



p-ISSN : 2520-0348 | e-ISSN : 2616-793X

DOI(Journal): 10.31703/gssr
DOI(Volume): 10.31703/gssr/.2024(IX)
DOI(Issue): 10.31703/gssr.2024(IX.III)

DOI(Journal): 10.31703/gssr
DOI(Volume): 10.31703/gssr/.2024(IX)
DOI(Issue): 10.31703/gssr.2024(IX.I)

GSSR

GLOBAL SOCIAL SCIENCES REVIEW
HEC-RECOGNIZED CATEGORY-Y

VOL. IX, ISSUE III, SUMMER (SEPTEMBER-2024)

Article Title

Cultivating Trademark Excellence: Revolutionizing Protection in Pakistan

Global Social Sciences Review

p-ISSN: 2520-0348 e-ISSN: 2616-793X

DOI(journal): 10.31703/gssr

Volume:IX (2024)

DOI (volume):10.31703/gssr.2024(IX)

Issue: III Summer (September 2024)

DOI(Issue): 10.31703/gssr.2024(IX-III)

Home Page

www.gssrjournal.com

Volume: IX (2024)

<https://www.gssrjournal.com/Current-issues>

Issue: III-Summer (September-2024)

<https://www.gssrjournal.com/Current-issues/9/3/2024>

Scope

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Submission

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Abstract

Traditionally, trademarks were regarded as useful instruments for the identification of the source thus legal protection was provided to them. However, recently, trademarks have advanced as efficient instruments for both commercial and social communication in a fresh yet difficult environment. This article attempts to evaluate and analyze the present trademark regime in Pakistan and proposes changes as deemed necessary. The study highlights Trademark law gaps, comparing foreign statutes and international standards. The main objective of the legislation of Trademark Ordinance 2001, as evident from its preamble, was to provide a mechanism for registration, protection of trademarks, and prevention of fraudulent marks. Similarly, an imprudent buyer should not be deceived and no confusion should come into the mind of a layman which may mislead him to buy a product of one manufacturer for the other while considering it to be the same, that he actually wanted to purchase.

Keywords: Intellectual Property, Trademark, Protection and Counterfeiting, Piracy, Dilution

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Pages: 1-7

DOI:10.31703/gssr.2024(IX-III).01

DOI link:[https://dx.doi.org/10.31703/gssr.2024\(IX-III\).01](https://dx.doi.org/10.31703/gssr.2024(IX-III).01)

Article link: <http://www.gssrjournal.com/article/A-b-c>

Full-text Link: <https://gssrjournal.com/fulltext/>

Pdf link: <https://www.gssrjournal.com/jadmin/Auther/31rv1o1A2.pdf>

Citing this Article

Cultivating Trademark Excellence: Revolutionizing Protection in Pakistan							
11	Author	Siddiq Naushen Tauheed Ullah Siddiqui Muhammad Pervez		DOI	10.31703/gssr.2024(IX-III).01		
	Pages	1-7	Year	2024	Volume	IX	Issue
Referencing & Citing Styles	APA 7th	Naushen, S., Siddiqui, T. U., & Pervez, M. (2024). Cultivating Trademark Excellence: Revolutionizing Protection in Pakistan. <i>Global Social Sciences Review</i> , IX(III), 1-7. https://doi.org/10.31703/gssr.2024(IX-III).01					
	CHICAGO	Naushen, Siddiq, Tauheed Ullah Siddiqui, and Muhammad Pervez. 2024. "Cultivating Trademark Excellence: Revolutionizing Protection in Pakistan." <i>Global Social Sciences Review</i> IX (II): 1-7. doi: 10.31703/gssr.2024(IX-II).01.					
	HARVARD	NAUSHEN, S., SIDDIQUI, T. U. & PERVEZ, M. 2024. Cultivating Trademark Excellence: Revolutionizing Protection in Pakistan. <i>Global Social Sciences Review</i> , IX, 1-7.					
	MHRA	Naushen, Siddiq, Tauheed Ullah Siddiqui, and Muhammad Pervez. 2024. 'Cultivating Trademark Excellence: Revolutionizing Protection in Pakistan', <i>Global Social Sciences Review</i> , IX: 1-7.					
	MLA	Naushen, Siddiq, Tauheed Ullah Siddiqui, and Muhammad Pervez. "Cultivating Trademark Excellence: Revolutionizing Protection in Pakistan." <i>Global Social Sciences Review</i> IX.II (2024): 1-7. Print.					
	OXFORD	Naushen, Siddiq, Siddiqui, Tauheed Ullah, and Pervez, Muhammad (2024), 'Cultivating Trademark Excellence: Revolutionizing Protection in Pakistan', <i>Global Social Sciences Review</i> , IX (II), 1-7.					
TURABIAN	Naushen, Siddiq, Tauheed Ullah Siddiqui, and Muhammad Pervez. "Cultivating Trademark Excellence: Revolutionizing Protection in Pakistan." <i>Global Social Sciences Review</i> IX, no. II (2024): 1-7. https://dx.doi.org/10.31703/gssr.2024(IX-II).01 .						



