
INFRINGEMENT OF TRADE MARK, CRIMINAL LIABILITY,
PROCEDURE AND TRIAL



RESEARCH CENTER, HIGH COURT OF BALOCHISTAN



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COURT: HON'BLE MR. JUSTICE SHOUKAT ALI RAKHSHANI

SUBJECT: INTELLECTUAL PROPERTY LAWS

DATE: 06TH JUNE 2024.

BY: WASEEM AHMED RAEES RESEARCH OFFICERS

QUERY: INFRINGEMENT OF TRADEMAKR, CRIMINIAL LIABILITY, PROCEDURE AND TRIAL?

S. Q. NO. 1. WHAT OFFENSE IS MADE OUT IF SOMEONE USES ONES TRADE MARK AND WHAT PROCEEDINGS COULD BE INITIATED AGAINST SUCH PERSON & IF SOMEONE USES THE IDENTITY OF ANOTHER IN FOOD, WHAT OFFENSE IS MADE OUT?

KEYWORDS: Civil Remedies, Falsifying Trademarks, False Trade Descriptions, Property Marks Rights, Injunctions, Damages, Accounts of Profits, Erasure of Offending Mark, Intellectual Property Laws, Session Courts, Judicial Magistrates, Investigation and Trial Procedures, passing off.

RESEARCH MEMO:

My lord, it is humbly submitted as under:-

Q. NO. 1 WHAT OFFENSE IS MADE OUT IF SOMEONE USES ONES TRADE MARK AND WHAT PROCEEDINGS COULD BE INITIATED AGAINST SUCH PERSON & IF SOMEONE USES THE IDENTITY OF ANOTHER IN FOOD, WHAT OFFENSE IS MADE OUT?

In answer to above query, it may be observed that in Pakistan, the use of another's trademark without authorization can lead to legal consequences under the Trade Marks Ordinance, 2001; Pakistan Penal Code as well as in certain cases Under the Balochistan Food Authority Act 2014. The consequences of such infringement can include civil remedies, as well as criminal penalties. Since the query is related to criminal consequences of infringement of trademarks; therefore, first part of this paper is confined to criminal consequences of such infringements.

Part-I

Criminal Offenses under The Trade Marks Ordinance, 2001, which provides **under Chapter XIII of the Ordinance** for criminal offenses for falsifying and falsely applying trademarks, making or possessing instruments for falsifying trademarks, and selling goods or providing services to which false trade-marks or false trade descriptions are applied. The penalties can include fines and imprisonment.

Criminal offenses under The Pakistan Penal Code (PPC): In PPC, punishments have also been provided for certain acts offend the trademarks rights and law. **Section 478, 479, 481, 482, 483, 485, 486, 487, 488 and 489 PPC** criminalize such acts.

Criminal offenses under Balochistan Food Authority Act 2014. In this statute, which has been promulgated mainly for the safety and standards of food and for establishment of Food Authority; punishments have been fixed under **sections 25 and 26 of the Act** for a person who publishes advertisement which falsely describe and food or where a person prepares package, label any food which is false, misleading or deceptive. In addition, if someone use the identity of another in food, such persons may be prosecuted for **cheating, personation**, or may be prosecuted for using or counterfeiting **Property Mark** as defined under section **479 and punishable under section 481 483, 486 or 488 PPC**.

Trial of offenses in relation to trademarks: All offenses **prescribed in the PPC** which are punishable for infringement of or relating to trademarks as well as **offenses prescribed under Trade Mark Ordinance 2001**, are **schedule offenses (declared Intellectual property law under section 2(h)) under the Intellectual Property Organization of Pakistan Act 2012** and made triable by “**Intellectual Property Tribunal**” as captured under **section 15, established under section 16, 17 & 18** of the Act *ibid*. However, **offenses relating to food stuff and prescribed under the Balochistan Food Authority Act 2014, are trial by Ordinary Courts i.e. Sessions Judges, Additional Sessions Judges and Judicial Magistrates** are empowered to try such offense, as envisaged **under section 40** of the Act *ibid*, and cognizable is dependent on the complaint being filed by the Authority.

Procedure for initiating criminal process: Although the offenses prescribed under the Trade Mark Ordinance 2001 and offenses punishable under the PPC have been made schedule offenses under The Intellectual Property Organization of Pakistan Act 2012, however, **no special procedure for investigation and trial** have been laid down in the Ordinance 2001 and Act 2012. Therefore, in view of the provisions of section 5 of the Code of Criminal Procedure 1898, the mechanism provided in the Code shall apply.

As regards the offenses which may be False Labelling made applicable to a case which involve false description of any food or, as cognizance by Courts for all offenses under the Act 2014 are made cognizable by Court only on a complaint by or on behalf of the Authority. However some offenses may be initiated under Chapter XVI of the Code, in view of section 41 of the Act 2014.

Part-II

1. **Civil Remedies:** The registered proprietor of a trademark has the exclusive right to use the trademark in relation to the goods for which it is registered. If another person uses a mark that is identical or so nearly resembling the registered trademark as to be likely to deceive or cause confusion, it constitutes infringement, and the proprietor may seek an injunction against the infringer and may also claim damages or an account of profits as well as obtaining order for erasure of offending mark under section 46, 47 of the Trade Marks Ordinance 2001 and before the Intellectual Property Tribunal in terms of **section 117 of the Ordinance 2001**. Apart this, if someone is aggrieved, being suffered damages from any act **prohibited under the Balochistan Food Authority Act 2014**, or **owner of an unregistered Trade Mark** may approach ordinary Court complaining **passing off tort**¹ and seek damages.

Conclusion: In conclusion, the infringement of trademarks in Pakistan is an act with both criminal and civil implications. The Trade Marks Ordinance, 2001, the Pakistan Penal Code, (and the Balochistan Food Authority Act 2014 in certain cases) provide a comprehensive legal framework to protect trademark, property marks and public from being misled by counterfeit identification in selling foods and goods. Criminal liability can result in fines and imprisonment, while civil remedies include injunctions, damages, and accounts of profits. The Intellectual Property Tribunal is the specialized body for the trial of offenses under the Trade Marks Ordinance, 2001, and the Intellectual Property Organization of Pakistan Act 2012, whereas ordinary courts handle offenses under the Balochistan Food Authority Act 2014. The procedure for initiating criminal proceedings follows the Code of Criminal Procedure 1898, with no special procedure outlined in the Ordinance 2001 or Act 2012.

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1. The tort of passing off is a common law remedy that protects the goodwill associated with a trader's business or brand from being misrepresented as that of another. The essence of passing off is that "A man is not to sell his own goods under the pretense that they are the goods of another man". The tort is actionable when a trader conducts business in a way that leads the public to believe that their goods or services are those of another, thereby causing confusion or deception