

# Pakistan

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## **Legal framework**

In Pakistan, trademark protection is governed by the Trademarks Ordinance 2001 and the Trademarks Rules 2004.

The ordinance aligned Pakistan's IP regime with its obligations under the Agreement on Trade-Related Aspects of Intellectual Property Rights and brought the national legislation into line with changing commercial practices evolved over the years. The ordinance broadens definition of a 'mark' to include three-dimensional and sensory marks, as well as incorporates provisions relating to service marks, well-known marks, unfair competition, border measures, comparative advertising and domain names.

In addition, Pakistan is a signatory to the

World Trade Organisation Agreement and the Paris Convention.

## **Unregistered marks**

Registration of trademarks in Pakistan is optional. However, rights in an unregistered trademark can be enforced only through the common law action of passing off or criminal proceedings. In both cases the plaintiff must provide evidence to establish its title to the mark. Priority in adoption and use is superior to priority in registration.

The rights in an unregistered mark may be claimed only if the rights holder successfully establishes that the mark has acquired a reputation and goodwill in Pakistan in relation to the goods or services for which it has been used. The protection afforded to unregistered marks is also extended to foreign marks which have a reputation in Pakistan based on extensive advertisements and publicity. The

Pakistan courts recognise the existence of cross-border reputation and have accorded protection to marks that have acquired reputation or goodwill without actual use in Pakistan.

### Registered marks

Any party can apply to register a trademark, provided that it has a good-faith claim to ownership of the mark. This claim may be based on use of the mark for particular goods or services by the applicant or its predecessor in title, or on its intention to use the mark.

### Power of attorney

A power of attorney can be submitted after filing the trademark application. For the Trademarks Office, such documents need only be notarised by a notary public in the country of execution; however, before the courts, all documents executed outside Pakistan must be notarised and legalised.

### Protection

**Protected:** Under the Trademarks Ordinance, a trademark may be registered if it:

- falls within the definition of a 'mark', which includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, figurative element, colour, sound or any combination thereof;
- is capable of being represented graphically; and
- is capable of distinguishing the applicant's goods or services from those of others.

**Not protected:** The absolute grounds for refusal of registration under the Trademarks Ordinance are as follows:

- Unless it is well known or has acquired distinctive character through use, a mark cannot be registered if it:
  - is devoid of any distinctive character;
  - designates the kind, quality, quantity, intended purpose, value, geographical origin, time of production of goods or rendering of services, or other characteristics of the goods or services; or
  - is customary in current language or in the honest and established practices of the trade.
- The mark consists wholly of the shape of the goods which results from their nature,

is necessary to obtain a technical result or gives substantial value to the goods.

- The mark:
  - consists of a scandalous design or matter whose use is likely to cause confusion and deception;
  - is not entitled to protection in a court of law;
  - is likely to affect religious susceptibilities of any class of citizens of Pakistan or in terms of the goods or services for which it will be used; or
  - is contrary to law or morality.
- The trademark application was made in bad faith.

The relative grounds for refusal of registration under the Trademarks Ordinance are as follows:

- The mark is identical to an earlier trademark that is registered for identical goods or services.
- The mark is similar to an earlier trademark registered for identical goods or services and there exists a likelihood of confusion on the part of the public.
- The mark is identical or similar to an earlier registered trademark for different goods or services, but the earlier trademark has a reputation in Pakistan and use of the later mark would take unfair advantage of or be detrimental to the distinctive character or repute of the earlier trademark.
- Use of the mark is liable to be prevented by any law (eg, the law of passing off) or an earlier right (eg, the law on copyright, design rights or registered designs).

These grounds apply unless the holder of the earlier mark or other earlier right consents to registration of the later mark.

### Procedures

#### Examination

On receipt of the trademark application, the Trademarks Office examines it to see whether it contains all requisite information and whether any of the absolute or relative grounds for refusal apply.

In case of objections, the Trademarks Office issues a 'show cause' notice setting out the grounds for objection. The applicant has two months (extendable to three months) to submit

a written response to the notice.

If the objections are not overcome by the written response, the Trademarks Office may hold a hearing to consider the matter further. The registrar's decision is then communicated to the applicant in writing. The applicant has two months from the date of decision to appeal, which takes place before the courts.

If the applicant meets all the objections raised by the Trademarks Office, the application is published in the *Trademarks Journal*, either as accepted or before acceptance and either unconditionally or subject to such limitations or disclaimer on the applicant's rights to the mark as the registrar thinks fit.

### Opposition

Upon publication of the trademark in the *Trademarks Journal*, any person may, within four months (including two one-month extensions), oppose the mark, stating the relevant facts and legal grounds of opposition and paying the official fee. The Trademarks Office will serve a copy of the notice on the applicant, which must file its counter-statement in support of the application within three months of receipt of the notice (including two one-month extensions). If the applicant fails to do so, the Trademarks Office will treat its application as abandoned.

