

IPR Toolkit - Pakistan

Patents

Introduction to Patents

A patent is a grant of exclusive rights by a government to an inventor, for a limited period of time, which allows the inventor to exclude others from making, using, selling, offering for sale or importing his or her invention in exchange for a disclosure of the invention to the public. The use of patents dates back to at least the 15th century and the term ‘patent’ has been in existence since at least the year 1700. The first patent law in Pakistan was the Patent and Design Act of 1911. This Act was replaced by the Patents Ordinance of 2000, which has been amended by Patents (Amendment) Ordinance in 2002. This Ordinance was further amended in 2007 and again in 2010. The patent law in Pakistan is presently governed by the Patents (Amendment) Act, 2010 (hereinafter called the “Act”) along with the Patent Rules, 2003.

Patent rights are territorial in nature and a patent obtained in Pakistan is not enforceable in another country. Similarly, foreign (including U.S.) patents are not enforceable in Pakistan. Pakistan has not yet acceded to the Patent Cooperation Treaty (PCT) and therefore PCT filings will not help Applicants obtain protection in Pakistan.

Market Entry Planning

It is imperative that an inventor file patent applications in Pakistan as early as possible. This is irrespective of whether he or she plans to commence use of the invention in Pakistan in the near future. As Pakistan grants patents on a ‘first to file’ basis, it is extremely important that the inventor be the first to apply for the grant of the patent. Furthermore, in order to protect proprietary rights to the invention, the inventor may consider using a non-disclosure agreement with any recipient party before he or she discloses any particulars regarding the invention. This will ensure that the recipient party is bound by its contractual obligation to maintain confidentiality about any aspect of the invention that is disclosed to them. Moreover, other framework agreements between the parties establishing the relation between them and defining each party’s rights and obligations should also be signed at the earliest possible moment.

Who can apply

- Any person claiming to be the true and first inventor of the invention;
- Any person being the assignee of a person claiming to be the true and first inventor;
- The legal representative of any deceased person who immediately before his/her death was entitled to make such an application.

What can be patented

Any invention that has the following three essential ingredients can be patented:

- (i) **The invention must be novel:** The inventor must have invented a product/process that is new and such an invention must not have ever been used before.
- (ii) **Must involve an inventive step:** This would mean that advancement has been made in the technology of the invention from existing technology that is obvious to a person of ordinary skill in that particular field.
- (iii) **The invention must be capable of industrial application:** The invention must be industrially applicable. It should possess utility before it is recognized as useful and can be granted a patent.

What is non-patentable under the Pakistani patent system

Many types of technological inventions can be patented. Any new product that has been created or any new process for developing a product may be patented. Though the range of things that can be patented is very wide, there are certain things which are not patentable in Pakistan. They are:

- (i) Things, which are discovered (i.e. which exist in nature). Only things that have been invented are patentable. For example, human genes may not be patented even in isolated form. Another example could be the discovery of a new star. This star has been discovered and not invented, so it cannot be patented;
- (ii) Mathematical methods and scientific theories, for example, Newton's Law of Motion or the Archimedes Principle cannot be patented;
- (iii) A literary, dramatic, musical or artistic work or any other aesthetic creation;
- (iv) Schemes, rules and methods for performing a mental act, playing a game, running a business, etc.;
- (v) Presentation of information;
- (vi) Substances that exist in nature or if they are isolated there from;
- (vii) Any invention that is contrary to public order or morality;
- (viii) Any invention that causes serious prejudice to human, animal or plant life or health or to the environment;

- (ix) Plants and animals other than micro-organisms, and biological processes for the production of plants or animals other than non-biological and microbiological processes;
- (x) Diagnostic, therapeutic and surgical methods for the treatment of human beings or animals;
- (xi) Mere discovery of any new property or new use for a known product or process;
- (xii) A mere change in physical appearance of a chemical product where the chemical formula or process of manufacture remains the same unless the invention meets the criteria for patentability;
- (xiii) Any invention that comprises traditionally developed or existing knowledge available or in possession of a local or indigenous community;
- (xiv) A substance obtained by a mere combination resulting only in the aggregation of the properties of the components thereof or a process for producing such substance.

