

Patents 2021

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Patents 2021

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Lexology Getting The Deal Through is delighted to publish the eighteenth edition of *Patents*, which is available in print and online at www.lexology.com/gtdt.

Lexology Getting The Deal Through provides international expert analysis in key areas of law, practice and regulation for corporate counsel, cross-border legal practitioners, and company directors and officers.

Throughout this edition, and following the unique Lexology Getting The Deal Through format, the same key questions are answered by leading practitioners in each of the jurisdictions featured. Our coverage this year includes new chapters on Israel, Singapore, Turkey and the United Kingdom.

Lexology Getting The Deal Through titles are published annually in print. Please ensure you are referring to the latest edition or to the online version at www.lexology.com/gtdt.

Every effort has been made to cover all matters of concern to readers. However, specific legal advice should always be sought from experienced local advisers.

Lexology Getting The Deal Through gratefully acknowledges the efforts of all the contributors to this volume, who were chosen for their recognised expertise. We also extend special thanks to the contributing editors, Louis E Fogel and Shaun M Van Horn of Jenner & Block LLP, for their continued assistance with this volume.



London

April 2021

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PATENT ENFORCEMENT PROCEEDINGS

Lawsuits and courts

- 1 | What legal or administrative proceedings are available for enforcing patent rights against an infringer? Are there specialised courts in which a patent infringement lawsuit can or must be brought?

The patent right holder of a product or process patent can enforce his or her right against making, using, offering for sale, selling or importing the product or the product obtained from the patented process, as the case may be, if such act is done without his or her consent.

The holder of a patent can bring a suit for infringement before the Intellectual Property Tribunal (IP Tribunal) of the relevant jurisdiction under section 60 of the Patents Ordinance 2000 (the Ordinance), which has exclusive power to entertain and decide such cases pertaining to infringement of intellectual property laws. Subject to the provisions of Intellectual Property Organization Act 2012 (the Act) the IP Tribunal has all the powers vested in a civil court under the Code of Civil Procedure 1908 (Act V of 1908) and in a Court of Session under the Code of Criminal Procedure 1898 (Act of 1898) respectively.

In relation to the import or export of infringing patented goods, the patentee can take action through the customs authorities under section 15 of the Customs Act 1969 and the Custom Rules 2001.

Trial format and timing

- 2 | What is the format of a patent infringement trial?

The format of patent infringement trial is that pleadings are drafted on the basis of law, facts and evidence and filed along with interlocutory injunction application together with affidavits. After the preliminary hearing, either an interim injunction application is granted restraining the infringer to use the patent or notice is issued to the defendant for appearing in a court or tribunal. After the decision on the injunction application, the main suit proceeds and issues are framed and then parties record their evidence relying upon the evidence submitted at the time of filing of pleadings and defence. The plaintiff and defendant appear themselves along with their witnesses, if any, they are cross-examined by the respective counsel. Thereafter, the case is fixed for final arguments and a court or tribunal passes the decision. However, if the interlocutory application seeking an injunction is allowed or refused by the court or tribunal, then the aggrieved party may prefer an appeal.

The court has the power to appoint an independent expert to assist it or to investigate any question relating to some scientific matter or fact and produce a report before the court or tribunal.

Since there is no jury in Pakistan, the disputed issues are decided by a judge.

The trial of a single patent typically takes around two to five years in Pakistan.

Proof requirements

- 3 | What are the burdens of proof for establishing infringement, invalidity and unenforceability of a patent?

According to Qanun-e-Shahadat 1984 (Evidence Act), the burden of proof rests on the person pursuing the relevant cause of action (ie, infringement must be proven by the right holder and invalidity must be proven by the party seeking revocation).

Standing to sue

- 4 | Who may sue for patent infringement? Under what conditions can an accused infringer bring a lawsuit to obtain a judicial ruling or declaration on the accusation?

Under section 60, a patentee or under section 64 of the Ordinance an exclusive licensee can sue for infringement of a patent and may prevent third parties not having the owner's consent from the acts of making, using, offering for sale, selling or importing an invention.

An accused infringer may bring a lawsuit on the basis of groundless threat under section 66 of the Ordinance for declaration under section 66 of the Ordinance that the threats have been unjustifiable or obtain an injunction in the case of continuance of threats or damages sustained by him or her.