The Trademarks Office will serve a copy of the counter-statement on the opponent, which has five months from receipt (including three one-month extensions) to file evidence in support of the opposition. If the opponent fails to file such evidence, its opposition will be treated as abandoned. The opponent may also opt to file a rejoinder to the applicant's counter-statement, which must be filed within three months (including two one-month extensions) of receipt of the applicant's counter-statement.

The applicant may also file evidence to support its application within five months (including three one-month extensions) of receipt of the opponent's evidence. The opponent may then file evidence in reply within four months (including three one-month extensions) of receipt of the applicant's evidence.

Once the evidence stage is closed, the registrar will appoint a date for hearing arguments. After the hearing, the registrar will issue his or her decision in writing and a copy of

the decision, signed by the hearing officer and stamped with the seal of the Trademarks Office, will be delivered to both parties. The parties may also apply to the registrar for issuance of detailed grounds of the decision.

### Registration

If the trademark application is published as accepted and is not opposed, or an opposition is decided in the applicant's favour, the mark will be registered. If the application is published before acceptance and is not opposed, the registrar will re-examine the application once the opposition period has expired and, in case of no further objections, the application will be accepted and the mark will be registered. The Trademarks Office will issue the applicant with a certificate of registration signed by the registrar and stamped with the seal of the Trademarks Office.

Once granted, the registration is valid for 10 years from the date of registration (ie, the date of application) and may be renewed for successive 10-year periods.

Renewal of registration is effected by filing a request for renewal in prescribed form accompanied by the official fee at any time in the six months before the registration's expiry date or the last renewal. After the first renewal, the registrar may require the applicant for renewal to submit evidence of use in Pakistan.

In case of non-renewal, the registrar will remove the mark from the register and publish notice of such removal in the *Trademarks Journal*. However, the registrar may restore the mark to the register and renew the registration if sufficient grounds for restoration are shown by the rights holder within six months of publication of the notice of removal in the *Trademarks Journal*, accompanied by the renewal and restoration fees.

### Cancellation/surrender

A rights holder may surrender its mark by written notification to the registrar. If surrender affects the rights of third parties based on legislation, decisions of an authority or a licence agreement, surrender shall take effect only with the consent of the parties concerned.

### Revocation and invalidation

An interested party may apply for revocation of a registered trademark or a declaration of

its invalidity. Such application can be made to the registrar unless there is an ongoing court proceeding involving the mark, in which case the application must be filed before that court. The registrar is also empowered to refer the application to the relevant court.

The grounds for revocation of a registered mark include that:

- the mark has not been put to good-faith use in Pakistan within five years of the date of registration without proper reason; or
- the mark has become customary in the trade due to the acts or inactivity of the holder.

If a trademark was registered in breach of any of the absolute or relative grounds for refusal as set out in the Trademarks Ordinance, this may serve as the basis for invalidation of the mark. However, this provision does not apply to a mark which was registered in breach of the absolute grounds (ie, having no distinctive character or being descriptive or generic), but which since registration has acquired distinctive character through use.

Where grounds for revocation or invalidation exist in respect of only some of the goods or services for which the mark is registered, the mark will be revoked or declared invalid only in relation to those goods or services.

When the Trademarks Office receives an application to revoke or declare invalid a trademark, it will forward a copy to the rights holder, and proceedings are the same as for oppositions. If the rights holder fails to defend a mark that has been challenged on the grounds of non-use, the registrar will immediately cancel the registration. In all other cases, the registrar's decisions will be merit based.

### **Enforcement**

The right to institute infringement proceedings under the Trademarks Ordinance is available only to the owner of a registered trademark. However, rights in an unregistered trademark can be enforced through the common law remedy of passing off.

A suit for infringement of a registered trademark can be filed in the relevant district court or high court. In order to succeed, the plaintiff need only establish its title to the mark and that the defendant's use infringes the trademark.

The following acts constitute infringement of a registered trademark under the ordinance:

- using a mark that is identical to the registered trademark in relation to identical goods or services;
- using a mark that is identical to the registered trademark in relation to similar goods or services and thus creating a likelihood of confusion on the part of the public;
- using a mark that is deceptively similar to the registered trademark in relation to identical goods or services and thus creating a likelihood of confusion on the part of the public;
- using a mark that is either identical or deceptively similar to the registered trademark in relation to similar or closely related goods or services;
- using a mark that is either identical or deceptively similar to the registered trademark in relation to different goods or services if the registered trademark is well known or has a reputation in Pakistan, and the use of the later mark is without due cause and takes unfair advantage of or is detrimental to the distinctive character or repute of the registered trademark;
- using a registered trademark as a trade name or part of a trade name; and
- using the registered trademark as a domain name or part of a domain name, or obtaining such domain name without the rights holder's consent and with the intention of selling it on.

Unregistered trademarks (including the get-up of a product or trade dress) in respect of which reputation and goodwill exist in Pakistan are protected by way of an action for passing off. Such action must be instituted in the civil court with jurisdiction to try the suit (ie, where the defendant resides or where the cause of action arose). To succeed, the plaintiff must establish:

- the mark's reputation in Pakistan;
- misrepresentation by the defendant; and
- resultant damage to the plaintiff's business or goodwill.

