

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 2143238  
BY TOUCH MEDIA CO LTD TO REGISTER THE MARK  
DAWN IN CLASS 16**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER No 48200  
BY PAKISTAN HERALD PUBLICATIONS (PVT) LIMITED**

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by Pakistan Herald Publications (PVT) Limited**

### **DECISION**

1. On 27 August 1997 Touch Media Co Ltd applied to register the mark DAWN for goods in Class 16 consisting of "printed matter; publications; periodicals; periodical publications; magazines; newspapers; journals".
2. The application is numbered 2143238.
3. On 12 February 1998 Pakistan Herald Publications (PVT) Limited filed notice of opposition to this application. They say:

"1. Pakistan Herald Publications (Pvt) Limited (hereafter "the Opponent") carry on business, inter alia, as the publishers of an English language newspaper, and provider of news services under and by reference to the name or mark "DAWN". The said newspaper "DAWN" is published in Pakistan, and is the leading English language newspaper in such territory. It has a substantial circulation and readership extending beyond Pakistan. The said newspaper was founded in 1947, and has continued in publication and circulation since that time.

2. The said publication "Dawn" formed the basis of an expansion into an internet news service offered by the Opponent since in or about 1994. The Opponent has offered an internet edition of the said newspaper and/or published extracts therefrom under and by reference to the said name or mark "DAWN" since 1994, and similarly offers a "Dawn Wire Service" relating to such news services. The Opponent and its aforesaid publications (both in newspaper and electronic form) enjoy a substantial reputation and goodwill both in Pakistan, and in many other countries of the World, particularly where there are ex patriot [sic] Pakistani communities. Such reputation and goodwill extends to the United Kingdom. In particular, a substantial number of readers take advantage of the services offered by "Dawn Internet", and for a substantial number of years copies of the "Dawn" newspapers have been subscribed to directly by U.K. residents.

3. The Opponent obtains news information and other data relevant to features carried in its said publications via an international network of news correspondents. For approximately the last 50 years a number of correspondents have been based in London, England, acting as "overseas correspondents" for the Opponent. The Opponent has sold advertising space, inter alia, in the U.K. to companies based in the U.K. since the early 1950's. Such advertising space is offered under and by reference to the name or mark "DAWN".
4. On this basis objection is said to arise as follows
  - (i) under Section 5(4)(a) because the opponents claim to have an earlier right
  - (ii) under Section 3(4). No further explanation is offered
  - (iii) under Section 3(6) firstly having regard to the repute of the opponents and their mark DAWN and secondly on the basis that two of the directors of the applicant company are Pakistani nationals and must, therefore, have been aware of the opponents.
5. There is also a reference to discretion. it is now well established that no such general or overriding discretion is available so I do not intend to make any further reference to this matter.
6. The applicants filed a counterstatement denying the above grounds.
7. Both sides ask for an award of costs in their favour.
8. Both sides filed evidence. The Registry wrote to the parties at the conclusion of the evidence rounds and invited them to say whether they wished to be heard. Neither side has asked for a hearing. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.
9. I will take the Section 5(4)(a) objection first. The relevant part of the statute reads:

"5.-(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

  - (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or
  - (b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

10. The conventional test for determining whether the opponents have succeeded under this section has been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] RPC 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:
  - (1) that the opponents' goods have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
  - (2) that there is a misrepresentation by the applicants (whether or not intentional) leading or likely to lead the public to believe that goods offered by the applicants are goods of the opponents; and
  - (3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicants' misrepresentation.
11. The opponents have filed statutory declarations by Hameed Haroon, the Deputy chief Executive Officer of Pakistan Herald Publications (PHP), publishers of Dawn newspaper, and Nasir Malick, the UK staff correspondent for the newspaper.
12. Mr Haroon's evidence is most relevant to the issue of goodwill. However before coming on to activity in the UK it is worth recording the following background information as set out in Mr Haroon's declaration:

"Dawn is the flagship publication of PHP. In addition to Dawn PHP publishes The Star, Karachi's most popular English language evening newspaper, The Herald, an influential monthly current affairs magazine, Dawn Wire Service, Pakistan's first electronic newspaper and two Gujarati language newspapers, Dawn Gujarati and Vatan. In 1994, PHP also launched Dawn, The Internet Edition.