Global Social Sciences Review

www.gssrjournal.com

DOI:<http://dx.doi.org/10.31703/gssr>



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Abstract

Traditionally, trademarks were regarded as useful instruments for the identification of the source thus legal protection was provided to them. However, recently, trademarks have advanced as efficient instruments for both commercial and social communication in a fresh yet difficult environment. This article attempts to evaluate and analyze the present trademark regime in Pakistan and proposes changes as deemed necessary. The study highlights Trademark law gaps, comparing foreign statutes and international standards. The main objective of the legislation of Trademark Ordinance 2001, as evident from its preamble, was to provide a mechanism for registration, protection of trademarks, and prevention of fraudulent marks. Similarly, an imprudent buyer should not be deceived and no confusion should come into the mind of a layman which may mislead him to buy a product of one manufacturer for the other while considering it to be the same, that he actually wanted to purchase.

Keywords: [Intellectual Property](#), [Trademark](#), [Protection and Counterfeiting](#), [Piracy](#), [Dilution](#)

Introduction

Almighty ALLAH called the human being the best creature among others due to bestowing the intellectual capacity to create intellectual things. This basic idea of creative work lies in every field. When you are about to create something unique with your great intellectual idea there are always

some threats to steal this idea or duplicate your product and take away your success. Therefore, the problem arises here to protect your creativity from stealing and secure your right to your intellectually conceived ideas. When we talk about such human creativity or human intelligence to create such an idea at different intervals then surely, we need a



system to protect those ideas and creations. So here, we find a system that is called in modern language 'intellectual property law or rights.' The reason for developing a legal system for intellectual property is to provide a mechanism for its protection and to offer reward to creative minds and keep fair trade practices. According to Maureen Daly, Intellectual property is a basket of different rights. Intellectual property may be divided into emblems, patents, copyrights, information rights, styles, and lead. Now we turn to define the meaning of trademark for first-time readers to understand it before we proceed.

The term 'mark' is defined in the Trademark Ordinance of 2001 of Pakistan. According to clause XXIV of section 2 of the Ordinance, mark includes in particular "a device, brand, heading, label, ticket, name including personal name, signature, word, letter, numeral, figurative element, color, sound or any combination thereof". Likewise, the term 'trademark' is defined under section 2 of sub-section (xlvi) of the Ordinance as any mark which may be represented graphically and capable of distinguishing goods or services of one enterprise from those of other enterprises; and (xlv) "similar goods" include goods which are of the same description.

Patents and copyrights are the creativity of the human mind. Whereas a trademark is simply an easy way of identifying goods. Similarly, a service mark is also an easy way of identifying services. Trademark rights trace their roots back to the common law – a legal system developed by the precedents and principles established by English courts of law.

Trademark Protection and Passing-Off Actions In Pakistan

In order to understand the concept, we should know about the term passing off. Passing-off may be defined as 'to show wrongly that one's business is that of, or connected with another, in a way likely to cause damage'. DUHAIMEAs Halsbury said that:

"Nobody has any right to represent his goods as the goods of someone else."

Halsbury, *n.d.* (per Halsbury L.C in 'camel hair Belting') Reddaway V. Banham, 1896

It means that no person has the right to show one's goods as of another. Generally, due to a lack

of awareness, traders usually think that remedy is only available to registrants of the trademarks, however, trademark law provides the same remedy to unregistered trademark owners as well in the form of passing off action. See Section 17(4)(a) of Trademark Ordinance, 2001

Passing off is a common law principle of tort that developed to protect the goodwill and reputation of the trademark of the trader against the damage caused by the infringer. Halsbury on the nature of trademark says: "No action can be brought against the unregistered trademark, but any right in such case may be protected by the means of an action of passing off.

