

BUSINESS BRIEF: PAKISTAN

Patents

How do you register or secure patent rights, and is national or international coverage most appropriate?

A patent can be secured by filing an application along with the specification and claims at the Patents Office, part of the Intellectual Property Organisation (IPO) of Pakistan. The application is subject to substantive examination. When an application has been examined it is advertised in the gazette and is open for the public to view. If there is no opposition within the prescribed time (four months from the advertisement date), the patent is issued upon payment of sealing fee. The Patents Office provides national coverage only.

What are the costs of obtaining a patent, and what are the costs of defending it?

The approximate official charges from filing until grant of a patent application and a single examination report is around \$95. Official charges for defending an opposition are \$15.

Where can you find information on existing patents in your jurisdiction?

The IPO has a website at www.ipo.gov.pk that provides basic information on existing patents. However, detailed information may be obtained by filing a request at the Patents Office.

Is there anything unusual about the patent law(s) that companies should be aware of, and what are the most common mistakes businesses make?

The existing law requires unity of invention and it does not provide protection to a group of inventions.

For inventions covering chemical products, separate applications are required for each derivative and salt of a chemical product.

Inventions containing claims of medical use directed to a method of medical treatment and

use/Swiss use claims (intended to cover the first, second or subsequent medical use of a known substance or composition) are also not allowed.

Disclosure of the invention before filing the patent application, non-exploitation, and not taking timely action against infringers are the most common mistakes patent owners make.

What are the key threats to patent owners, and what is the best strategy if you suspect someone is infringing your patent?

Invalidation of a patent by third party and infringement are the key threats to patent owners and proactive steps should be taken to prevent the patent from becoming susceptible to invalidations. The best strategy to counteract infringement would be to file a lawsuit against any person or company using a valid patent to make, sell or use an invention without a licence.

Trademarks

How do you register or secure trademark rights and what protection do they grant?

Trademark rights may be secured either by obtaining registration under the Trade Marks Ordinance 2001 through filing an application in the Trade Marks Registry or by using the trademark. After registration, the rights are *prima facie* with the proprietor of the trademark. The owner is granted the exclusive right to use the mark for the goods/services that it covers. A trademark also grants a statutory right against infringers for the time that it is in force under the Trade Marks Rules 2004.

What are the costs of registering a trademark and what are the costs of defending it?

The approximate official cost of registration of a straightforward trademark without any objection is \$80 for a single class; applications covering multiple classes are not acceptable.

The official charge for defending a trademark in opposition and rectification proceedings is \$14, excluding extension costs.

What are the key threats to trademark owners and what is the best strategy for dealing with infringement?

The key threats are misappropriation of trademarks, infringement and passing off. The best strategy for dealing with infringement is to initiate a civil action before the court of a competent jurisdiction. As a first step, sending a cease-and-desist notice provides an opportunity for a possible settlement. The preemptive strategy is to register one's trademark in a timely manner.

What are the most common mistakes trademark owners make?

The most common mistakes include non-use of the trademark within the stipulated period of five years after the mark has been put on the trademark register. This may consequently bring the risk of a revocation action from a third party and weakens any action that may be taken against infringers or oppositions against a third party registering a mark.

With the assumption that they will be registered, owners sometimes start using their trademarks before registration. Some trademark owners are also not active enough in monitoring the markets and conducting surveys.

Counterfeiting

How big a problem is counterfeiting in your jurisdiction?

Local counterfeit goods and the import of fake products are a continuing problem in our jurisdiction.

What industries are particularly at threat?

Counterfeit pharmaceutical goods are a rising problem and a public health concern.

“THE MOST COMMON MISTAKES INCLUDE NON-USE OF THE TRADEMARK WITHIN THE STIPULATED PERIOD OF FIVE YEARS AFTER THE MARK HAS BEEN PUT ON THE TRADEMARK REGISTER.”

There is also counterfeiting in the textile and confectionery industries. Due to pirated CDs and DVDs of music and films being easily available, the entertainment sector is also under threat.

What are the best strategies for dealing with the problem?

The best strategy is to publish a cautionary notice about counterfeit goods in leading newspapers to make people aware of counterfeit goods that are circulating in the market. If the counterfeit goods are being imported, the customs department may be notified as it may exercise its power to confiscate the counterfeits.

How can public-private partnerships to tackle counterfeiting be improved?

Enforcement is mainly through the courts, but IP offices may involve the private sector to develop processes designed to help protect IP.

Copyright

What are the key challenges to copyright owners in your jurisdiction?

The greatest challenges copyright owners have to deal with are piracy, infringement and counterfeiting. Unauthorised use of copyrighted material online including illegal sharing or downloading of material is also a key challenge.

How should people ensure they are protected against copyright infringement?

Registration of copyright is not mandatory in Pakistan, as copyright vests from the moment the work is created and recorded in a tangible form. However, a certificate of copyright registration in a work shall be *prima facie*

evidence in a court that the owner named in the certificate owns the copyright to the work.

What is the best way to deal with infringement?

The best way to deal with infringement is to file a lawsuit in the relevant courts. Special remedies for copyright infringement may also be taken if the copyright owner is unable to institute immediate regular legal proceedings by applying to the court for immediate

provisional orders to prevent infringement. However, before taking legal action, the owner of the copyright may send a cease-and-desist letter to the infringer.

General

Are there any other IP developments we should know about?

Many trademark infringement matters have been taken for action to the Competition Commission of Pakistan under the Competition Act. ■



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