Rights of a patentee in Pakistan

The holder of a valid patent in Pakistan has the right to:

- Prevent third parties from making, using, offering for sale, selling, or importing the patented product, or to prevent third parties from the act of using the process, and from the acts of using, offering for sale, selling, or importing a product obtained directly by the patented process;
- Assign, or transfer the patent and to conclude licensing contracts;
- Institute court proceedings against any person who infringes the patent or who performs acts which make it likely that infringement will occur.

Procedure for grant of patent

The patent system in Pakistan is on a 'first-to-file' basis. Currently, the grant of a patent in Pakistan normally takes eighteen to twenty-four months. The patent application can be filed at the Intellectual Property Office in Karachi or Lahore. The different steps that are involved in the process for grant of a patent in Pakistan are as follows:

- Select a patent agent in Pakistan:

As the area of patents is highly specialized, you should consult a local IP law firm or a patent agent before proceeding with filing.

- Preparation of the paperwork and filing of application

Every application for the patent must be made in the prescribed form and must be filed at the IP Office in the prescribed manner. The forms for the filing of a patent in Pakistan are available at <http://www.ipo.gov.pk/Patent/PatentFees.aspx>. The application has to be accompanied by a declaration to the effect that the Applicant is in possession of the invention which he claims to have invented. A patent application should be accompanied by the provisional or complete specification and drawings (if any). Each complete specification should include:

- Description of the invention and its operation or use and the method by which the invention is to be performed.
- The best method of performing the invention, which is known to the applicant and for which he is entitled to claim protection.
- Claims defining the scope of invention for which protection is claimed.
- Abstract to provide technical information on the invention.

A patent application can be filed at the Intellectual Property Office in Karachi or Lahore.

- Publication and Examination of Patent Applications

If the application at the time of filing is accompanied by a provisional specification¹ and not the complete specification then the complete specification must be filed within twelve months from the initial filing date. If the complete specification is not filed within this period, the application is deemed to have been abandoned.

All applications accompanied by a complete specification, are referred by the Controller to the examiner and the examiner makes a report to the Controller. If the Applicant does not comply with the requirements of the Act, the Controller will give the Applicant an opportunity to be heard and an opportunity to comply with the requirements of the Act. After the application and the complete specification are accepted the application is published in the Official Gazette and is thereafter open to public inspection.

Any time after the publication of the specification, any person may make observations in writing to the Controller on the novelty of the invention giving evidence in support of his observations and the Controller shall consider the observations before the grant of patent. The person who makes such observations does not become a party to the proceedings before the Controller.

- Grant of a patent

Where the complete specification of the application has been accepted and no opposition has been filed against it, or if an opposition has been filed and is decided in favor of the

¹The specification is a written description of the invention and of the manner and process of making and using the same.

Applicant, the Applicant makes a request in the prescribed form that the patent be granted to him. The Controller then seals the patent with the seal of the Patent Office and enters the patent in the Register of the Patents. Each patent is dated as of the date of filing of the application and in case of a Paris Convention application the date of grant is the date of the earliest application.

▪ Pre-grant and Post-grant opposition

If an application for a patent has been published but a patent has not been granted, any person may, in writing and within four months of the publication of the application in the Official Gazette, oppose the application by making a representation to the Controller. The opposition can be made on the following grounds:

- The Applicant for the patent obtained the invention or any part thereof from the opposing party or from the person for whom the opponent is the legal representative, assignee, agent or attorney;
- That the invention is not a patentable invention within the meaning of the Act;
- That the specification does not disclose the invention in a manner clear and complete enough for it to be carried out by a person skilled in the art;
- That the claims are not clear or extend beyond the scope of the disclosures in the complete specification as originally filed; or
- That the complete specification describes or claims an invention other than that described in the provisional specification and that other invention is the subject of a earlier patent application made by the opponent, or the invention was previously made available to the public by publication in any document

The Controller shall, if requested by the person who is opposing the patent application, schedule a hearing in the matter. If the opposition is decided in favor of the Applicant the patent will be granted and the patent published in the Office Gazette.

