
2022 C L D 176

[Lahore]

Before Ali Baqar Najafi, J

Messrs SHANN'S COSMETICS AND CHEMICALS
through Managing Partner---Appellant

versus

REGISTRAR OF TRADE MARKS
and another---Respondents

F.A.O. No. 95 of 2008, decided on 7th May, 2021.

Trade Marks Ordinance (XIX of 2001)---

***---Ss .8(a), 10(1)(2), 21 & 114---Registration of trade mark---
Deception and confusion---Principle---Objection to registration of trade
mark--- Appellant claimed to be owner of registered trade mark "Soft
Touch" and filed his objection to registration of trade mark "Sweet
Touch" by respondent---Authorities dismissed the objection and
application for registration of trade mark filed by respondent was
allowed---Validity---Where two marks were not identical, the crucial
point requiring consideration was that it should so nearly resemble that
it would likely to deceive or cause confusion in course of trade---***

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Unwary or incautious or careless or unguarded purchaser was likely to be misled or deceived into purchasing goods of person keeping in view the vast difference in literary ratio and condition of like in Pakistan as compared to developed countries---Appellant had been using trade mark "Soft Touch" since long which was not only distinctive but was continuously in use and respondent realizing such fact had copied it to "Sweet Touch" in order to deceive customers---High Court set aside the order passed by authorities---Appeal was allowed, in circumstances. [p. 180] A

Messrs Burney's Industrial and Commercial Co. Ltd. v. Messrs Rehman Match Works PLD 1983 Kar. 357 and U.B. Chemical Industries Company Limited v. Ahmad Nawaz and others 2002 CLD 604 ref.

Messrs Hilal Confectionary (Pvt.) Ltd. v. Messrs Naveed Enterprises and another 2018 CLD 1; Messrs Mehran Ghee Mills (Pvt.) Limited and others v. Messrs Chiltan Ghee Mill (Pvt.) Limited and others 2001 SCMR 967; Muhammad Ashraf alias Makkhan v. Muhammad Akram 2016 CLD 437; Messrs Hero Motors Ltd. through Authorized Signatory v. Babar Auto Trading and Manufacturing Company through Proprietor 2010 CLD 22 and General Biscuit and another v. English Biscuit Manufacturers (Private) Limited through Chief Executive/Director/Manager 2004 CLD 680 rel.

Usman Nassir Awan and Babar Afzaal for Appellant.

Haider Afzal Khan and Ms. Nazima Kiran Chuhan for Respondent No. 2.

ORDER

ALI BAQAR NAJAFI, J.---This First Appeal from Order under section 114 of the Trade Marks Ordinance, 2001 is directed against the judgment dated 31.10.2007 passed by the Registrar of Trade Marks whereby the appellant's opposition No.310/05 to Application No.173601 in Class-3 dated 31.11.2007 against the registration of Trade Mark "Sweet Touch" in favour of respondent No.2 was dismissed.

2. Brief facts giving rise to the filing of this appeal are that the appellant is carrying on the business of manufacturing and selling the cosmetic goods and allied products since 1982. The appellant adopted the trademark "Soft Touch" for the goods in the year 1982 and ever since is being used by him for the sale of cosmetic goods. The said Trademark was registered under Registration No.140433 in class 3 and, therefore, by virtue of long extensive use the appellant has got exclusive right to use the said trademark in respect of the cosmetic goods. This trademark has become very popular and was distinguished amongst the traders,

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general public due to their high quality not only in Pakistan but also abroad. The appellant had spent handsome amount on the introduction, marketing and publicity of the said goods. In fact the said trademark had become a distinction for the appellant's goods due to its substantial reputation and goodwill. However, in the Trade Marks Journal No.645, published in October, 2004, the appellant came to know that the respondent Registrar Trade Marks has provisionally accepted Application No.173601 in class 3 filed by respondent No.2 for the registration of Trade Mark "Sweet Touch". The appellant, therefore, filed notice under section 15(2) of the Trade Marks Act, 1940, Rule 30 of the rules made thereunder read with Article 10 of the Fourth Schedule of Trade Marks Ordinance, 2001 which was also numbered as Opposition No.310/2005 whereas respondent No.2 also filed counter statement (TM-6). Vide the impugned judgment dated 31.10.2007, the Registrar/respondent No.1 had dismissed the opposition and allowed the application for registration in favour of respondent No.2 which is impugned in the present appeal.

