

THE HIGH COURT OF SINDH, KARACHI

Suit No. 94 of 2020

[Jazaa Foods (Pvt.) Ltd. & another versus Junaid Jamshed (Pvt.) Ltd. & others]

Plaintiffs : Jazaa Foods (Pvt.) Limited & another through M/s. Arshad M. Tayebaly & Omer Memon Advocates.

Defendants : Junaid Jamshed (Pvt.) Limited and 02 others through Mirza Mehmood Baig, Advocate.

Suit No. 124 of 2020

[U&I Garments (Pvt.) Ltd. & another versus Jazaa Foods (Pvt.) Ltd.]

Plaintiffs : U&I Garments (Pvt.) Ltd., & another through Mirza Mehmood Baig, Advocate.

Defendant : Jazaa Foods (Pvt.) Limited through M/s. Arshad M. Tayebaly & Omer Memon Advocates.

Date of hearing : 06-02-2020.
[CMA Nos:745 & 933 of 2020]

Date of decision : 07-04-2020.

ORDER

Adnan Iqbal Chaudhry J. - The dispute between the parties is over the use of the name of the celebrity, late Junaid Jamshed. This order decides competing applications for temporary injunction moved in the subject suits.

2. Jazaa Foods (Pvt.) Ltd. (hereinafter 'Jazaa Foods') is in the business of packing and distributing food items such as rice, fried onion, spices etc. It's trade mark 'Jazaa' is registered in Class 30 in respect of rice, wheat flour, flour milling products, sauces (condiments), spices etc. The late Junaid Jamshed was one of the founding members/shareholder of Jazaa Foods and presently one of his sons is a shareholder and Director thereof. Therefore, in conjunction with it's registered trade mark 'Jazaa', the goods of Jazaa Foods bear the words 'by Junaid Jamshed', hereinafter referred to as

'the mark¹ in question', *albeit* those words are not part of the registered trade mark of Jazaa Foods.

3. U&I Garments (Pvt.) Ltd. is in the business of manufacturing clothing, ready-wear garments, footwear, bags, fragrances etc. bearing the trade mark 'JunaidJ.Jamshed', which goods are then supplied by it to the company, Junaid Jamshed (Pvt.) Ltd., for onward retail. Per Suit No. 94/2020, the late Junaid Jamshed was a shareholder also in Junaid Jamshed (Pvt.) Ltd., and presently, his son is still shareholder. However, the registered trade mark 'JunaidJ.Jamshed' is the property of U&I Garments (Pvt.) Ltd., and the company Junaid Jamshed (Pvt.) Ltd. is an authorized user thereof pursuant to a license. The Defendant No.3 of Suit No. 94/2020 is the Chief Executive of both U&I Garments (Pvt.) Ltd. and Junaid Jamshed (Pvt.) Ltd. (collectively 'U&I Garments'). The trade mark 'JunaidJ.Jamshed' is registered not only in Classes in respect of textiles, garments, footwear and handbags, it is also registered in a number of other Classes including Class 30 (rice, spices etc.) in which the trade mark of Jazaa Foods is registered.

4. Suit No. 94/2020 has been filed by Jazaa Foods (plaintiff No.1) and by Taimur Jamshed son of late Junaid Jamshed (plaintiff No.2) *inter alia* for an injunction to restrain U&I Garments and others from creating hindrances or obstructions in the use by Jazaa Foods of the mark in question, and by CMA No. 745/2020 they pray for a temporary injunction accordingly. It is the case of the said plaintiffs that the business of Jazaa Foods had been started by the late Junaid Jamshed along with other members; that during his lifetime Junaid Jamshed spear-headed the marketing campaign of Jazaa Foods, and in that vein, given his celebrity status, he had vide a written authorization dated 28-06-2016, permitted Jazaa Foods to use the mark in question; that Jazaa Foods has ever since been using the mark in question without any objection from U&I Garments; that in

¹ Under section 2(xxiv) of the Trade Marks Ordinance, 2001, a 'mark' is defined to include a personal name.

December 2019, three years after the death of the Junaid Jamshed, the Defendant No.3 who is the Chief Executive of U&I Garments, asked Jazaa Foods to obtain a license from U&I Garments for the use of the mark in question, thus implying that unless Jazaa Foods obtains such a license, U&I Garments would treat that as an infringement of its trade mark; and that on the refusal of Jazaa Foods to comply, the Defendant No.3 has threatened to impede and damage the business of Jazaa Foods.