A person may bring a lawsuit to obtain a declaration of non-infringement under section 67(1) of the Ordinance, to show that the plaintiff had applied in writing to the patentee or licensee together with the process or article and that the patentee or licensee refused or neglected to give an acknowledgement.

Inducement, and contributory and multiple party infringement

- 5 | To what extent can someone be liable for inducing or contributing to patent infringement? Can multiple parties be jointly liable for infringement if each practises only some of the elements of a patent claim, but together they practise all the elements?

According to section 60 of the Patents Ordinance 2000, to prove infringement, the product or process against which infringement action is taken needs to satisfy all of the essential features of a patented invention.

However, even if the infringed product or process in question does not satisfy all of the essential features of a patented invention but it manifests a part of the patent that is not claimed in claims but is a part of the disclosure of invention, it would amount to contributory or indirect infringement pursuant to section 60 of the Ordinance. Hence, any person can be found liable for contributory infringement if he or she offers to import or put on sale any of the components protected under the patent. Multiple parties can, therefore, be liable for contributory infringement.

Joinder of multiple defendants

- 6 | Can multiple parties be joined as defendants in the same lawsuit? If so, what are the requirements? Must all of the defendants be accused of infringing all of the same patents?

The Civil Procedure Code 1908 (CPC) allows multiple parties to be joined as defendants in the same lawsuit. Order 1, Rule 3 thereof provides that all persons may be joined as defendants against any right to relief in respect of, or arising from, the same act or transaction or series of acts or transactions whether jointly, severally or in the alternative and if separate suits were brought against such persons any common question of law or fact would arise. In this regard all the defendants must be alleged for infringement of the same patent in question as joined parties; either they are alleged for using, making or selling a whole patented product or a product obtained from a patented process or liable for partial or contributory infringement.

Infringement by foreign activities

- 7 | To what extent can activities that take place outside the jurisdiction support a charge of patent infringement?

A patent right granted in Pakistan can be extended within the territorial boundaries of Pakistan.

Infringement by equivalents

- 8 | To what extent can 'equivalents' of the claimed subject matter be shown to infringe?

There is neither any statutory provision in the Ordinance nor any judicial rulings from superior courts that govern the scope of infringement by applying the doctrine of equivalent in Pakistan.

Discovery of evidence

- 9 | What mechanisms are available for obtaining evidence from an opponent, from third parties or from outside the country for proving infringement, damages or invalidity?

There is no mechanism by which a party can obtain relevant information and evidence from another party or third parties or from any opponent outside the country.

Litigation timetable

- 10 | What is the typical timetable for a patent infringement lawsuit in the trial and appellate courts?

There is no fixed time frame for a patent infringement lawsuit in the trial and appellate court, whereas a preliminary injunction takes approximately two to six months but final order takes around two to five years or more.

Litigation costs

- 11 | What is the typical range of costs of a patent infringement lawsuit before trial, during trial and for an appeal? Are contingency fees permitted?

The typical range of costs of a patent infringement lawsuit before trial, during trial or for an appeal depends on the nature of the case and on various factors, including amounts involved and complexity of the patent invention. The range varies from case to case and attorney to attorney, ranging from US\$7,000–US\$30,000. A contingency fee is not allowed.

Court appeals

- 12 | What avenues of appeal are available following an adverse decision in a patent infringement lawsuit? Is new evidence allowed at the appellate stage?

As per section 19 of the Act, any person aggrieved by the final judgment and order of the Tribunal may, within 30 days of the final judgment or order of the Tribunal, refer an appeal to the High Court with jurisdiction over the Tribunal. If an appeal is filed against any order passed by the Tribunal it will be heard by a single judge and if the appeal is filed against any judgment or decree it shall be heard by a division bench of the High Court.

Any judgment, decree or order passed by the High Court can be challenged in the Supreme Court of Pakistan.

Admissibility of new evidence may be allowed according to Order 41 Rule 27 of CPC on the basis that either the lower court refused to admit evidence that is required to be admitted, or if the appellate court requires any document or any witness examined to enable it to pronounce judgment, or for any other substantial cause.