Passing off is an actionable wrong of the defendant for trading purposes and is based on the wide principle that no man has the right to represent the goods of another as his own. The principle is that "trading must not only be honest but must not even unintentionally be unfair". (Lord Morris in Parker-Knoll V. Knoll International, 1962).

The reason behind the passing of action is to prevent dishonest trading, safeguard commercial goodwill, and ensure that purchasers are not exploited. For this purpose, the plaintiff must establish that his business or goods have acquired the reputation or goodwill and that the defendant has used a mark similar to his trademark which is sufficient to cause confusion or mislead the ordinary buyer. It is in fact the 'tendency to mislead, misguide or confuse' which forms the basis of passing on action as provided in the case Reckitt & Colman Borden, 1990 of Lord Oliver as well.

Passing-off is an 'unfair competition by misrepresentation' as stated by Christopher Wadlow in the Third Edition of his book - The Law of Passing Off. The US law also considers passing off as unfair competition.

Essentials That Constitute Passing-Off Action

The characteristics or essential ingredients of passing off have been described and explained in a number of cases Reckitt & Colman Borden, 1990 and are mentioned below:

1. Misrepresentation
2. Made by a person during the course of trade

3. To potential consumers that the goods or services were supplied by or belong to the original owner.
4. Likely to harm business or a trader's goodwill in the sense that it is reasonably a conceivable consequence that would probably cause actual damage to that other.

In the case of HAMDARD LABORATORIES (WAQF) PAKISTAN Versus MUHAMMAD FAHIM – with regards to Classic Trinity, there are three elements of passing off that the courts are supposed to consider. The following are the three elements:

1. Goodwill of the plaintiff's trademark in respect of identical or similar goods;
2. Defendant's Misrepresentation;
3. The acts of the defendant causing actual damage (or to be caused) to the Plaintiff

In the case of Reckitt & Colman Products Ltd v. Borden INC. and others [1990] 1 WLR 491, talking through Lord Oliver of Aylmerton, the House of Lords set out certain criteria and guidelines by summarizing the statute of passing off in one brief overall proposition — no one can carry off his products like those of another. He further noted that in order to win in a passing off action, the plaintiff would have to prove three aspects.

The Supreme Court has approved these ingredients of passing off namely misrepresentation, deception, reputation or goodwill and damage in the case of STARBUCKS(HK) LIMITED and another — versus BRITISH SKY BROADCASTING GROUP PLC and others See Starbucks (HK) Ltd. And Ors. VS British Sky Broadcasting Group PLC & Ors. 2015 S C M R 919., as well as the High Court. See 2001 CLC 1368

Jurisdiction and Legal Framework: Scope of Protection and Remedies

It is one of the obligations of the Paris Convention, Trips Agreement as well as the World Trade Organization that in case of an infringement of a trademark, the member country should take all necessary measures to ensure sanctions and to provide remedies.

This relief is based on Specific Relief Act, 1877 (Sections 52 to 57) and the Civil Procedure Code, 1908 (O.39, R 1& 2 read with section 151). Moreover, this relief is expressly mentioned in the Trademark Ordinance, 2001 as well.

In *Snowwhite Dry Cleaners vs Snowash Dry Cleaners* 2013, the plaintiff filed the suit against the defendant and pleaded that he was running a Dry Cleaner Shop under the style of Snowwhite Dry Cleaner since 1949. The defendant, his ex-employee, opened another dry cleaner shop in April 2011 under the name and style of “Snowash Dry Cleaner”. The name and style were very similar, deceiving the general public and creating confusion in mind as well as causing irreparable loss to the plaintiff. An injunction was granted by the High Court.

As the word ‘damages’ indicates a sum of money, imposed by the law in case of violation or infringement of some right. The same remedy is available to trademark holders either registered or not registered.

In the matter of Messer'sDHL Pakistan (Pvt.) Ltd. M/S DHL Pakistan PVT. Ltd., 2013, the respondent used the mark with the sole purpose of reaping the benefit from goodwill attached with the complainant. The mark or logo misled the customer. Damages were imposed worth PKR. 10,000,000.

Judicial Analysis of Passing-Off Action

Apart from legislation, the role of the judiciary in strengthening the concept of passing-off cannot be forgotten. The judiciary played a remarkable role in protecting the sanctity, integrity, and rights of trademark holders.