5. Right after Suit No. 94/2020, U&I Garments (Pvt.) Ltd. and Junaid Jamshed (Pvt.) Ltd. (hereinafter collectively 'U&I Garments') also filed Suit No. 124/2020 against Jazaa Foods *inter alia* for trade mark infringement and for passing-off. By CMA No. 933/2020, U&I Garments has prayed for a temporary injunction to restrain Jazaa Foods from using the mark in question in any fashion or manner.

6. Mr. Arshad Tayabaly, learned counsel for Jazaa Foods had submitted that Suit No. 94/2020 had been filed by it for protective relief which is also envisaged under section 52 of the Trade Marks Ordinance, 2001, which provides that where a person threatens to bring an action against another person on the ground that the other person has infringed a registered trade mark, or a trade mark alleged by the person to be registered, any person aggrieved by the threat may bring proceedings against the person making the threat for relief envisaged in the said section. Learned counsel submitted that right after this suit, U&I Garments has threatened the distributors of the Jazaa Foods and have also approached Facebook for removing the content of Jazaa Foods, which acts are a manifestation of the apprehensions expressed by Jazaa Foods in its suit. Learned counsel submitted that the mark in question is not deceptively similar to the trade mark of U&I Garments, and that in any case, the registered trade mark of U&I Garments is subject to the disclaimer that they do not have the right to the exclusive use of the name '*Junaid Jamshed*'.

7. It is the case of U&I Garments that the use of the mark in question by Jazaa Foods is deceptively similar to the registered trade

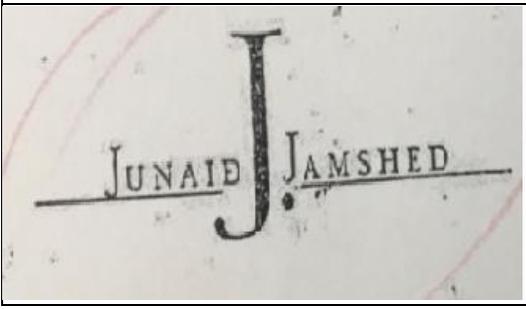
mark of U&I Garments and hence trade mark infringement. Mirza Mehmood Baig, learned counsel for U&I Garments submitted that the name '*Junaid Jamshed*' is not part of the registered trade mark of Jazaa Foods, whereas, the said name was central to the registered trademark of U&I Garments; and that the trade mark of U&I Garments was also registered in Class 30 in respect of the same food items as of Jazaa Foods and therefore Jazaa Foods is also liable for passing-off.

8. Heard the learned counsel and perused the record.

In the circumstances of the case, where the action threatened, or at least one such action contemplated under section 52 of the Trade Marks Ordinance, 2001 has already materialized by U&I Garments filing Suit No. 124/2020, I need not dwell on the import and scope of section 52 of the Trade Marks Ordinance, 2001 for the purposes of deciding the applications for temporary injunction, especially when sub-section (3) of section 52 envisages that while considering relief under sub-section (2), the Court will satisfy itself that the acts of the plaintiff do not constitute infringement of a registered trade mark. In other words, the circumstances of the case are such that the temporary injunction sought by Jazaa Foods depends on the fate of the temporary injunction sought by U&I Garments. It would thus be expedient to first and primarily examine the case of U&I Garments.

9. The respective trade mark of the parties as those appear on the Register of trade marks are as follows:

TABLE I

Registered Trademark of U & I Garments	Registered Trademark of Jazaa Foods
	

The mark in question, i.e. the name 'Junaid Jamshed', as used by Jazaa Foods in conjunction with its registered trade mark is as follows:

TABLE II



10. While U&I Garments objects to the use of the name 'Junaid Jamshed' (mark in question) by Jazaa Foods, but almost all of the trade mark registration certificates of U&I Garments, and in particular the certificate in respect of Class 30 in which Jazaa Foods also carries on business, are with the following disclaimer:

"DISCLAIMER: REGISTRATION OF THIS TRADE MARK SHALL GIVE NO RIGHT TO THE EXCLUSIVE USE OF WORD 'JUNAID JAMSHED' AND LETTER 'J' EXCEPT AS SUBSTANTIALLY SHOWN ON THE LABEL."