Competition considerations

- 13 | To what extent can enforcement of a patent expose the patent owner to liability for a competition violation, unfair competition, or a business-related tort?

If the federal government determines and is satisfied that the patentee or his or her licensee is anticompetitive and that the exploitation of the invention would remedy such practices, then the federal government under section 58 of the Ordinance, even without the consent of the owner of the patent, may allow a government agency or a third person designated by the federal government to exploit a patented invention.

Moreover, if the licence agreement or any other contract between the patent owner and any third party contains any anticompetitive clause, permission from the Competition Commission of Pakistan is required under section 5 of the Competition Act 2010.

Alternative dispute resolution

- 14 | To what extent are alternative dispute resolution techniques available to resolve patent disputes?

An alternative dispute resolution mechanism is available in Pakistan.

Section 89(A) of CPC provides for alternative dispute resolution and, if the court considers it necessary with regard to the facts and circumstances of the case, with the consent of the parties it may adopt an alternative dispute resolution method such as mediation or conciliation. This provision, together with Rule 1A (iii) Order X, gives that the court may adopt any lawful procedure within the provisions of CPC, and with the consent of parties may opt for an alternative method of dispute resolution, including mediation, conciliation or any such other means. After the said mediation, if any issue arises for the enforcement of settlement the court will play its role to enforce the decision of the mediator.

SCOPE AND OWNERSHIP OF PATENTS

Types of protectable inventions

- 15 | Can a patent be obtained to cover any type of invention, including software, business methods and medical procedures?

Patent under the Ordinance covers any new and useful product or process, in any field of technology, and includes any new and useful improvement of either of them but software, business methods and

methods of medical treatment are excluded from patentable subject matter. Non-patentable subject matter is given in sections 7(2) and 7(4) of the Ordinance, which includes the following categories:

- discovery, scientific theory or mathematical method;
- literary, dramatic, musical and artistic works;
- scheme, rule, method of performing mental act, game or doing business;
- presentation of information;
- inventions contrary to law or morality or prejudicial to health and environment;
- substances that exist in nature or are isolated therefrom;
- plants and animals and essentially biological processes for the production of plants or animals;
- methods of medical treatment including diagnostic, therapeutic and surgical methods for humans or animals;
- new or subsequent use of a known product or process; and
- mere change in physical appearance of a chemical product if it does not meet the criteria of patentability.

Patent ownership

16 Who owns the patent on an invention made by a company employee, an independent contractor, multiple inventors or a joint venture? How is patent ownership officially recorded and transferred?

The right to the patent for an invention made by an employee during the course of his or her employment in the area of activity of the employer belongs to the inventor in the absence of any contractual obligation to the contrary except when the employer proves that the invention could not have been made without the use of the employer's facilities, equipment and the like necessary for the invention.

In the case of multiple inventors or a joint venture, unless an agreement to the contrary is in force, each of the persons is entitled to an equal undivided share in the patent.

The right to a patent is recorded in the Register of Patents maintained in the Patent Office and this right may be assigned to any person or legal entity during the pendency of application or after the patent is granted.

DEFENCES

Patent invalidity

17 How and on what grounds can the validity of a patent be challenged? Is there a special court or administrative tribunal in which to do this?

The validity of a patent can be challenged by way of revocation, and the reason for a revocation may be any one or more of the grounds upon which the grant of the patent can be opposed, such as:

- the applicant for the patent obtained the invention or any part thereof from the person who is the legal representative, assignee, agent or attorney;
- the invention is not a patentable invention under the direction of the Ordinance;
- 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;
- the claims are not clear or extend beyond the scope of the disclosures in the complete specification as originally filed; and
- the complete specification claims an invention other than that described in the provisional specification and that such other invention either forms the subject of an application made by the opponent for a patent that, if granted, would bear a date in the

interval between the date of the application and the leaving of the complete specification, or has been made available to the public by publication in any document in that interval.

There is no special court or administrative tribunal for challenging the validity of a patent. An application for revocation of a patent can be filed with the High Court under section 46 of the Patents Ordinance 2000, or with the Controller of Patents under section 47, or by the federal government under section 48.

