

HELLO

Series of brief newsletters released by Bharucha & Co. on latest development of IP predominantly in Pakistan.

PAKISTAN STARTS RECEIVING INTERNATIONAL TRADE MARK APPLICATIONS THROUGH MADRID ROUTE FROM 24TH MAY 2021

After the accession to the Madrid Protocol in February 2021, Pakistan is finally about to enter the system with effect from May 24, 2021, allowing trademark owners in Pakistan the opportunity to file International Applications using the Madrid System.

In order to file an International Application, the trademark owners will need to have a basic application or registration in the 'home' country, which means that the trademark owner has either already registered or has filed an application with the Pakistan Trade Marks Registry (TMR). This registration or application is known as the Basic Mark.

The procedure of filing the International Application starts with filling and submitting the application on the relevant form (available at the WIPO website in English, French and Spanish). The International Application uses the NICE classification for classification of goods and services. After filing the International Application in the TMR, the TMR will check whether the application corresponds with the particulars of the applicant's Basic Mark, certify the application and forward it to World Intellectual Property Office (WIPO) in Geneva. The handling fees for the same is PKR 5,000 and is to be paid directly to WIPO as the TMR will not collect and forward the fees to WIPO.

There are four ways in which the fees may be submitted to WIPO i.e. Current Account at WIPO, Credit Card (in certain cases), Bank Transfer or Postal Transfer (within Europe only). Failure to pay the fees in full will result in the issuance of an Irregularity Notice which has a payment deadline of typically 3 months, after which the application is deemed to be considered abandoned. The fees payable in connection with an Application for International Registration comprises of the basic fees which is 653 Swiss Francs (approximately PKR 111,600), where no reproduction of the mark is in color and 903 Swiss Francs (approximately PKR 154,300) where any reproduction of the mark is in color, followed by a complementary fee of 100 Swiss Francs (approximately PKR 17,100) for each Contracting Party designated and a supplementary fee of 100 Swiss Francs (approximately PKR 17,100) for each class in excess of the first three classes of goods and services.

An International Registration is dependent on the Basic Mark for a period of five years from the date of the International Registration. If, in this period, the Basic Mark ceases to have effect, the Office of origin, in Pakistan's case the TMR, will have to notify WIPO of the facts and decisions affecting the Basic Mark and request for cancellation of the International Registration as such or in respect of the goods and services that are affected or not affected by the facts and decisions. The way out to make the International Application independent of its Basic Application is the transformation of the International Application into a National Application.

References:

<https://www.wipo.int/madrid/memberprofiles/result?countries=10320&datafields=9582,9583,9584,9580,9593>
https://www.wipo.int/madrid/en/how_to/file/file.html





Bharucha & Co.
Intellectual Property Attorneys

https://www.wipo.int/madrid/en/how_to/file/fees.html
<https://www.wipo.int/madrid/en/fees/sched.html>