3. Learned counsel for the appellant contend that the appellant is original creator, developer, adopter and first user of the trade mark "Soft Touch" since 1982 which is known world over and, therefore has exclusive right to use it. Adds that respondent No.2 applied for registration of trade mark with prior knowledge that the appellant has a right in the said trade mark and that registered trade mark is similar in the famous and earlier registered trade mark of the appellant which is bound to cause confusion and deception amongst the buyers in public, therefore, is not entitled for registration under sections 8(a) and 10(1) of the Trade Marks Ordinance. Adds that respondent No.2 is not entitled to register the trade mark under section 10(2) of the Trade Marks Act, 1940. Adds that the impugned judgment is over stepping of the basic intention for registration of trade mark. Contend that only one affidavit of proprietor was placed on record and no other document was relied upon to form basis for passing the impugned judgment. Also contend that word touch is common to trade and as such the impugned judgment is not sustainable. Place reliance upon case titled "Messrs Burney's Industrial and Commercial Co. Ltd. v. Messrs Rehman Match Works" (PLD 1983 Karachi 357), "U.B. Chemical Industries Company Limited v. Ahmad Nawaz and others" (2002 CLD 604), "Messrs Hilal Confectionary (Pvt.) Ltd. v. Messrs Naveed Enterprises and another" (2018 CLD 1), "Messrs Mehran Ghee Mills (Pvt.) Limited and others v. Messrs Chiltan Ghee Mill (Pvt.) Limited and others" (2001 SCMR 967) to argue that sections 46, 80(3) read with section 17 of the Act were misinterpreted while passing the impugned judgment, therefore, pray for setting aside the same.

4. Conversely, the learned counsel for respondents submit that the appellant's registration it being implied in the infringement proceedings

as the trade mark must be unique and under section 21(c) of the Act the others can use the trade mark since "Soft Touch" is not unique. Place reliance upon "Muhammad Ashraf alias Makkhan v. Muhammad Akram" (2016 CLD 437), "Messrs Hero Motors Ltd. through Authorized Signatory v. Babar Auto Trading and Manufacturing Company through Proprietor" (2010 CLD 22), "General Biscuit and another v. English Biscuit Manufacturers (Private) Limited through Chief Executive/Director/Manager" (2004 CLD 680) and pray for dismissal of appeal.

5. Arguments heard. File perused.

6. After hearing the learned counsel for the parties and perusal of record, it is straightaway observed that the Registrar vide his order has concluded that **SOFT TOUCH** and **SWEET TOUCH** are entirely different as the word TOUCH is common when SOFT and SWEET are distinguishable visually and phonetically within the meaning of section 21 of the Trade Marks Ordinance, 2001. It is, therefore, expedient to reproduce it hereunder:-

21. Registration subject to disclaimer.- If a trade mark contains-

- (a) any part not separately registered as a trade mark in the name of the proprietor;
- (b) any part for the separate registration of which no application has been made; or
- (c) any matter common to the trade, or otherwise of a non-distinctive character; the tribunal, in deciding whether the trade mark shall be entered or shall remain on the Register, may require, as a condition of its being on the Register, that the proprietor shall either disclaim any right to the exclusive use of such part or of all or any portion of such matter, as the case may be, to the exclusive use of which the tribunal holds him not to be entitled, or make such other disclaimer as the tribunal may consider necessary for the purposes of defining the rights of the proprietor under the registration:

Provided that no disclaimer shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made.

7. Admittedly, the word "Touch" was not exclusively used by the appellant. In case titled "Muhammad Ashraf alias Makkhan v. Muhammad Akram" (2016 CLD 437), in the trade mark "Makkhan Sweet and Bakers", Makkhan was not exclusively used by the claimant,

therefore, was separable. In "Messrs Hero Motors Ltd. through Authorized Signatory v. Babar Auto Trading and Manufacturing Company through Proprietor" (2010 CLD 22), the word "Hero" was not used exclusively, therefore, "Asia Hero" was different, therefore, it can be registered separately. In "General Biscuit and another v. English Biscuit Manufacturers (Private) Limited through Chief Executive/Director/Manager" (2004 CLD 680), the word "Zeera Plus" was not distinctive form Zeera.

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 he was using the trade mark "SOFT TOUCH" since long which was not only distinctive but had been continuously in use and respondent realizing this fact has copied it to "SWEET TOUCH" in order to deceive the customers, 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), this appeal is allowed and the impugned order is set aside.

MH/S-32/L

Appeal allowed.