Absolute novelty requirement

18 Is there an 'absolute novelty' requirement for patentability, and if so, are there any exceptions?

According to section 8 of the Ordinance, there is an absolute novelty requirement that an invention shall be considered new if it does not form part of the state of the art. Section 8(2) describes the state of the art to comprise everything disclosed to the public anywhere in the world, by publication in tangible form or by oral disclosure, by use or in any other way before filing and priority date of application. It also includes publication of inventions under section 21 and traditionally developed, or existing knowledge available or in the possession of a local or indigenous community.

The only exception is that if an article is exhibited at an official or officially recognised international exhibition within 12 months preceding the date of filing of an application for grant of a patent, disclosure of a patentable invention in respect of goods shall not constitute 'state of the art'.

Obviousness or inventiveness test

19 What is the legal standard for determining whether a patent is 'obvious' or 'inventive' in view of the prior art?

The legal standard to consider the invention having inventive step is given in section 9 of the Ordinance, which sets out that an invention shall be considered as an involving inventive step if it has not been obvious to a person skilled in the art prior to the date of application for a patent.

Patent unenforceability

20 Are there any grounds on which an otherwise valid patent can be deemed unenforceable owing to misconduct by the inventors or the patent owner, or for some other reason?

According to section 48 of the Ordinance, a valid patent can be revoked and deemed unenforceable by the federal government on the grounds that if a patent or the mode in which it is exercised is mischievous to the state or generally prejudicial to the public, or it is obtained through concealment or misrepresentation in the application. Further, after the compulsory licence is granted, if it is found that it does not sufficiently work or it does not begin within two years of the grant of such a licence, the federal government, after giving the patentee an opportunity to be heard, makes a declaration to that effect in the Patents Journal, and thereupon the patent shall be deemed to have been revoked.

Prior user defence

- 21 | Is it a defence if an accused infringer has been privately using the accused method or device prior to the filing date or publication date of the patent? If so, does the defence cover all types of inventions? Is the defence limited to commercial uses?

Use of and acting in good faith may not be considered an infringement under provision of section 30(5)(d) read with section 30(6) of the Ordinance. Therefore, if a person was doing or had made effective and serious preparation to do before filing or priority date of application that person may continue to do the act notwithstanding the grant of patent and this defence may apply in all type of inventions and is not limited to commercial use.

REMEDIES

Monetary remedies for infringement

- 22 | What monetary remedies are available against a patent infringer? When do damages start to accrue? Do damage awards tend to be nominal, provide fair compensation or be punitive in nature? How are royalties calculated?

The reliefs that a court may grant in any suit for a patent infringement can be an interim injunction followed by a permanent injunction subject to such terms, if any, as the court thinks fit and at the option of the plaintiff, either damages or account of profits. In the case of damages, the amount of compensation awarded by the courts takes into account certain factors including damage caused by infringement and commercial valuation of the patent. Pakistani courts are generally reluctant to award heavy damages, hence the amount in terms of damages remains nominal in nature.

However, under section 62 of the Ordinance, damages shall not be awarded against an infringer who proves that at the date of the infringement he or she was not aware, and had no reasonable ground for supposing, that the patent existed.

There is no law or regulation that ascertains the amount of royalties to be paid to a patentee.

Injunctions against infringement

- 23 | To what extent is it possible to obtain a temporary injunction or a final injunction against future infringement? Is an injunction effective against the infringer's suppliers or customers?

Temporary injunctions followed by the final injunctions are generally not granted against future infringement.

Banning importation of infringing products

- 24 | To what extent is it possible to block the importation of infringing products into the country? Is there a specific tribunal or proceeding available to accomplish this?

Under section 30 of the Ordinance, a patentee can prevent third parties importing the product without his or her consent where the patent is a product, and likewise from importing the product obtained directly by that process. A suit can be filed under section 60 of the Ordinance in an IP tribunal.

Importation of infringing products can also be restricted under section 15 of the Customs Act 1969, whereby a patent holder may get the infringing articles seized, confiscated or detained at the border to prevent the product from entering Pakistan.

Attorneys' fees

- 25 | Under what conditions can a successful litigant recover costs and attorneys' fees?

It is possible to recover costs from the losing party if the successful party claims the cost in the prayer of its plaint and if the court thinks it may give direction to the losing party as it thinks fit.

