

IPR Toolkit - Pakistan

Trademarks and Geographical Indications

Introduction to Trademarks and Geographical Indications

A trademark is “any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings.”

¹ Its origins date back to ancient times, when craftsmen reproduced their signatures, or "marks" on their artistic or utilitarian products.

The first trademark law in Pakistan was passed in 1940 and was known as the Trade Marks Act, 1940. Thereafter in order to comply with its international obligations, the Government of Pakistan decided to amend and consolidate the law relating to trademarks and unfair competition to provide for registration, better protection of trademarks, and the prevention of infringement. Therefore, the President of Pakistan passed the Trade Marks Ordinance, 2001. Trademark law in Pakistan is presently governed by the Trade Marks Ordinance, 2001 and the Trade Marks Rules, 2004.

The trademark law in Pakistan requires no evidence of prior use of the mark in commerce for filing. A trademark application can be filed on a ‘proposed to be used’ or ‘intent-to-use’ basis or based on use of the mark in commerce.

The Trade Marks Registry, which is under the administrative control of Intellectual Property Organization of Pakistan, is the office that is in charge of registering trademarks in Pakistan. A trademark registration in Pakistan gives exclusive proprietary rights to the rights holder for protection of their trademark in Pakistan. However because the Pakistani legal system is a common law system, even an unregistered trademark is entitled to protection and the rights holder of the unregistered trademark can initiate action against a third party under the ‘law of passing off’.

Pakistani trademark law protects both domestic and foreign trademarks. Over the past several years, many foreign entities have been able to protect their trademarks in Pakistan. For example, in the case of *Mars Incorporated v. Pakistan Mineral Water Bottling Plant (Pvt.) Ltd.* {2001 M L D 39} the High Court of Karachi granted an interim injunction restraining the Defendant from using the internationally well-known mark MARS on soft drinks. This injunction was granted despite the fact that Pakistan Mineral Water Bottling Plant (Pvt.) Ltd. had registered the trademark MARS with the Trade Marks Registry.

The trademark law in Pakistan also protects geographical indications. Geographical indications are “indications, which identify a good as originating . . . in a region or locality . . . , where a given quality, reputation or other characteristic of the good is

¹ See TRIPS article 15

essentially attributable to its geographical origin.”² Most commonly, a geographical indication consists of the name of the place of origin of the goods. Agricultural products often have qualities that derive from their place of production and are influenced by specific local factors, such as climate and soil.

Market Entry Planning

Though Pakistan has passed laws protecting the intellectual property rights (IPR) of rights holders, its enforcement and implementation of these laws remains a matter of grave concern for rights holders. It is therefore imperative that businesses develop a comprehensive strategy for protecting their IPR and take steps to safeguard their rights before they enter the Pakistani market.

Registration of trademarks is an important step that businesses should pursue in Pakistan. Many foreign and domestic rights holders have been able to successfully register their marks in Pakistan.

In addition to the registering of their trademarks in Pakistan, businesses should also consider adopting other strategies for protecting their trademarks. Some possible strategies are outlined below:

- Hire a local law firm specializing in IPR.
- Conduct clearance searches in the Pakistani Trade Marks Registry to determine if a potentially conflicting trademark application is pending or has been registered.
- Get common law searches (this includes the internet, market surveys, yellow pages, directories, etc.) to ascertain whether third parties are using your trademarks and if so, how much.
- Based on the results of the registration clearance search and the common law search, and after seeking your local counsel’s opinion, decide if your trademark is available for use. If the trademark is available for use, immediately apply for registration. You should also consider hiring a watching service to monitor the Trademarks Journal in order to alert you to any published deceptively similar trademarks³ that might be of concern to you.
- If you own a trademark that has been used and has acquired goodwill and reputation, it is advisable that along with filing of the trademark application in Pakistan, you also make press releases, publish cautionary notices and advertise the mark to ensure that the relevant section of the public is aware that you are entering the Pakistani market and are protecting your trademark from any kind of third party IPR violation.

² See Article 22 of TRIPS Agreement

³ Pakistan’s trademark law defines deceptively similar trademark as ,”in relation to trade mark means such near resemblance between it and another trade mark that it is likely to deceive or cause confusion”

- You should also take immediate steps to register your domain names (top level domain names including country code top level domain names) in Pakistan, in order to protect them from any kind of third party violation.
- If you discover that your trademark is being infringed, you should take immediate steps to protect it, either by filing oppositions to registration, filing cancellations, conducting investigations, sending cease and desist notices, or initiating appropriate civil and criminal actions.

