



Article No. 01/2017

Registered Trade Mark with Disclaimer – Absence of Exclusive Right in the Word – No Infringement

Appellant: MUHAMMED ASHRAF alias MAKKHAN

Respondents: MUHAMMED AKRAM

Decision: Appeal Dismissed

Appellant challenged the order of the Additional District Judge, Sheikhpura, dismissing its application for grant of temporary injunction against use of the word “MAKKHAN” (Urdu word for ‘butter’) by Respondent in its trade mark. Appellant submitted that the impugned order was bad in law as the learned Additional District Judge did not give due credence to the registration of the Appellant’s trade mark. Respondent submitted that the said order was in accordance with law as the Appellant had no exclusive right on the use of the word “MAKKHAN” as it has been registered with the condition, “*Registration of this trade mark shall give no right to the exclusive use of MAKKHAN SWEET AND BAKERS and other descriptive matter appearing on the label.*” Respondent contended that the Appellant voluntarily disclaimed the word “MAKKHAN” at the time of obtaining registration of its trade mark and Appellant and Respondent were real brothers who prior to undertaking separate businesses were working together under the same name and style and using the same trade mark “MAKKHAN”. The Respondent also submitted that during the term of their joint business Appellant was responsible for manning the sales counter and outdoor activities relating to the business whereas Respondent was looking after the manufacturing aspects of the joint business and that the Appellant got the trademark registered in his name illegally.

Section 21 of the Trade Marks Ordinance 2001 deals with disclaimer which reads as:

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 proprietors 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 court observed that it is quite apparent that a disclaimer is imposed by the Registrar on any part of the trade mark, as a condition for allowing, where the Registrar finds that said part of the mark is, *inter alia*, common to trade or otherwise of a non-distinctive character and the Tribunal (Registrar) holds the applicant not to be





Bharucha & Co.
Intellectual Property Attorneys

entitled to the exclusive right to use thereof. A disclaimer, thus, limits the extent of the exclusive right, which a registration may give to a trade mark owner. In view of disclaimer, it is manifest that Appellant had himself disclaimed any exclusive right to the words “Makkhan Sweets and Bakers”, Appellant therefore was not entitled to be considered to have made out a *prima facie* case on the basis of registration in question. Consequently, the court held that in the absence of having any exclusive right in the word “MAKKHAN” Appellant failed to show that he had *prima facie* case, balance of convenience in his favour and that he would suffer an irreparable loss by continuation of business by Respondent by selling his goods under the word “MAKKHAN”. As such, the order passed by the learned Additional District Judge, was deemed to be within its legal boundary, not required to be interfered by High Court and the appeal was dismissed.