Published from Karachi and Lahore and read throughout Pakistan and the rest of the world, Dawn enjoys both nation-wide and world-wide influence. There is now produced and shown to me marked Exhibit HH1 a copy of the Fiftieth Anniversary copy of Dawn published on 29 July 1997. The Fiftieth Anniversary copy of Dawn was published before Touch Media was incorporated on 19 August 1997 and before Trade Mark Application number 2143238 was made on 27 August 1997. More recent example copies of Dawn dated 25 December 1997 and 27 December to 31 December 1997 are also exhibited at HH1. It can be seen from all of these newspapers and their supplements and magazines that the name or mark "DAWN" is used prominently. The printed version of Dawn has a weekday circulation of over 95,000 copies and a total readership base in excess of 524,000 readers in

Pakistan. Dawn is read by policy and decision makers in the public and private sectors, at federal and provincial government level and by the majority of Pakistan's English reading newspaper public. Dawn is Pakistan's most authoritative newspaper, respected for its uncompromising track record in news reporting and comment. Dawn is backed by a strong editorial team including some of Pakistan's most distinguished journalists, with more than 200 correspondents in Pakistan and abroad (including the United Kingdom) and an extensive syndication and wire service network."

13. The newspaper has been represented in the UK by news correspondents since 1947. Mr Haroon lists the eight correspondents who have filled this position since 1947. They report on events in the UK with particular emphasis on developments relating to the British Foreign Office, proceedings in the Houses of Parliament, the general position of Pakistanis resident in Britain and British citizens of Pakistani origin. Three main areas of activity are relied on in support of the claim to common law rights. These are
  - (i) circulation of Dawn in the UK
  - (ii) Internet readership in the UK
  - (iii) advertising revenues from the UK
14. I do not need to say a great deal about the third category as it is very doubtful whether it assists the opponents in this action. Suffice to say that PHP generate modest advertising revenues from UK firms. In the main these seem to be UK firms who have offices or operations in Pakistan. The assumption must, I think, be that the advertisements they place are intended to support or drum up business for their activities in Pakistan. Whilst I have no doubt that this is an entirely normal and to be expected method of working such activity does not in itself support a claim to a common law right under the sign Dawn in relation to a relevant business in the UK.
15. The main points to emerge from the evidence in relation to categories (i) and (ii) are:
  - between 1947 and 1975 an average of 1000 copies of Dawn was subscribed to daily in the UK. Most of the subscribers were in the London area
  - from 1974 onwards Dawn Overseas Weekly was launched to satisfy a demand for news on Pakistan from the 3500 or so expatriates living in Britain
  - the Dawn Weekly publication was sold either through private subscription or bought in bulk by the Embassy of Pakistan in Britain and delivered to members of Parliament, civil servants and UK companies with business interests in Pakistan (copies of the publication are exhibited at HH2)
  - by the mid 1990s demand was levelling off due to increased postal costs

and postal delays but a small base of subscribers still exists

- to counter this levelling-off in demand the Dawn Wire Service was launched. Unfortunately the main exhibit in support of this (HH3) is after the material date.
- in 1994 an Internet edition of the newspaper was launched. It is said to have a substantial readership in Britain amongst academics, policy makers, the wider Pakistan community in Britain and British citizens of South Asian origin
- an example of the Internet edition of the newspaper is at HH4. Also included in the exhibit is a list of UK based visitors to the website who took the time to fill out a feedback form in the previous six months. Some 212 names are listed. I approach this evidence with some caution as the main part of HH4 is a December 1998 internet edition of the newspaper (ie. after the date). The feedback list was compiled over a period which spans the relevant date.