In the case of Messer's Hilal Confectionary (Pvt.) Ltd. vs Messer's Naveed Enterprises, both the appellant and respondent were manufacturers of well-known candies, i.e. Khopra Candy. Messer's Hilal Confectionary (Pvt.) Ltd, 2018 The plea of the appellant was that the respondent adopted a similar color, scheme, packaging, label, and wrapper for its product, Khopra Candy. Therefore, the appellant prayed for a permanent injunction as it had established a tremendous goodwill in Pakistan since 1993 and the use of its trademark by the defendant was deceiving the appellant's customers besides causing financial loss to it and passing off its goods. In this case, the trial court made an error while passing the impugned order in favor of the defendant and was unable to apply the judicial mind. The appellate court observed that the rules of guidance, for the test of comparison,

have already been laid down by the Hon'ble Supreme Court of Pakistan and the High Court in a number of cases. After scrutiny, it was held that the plaintiff had a locus standi and the defendant wrongly used a similar mark that caused confusion and deception to an unwary purchaser. Hence injunction was granted.

In the case of Burney's Industrial and Commercial Co. Ltd. vs Rehman Match Works, [1983](#) the mark used by the defendant was very similar or identical by its set-up, color scheme, design, and other features and had the tendency to cause confusion in the mind of unwary purchaser. The injunction was granted.

Critical Analysis

Pakistan has enormous corporate development capacity. Companies can expand quicker in Pakistan which implies that the volume of Trademark registration may also rise along with the corporate expansion.

In such an age of advanced technology; cyberspace, domain names, and web services and sites are used by the trademark owner to give facilities or products to their customers. They are also allowed security to their trademarks because they are more than pure email or precious assets of traders with regard to their company.

Similarly, trademark legislations apply to internet operations. They receive the same security as they receive the products or facilities. The Trade Ordinance of 2001 offers protection under Chapter 84 and Subparagraph 3 and the domain names for these operations. This solution was enacted on the basis of equity and fairness in the English common law system. AbdulBasit, [2017](#) It is one of the trademark industry's challenges that printing, piracy, and destroying well-known trademarks are among the enormous issues facing the nation, as there are pirates everywhere. The judges' awards of penalties are efficient but not sufficient. The registry offices and the related departments are required to regulate and solve these issues by taking effective steps. The submissions should be inspected for comparable marks on the Trademark Register.

Similarly, the entries should be checked on the Trademark register for similar marks, and if the infringer has established long use of the trademark

even then the matter should not be taken leniently, because it is an actionable wrong by a trader to conduct his business to lead the purchaser to believe that his goods are the goods of another person. As it is an action of passing off. It is therefore immaterial or absurd that false representation is expressly or implicitly created by word or image of label, trade name, or getup with which other person's products are connected in the nation's mind.

Tektronix Incorporated v. M. Abdul Manan, 1973 restrained the defendant. In the absence of any definite definition of goodwill and reputation in the statute, the concept becomes one of the challenges. Pakistan's courts failed to determine the distinction between goodwill and reputation. They made interchangeable use of it. However, goodwill is a form of ownership that is restricted to local jurisdiction, while the term reputation, which transgresses borders, is focused on passing on action.

Conclusion

The foregoing analysis and assessment of the trademark mechanism reveal that the level of protection of trademarks at the domestic level is not up to the mark. Similarly, the brand owners as well as the general public are facing various issues in the present scheme with growing difficulties in the protection, maintenance, and enforcement of their trademark rights and remedies against the counterfeiters. Counterfeiting, dilution, imitation, and piracy have a negative effect on the economy of the nation as well as the individual.

These germs or cancer-like diseases cause loss of sales and damage to the goodwill and reputation of the trademark holder's enterprise, established through his hard work. This activity also harms foreign investment because foreign manufacturers do not tend to produce their products in nations where counterfeiting is rife which contributes to unemployment and loss of tax revenue as well. Counterfeiting and piracy being unchecked, cause huge trench in the economy globally. Such illegal activities deprive governments of revenue for public services, put an extra burden on taxpayers, disrupt hundreds of thousands of legitimate jobs, and expose consumers to injurious and unhygienic products.

Giants like Microsoft previously had some initial talks with Pakistan to open its offices in the country and expand business. However, its only concern was to ensure protection of its trademark and copyright which could not be achieved within the given framework of intellectual property rights in Pakistan. It was indeed a great loss of foreign investment in the country due to its own deficient framework.