Who can apply and what can be registered

Under the Trade Marks Ordinance, 2001, a person who is the proprietor of the trademark can apply for the registration of their marks for goods as well as services. Any word, signature, name, logo, label, numerals or combination of colors used by one enterprise on goods or services can be registered as a trademark in Pakistan. Under the Pakistani trademark law the following are the types of trademarks that can be registered:

- Product mark: a mark that is affixed to identify goods.
- Service mark: a mark used to identify the services of an entity, such as the trademark for a broadcasting service, retail outlet, etc. They are used in advertising the services.
- Certification mark: 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.
- Collective mark: a mark distinguishing the goods or services of members of the association which is the proprietor of the mark from those of other undertakings.
- Geographical indications can also be protected in Pakistan as certification or collective trademarks.

Any person claiming to be the proprietor of a trademark may apply in writing for registration.

What cannot be registered

The following are the types of marks that cannot be registered in Pakistan:

- Which are not capable of being represented graphically and are unable to distinguish goods or services of one undertaking from those of other undertakings;

- Which are devoid of any distinctive character;
- Which consist exclusively of marks or indications which designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services;
- Which consist exclusively of marks or indications which have become customary in the language or in the established practices of the trade;
- Which consist exclusively of the shape which results from the nature of the goods themselves, the shape of goods which is necessary to obtain a technical result or the shape which gives substantial value to the goods;
- Which consists of, or contains, any scandalous design, or any matter the use of which would be disentitled to protection in the High Courts or District Courts by reasons of it being likely to deceive or to cause confusion, is likely to hurt the religious sensibilities of any class of citizens of Pakistan, or is contrary to any prevailing law or morality;
- The application for registration of which has been made in bad faith;
- A word that is a commonly used and accepted name of any single chemical element or any single chemical compound in respect of a chemical substance or preparation or which is declared by the World Health Organization and notified in the prescribed manner by the Registrar from time to time, as an international non-proprietary name or which is deceptively similar to such name;
- A generic term;
- The national flag or any other State Emblem of a country which is a signatory to the Paris Convention (hereinafter known as ‘Convention country’) shall not be registered without the authorization of the competent authorities of that country, unless it appears to the Registrar that use of the flag in the manner proposed is permitted without such authorization;
- Which consists of or contains the armorial bearings or any other State emblem of a Convention country;
- Which consists of, or contains, official mark or hallmark adopted by a Convention country shall not be registered in relation to goods or services of the same or a similar kind as those in relation to which it indicates control and warranty;
- Which consists of or contains such emblem, abbreviations or name of an international organization which is protected under the Paris Convention.

Registration Procedure

In case of an identical trademark being filed by two different applicants where the date of use in commerce is identical or if applications for the registration of both marks have been filed on an 'intent-to-use' basis, the Applicant who files the trademark application first with the Pakistan Trade Marks Registry will have priority. It is therefore important to apply for registration of your mark as soon as possible. The registration of a trademark in Pakistan typically takes about two to three years, assuming that the trademark is not opposed by a third party. The Trade Marks Registry is the appropriate office for filing a trademark application in Pakistan. Trademark applications can be filed either at the Karachi office or at the branch office of the Trade Marks Registry in Lahore. The different steps that are involved in the registration process in Pakistan are as follows:

- Select a trademark agent/attorney in Pakistan:

The trademark law in Pakistan allows the proprietor to file a trademark application only if they have a place of business in Pakistan. Should that not be the case, the rights holder will be required to file an application through a trademark agent/attorney. The trademark agent/attorney can do trademark searches and prepare, file, and prosecute applications.

- To determine if the mark is eligible and available for registration:

The trademark agent will determine if the trademark is eligible for registration and also conduct clearance searches to determine if there is any deceptively similar mark that already exists on the Register of Trade Marks. It is advisable to conduct a common law search to ascertain if there are any third parties that might already be using the trademark.