16. It will be apparent from the above that the opponents' use is relatively slight but long standing. Slight use does not necessarily mean that a sign (or rather the underlying business) cannot benefit from protection (see Wadlow's *The Law of Passing Off* at 6-09). The question to be addressed is whether the mark or sign is distinctive within the relevant market. It seems to me that it is not an opponent's fault if that market is in itself a small one. In this particular case the opponents base their claim on the circulation in the UK of an English language newspaper aimed at the Pakistani community. The copies of the newspaper that have been exhibited support Mr Haroon's claims as to the nature of the newspaper. The main newspaper is what might commonly be referred to as a broadsheet, with the emphasis on serious content. It contains in depth news coverage, informed commentary on the issues of the day and has a full business and financial section. The Overseas Weekly edition is smaller in format but with a broadly similar content.
17. The likely readership base must be judged accordingly. I note that the opponents say it is aimed particularly at the Pakistani ex-patriate community in the UK. No doubt that would include individual businessmen, business organisations, diplomats, academics and the like living and working in this country. A slightly wider audience might be found amongst British citizens of Pakistan origin and UK companies with a particular interest in the Pakistani market. But even allowing for this wider audience it seems to me that the potential readership base is likely to be relatively small. The duration of activity in the UK is to that extent a rather better indicator of established and continuing goodwill in the circumstances of this case than overall number of subscribers. I bear in mind also that newspapers are often familiar to and read by more than simply the individual purchaser or subscriber. That is particularly the case with purchases by corporate bodies. Wadlow's at 6-11 refers to the following passage from *Kark (Norman) Publications Ltd v Odhams Press Ltd*, 1962 RPC 163

"[I]t is enough to show that a substantial number of persons likely to become purchasers of the goods are liable to be deceived by the defendant's use of the name. On the one hand it is not necessary to show that all, or substantially all, persons in the market associated the name with the plaintiff's goods, if this can be shown of a substantial proportion of persons who are probably purchasers of the goods in question. On the other hand, that careless or indifferent persons may be led into error is not enough."

and comments that

"It is impossible to give an *a priori* definition of what number or proportion of the market counts as substantial. The standard varies from case to case, but two contrasting situations may be distinguished. If the mark is arbitrary, then provided it means something to a proportion of the public which is not trivial then it probably does not matter that to the majority it conveys nothing at all. Arbitrary marks have been protected despite user being on such a small scale that they can have been distinctive to very few. On the other hand, if the mark is *prima facie* ill-adapted to distinguish the plaintiff's goods, for instance because it is descriptive, distinctive of a third party in another field, or very simple, then a much larger proportion are required to use or recognise it in a trade mark sense. Relief has been refused although a mark which was descriptive in its origins had almost certainly become distinctive to the majority of purchasers."

18. The applicants have challenged the opponents' claim to reputation/goodwill in a statutory declaration by Abyez Ahmed, their Secretary. He notes in particular that circulation is mainly to private subscribers or by way of bulk supplies to the Embassy of Pakistan and assumes that the newspaper which is published in Pakistan is not freely available for purchase in the UK. If by that Mr Ahmed means it is not generally available at newsagents and other conventional outlets for newspapers I accept that that is probably the case. Certainly the opponents make no claim that this is the case. But this is hardly surprising given the nature of the paper and the likely readership base. The target audience is small in number and probably best served by private subscription and the other distribution methods referred to by the opponents.
19. In summary whilst I do not think it can be said that the opponents have established an overwhelming case I believe there is sufficient information for me to be satisfied that they enjoy goodwill in this country under what is by any standard a distinctive name (Dawn). The first leg of the passing off test is thus satisfied.
20. In circumstances where an applicant has adopted a mark which is identical to the sign used by an opponent and intends to trade in identical goods it is reasonable to infer that misrepresentation and damage will occur. That appears to be the position here. I do not, therefore, need to dwell on these aspects of the passing off test. I should however record that the applicants say their company was established in August 1997

(the trade mark filing date is also August 1997) and produced their first newspaper shortly thereafter. Mr Malick, the opponents' UK staff correspondent, reports as follows in his declaration:

"There has been confusion caused by the publication of Dawn London. In about late August 1997 I was contacted by Mr Chaudahry Mahbub, the vice president of the Pakistan People's Party (UK). I had only been working in the United Kingdom since June 1997 and this was my first contact with Mr Mahbub. Mr Mahbub asked for my facsimile number as he said he wished to send me a press release. As the conversation developed it became clear that he thought I was a representative of Dawn London. I had to explain that I was the United Kingdom correspondent for the Dawn newspaper published from Karachi and that Dawn London was not connected in [any] way to the Dawn published by PHP.

I was also contacted by Mr Anir Qare, a teacher of Urdu then working at Leyton Sixth Form College, Leyton who asked whether the Dawn published by PHP had started publishing a paper locally, by which he meant in London. Similarly queries were made [by] some friends of my brother Qaiser Mansoor Malick who asked whether I was working on bringing out a PHP Dawn publication from Ilford. The confusion further increased because Dawn London was being published from Ilford which is where my office and residence is also located."

21. Neither Mr Mahbub nor Mr Qare have given evidence themselves or been cross-examined. However I do not find it at all surprising that such problems have arisen. They merely serve to confirm what I would have expected to be the case that misrepresentation and damage are likely to occur. The opposition, therefore, succeeds under Section 5(4)(a).
22. Of the remaining two grounds Section 3(4) is unexplained and offers no obvious basis for success. The opponents' case under Section 3(6) is put as follows:

"The mark applied for should not be registered in accordance with Section 3(6) of the Trade Marks Act 1994 in that, and to the extent that the said application was made in bad faith. In particular, but without prejudice to the generality of this plea, the Opponent will rely upon the notoriety, fame and repute of the Opponent and its said mark DAWN as aforesaid, and particularly upon the fact that a director of the Applicant Mr Ahasan Ali Malik is a Pakistani national, and that another director and the secretary of the Applicant, Mr Abyuz Ahmed is also a Pakistani national. The Opponent will contend that in their capacity as Pakistani nationals, in particular, it is inconceivable that the said gentlemen, who control and direct the actions of the Applicant were unaware of the Opponent and its said name or mark DAWN prior to and/or at least at the date of the Application in suit."

23. To the extent that the case is based on the reputation of the opponents' mark that is a



relative ground objection which I have dealt with above. The second basis on which bad faith is said to arise is that two of the Directors of the applicants are Pakistani nationals and could not have failed to be aware of the opponents and their publication DAWN. Mr Ahmed, for the applicants, says that a search of the UK register was undertaken prior to filing the application. He also notes that "different newspapers can be published in different countries under the same name." He cites by way of example a daily newspaper in Pakistan under the name The Nation and a weekly publication in the UK under the name The Nation from a different company. That does not entirely deal with the opponents' point about the applicants' state of knowledge regarding the DAWN publication or what steps they took (beyond a trade mark register search) to satisfy themselves that they were entitled to apply for the mark in this country. Furthermore the opponents' evidence also includes (at HH7) copies of several editions of the applicants' newspaper purchased by their (the opponents) UK solicitors. The newspapers carry dates in March and April 1998. It is said, inter alia, that a photograph which appears in the top right-hand corner of the front page of each edition is that of Mohammed Ali Jinnah, the founder of the Pakistan Herald publication. Photographs in the 50<sup>th</sup> anniversary edition of the opponents' newspaper (at HH1) appear to give some credence to this claim. The applicants have not specifically commented on the matter. In the absence of cross examination the point remains unexplained and the facts not clearly established. In summary, whilst I have some misgivings about the applicants' position I do not think there is a sufficient basis for me to reach a finding against them under Section 3(6).

24. As the opposition has been successful the opponents are entitled to a contribution towards their costs. I order the applicants to pay the opponents the sum of £635. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 05 day of April 2001**

**M REYNOLDS**  
**For the Registrar**  
**the Comptroller-General**