



The Legal 500 & The In-House Lawyer  
Comparative Legal Guide  
Pakistan: Intellectual Property

This country-specific Q&A provides an overview to intellectual property law in Pakistan.

It will cover intellectual property rights, licensing, enforcement, establishing infringement or liability, and challenges to intellectual property.

This Q&A is part of the global guide to Intellectual Property. For a full list of jurisdictional Q&As visit <http://www.inhouselawyer.co.uk/index.php/practice-areas/intellectual-property/>



**Country Author: Bharucha & Co.**

The Legal 500



**Mohammad Fazil Bharucha**

[mfb@bharuchaco.com](mailto:mfb@bharuchaco.com)

The Legal 500



**Samina Naz Siddiqui**

[samina.siddiqui@bharuchaco.com](mailto:samina.siddiqui@bharuchaco.com)

- 1. What different types of intellectual property rights exist to protect: (a) Inventions (e.g. patents, supplementary protection certificates, rights in trade secrets, confidential information and/or know-how); (b) Brands (e.g. trade marks, cause of action in passing off, rights to prevent unfair competition, association marks, certification marks, hallmarks, designations of origin, geographical indications, traditional speciality guarantees); (c) Other creations, technology and proprietary interests (e.g.**

**copyright, design rights, semiconductor topography rights, plant varieties, database rights, rights in trade secrets, confidential information and/or know-how).**

**(a) Inventions (e.g. patents, supplementary protection certificates, rights in trade secrets, confidential information and/or know-how);**

- Patents: In Pakistan, inventions can only be protected by patents, which are governed by the Pakistan Patents Ordinance, 2000.
- There is no legislation available for the protection of supplementary protection certificates, rights in trade secrets, confidential information and/or know-how in Pakistan.

**(b) Brands (e.g. trade marks, cause of action in passing off, rights to prevent unfair competition, association marks, certification marks, hallmarks, designations of origin, geographical indications, traditional speciality guarantees);**

- Trade marks, hallmarks
- Cause of action in passing off
- Right to prevent unfair competition (under competition laws)
- Collective marks
- Certification marks
- geographical indications (limited protection)

**(c) Other creations, technology and proprietary interests (e.g. copyright, design rights, semiconductor topography rights, plant varieties, database rights, rights in trade secrets, confidential information and/or know-how).**

- Copyright
- Designs
- Layout-Designs of Integrated Circuits
- Plant varieties (through Plants Breeders' Rights Act 2016)

2. **What is the duration of each of these intellectual property rights? What procedures exist to extend the life of registered rights in appropriate circumstances?**

Patents: The total term of a patent in Pakistan is 20 years from the date of basic filing date which is not extendable. Renewal fee is required to be paid for each year.

Trade Marks: A trade mark, collective mark and certification mark is registered for a period of ten years from the date of filing of application or priority date, which can be extended for further period of ten years each ad infinitum.

Copyright: The general rule is that copyright subsists in any literary, dramatic, musical and artistic work (other than a photograph) published within the lifetime of the author and until fifty years after the death of the author. Whereas, in case of a cinematographic work, copyright subsists until fifty years after the work is published.

Designs: is registered for a period of ten years from the date of filing of application or priority date, which can be extended for further two terms of ten years each.

3. **Who is the first owner of each of these intellectual property rights and is this different for rights created in the course of employment or under a commission?**

In case of patents the inventor is considered to be the first owner of intellectual property but it is different for the rights created in the course of employment or under a commission as it depends upon the terms of agreement/contract between the parties.

The first adopter/user is normally considered to be the first owner of the trade mark, collective mark and certification mark.

The author of a work is the first owner of copyright.

The applicant of a Design is the first owner of the Design.

4. **Which of the intellectual property rights described above are registered rights?**

Patents, Trade Marks, Copyright, Designs and Layout-Designs of Integrated Circuits are registered rights.

5. **Who can apply for registration of these intellectual property rights and, briefly, what is the procedure for registration?**

Any person claiming to be the owner of the respective right can apply for the registration intellectual property rights.

In Patents, once an application is filed, it is examined in seriatim. Examination is based on substantial and formal matters and multiple examination reports may be issued. If all the objections are met to the satisfaction of the Controller application is accepted though there is no fixed time frame for acceptance of an application. In case if no opposition is filed against the application within four months of publication, sealing fee is to be paid. Upon payment of sealing fee Letters Patent Document (grant letter) is issued.