Any interested person can also file a notice of opposition within one year after the grant of the patent requesting the Controller revoke the patent. The Controller after hearing the patentee and the opponent may decide to maintain, revoke or amend the patent.

▪ Term of a Patent

The term of a patent is twenty years from the date of the application. To keep the patent valid for the twenty-year term a renewal fee must be paid every year. If the renewal fee is not paid within the prescribed time, the patent will cease to have effect.

▪ Revocation of Patent

At any time during the life of the patent, the High Court, the Controller or the Federal Government may revoke a patent.

A patent can be revoked by the High Court based upon a successful petition by any of the following persons:

- Any interested person, or
- Federal Government, or
- On a counter claim by the defendant in a suit of infringement.

This petition can be filed on any of the grounds on which a patent application can be rejected or if the Federal Government states in its petitions that the patentee has failed to comply with its request to make, use or exercise the patented invention for the services of the Government upon reasonable terms.

The Controller can revoke a patent on a petition made by any person interested on any of the grounds on which the application can be opposed as mentioned above.

The patent can be revoked by the Federal Government if:

- A patent or the mode in which it is exercised is mischievous to the State or generally prejudicial to the public; or
- A patent has been obtained through concealment or misrepresentation in the application; or
- A compulsory license granted to prevent the abuse which might result from the exercise of the exclusive rights conferred by the patent has not been sufficient. Prior to revocation, the patentee is given an opportunity to be heard. Should the Federal Government make a decision that is unfavorable to the patentee, it will publish a declaration to this effect in the Official Gazette and the patent is deemed to have been revoked. This proceeding shall not begin before the expiration of two years from the grant of first compulsory license.

▪ Compulsory Licenses

The Federal Government can, without the consent of the patentee, issue a compulsory license² for the patent in the following circumstances:

- The public interest, in particular, national security, nutrition, health or the development of other vital sectors of the national economy so requires; or
- The Federal Government has determined that the manner of exploitation, by the owner of the patent or his licensee, is anti-competitive;
- The patent holder refuses to grant a license to a third party on reasonable commercial terms and conditions; or
- Where the patent has not been exploited in a manner, which contributes to the promotion of technological innovation and to the transfer and dissemination of technology.

Before making any decision, the Federal Government may give the patentee and the interested person a chance to be heard. The Federal Government after granting a compulsory license to the third party may at the request of the owner of the patent,

² Compulsory licensing is when a government allows someone else to produce the patented product or process without the consent of the patent owner.

terminate the license if it is satisfied that the circumstances which led to the decision have ceased to exist and are unlikely to recur, or that the person to whom the compulsory license was granted failed to comply with the terms of the decision. An appeal against the decision of the Federal Government can be made to the High Court.

The Controller also has the power to issue a compulsory license to prevent abuses which might result from the exercise of the rights conferred by the grant of the patent, if a request is made in the prescribed manner after four years from the date of filing or three years from the date of the grant, whichever period expires last. A compulsory license cannot be issued if the owner of the patent satisfies the Controller that circumstances exist which justifies the non-exploitation or insufficient exploitation of the patented invention in Pakistan. The Controller while issuing a compulsory license must fix the scope and function of the license, the time limit within which the licensee must begin to use the patented invention and the adequate amount of remuneration to be paid to the owner of the patent (up to three percent of the total sales, taking into consideration its trade price) and the conditions of payment.

Infringement and Enforcement Remedies

In case of an infringement, a right holder has the option of initiating a civil action against the infringer. The right holder may initiate a suit for infringement against any person who during the validity of the patent, makes, sells or uses the invention without his license, or counterfeits it, or imitates it. The suit may be filed in a District Court having jurisdiction to hear the case. However, in instances where a counter-claim for revocation of the patent is made by the infringer, the suit along with the counter-claim, is transferred to the High Court for decision. In any suit for infringement the Court can grant relief by way of damages, injunctions, or an accounting.