Similarly, Silicon Valley gained its name and fame just because most of the famous Brands and Companies opened up their offices there and are running their business globally by making Silicon Valley their central point of operation. Why can't Pakistan? Pakistan has all the potential to drive its economy straight-up by simply implementing a robust regulatory regime of Trademark.

Recommendation and Suggestions

Following are the recommendations based on the foregoing analysis and conclusion:

Adequate and efficient trademark system

An efficient system is required in place to encourage traders to reap innovation-based advantages, as trademark is the most widely registered type of intellectual property worldwide. Similarly, at the domestic level, there is a need to understand the significance of trademarks. It is evident that in economic development, a trademark provides a motivated medium. Trademark is a helpful tool for launching and supporting a fresh product and generating revenue as it comes with a reputation for quality, reliability, and other attributes. Even a trademark offers long-term commercial advantages beyond the life of the patent and the example is the Bayer company which even after the expiry of the patent took advantage of its product namely Aspirin[®] from its trademark. The trademark framework needs to be well structured, simplified, time-saving, cost-effective, and helpful for the development of trademarks, registration, protection, marketing, use, and implementation.

Workshops, Training, and Awareness Sessions

There is a need to educate the government and business community about the trademark's role

and importance. Raise awareness to the community and generate a worldwide value chain. It should be made easy to handle and register a powerful trademark scheme on the local and global stage. Effective means of compliance, as well as ad registration, help safeguard the property of the trademark. The Government Departments in collaboration with commerce and industry should arrange programs and brand sessions of awareness for the related government and business groups. This will allow the trademark industry to succeed quickly. Pakistan, like other countries, also has so many ways to succeed, but regrettably, the potential has not yet been tapped in full.

Development of Infrastructure & Framework

Too much delay in issuing a certificate due to a lack of trademark registry offices and lack of human resources is another defect of the current system. Workload and overburden lie on a few trademark offices which cause a painful environment for the businessman. Therefore, offices should be opened in every city. Similarly, more intellectual property tribunals should be set up for prompt disposal of IP-related cases as well.

The FIA and IP Special Unit Force

A task force should be set up to cope with counterfeit and piracy issues and arrest the person against whom an allegation is made instantly after a satisfactory investigation as the UK has set up its distinct police service to cope with such issues and cases.

Compulsory Registration

Trademark registration should be made compulsory as China has taken this bold step to overcome the Stealing of trademarks in pursuit of promotion and support of innovations.

Online Registrations System

Registration methods should be innovated and the request should be automatically denied if the candidate files on the online system a trademark similar to others. Online systems should be made efficient. There is no such an efficient online system in place as yet. Online systems can relieve long and perplexed procedures as well.

Implementation of the Madrid Protocol Agreement

The Intellectual Property Organization of Pakistan is a signatory to the Madrid Protocol Agreement for the facilitation of international registrations of trademarks yet an effective implementation is pending.

Separation between Trademark and Copyright

Trademarks and copyrights should be dealt with separately. Due to the absence of awareness, most of the traders assert their trademark privileges on the grounds of copyright law and are unable to obtain the advantage they really qualify for.

Amendments in Penal laws

There is no adequate criminal proceeding, provided for the breach of a trademark as there is a meager imprisonment, provided under sections 476 to 489 of Pakistan Penal Code 1860, which also declares it as a bailable offense. The imprisonment term has been provided for one to three years only in the current statute. However, it is recommended that the imprisonment term should be increased and

the wrong should be considered as a non-bailable offense. In this regard, the examples may be cited of the United Kingdom and Japan where the imprisonment period is ten years for such offenses and ten million as a fine.

Amendments in Intellectual Property laws

Likewise, a 'compromise paragraph' should also be introduced in the trademark law. As there may proceed a desire from one party to compromise, they may be able to readily do so on certain terms and conditions before the appropriate forum and these compromises should be recorded in the competent forum to prevent future discomforts. It will also help to alleviate the court's work pressure.

These recommendations will help to control trademark infringement – a violation of intellectual property rights. A robust trademark system encourages fair market competition, as well as protects the interests of consumers. Pakistan should also adopt best international practices such as China, the UK, the USA, and Japan have built their powerful trademark system and set up a distinct police department to enforce trademark law and defend the owners against the infringers.

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