- Completing the application form and filing

The trademark agent can complete and sign the application form, provided that the rights holder has issued a signed power of attorney appointing them as the trademark agent. The details which must be mentioned in the trademark application are the full name and address of the Applicant, a statement of goods or services in relation to which it is sought to register the trademark, the international classification of goods or services, a representation of the trademark and the full name, address and contact details of the agent, in case the application. The application should also mention if the trademark is being used by the Applicant, or with his consent, in relation to goods or services, or if he has a good faith intention that it will be used. Copies of all the forms are available at <http://www.ipo.gov.pk/Trademark/TrademarkForms.aspx>. Pakistan being a signatory to the Paris Convention recognizes foreign priority. An Applicant can claim priority from an application filed in another signatory country provided that

the application in Pakistan is filed within six months of the filing of that application. Filing fees are approximately PKR 1,000 (approximately \$13 USD) per class. The application can be filed in the Trade Marks Registry at either Karachi or Lahore.

- Review by the Trade Marks Registry

After the application has been filed, the Trade Marks Registry reviews it to ensure that it is complete in all respects and thereafter allots an application number to the applications. If the trademark is registered, the application number becomes the registration number.

- Preliminary Approval and Publication, Show Cause Hearing or Rejection of the Application

During the process of examination, the Trade Marks Registry determines if the trademark is barred from registration either under absolute grounds for refusal and/or relative grounds (prior trademark rights) as prescribed in the Trade Marks Ordinance, 2001. The Trade Marks Registry will issue an examination report and the Applicant must respond to any objections that have been raised in the examination report within the prescribed period. Thereafter and based on the response to the examination report that has been filed by the Applicant, the Registrar of Trade Marks determines if the application should be refused, accepted for advertisement, accepted subject to certain limitations or put up for a “show cause” hearing, during which the application might be accepted, rejected, or accepted subject to certain limitations.

- Registration

Within two months of the publication of the trademark in the Trade Marks Journal, should the trademark not be opposed by a third party, it will be accepted. Thereafter a Demand Notice is issued to the Applicant requesting him to pay the requisite registration fee. After the Applicant has paid the relevant registration fee, the registration certificate is issued.

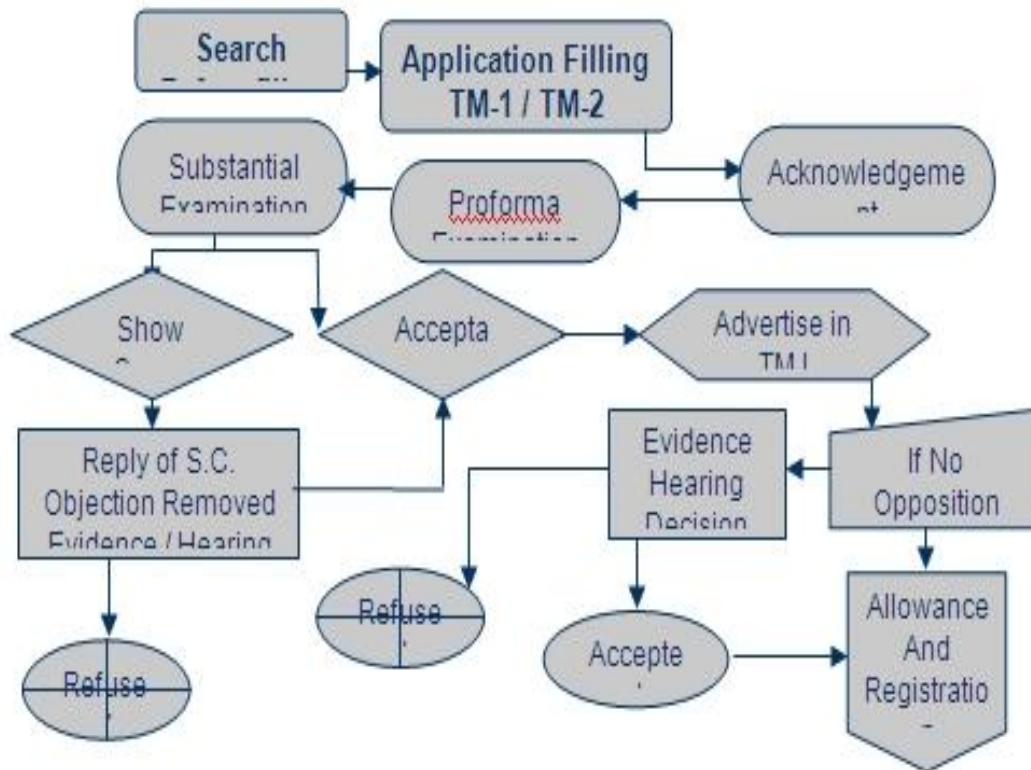
- Term of Trademark Registration

Trademark protection in Pakistan is perpetual, subject to renewal of the registration every 10 years. The application for the renewal of a trademark can be filed 6 months before the expiration of the term of registration.