In the case of *Glaxo Group Limited and others v. Evron (Private) Limited and another* {1992 CLC 2382 (Karachi)}, the Division Bench of Karachi High Court accepted the appeal filed by Glaxo and granted an interim injunction against Evron in a case where Evron was importing a drug by the name of 'Malfax' containing rantidine from Canada during the validity of Galxo's process patent for preparing rantidine in Pakistan. The Court held that "If a person, in making a product overseas uses processes which would be infringing processes here, those processes being a principal part of the manufacture and then imports the article into this country, he is guilty of an infringement. The reason is because, by using those processes overseas and bringing the product here to sell, he deprives the Pakistani Patentee of the benefit of the invention."

In another case of *Smith Kline Beecham Corporation and others v. Pharma Evo (Pvt.) Ltd.* {2006 CLD 716 (Karachi)}, the Karachi High Court granted an interim injunction to Smith Kline Beecham and restrained Pharma Evo from manufacturing, importing or offering for sale the pharmaceutical 'Rosiglitazone' since Smith Kline Beecham had a valid process patent for the manufacture of the drug. This interim injunction was granted despite the fact that Pharma Evo had registered their product with the Director-General Health, Government of Pakistan.

Administrative Provisions: Besides the civil remedies mentioned herein above, there are also certain provisions under the Customs Act, 1959 which prohibit the import or export of goods which infringe the patent of a right holder. Goods stopped for the violation of these provisions may be liable for detention, seizure or confiscation by Customs authorities and penalties are described under Customs Act, 1969.

Expected Developments: It is expected that a system of electronic filing of patent applications will commence shortly in Pakistan. The IP Office is in the process of preparing the launch of this system. Moreover, the government of Pakistan is also contemplating acceding to the Patent Cooperation Treaty though no final decision has been taken.

Patent Legislation in Pakistan

Patents (Amendment) Act, 2010
The Patent Rules, 2003

International Patent Treaties to which Pakistan is a signatory

Paris Convention for the Protection of Industrial Property
Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS)

Patents Related Websites

<http://www.ipa.gov.pk>

<http://www.uspto.gov>

<http://www.wipo.int/patentscope/en/>

FAQs

1. Do I have to file the complete specification of the invention at the time of filing of the patent application?

No. You can file the patent application with a provisional specification. However the complete specification has to be filed within twelve months of the filing of the patent application or else it will be deemed abandoned.

2. How do I file a patent application in Pakistan?
The procedure for grant of a patent is described under the section 'Procedure for Grant of a Patent.'

3. What is the filing fee?

The official filing fee for filing one patent application accompanied by provisional/complete specification in 2010 is PKR 2250 (approximately \$37) The details of the official filing fees for various kinds of applications can be found at <http://www.ipo.gov.pk/Patent/PatentFees.aspx>. The attorney or agent fees for filing the application will depend on the patent attorney or agent selected.

4. What are the different types of patent applications under the Pakistani patent system?

The following are the different types of patent applications under the current patent system:

(i) Ordinary Application

(ii) Application for Patent of Addition (granted for Improvement or Modification of an already patented invention, for an unexpired term of the main patent).

(iii) Divisional Application (in case of plurality of inventions disclosed in the main application).

(iv) Convention application, claiming priority date on the basis of prior filing in a Convention Country.

5. What is the duration of patent protection in Pakistan?

A patent is valid for twenty years from the date of filing of the patent application in Pakistan.

6. Can rectification proceedings to amend or alter an entry existing in the Register of Patents be initiated for a patent?

Rectification proceedings can be initiated against a patent by an aggrieved person before the High Court on any of the following grounds:

- by the absence or omission from the register of any entry;
- by any entry made in the register of patents without sufficient cause;
- by any entry wrongly remaining on the register; or
- by any error or defect in any entry in the register.

The High Court has discretion to pass orders for variation or deletion of any entry.