humble view. Respondent No.1 has failed to consider that the goods marketed and sold by the Appellant and the Respondent No.2 are of identical nature being pharmaceutical products and thereby incorrectly allowed the confusing similar mark “GLITZ” in favour of Respondent No.2 to proceed for registration.

8. The material placed on record shows that so far as the claim of the Appellant as regards registration of trade mark “GETZ” and its prior use, disclosed in the memo of appeal is concerned, it is an undeniable reality established on record, therefore, it needs no further discussion. At the cost of repetition, to me the impugned decision has been passed, ignoring the peculiar facts and circumstances of the case and the provisions of Trade Marks Ordinance, 2001, in particular section 17 has been wrongly applied by Respondent No.1 while passing the order. Per learned counsel, the product bearing mark “GETZ” are in use in Pakistan by the Appellant since 2005 hence Respondent No.1 seemingly has failed to take into account the imitative nature of the marks and confusing similarity in between the impugned mark “GLITZ” and Appellant’s prior owned mark “GETZ”.

9. It does not require much imagination to notice that trademark of respondent No.2 and appellant have close resemblance

and are likely to cause confusion in public eyes. The question that whether there has been an infringement or not can in such circumstances be decided by placing two marks together and then to determine about their similarity or distinctiveness, but if the two marks are identical, no further probe is needed and infringement is established. Essential features of the marks are usually looked into for effectively deciding the issue of infringement or even passing off. If there is a striking resemblance, *ex facie*, it would lead towards the conclusion that the mark has been infringed, which appears to be the case at hand.

10. I have examined the both marks of appellant as well as respondent No.2 and by placing them in juxtaposition carefully examined the same. For ready reference their reproductions are placed below, which depicts similarities in the two trademarks, sufficient to cause confusion among the ordinary customers:-

Appellant trademark	Respondent-2 trademark
	

11. The main guiding principle to examine the genuineness of the subsequent claim of Respondent No.2 for the registration of its trade mark “GLITZ” is that upon comparison of the two, the Court is to be satisfied that there are sufficient features to differentiate between the two trademarks phonetically as well as visually, so that an unwary buyer of the same product, as in the instant matter, is genuinely not confused and misguided due to the feature of similarities between the two marks. In “Messrs Burney’s Industrial

and Commercial Co. Ltd. v. Messrs Rehman Match Works” (PLD 1983 Karachi 357), it was held that where two marks are not identical the crucial point required consideration is that it should so nearly resemble that it is likely to deceive or cause confusion in course of trade. Obviously, an unwary or incautious or careless or unguarded purchaser is likely to be misled or deceived into purchasing goods of person keeping in view the vast difference in literary ratio and condition of life in Pakistan as compared to developed countries. The case of the appellant is that it was using the trade mark “GETZ” since long which was not only distinctive but in use of respondent No.2 and respondent No.2 realizing this fact has copied it to “GLITZ” in order to deceive the customers, not only so the placement of distinctive elements like an emblem on the effect and word “pharma” under the dominant feature of the mark GETZ is also chosen to deceive, therefore, while relying upon case titled “Messrs Mehran Ghee Mills (Pvt.) Limited and others v. Messrs Chiltan Ghee Mill (Pvt.) Limited and others” (2001 SCMR 967), opposition filed by the appellant ought to have been allowed. In my considered opinion, the concept of totality of impression, test of average consumer etc. recorded by the Respondent No.1 in its impugned order is misconceived and erroneous. As observed by me there are sound reasons disclosed by the Appellant in its Opposition No.2245/2017, which justify grant of such opposition and consequent rejection of Application of 373851 in class 5 of registration of Trade mark “GLITZ” in favour of Respondent No.2. This view of the matter is supported from the following judgments of Honourable Supreme Court of Pakistan, which are of binding nature:

PLD 1984 Supreme Court 8 (Jamia Industries Ltd. v. Caltex Oil (Pak) Ltd. and another).  
PLD 1990 Supreme Court 313 (Seven-Up Company v. Kohinoor Thread Ball Factory and 3 others).  
2012 SCMR 1504 (Shan Food Industries v. Eastern Products (Pvt.) Ltd. and others).  
2015 CLD 1245 (Messrs Farooq Ghee and Oils Mills (Pvt.) Ltd. v. Registrar of Trade Marks, Trade Mark Registry and others).

10. In view of the rationale and deliberations discussed above, the appeal at hand was allowed at the conclusion of the hearing vide order dated 14.02.2024 in the following terms:-

“For the reasons to follow this Appeal is allowed. The decision of the Registrar dated 17.09.2020 is set aside, the Respondent No.2 however is given six months’ time to change from GLITZ Pharma to any other trade name, which is not deceptively similar to the Appellant’s trademark/tradename GETZ or any third party’s trademark and to make appropriate applications before SECP and Drug Regulatory Authority etc. to do the needful.”

11. Above are the reasons of short order.

Karachi

Dated:

JUDGE

Aadil Arab