Should the rights holder of a trademark come across a trademark that is deceptively similar to their mark and which has been published in the Trade Marks Journal they can oppose the challenged mark within two months of the publication of the journal. Any third party who believes the advertised mark should not be registered can initiate an opposition proceeding by filing a Notice of Opposition in the appropriate office of the

Trade Marks Registry. It typically takes about two to three years for the opposition proceedings to conclude.

Below is the chart depicting the complete procedure for registration as is followed by the Trade Marks Registry in Pakistan.⁴



Infringement & Enforcement Remedies

A registered trademark is said to be infringed in the following circumstances:

- If a third party uses a trademark in the course of the trade which is identical with the registered trademark and in relation to goods or services which are identical with those for which it is registered. For example, in *Wrangler Apparel Corporation v. Axfor Garments* {2008 C L D (70)}, Wrangler had filed a suit requesting that Axfor Garments be restrained from using the trademark "Wrangler" and the "W" stitch logo on its clothing including jeans, jackets, shirts and belts. Wrangler had registered its trademarks in Pakistan. The Court passed an order of injunction against the Defendant and restrained them from using Wrangler's trademarks on any of its products.
- If a third party uses, in the course of trade, a mark which is identical with the registered trademark and is used in relation to goods or services similar to the

⁴ Source: www.ipo.gov.pk

goods or services for which the trademark is registered or the mark is deceptively similar to the registered trademark and is used in relation to goods or services identical with or similar to the goods or services for which the trademark is registered or if there exists a likelihood of confusion on the part of public, which includes the likelihood of association with the trademark;

- If a third party uses in the course of trade, a mark which is identical or deceptively similar to, the trademark in relation to goods or services of the same description as that of goods or services in respect of which the trademark is registered, services that are closely related to goods in respect of which trademark is registered or goods that are closely related to services in respect of which the trademark is registered;
- If the third party uses in the course of trade, a mark, which is identical with or deceptively similar to the registered trademark and is used in relation to goods or services which are not similar to those for which the trademark is registered;
- If the use of a trademark without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the registered trademark when the registered trademark is a well-known trademark, or has a reputation in Pakistan;
- If a third party uses such registered trademark as his trade name or part of his trade name;
- If the third party uses the registered trademark as his domain name or part of his domain name or obtains such domain name without consent of the proprietor of the registered trademark and with the intention of selling such domain name to another person including the proprietor of the registered trademark;
- If a third party applies a registered trademark to material intended to be used for labeling or packaging goods when he knows or has reason to believe that the application of the mark was not duly authorized by the proprietor or a licensee;
- If any third party sells or offers or exposes goods for sale, or puts them on the market or has them in possession for sale or any purpose of trade or manufacture any goods which bear a mark which infringes the registered trademark.

Being a signatory to the Paris Convention and the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS), Pakistan recognizes the concept of a well-known mark. A mark which has been designated as a well-known mark is accorded stronger protection because of this status. Under the provisions of the Trade Marks Ordinance, 2001, the factors that go into determining whether a trademark is a well-known mark are as follows:

- The amount of recognition of the trademark in Pakistan or internationally;

- The degree of inherent or acquired distinctiveness of the trademark;
- The duration of the use and advertising of the trademark in Pakistan or internationally;
- The commercial value attributed to the trademark in Pakistan or internationally;
- The geographical scope of the use and advertising of the trademark in Pakistan or worldwide;
- The quality and image that the trademark has acquired in Pakistan or internationally; and
- The exclusivity of use and registration attained by the trademark and the presence or absence of identical or deceptively similar third party trademarks validly registered or used in relation to identical or similar goods and services.

The Trade Marks Ordinance, 2001 provides for both civil and criminal remedies.

Civil Litigation: A suit can be initiated either under the “law of passing off” or infringement under the Trade Marks Ordinance, 2001 depending on whether the trademark is unregistered, pending registration, or registered. The suit can be filed either at the High Court or at the District Court. The complaint filed by the rights holder should demonstrate that the alleged infringing act involves a mark that is identical or similar to a trademark of the rights holder. It should also specify that the representation of the trademark that is being used in connection with goods or services might confuse the public regarding the origin of the infringing goods/services and that this act of the infringer has interfered with the trademark holder's rights of exclusive use or has caused the rights holder economic loss. The rights holder can request the Court to grant an order of injunction, damages and delivery of infringing goods, materials or articles. Moreover, where a person is found to have infringed a registered trademark, the Court may make an order to cause the offending trademark to be erased, removed or obliterated from any infringing goods, materials or articles in his possession, custody or control or to secure the destruction of the infringing goods, materials or articles if it is not reasonably practicable for the offending mark to be erased, removed or obliterated.