11. The registration of a trade mark with a disclaimer is provided by section 21 of the Trade Marks Ordinance, 2001 as under:

- "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 purpose 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.”

The effect of a trade mark registered with a disclaimer is then dealt with by section 42 of the Trade Marks Ordinance, 2001 as under:

- “42. **When a trade mark is not infringed** - (1)
(2)
(3) Where registration of a trade mark is subject to a disclaimer, a person shall not infringe the trade mark by using disclaimed part of the trade mark.”

12. The fact of the matter that emerges is that while registering its trade mark ‘JunaidJ.Jamshed’, U&I Garments had made a disclaimer under section 21 of the Trade Marks Ordinance, 2001 that it will not be entitled to the exclusive use of the name ‘*Junaid Jamshed*’. The presumption is that while registering the said trade mark, the Registrar was of the view that the disclaimed feature of the trade mark was of a non-distinctive character or may otherwise be in common use and thus U&I Garments was not entitled to its exclusive use. In the instant case, the words disclaimed were the name of a celebrity, ‘*Junaid Jamshed*’, and thus arose the likelihood of its use elsewhere by or on the authority of the said celebrity. In *Muhammad Ashraf v. Muhammad Akram* (2016 MLD 389) it was held that the principle that registration of a trade mark gives rise to a *prima facie* case, balance of convenience and likelihood of irreparable loss, that principle would be applicable where the trade mark was registered without a disclaimer, restriction or limitation; and that where a disclaimer, restriction or limitation to the exclusive use of any word/feature/description of a trade mark is imposed pursuant to section 21 of the Trade Marks Ordinance, 2001, then such disclaimer, restriction or limitation would have to be considered while determining an application for temporary injunction.

13. The effect of the disclaimer in the trade mark registration of U&I Garments is that unless the name ‘*Junaid Jamshed*’ is used by another in substantially the same fashion and get-up as used by U&I

Garments (Table I supra), it cannot claim to be aggrieved. A comparison of the mark in question with the trade mark of U&I Garments shows that there is no similarity in the fashion and get-up of the name '*Junaid Jamshed*' as used in the two marks. Therefore, in view of section 42(3) of the Trade Marks Ordinance, 2001, the said use by Jazaa Foods of the name '*Junaid Jamshed*' would not constitute trade mark infringement. As regards the allegation of passing-off, it is settled law that an action for passing-off is essentially to protect 'property in goods' based on the reputation of those goods, as distinct from an action to protect a trade mark which is a property in itself (see *Tabaq Restaurant v. Tabaq Restaurant*, 1987 SCMR 1090). Though it has been pleaded by U&I Garments that they have 'recently' introduced food products in Class 30 as that of Jazaa Foods, but nothing has been placed on the record thus far to show similar goods bearing the trade mark '*Junaid J. Jamshed*' let alone to show passing-off.

14. Given the disclaimer and its effect discussed above *inter alia*, U&I Garments does not have a *prima facie* case for the grant of a temporary injunction to restrain the use of the mark in question by Jazaa Foods; the balance of convenience is not in its favor, nor would it suffer any irreparable loss if injunction is refused as apparently no action has been taken by it against the use of the mark in question by Jazaa Foods since 2016. Conversely, Jazaa Foods meets the test of the said three ingredients for the grant of a temporary injunction. Jazaa Foods has relied upon photographs to show that during his lifetime, Junaid Jamshed himself used his name (mark in question) to promote Jazaa Foods; that the mark in question is being used by Jazaa Foods at least since 2016 without objection; that Junaid Jamshed had given a written authorization to Jazaa Foods to use his name; and therefore unless the Defendants of Suit No. 94/2020 (U&I Garments & others) are restrained from interfering in the said use, Jazaa Foods is likely to suffer irreparable loss. Consequently, CMA No. 933/2020 moved by the Plaintiffs in Suit No. 124/2020 is dismissed; whereas, CMA No. 745/2020 moved by the Plaintiffs in Suit No. 94/2020 is granted in

terms that pending suit the Defendants of Suit No. 94/2020 are restrained from interfering in the use of the mark/name '*by Jamshed Junaid*' by Jazaa Foods in conjunction with their registered trademark '*Jazaa*' in Class 30 in the fashion and get-up that appears in Table II *supra*.

JUDGE

Karachi
Dated: 07-04-2020