Wilful infringement

- 26 | Are additional remedies available against a deliberate or wilful infringer? If so, what is the test or standard to determine whether the infringement is deliberate? Are opinions of counsel used as a defence to a charge of wilful infringement?

There are no additional remedies available against deliberate or wilful infringer specified in the Ordinance.

Time limits for lawsuits

- 27 | What is the time limit for seeking a remedy for patent infringement?

Under the Limitation Act 1908, the claim of compensation for infringement is limited to a three-year period from the date of infringement. Therefore, any action of patent infringement brought after a lapse of a three-year period shall be barred under the law.

Patent marking

- 28 | Must a patent holder mark its patented products? If so, how must the marking be made? What are the consequences of failure to mark? What are the consequences of false patent marking?

It is not mandatory for a patent holder to mark its patented product. However, as per section 62 of the Ordinance in the case of infringement proceeding if the defendant proves that the patent number was not mentioned on the patented article the court will not award damages against the defendant. False patent marking is punishable under section 73 of the Ordinance.

LICENSING

Voluntary licensing

- 29 | Are there any restrictions on the contractual terms by which a patent owner may license a patent?

There are no restrictions on the contractual terms by which a patent owner may license a patent.

Compulsory licences

- 30 | Are any mechanisms available to obtain a compulsory licence to a patent? How are the terms of such a licence determined?

According to section 59 of the Ordinance, on a request made to the Controller of Patents after the expiration of a period of four years from the date of filing of the patent application or three years from the date of the grant of the patent, whichever period expires last, the Controller may issue a non-voluntary licence. However, if the patentee satisfies the Controller that circumstances exist that justify the non-exploitation or insufficient exploitation of the patented invention in Pakistan then such a licence will not be issued.

In his or her order for a compulsory licence, the Controller will fix the scope and function of the licence, time limit within which the

licensee must begin to exploit the patented invention and the amount of remuneration to be paid to the owner of the patent together with the conditions of payment.

PATENT OFFICE PROCEEDINGS

Patenting timetable and costs

31 | How long does it typically take, and how much does it typically cost, to obtain a patent?

Once the application is filed, it is examined and usually an examination report is issued within the year and prosecution takes two to three years depending on the complexity of the subject matter. Once the invention meets patentability criteria, the application gets accepted. After acceptance of the application by the Controller of Patents, the application is published in the Patents Journal for opposition purposes. If no opposition is filed within four months, a sealing fee is paid and a Letters Patent Document is issued. The official fee from filing to grant with two official actions would be US\$100 approximately; however, the attorney fee may vary from case to case.

Expedited patent prosecution

32 | Are there any procedures to expedite patent prosecution?

There is no procedure to expedite the prosecution in law at the moment.

Patent application contents

33 | What must be disclosed or described about the invention in a patent application? Are there any particular guidelines that should be followed or pitfalls to avoid in deciding what to include in the application?

The guidelines for contents of the specification are given in section 15(3) of the Ordinance, which requires every complete specification shall fully and particularly describe the invention and the method by which it is to be performed with sufficient disclosure of invention and end with a claim of concisely defining the scope of the invention for which protection is claimed.

However, according to section 15(4) of the Ordinance, the claims of invention shall relate to a single invention, must be clear, succinct and shall be fairly based on the matter disclosed in the specification.

The Patent Office has provided the guidelines to draft a specification in a manner that meets the standard required by the Patent Office and it can be viewed on the official website of the IPO Pakistan www.ipo.gov.pk.

Prior art disclosure obligations

34 | Must an inventor disclose prior art to the patent office examiner?

It is not an obligation on the applicant or inventor to disclose prior art. However, as per section 17 of the Ordinance, during the examination of an application the Controller may ask for a reference to other patents to avoid substantial risk of infringement of other patents. Furthermore, to have a speedy prosecution it is important to include prior art in the specification to distinguish novel features of the invention and its non-obviousness over prior art in the international context and technological developments in that area of technology whereas failure to mention the same may result in the issuance of multiple examination reports and delay in the acceptance of the application.

Pursuit of additional claims

35 | May a patent applicant file one or more later applications to pursue additional claims to an invention disclosed in its earlier filed application? If so, what are the applicable requirements or limitations?