The Sindh High Court in *M. Sikander Sultan v. Masih Ahmed Shaikh* {2003 C L D (26)} confirmed an order of interim injunction against the Defendants and restrained them from using the trademark SHAN as it was a colorable imitation of the Plaintiff's trademark AALI SHAN and stated that “the registration of trademark is not meant for the benefit of the trader only but also protects the public-at-large and its main object is to secure free enjoyment of the right of manufacturing and marketing of one's products and also to save general public from being deceived by the acts of unscrupulous manufacturers and sellers of goods bearing the fake trademark of others. For maintaining the purity of the trademark and for safeguarding the interest of the public, it is the duty of the Court to put

restraint on use of another's trademark by a person like the defendant; who is not entitled to use it.”

Criminal Litigation: The trademark law in Pakistan provides for criminal remedies in case of violation of a rights holder's trademark. A criminal action can be initiated by filing a written complaint in the police station within whose jurisdiction infringement has taken place. After the proceedings have been initiated, the court may pass search and seizure warrants under which the premises of the infringer can be raided and the infringing goods seized. Should an infringer be found guilty of violating the rights holder's trademark, he may be liable for imprisonment or fine or both. An infringer can be imprisoned for a maximum of three years with a maximum fine of PKR 50,000 (approximately \$630 USD) under the Trade Marks Ordinance, 2001. In addition, the court has the authority to order the seizure, forfeiture, and destruction of infringing goods. Though provisions for criminal sentences exist in the Pakistani trademark law, such sentences are rare.

Customs Laws: Besides the civil and the criminal remedies mentioned herein above, there are also certain provisions under the trademark law and the customs law which prohibit the import or export of counterfeit goods. Should such goods be seized by the Customs authorities, the offender is liable for detention and the infringing goods can be seized or confiscated.

Expected Developments

Pakistan is not yet a signatory to the Madrid Protocol but the Pakistani government is contemplating acceding to this Agreement. The IP Office is also preparing to digitize its records and introduce a system for the electronic filing of trademark applications. Moreover, Pakistan is also in the process of drafting a separate law to protect geographical indications.

Trademark Legislation in Pakistan

The Trade Mark Ordinance, 2001 along with the Trade Mark Rules, 2004.

International Trademark 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)

Trademark Related Websites

<http://www.ipo.gov.pk>
<http://www.wipo.int/trademarks/en/>
<http://www.uspto.gov>

FAQs

1. Must I sell my products or offer my services in Pakistan before I seek protection?

No, Pakistani trademark law allows filing of a trademark application in Pakistan on an 'intent-to-use' basis.

2. How do I file for a trademark in Pakistan?

The procedure for the registration of a trademark is described under the section 'Registration Procedure'

3. What is the filing fee?

The official filing fee for one trademark application in one class and without claiming priority in 2010 is PKR 1000 (approximately \$13). The details of the official filing fees for various kinds of applications can be found at <http://www.ipa.gov.pk/Trademark/Downloads/TM-rules%202004.pdf>.

4. Can I file a single application for use of my mark on more than one good or in association with more than one service in Pakistan?

No. Pakistan does not have a system of multi-class applications. Therefore one application can be filed only for the registration of one class of goods or services.

5. I have a design logo and want to apply for the registration of the same mark for identical goods and services in black and white as well color. Can I do so in one application?

Yes. You can do so in one application as Pakistan recognizes the system of a series application.

6. What is the duration of a trademark in Pakistan?

A trademark in Pakistan is valid for 10 years and can be renewed thereafter indefinitely for periods of 10 years.

7. Can I appeal against the decision of the Registrar of Trade Marks?

Yes. The appeal against the decision of the Registrar of Trade Marks will be to the High Court.

8. If a person portrays his or her trademark as registered while in reality it is not, is that an offense?

Yes. Should a person represent that his trademark is registered while the same has not been registered he is liable to be punished with imprisonment that may vary

from one month to six months or with a fine of PKR twenty thousand rupees (approximately \$252) or with both.