

THE HIGH COURT OF SINDH KARACHI

J.M. No. [-] 1494 of 2024

Applicants : M/s. Dr. Mubin Akhtar Hospital and
Dr. Syed Abdur Rehman through Raja
Qasit Nawaz Khan, Advocate.

Respondents : Nemo.

Date of hearing : 14-01-2025

Date of order : 14-01-2025

ORDER

Adnan Iqbal Chaudhry J. - The Applicants, carrying on business in the name and style 'M/s. Dr. Mubin Akhtar Hospital', have filed this J.M. as an application both under section 73 and section 80 of the Trade Marks Ordinance, 2001 [**the Ordinance**], respectively for revoking and invalidating the registration of the trademark 'M/s. Dr. Mubin Akhtar Hospital' registered in favour of the Respondent No.1. Simultaneously, the Applicants also filed a suit before this Court to challenge the registration of that trademark. By a separate order passed today, the plaint of that suit has been returned under Order VII Rule 10 CPC given that the exclusive jurisdiction to try such suit vests in the Intellectual Property Tribunal [**IP Tribunal**] under the Intellectual Property of Pakistan Organization Act, 2012 [**IPOP Act**], so also under the Ordinance. With regards to this J.M. too, the office has raised an objection to its maintainability before the High Court.

2. To make applications under sections 73 and 80 of the Ordinance to the High Court, learned counsel relies on sub-section (4) of both provisions which read:

- "73(4). An application for revocation may be made by an interested party to the Registrar, except that -
- (a) if proceedings concerning the trade mark in question are pending in the High Court, the application shall be made to the High Court, and
 - (b) in case the application is made to the Registrar, he may at any stage of the proceedings refer the application to the High Court.

80(4). An application for declaration of invalidity may be made by an interested party either to the Registrar or to the High Court, except that -

- (a) if proceedings concerning the trade mark in question are pending in the High Court, the application shall be made to the High Court, and
- (b) in any other case, if the application has been made to the Registrar, he may at any stage of the proceedings refer the application to the High Court."

3. It can be argued that after the overriding provisions of the IPO Act, the forum of the High Court provided in sections 73 and 80 of the Ordinance stands substituted for the IP Tribunal. A decision to that effect has already been rendered by a learned single Judge of the Islamabad High Court in *Shaheen Chemist v. Zahid Mehmood Chaudhry* (2023 CLD 1). However, for the present, I do not proceed to examine that aspect of the matter.

4. Sub-section (4) of section 73 of the Ordinance clearly requires the revocation application to be made to the Registrar of Trade Marks, and it is only by way of an exception that it can be made to the High Court *i.e.* if prior proceedings concerning that trademark are pending in the High Court. That has also been held by this Court in *Royal PVC (Pvt.) Ltd. v. Registrar of Trade Marks* (2011 CLD 833).

5. The text of sub-section (4) of section 80 of the Ordinance is slightly different. Though it can be argued there that an option is given to make the application for invalidation either to the Registrar or the High Court, however section 116 of the Ordinance goes on to clarify that:

"116. Procedure in certain cases of option to apply to the High Court, a District Court or Registrar. - Where under this Ordinance, an applicant has the option of making an application either to the High Court, IP Tribunal or to the Registrar -

- (a) if any suit or proceedings concerning the trade mark in question are pending before the High Court, IP Tribunal, the application shall be made to the High Court or, as the case may be, the IP Tribunal: and
- (b) in any other case, if the application is made to the Registrar, he may at any stage of the proceedings refer the application to the High Court, IP Tribunal."

6. Therefore, sub-section (4) of section 80 of the Ordinance is to be read with section 116 of the Ordinance. On a combined reading thereof it is manifest that even an application under section 80 of the Ordinance lies before the Registrar of Trade Marks, and that it can be made to the High Court only if the High Court is already seized of a prior suit or proceedings concerning that trademark. As held by a Division Bench of this Court in *H&B General Trading Company v. International Marketing Company* (2009 CLD 1028), the intent of sub-section (4) of sections 73 and 80 is to avoid conflicting decisions by different forums in respect of the same trademark.

7. For filing the J.M. before the High Court, the Applicants refer to Suit No. 924/2022 pending before the High Court. However, the plaint of that suit reflects that it has been filed by the Respondent No.1 against the Applicant No.2 and others for claiming a stake in Karachi Hospital (Pvt.) Ltd. and does not concern the trademark 'M/s. Dr. Mubin Akhtar Hospital'. As regards the suit filed alongside this J.M. which has been returned for presentation before the IP Tribunal, that surely cannot be treated as a suit 'pending' before the IP Tribunal at the time of the J.M.

8. When there is no suit or proceedings pending before the High Court concerning the trademark in question, sub-section (4) of sections 73 and 80 of the Ordinance do not permit applications thereunder to be made to the High Court. In such circumstances, the case of *Sadiq & Suharwardy v. Ismail Industries Ltd.* (order dated 10-01-2024 in Suit No. 200/2020) is of no help to the Applicants. Consequently, this J.M. is returned to the Applicants under Rule 119 of the Sindh Chief Court Rules (O.S.) read with Order VII Rule 10 CPC for presenting the underlying applications to the Registrar of Trade Marks in the form prescribed in the Trade Mark Rules, 2004.

JUDGE

*PA/SADAM