In a civil suit for infringement and/or passing off the plaintiff may seek relief such as a permanent injunction, damages, rendition of accounts and costs. The plaintiff may also seek a temporary injunction while the suit is pending.

For the temporary injunction to be granted, the plaintiff must establish that it has a good-faith case, the balance of inconvenience is in its favour (ie, it will be seriously inconvenienced if no injunction is granted) and the plaintiff will suffer irreparable loss if the injunction is not granted.

The court may order delivery up of the infringing goods, material or articles for erasure or destruction. However, such relief is available only to the owner of a registered trademark.

Criminal proceedings may also be brought against the infringer by filing a private complaint with the local police and magistrates (including, if required, a request for search and seizure). However, to succeed in such action based on unregistered rights, the offending mark must be deceptively similar to the complainant's.

A civil suit usually takes up to five years (depending on the nature of the proceedings and the backlog of cases). The timeframe for the resolution of trademark disputes through criminal actions is approximately 18 months to two years.

### **Ownership changes and rights transfers**

Every assignment to be recognised under the Trademarks Ordinance must be recorded with the Trademarks Office pursuant to the prescribed procedures. The signature of each party on the assignment deed must be witnessed by at least two witnesses and notarised in the country of execution.

In general, the authorised use by a licensee under the control of the rights holder will inure to the benefit of the rights holder for defending a cancellation action for non-use or for any other purpose for which such use is material under the ordinance. While it is not compulsory to record the licence agreement with the Trademarks Office, the confirmation issued on recordal operates as good-faith evidence of the rights holder's authority and control over the licensee which may otherwise have to be proved through evidence.

### **Related rights**

Both trademark and copyright protection may be claimed in respect of works of visual arts (ie, logos, designs, devices, labels, packaging, portraits and other artistic works), word marks (ie, advertising slogans, book titles) and

sound marks (ie, jingles). However, the focus of protection differs as copyright protects individual creations, enabling the author to exploit his or her work of art itself for his or her own benefit, and has no bearing on the association of the work of art to any goods or services. A trademark, on the other hand, protects the source identifying aspect of a particular product or service.

### **Online issues**

The general principles of trademark law apply to the use of registered or unregistered trademarks in domain names, websites, hyperlinks, online advertisements or metatags.

The Pakistan Network Information Centre (PKNIC) is responsible for the allocation and registration of the Pakistan country-code top-level domain ('.pk'). The Domain Name Dispute Resolution Centre (DNDRC) has been appointed as the '.pk' domain name dispute resolution provider. All domain name disputes are governed and administered in accordance with the PKNIC Policy and Rules, which are essentially similar to the Uniform Domain Name Dispute Resolution Policy and Rules, established and adopted by the Internet Corporation of Assigned Names and Numbers.

A domain name registration with PKNIC does not in itself create any IP rights. Thus, in case of conflict between the PKNIC Policy and existing IP legislation (eg, the Trademarks Ordinance), the latter will prevail and govern the rights of the parties falling within its ambit. [WTR](#)

Examination/registration		
<b>Representative requires a power of attorney when filing? Legalised/notarised?</b>	<b>Examination for relative grounds for refusal based on earlier rights?</b>	<b>Non-traditional marks registrable?</b>
No (only notarisation required) 	Yes 	3D; single colour; sound. 

Unregistered rights		Opposition
<b>Protection for unregistered rights?</b>	<b>Specific/increased protection for well-known marks?</b>	<b>Can a registration be removed for non-use? Term and start date?</b>
Yes 	Yes 	Yes: four months (including two one-month extensions). 

Removal from register		
<b>Can a registration be removed for non-use? Term and start date?</b>	<b>Are proceedings available to remove a mark that has become generic?</b>	<b>Are proceedings available to remove a mark that was incorrectly registered?</b>
Yes: five years' non-use immediately preceding filing date of application for removal.	Yes 	Yes 

Enforcement		
<b>Specialist IP/trademark court?</b>	<b>Punitive damages available?</b>	<b>Interim injunctions available? Time limit?</b>
No 	Yes: in rare cases. 	Yes: until judgment or until further orders of court. 

Ownership changes	Online issues	
<b>Mandatory registration for assignment/licensing documents?</b>	<b>National anti-cybersquatting provisions?</b>	<b>National alternative dispute resolution policy (DRP) for local ccTLD available?</b>
Yes/No   	Yes: regulated by general legislation. 	Yes: PKNIC DRP. 

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Zulfiqar Khan is an IP attorney in Pakistan at Khursheed Khan & Associates. Mr Khan has helped clients to use their IP assets to excel in their business. With his first degree in mechanical engineering he sought three patents, qualified as a patent agent and later became an attorney at law specialising in patents, trademarks, domain names, information technology and telecommunications. He brought Microsoft to Pakistan and helped Warner Brothers to tackle the pirate markets in Pakistan. He teaches law and has written Pakistan's trademark law. He has also drafted Pakistan's current patents and design regulations.