

Pakistan

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Patents

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

Inventions are protected under Pakistan Patents Ordinance, 2000, and Patents Rules, 2003. A patent can be secured by filing an application for patent protection with the Pakistan Patent Office which is subject to substantive examination.

Upon successful completion of examination, the application is advertised in the Patents Journal and is made open to public. If there is no opposition, upon payment of a sealing fee, the patent document is issued. Patents are protected with national coverage only.

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

Official fees, as per prevailing Pakistani rupee exchange rate with US dollars are:

- Filing fee for patent specification consisting of 40 pages and 20 claims: \$41
- Fee for filing response to examination report (per report): \$5; and
- Sealing fee: \$41.

There are no official charges for formalities relating to defending, except for an extension if needed, while official charges for attending a hearing are \$14.

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

The Intellectual Property Organisation (IPO) of Pakistan's website provides basic information on existing patents. Information is also published in the Patents Journal, but complete information may be obtained by filing a request with the Office.

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

There are certain limitations in the existing law that companies should be aware of:

- Section 15(4): claims should relate to a single invention and be clear and fairly based on the matter disclosed in the specification.
- Section 15(8): for inventions of a chemical product intended for use in agriculture or medicine, separate applications are required for each derivative and salt of the chemical product.
- Section 7(4)(c) and (d): claims directed to a method of medical treatment and use/Swiss use claims are also not allowed.

Failing to file an application in Pakistan within 12 months of the earliest application, not exploiting a patent in Pakistan, and not taking timely action against infringers are some of the common mistakes businesses 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 patents by third parties, infringement and counterfeiting are key threats to patent owners.

The best strategy against infringement is to be vigilant, taking appropriate legal action against any person who during the validity of the patent, makes, sells or uses the invention without a licence or counterfeits it.

Trademarks

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

Trademark rights may be secured either by obtaining registration by filing an application in the trademarks registry or

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by use of the mark. Registration is a *prima facie* evidence of the right of the proprietor in the trademark as it is a personal property. It also grants a statutory right against infringers by obtaining relief under the Trade Marks Law and any other law in force at the time.

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

- Filing fee for a trademark in one class: \$18 (a multi-class application cannot be filed);
- Registration fee: \$54;
- Fee for filing counter statement: \$9; and
- Extension of time: \$9.

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

The key threats to owners are trademark misappropriation, infringement and passing off. The best strategy for dealing with infringement is to initiate a civil action before the IP Tribunal or a court.

A pre-emptive strategy is to register your trademark in a timely manner. As a first step, sending cease-and-desist notice provides the opportunity for a possible settlement.

Another key threat is an action for cancellation based on non-use for a continuous period of five years from the registration of the mark.

What are the most common mistakes trademark owners make?

Non-use of the trademark within the five years after the mark has been put on the register, which brings the risk of revocation action from any interested third party. This also weakens any action to be taken against infringers and oppositions against the registration of a third party's mark.

At times, owners of foreign trademarks don't register their trademark in Pakistan prior to entering the local market and their local agents register the mark in their own name. This creates problems when the relationship between the parties is terminated.

Counterfeiting

How big a problem is counterfeiting in your jurisdiction?

Local counterfeits and the import of counterfeit goods is an ongoing problem. Easy access to social media and the ease of travel overseas brings a heightened awareness of foreign brands which nurtures counterfeiting.

What industries are particularly at threat?

Counterfeit pharmaceutical goods are a rising problem and a public health concern. There is rampant counterfeiting in the textile, food and confectionery industries. Many fake consumer items are also being sold.

What are the best strategies for dealing with the problem?

You must be vigilant and publish cautionary notices, while garnering publicity through other campaigns to make people aware of infringed or counterfeit products circulating in the market. If the counterfeit goods are being imported, customs should be notified.

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

The IPO may involve private sector to understand and discuss the issues, and develop processes to ensure better protection of 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 copyright 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, as copyright vests from the moment the work is created and recorded in a tangible form. However, a certificate of registration is *prima facie* evidence in any legal proceeding that copyright subsists in the work and that the owner named in the certificate is the copyright owner.

What is the best way to deal with infringement?

The best way to deal with infringement is to file a suit in the IP tribunal/court. Special remedies for infringement may also be taken, by applying to the tribunal for immediate provisional orders. Before taking legal action, the owner may send a cease-and-desist notice to the infringer.

Other developments

In 2017, Pakistan's government amended the Customs Rules, to incorporate a new chapter which provides a mechanism for action against the import into Pakistan of

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infringing goods in violation of the existing IP laws.

In 2019, certain amendments in the patents, trademarks and copyright laws were approved by the IPO board and are in the process of submission to the Ministry of Commerce.

Patent, trademark and copyright fees have been enhanced with effect from March 2019.

In a milestone achievement, the Senate Standing Committee on Commerce approved the Geographical Indications (GI) Bill in 2020. ●

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