



Trade Mark System in Pakistan

Aaisha Makhdum
(Executive Director)

**Intellectual Property Organization of
Pakistan**

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Scheme of Presentation

- Intellectual Property Management in Pakistan
- Trade Mark Legislation
- Trade Marks Registry and its offices
- Main features in Legislation
- Collective marks
- Certification marks
- Trademark Filing Statistics
- Importance of Trade ,Mark Registration

Intellectual Property Management in Pakistan

Established 8th April, 2005

- Works under administrative control of Ministry of Commerce
- Policy Board comprising of 15 members including 5 members from private sector

Intellectual Property Rights Legislations

- Intellectual Property Organisation of Pakistan Act, 2012
- Patent Ordinance 2000
- Trade marks Ordinance 2001
- Copyright Ordinance 1962 (amended in 2000)
- Registered Designs Ordinance, 2000
- Registered Layout-Designs of Integrated Circuits Ordinance, 2000

Trade Mark Legislation

Prior to WTO Legislation

- Trade Marks Act, 1940
- Trade Marks Rules, 1963

WTO Agreement on Trade related Aspects of Intellectual property rights (TRIPS)

- Trade Marks Ordinance, 2001
- Trade Marks Rules, 2004

Term of Protection

Trade Marks Act, 1940

- For Seven years from the filing date
Renewal for Fifteen years

Trade Marks Ordinance, 2001

- For Ten years from the filing date ,Renewal for Ten years

Trade Marks Registry

- Established in 1948 at Karachi
- Branch Office at Lahore in 1974
- Trademark application receiving desk at IPO Office in Islamabad since 2010

Positions:

- Registrar 1
- Deputy Registrars 2
- Assistant Registrars 4
- Examiners 16
- Support Staff 78

The Main Functions of Trade Mark Registry

- Search before filing of Application (Rule 87).
- Filing of Application (Under section 22) .
- Examination (Under Section 27).
- Publication (Under Section 28).
- Printing in Trademarks Journal
- Opposition Procedure (Under Section 29).
- Issuance of Registration Certificate (Under Section 33).
- Duration and Renewal of the Registration (Under Section 35).
- Post Registration Matters

ELIGIBILITY

- Any person claiming to be the proprietor of a trademark used or proposed to be used by him.
- Jointly owned trademarks to be registered in the name of joint proprietors.
- In the name of a company.

Salient Features of Trade Marks Ordinance 2001

Definition :

“Mark” includes, in particular, a device, brand, heading, label, ticket, name including personal name, signature, word, letter, numeral, shape of goods or their packaging, figurative element, color, sound, scent or any combination thereof

Salient Features (Contd)

“Trade Mark” means any mark capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

Salient Features (Contd)

Classification of goods and services-

- A Trade Mark may be registered in respect of-
 - goods;
 - services; or
 - both goods and services,
- Comprised in the prescribed classification of goods or services in accordance with the international classification of goods and services.
- Any question arising as to the class within which any goods or services fall shall be determined by the Registrar

Salient Features (Contd)

Absolute grounds for refusal of registration

- Devoid of any distinctive character
- Designate the kind, quality, quantity, intended purpose, value.
- Shape –nature, technical result, substantial value
- Scandalous , deceptive ,
- Exceptions- Well known marks , distinctiveness by use

Use of names of chemical compounds barred

Salient Features (Contd)

Relative grounds for refusal

- Identical or similar to earlier mark
- Likelihood of confusion, unfair advantage , law of passing off , law of copyrights, law of designs.
- Consent of owner of earlier mark
- May refuse to register any of them until their rights have been determined by the Court of law.

Salient Features (Contd)

Application for registration

- Request
- Statement of goods and services
- Classification
- Agent
- Being used in Pakistan or to or to be used
- Fee
- Date of filing

Temporary protection during exhibition-6 months

Salient Features (Contd)

Examination:

- as to the prescribed requirements .
- a search of earlier trade marks
- Opportunity to make representation or to amend the application.
- Acceptance and publication
- Notice of opposition, counterstatements

Salient Features (Contd)

Grounds of opposition

- Same on which registration may be rejected except the ground that the trade mark cannot be represented graphically.
- **applicant does not** intend to use or assign or he is not t the owner
- the application, or a document filed in support of the application, was amended contrary to the provisions of the Law
- false evidence
- substantially identical with, or deceptively similar to, a well known mark, or a trade mark
- Geographical indication: Indication of Origin
- the pre-acceptance advertisement of the application under exceptional circumstances was without sufficient cause or reason

Salient Features (Contd)

- Divisional Application
- Duration of Trade Mark 10 years from date of filing
- Renewal 10 years
For renewal –Registrar may require evidence of use

Salient Features (Contd)

Effect of Registration

- Trade mark is like any other personal property.
- exclusive rights in the trade mark which are infringed by use without consent of the owner.
- right to obtain relief
- The rights of the proprietor shall have effect from the date of actual registration:
- No infringement proceedings before the date on which the trade mark is in fact registered

Salient Features (Contd)

Infringement of Registered Trade Mark.-

- likelihood of confusion.
- trade name or part of trade name.
- domain name or part of his domain name
- Alleged Infringer- a person who sells or offers or exposes goods for sale, or puts them on the market or has in possession for sale or any purpose of trade or manufacture any goods bearing a mark which infringes a registered trade mark shall be treated as a party to infringement of a registered trade mark

Infringement proceedings

District Court

- Infringement actionable by the proprietor of the trade mark.
- Damages, injunctions, accounts or otherwise available in respect of the infringement of any other property right.
- Passing off goods
- Delivery up of infringing goods
- Importation of infringing goods

Salient Features (Contd)

- Unfair Competition as defined in Paris Convention
- Grounds of Revocation
- Grounds for invalidity of registration
- Special provisions for textile goods
- Offenses and penalties

Collective Marks

- (First Schedule) (Defined, S. 82)

“... a mark distinguishing the goods or services of members of the association which is the proprietor of the mark from those of other undertakings.”

Certification Marks

(Second Schedule)(Defined,S.83)

“... a mark indicating that the goods or services in connection with which it is used are certified by the proprietor of the mark in respect of origin, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics.”

Trade Mark Statistics

Application received and registrations granted during last 10 years

Activities	2006-07	2007-08	2008-09	2009-10	2010-11	2011-12	2012-13	2013-14	2014-15	2015-16
Application received	14309	14595	14789	16603	18769	18582	22828	22828	27382	37857
Registration Granted	6513	8858	5432	7424	6760	6554	12336	12336	9675	11811

Pakistan's membership of International Treaties relating to Trade Marks

- Paris Convention on Protection of Industrial Property
- The World Trade Organization Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS)
- Madrid Agreement or Protocol under consideration

Importance of Registering a Trade Mark

- Positioning and identifying companies
- Identifying the niche in the market for a new entrant:
- Focus for all stakeholders in the company, including employees and suppliers;
- Improving the management of the company
- Source of collateral for borrowing funds
- Potential source of revenues through licensing and franchising
- Providing residual incomes on sale at cessation of trading.
- Branded goods perceived better
- Menace of counterfeiting



Website: www.ipo.gov.pk
E-mail: info@ipo.gov.pk

THANK YOU