General procedure for trade mark registration is filing an application on the prescribed form along with a notarized Power of Attorney. After filing of the application, it takes about a year for examination of an application. Upon examination, if no objection is raised against the Trade Mark, it is ordered to be advertised and proceeds to advertisement in the Trade Marks Journal. In case, there is any objection, the Registry issues examination report to which the applicant is required to file reply. Thereafter, if it is found satisfactory, the mark is ordered to be advertised. If it is not or any further clarification/explanation is required, which is usually the case, the application is fixed for hearing before a Tribunal. In case of satisfactory arguments during the hearing order for advertisement of the mark is issued. The purpose of advertisement is for

inviting opposition by third parties within the statutory period of two months (which is extendable for a further period of two months by filing request on prescribed form). In case the mark is opposed, the application will remain pending until the decision of the opposition. In case, no opposition is filed, the Registry will issue Demand Note for payment of registration fees and after the payment of fees, the mark proceeds to the registration.

In Designs, once an application is filed, it is examined in seriatim. Examination is based on substantial and formal matters and multiple examination reports may be issued. If all the objections are met to the satisfaction of the Registrar, application is registered.

Application for registration of copyright is made on prescribed form. For Registration of an artistic work an advertisement is published in any national Urdu or English language daily newspaper. If no objection to such registration is received by the Registrar within thirty days of the receipt of the application by him, he shall 'if satisfied about the correctness of the particulars given in the application, enter such particulars in the Register.

An application for the registration of a layout-design is filed only if a layout-design has not been commercially exploited or has been commercially exploited for not more than two years. The Controller shall, where the application complies with all the requirements, after such enquiry as he thinks fit, register the layout-design in the Register of Layout-Designs. The registration of a layout-design is then published in the official Gazette.

## **6. How long does the registration procedure usually take?**

There is no prescribed time for registration of IP rights as it depends upon the work load at the concerned departments.



**Do third parties have the right to take part in or comment on the registration process?**

7. Yes, third parties have right to oppose/object or comment on the registration process.

**8. What (if any) steps can the applicant take if registration is refused?**

The applicant may prefer an appeal against the refusal in High Court.

**9. What are the current application and renewal fees for each of these intellectual property rights?**

The official fee for filing a Trademark application is PKR 20,00 for a single class. Registration fee is PKR 6,000.

For renewals, the fee is PKR 10,000 per mark.

The schedule of approximate official cost for filing a Patent application and renewals (in PKR) is as follows:

Description	Fees
Application for Patent	4,500
For each sheet of specification in addition to 40 including sequence listing	150
For each claim in addition to 20	300
Renewal fee for each year from 5th to 8th year	6,000
Renewal fee for each year from 9th to 12th year	9,000
Renewal fee for each year from 13th to 16th year	12,000
Renewal fee for each year from 17th to 20th year	16,000

The approximate official cost for filing design application is PKR 450. For renewals, the fee is PKR 750.

The approximate official cost for filing Copyright application is PKR 1,000.

10. **What are the consequences of a failure to pay any renewal fees and what (if any) steps can be taken to remedy a failure to pay renewal fees?**

In case of failure to pay any renewal fees, the IP right is likely to be ceased/removed. As a remedy, restoration application within the prescribed time may be filed in some instances and if not filed the right ceases to exist.

11. **What are the requirements to assign ownership of each of the intellectual property rights described above?**

- Notarized Assignment document.
- Notarized Power of Attorney.

12. **Is there a requirement to register an assignment of any of these intellectual property rights and, if so, what is the consequence of failing to register?**

It is not mandatory to register an assignment of any of the intellectual property right. However in case of non-recordal of assignment, assignee may face difficulties while enforcing or defending its right in relation to third parties.

13. **What are the requirements to licence a third party to use each of the intellectual property rights described above?**

A right holder may license its rights through a license agreement, exclusive or otherwise in favour of any third party. The agreement must be in writing and duly executed by the grantor.



**14. Is there a requirement to register a licence of any of these intellectual property rights and, if so, what is the consequence of failing to register?**

It is not mandatory to register a licence. In case of non-recordal of license, both the licensor and licensee may have to produce other supporting evidence to demonstrate their relationship in case of any action concerning the IP right.