Since unity of an invention is a strict condition, divisional application may be filed at any time before acceptance of the application, which is examined and accepted together with the parent application. A patent of addition can also be filed for improvement or modification of an invention for which a patent has already been applied for or granted.

Patent office appeals

36 | Is it possible to appeal an adverse decision by the patent office in a court of law?

According to section 69(3) of the Ordinance, an appeal shall lie with High Court against any decision, order or direction of the Controller or, as the case may be, the federal government under any of the provisions of the Ordinance and it shall be made within three months from the date of the decision, order or direction of the Controller.

Oppositions or protests to patents

37 | Does the patent office provide any mechanism for opposing the grant of a patent?

After acceptance, a patent application is advertised in the Patents Journal and within four months of advertisement any person may give notice of opposition against the grant of the patent to the Controller of Patents. Notice of opposition comprises grounds and a statement setting out fully the nature of the opponent's interests and facts along with prescribed form and fees under Rule 18 of the Patents Rules 2003.

Priority of invention

38 | Does the patent office provide any mechanism for resolving priority disputes between different applicants for the same invention? What factors determine who has priority?

There is no mechanism given in the Ordinance except that the Patent Office follows the first to file rule unless there is a priority claim in an application.

Modification and re-examination of patents

39 | Does the patent office provide procedures for modifying, re-examining or revoking a patent? May a court amend the patent claims during a lawsuit?

Improvement or modification of an invention for which application for patent is being filed or has already been filed or a patent has been granted and upon a request by the applicant the Controller may grant a patent of addition by virtue of section 39 of the Ordinance. This patent of addition application is examined in the same manner as its basic application. However, under the provision of section 41 of the Ordinance, patent of addition is not to be refused on the ground of inventive step.

Further, in the case of an invention being an improvement in or modification of another invention is the subject of an independent patent and the patentee in respect of that patent is also the patentee in respect of the patent for the main invention, under section 39(2) of the Ordinance the Controller may upon request of the patentee revoke the patent for the improvement or the modification and grant to the patentee a patent of addition in respect thereof, bearing the same date as the date of the patent so revoked.

According to section 43 of the Ordinance, in any proceeding for revocation of a patent before the High Court, the High Court may allow the patentee to amend his complete specification and if in any such proceedings for revocation the High Court decides that the patent is invalid, it may allow the specification to be amended instead of revoking the patent.

Patent duration

40 | How is the duration of patent protection determined?

The total term of a patent in Pakistan is 20 years from the filing date of the application and in the case of a convention application the date of such earliest application filed in the convention country from which priority has been claimed. The duration of patent protection is not extendable.

UPDATE AND TRENDS

Key developments of the past year

41 | What are the most significant developing or emerging trends in the country's patent law?

There has been no significant development in the Pakistan Patents law during the past year; however, during 2019 the IPO Pakistan drafted Patent Rules, which are currently pending approval.

Coronavirus

42 | What emergency legislation, relief programmes and other initiatives specific to your practice area has your state implemented to address the pandemic? Have any existing government programmes, laws or regulations been amended to address these concerns? What best practices are advisable for clients?

With the support of the World Bank, a research initiative entitled RAPID Research and Innovation Fund programme has been taken that aims to mobilise the research capacities of universities in support of national efforts to address the covid-19 crisis. Under the initiative, a rapid assessment and review mechanism has been established to analyse research and innovation proposals urgently.

All IP Offices, such as the Trademark Registry, Patent & Design Office, Copyright Office, their branch offices and IPO-Pakistan Regional, were closed for public dealing from 24 March 2020 to 10 May 2020 as a precautionary measure against the covid-19 pandemic. All statutory deadlines falling within the lockdown period for any applications claiming conventional priorities before the Patent Office were postponed till the first working day the work resumes after lifting of the lockdown. Also, all hearings scheduled in relation to trademarks, patents, designs and copyright matters were postponed from 25 March 2020 to 10 August 2020. Moreover, as per the order passed by the Hon'ble High Court of Sindh on 22 April 2020 in CP No. D-2176/2020, all scanned and unstamped documents were to be accepted for the time being subject to the filing of the signed version of the same documents as and when available.

The situation is subject to change, thus for the latest information one may refer to the IPO website <https://ipo.gov.pk/>.



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