



Intellectual Property Rights (IPR) Course & Tool Kit for Business Incubators

Day 2

Session 1, Part 1: Discussion on Homework for IPR Course

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Day 1

Session 2: Distribution of IPR Homework

Activity 1: Case Study

Dispute on Trademark 'WONDER WORLD' in the case of

Destination Mall (Private) Ltd v Monster Adventure (Private) Limited (2014)

Facts of the case:

1. In 2012, Destination Mall, based in Lahore, applied for the registration of the mark 'WONDER WOLRD' as their trademark.
2. No work was started under this trade name and Destination Mall did not use the trade mark.
3. In 2013, Monster Adventure got the trade mark 'WONDER WOLRD' registered in the U.K. in respect of entertainment for children (play area).
4. Monster Adventure started using the trademark on its website, social media sites and started publicizing its business under the mark WONDER WORLD (logo) in the UK.
5. Monster Adventure also took land on lease and started setting up a similar play area site in Lahore in 2013.
6. Then in 2014, Monster Adventure's 'WONDER WOLD' launched its play site in Gulberg, Lahore.
7. Monster Adventure first applied for trademark registration for WONDER WORLD (logo) in Pakistan in 2013.
8. Meanwhile, Destination Mall filed a trademark infringement suit against Monster Adventure, on the basis of its earlier trademark application for the mark 'WONDER WORLD'.



Legal points to note:

- “Applied for registration of the mark” means that the application for registration of the trademark is still pending in front of the registrar and registration has not yet been granted.
- “Use of trademark” means that the applicant has been using the trademark for business i.e. the business owner has sold his goods or services or advertised them under the applied mark.
- “Registered trademark” means a mark that has been registered by the trademarks registry and a certificate of registration has been issued.

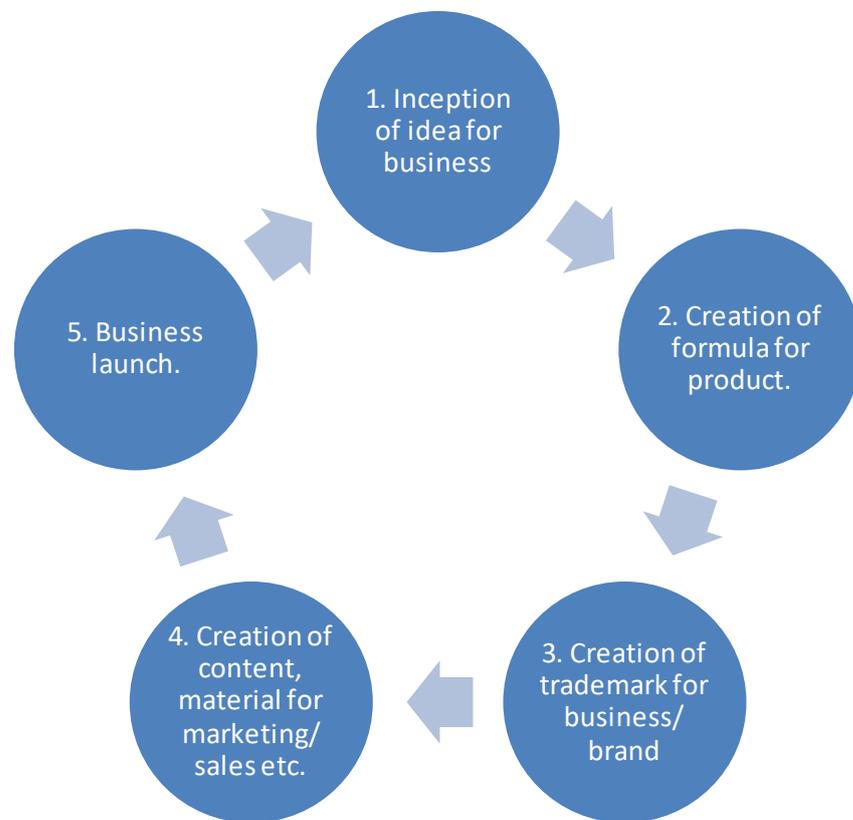
Activity 1: Questions for homework:

1. When should Monster Adventure (Private) Limited have filed an application before the Registrar of Trademark, in Pakistan?
 - (a) At the time of inception of the idea of ‘WONDER WORLD’ play place.
 - (b) At the time of registering of business.
 - (c) At the time of advertising the business.
 - (d) Prior to the date of application of Destination Mall.
2. Can Destination Mall establish goodwill and reputation, when there is no business being conducted by Destination Mall under the trademark WONDER WORLD?
3. What do you think Destination Mall could have done differently to secure its rights in the trademark ‘WONDER WORLD’?
4. What do you think Monster Adventure could have done differently, to secure its rights in the trademark ‘WONDER WORLD’?
5. Who in your opinion, is the owner of the trademark WONDER WORLD?

Activity 2:

Homework Reflection Activity: Map out your value chain

Map out your value chain for your startup, including where you may need to protect different aspects of your intellectual property and where you may need to grant licenses to suppliers and partners.





Day 2

Session 1, Part 1: Discussion on Homework for IPR Course

Activity 1 Review: Questions with responses for discussion on Day 2

1. In light of the facts of the case, when should Monster Adventure have filed an application before the Registrar of Trademarks in Pakistan?
 - (a) At the time of inception of the idea of “WONDER WORLD” play place.
 - (b) At the time of registering of business/trade.
 - (c) At the time of advertising the business.
 - (d) Prior to the date of application of Destination Mall.

1. Ans. The correct answers are (a), (d).

2. Can Destination Mall establish goodwill and reputation, when there is no business being conducted by Destination Mall under the trademark “WONDER WORLD”?

Ans. No, the court ruled that since Destination Mall could not establish using the trademark, it could not establish that any goodwill had been created under it.

3. What do you think Destination Mall could have done differently, to secure its rights in the trademark “WONDER WORLD”?

Ans. Destination Mall could have had a better chance securing its IP rights under the trademark “WONDER WORLD” if it had also used the trademark to promote its business and consequently goodwill.

4. What do you think Monster Adventure could have done differently, to secure its rights in the trademark “WONDER WORLD”?

Ans. Monster Adventure could have searched the trademarks register to check if there was any pending similar, identical or registered trademark, with the trademarks registry. It is advisable to get this checked by a professional lawyer, to avoid possible cases of dispute in the future, in case any similar application of trademark is overlooked, which is what happened in the case of Party B.

5. Who in your opinion, is the owner of the trademark “WONDER WORLD”?

Ans. According to the court order, Destination Mall could not get a stay against Monster Adventure. Monster Adventure was allowed to continue to use the trademark because they were using it and investing in it, unlike Destination Mall. The court neither declared Destination Mall nor Monster Adventure, as the owner of the mark, until further arguments could be presented in court. Meanwhile, Destination Mall did not pursue the case any further, to date and also did not challenge the order in appeal. Therefore Monster Adventure continues to use the trademark “Wonder World.”



Notes to share with class on Day 2:

- **Order from Civil Court in the case of Destination Mall Private Ltd v Monster Adventure Private Limited (2014):**

Stay was dismissed, and Monster Adventure is still using the “WONDER WORLD” trademark.

Activity 2 Review:

Homework Reflection Activity

Participants may be shown a basic flow chart with suggestions on when they should apply for the registration of their trademark, copyright and patents.

Disclaimer: Participants of this course must be informed that the U.S. Embassy in Pakistan bears no responsibility for business decisions based on this reflection exercise. This diagram shows a basic value chain only and businesses with specific queries should contact expert attorneys or IPR agents for a detailed assessment of when and where its respective intellectual properties should be applied for registration.

More information about experts working in IPR is provided in the Course Overview of this IPR Tool Kit.