**15. Are exclusive and non-exclusive licensees given different rights in respect of the enforcement of the licensed IP, and if so, how do those rights differ?**

In case of trademarks the holder of an exclusive license has the like rights as the proprietor, whereas, in non-exclusive license, licensee has limited rights.

**16. Are there criminal sanctions for infringement of any intellectual property rights, and if so, what are they and how are they invoked?**

Yes, there are criminal sanctions for infringement of trade mark and copyright in the form of imprisonment or fine or both in different descriptions.

Criminal action can be invoked by lodging a complaint with the relevant enforcement agencies.

**17. What other enforcement options are available for each of the intellectual property rights described above? For example, civil**

**court proceedings, intellectual property office proceedings, administrative proceedings, alternative dispute resolution.**

Yes, other enforcement options are available such as civil proceedings, intellectual property office proceedings. A civil suit for Infringement and passing-off can be filed before Intellectual Property Tribunal of jurisdiction. Complaint can also be filed in the Competition Commission of Pakistan.

**18. What is the length and cost of such procedures?**

There is no prescribed time but it usually takes about five to six years for a decision. The court fee is PKR 15,000.

**19. Where court action is available, please provide details of which court(s) have jurisdiction, how to start proceedings, the basics of the procedure, the time to trial, the format of the trial, the time to judgment and award of relief and whether any appeal is available.**

Civil suits and criminal cases can be initiated before Intellectual Property Tribunals having jurisdiction which is determined by the Defendant's place of business or residence.

The complete process of filing the suit is that it is filed along with interlocutory injunction application. After preliminary hearing, it is the discretion of the court either to grant interim injunction restraining the infringer to use the mark or issue notice to the defendant for appearing in Court. If the infringer avoids appearing in court on the said notices the court passes orders for publication of the notice in the newspaper. If the infringer attends the court usually grants time to the infringer for filing defence and objection to the injunction application and then hearing is fixed to decide the injunction application. After decision on the injunction application, the main suit proceeds, during which the court records evidence of the parties, fix it for final arguments and decision.


The whole procedure takes a long time but if injunction application is allowed, then such injunction persists till final decision in the suit.

Reliefs may be sought such as injunction, delivery of infringing materials, rendition of accounts and damages.

In Criminal matters, the Tribunal issues bailable warrant of arrest against the infringer. Yes, appeal is available to any party who is aggrieved by any order or judgment of the court.

20. **What customs procedures are available to stop the import and/or export of infringing goods?**

Right holders with valid grounds for suspicion that goods being imported into Pakistan are infringing its rights under the copyright or trademarks laws, may make an application at the time of arrival of suspected goods at the notified customs station on the prescribed format to the Director of IPR Enforcement having jurisdiction, requesting for initiating enforcement action against such goods likewise when such goods infringe the provision of patents, designs and integrated circuit layout design laws, the right holder or the collector of customs, as the case may be, shall follow the same course of action as well. The applicant along with the application, is required to submit all prescribed documents such as, certified copy of the registration certificate; copies of national identity card (of individual), national tax certificate, passport and a notarized undertaking on prescribed format indemnifying the custom authorities against all liabilities. The applicant shall also submit a bank guarantee on prescribed format from a schedule bank (for an amount of Pakistani Rupees five hundred thousand or twenty-five percent of the value of suspected infringing goods whichever is higher for compensation of the losses likely to be suffered by the owner of imported goods due to false application and payment of various expenses during the process such charges incurred on account of investigating, demurrage, detention, warehousing, etc.).



**Are any non-court enforcement options or dispute resolution mechanisms mandatory in respect of intellectual property disputes in any circumstances? If so, please provide details.**

There are no mandatory non-court enforcement options or dispute resolution mechanisms available in respect of intellectual property disputes.

22. **What options are available to settle intellectual property disputes?**

Disputes may be settled through National Centre for Dispute Resolution.

23. **What is required to establish infringement of each of the intellectual property rights described above? What evidence is necessary in this context?**

In case of infringement of product patent, it is essential for the plaintiff to establish that the product used by the defendant is identical or similar to the product patented by the plaintiff. However, in case of process patent, the onus of proof to establish that the process used by infringer to obtain the product is identical to the product of the patented process.

To establish infringement of a registered trade mark, the impugned mark must be identical or similar to the registered mark.

Any unauthorised publication of the copyrighted work will constitute infringement. It must be established that there has been a piracy of design.

In any case, the documentary evidence has to be filed by both the parties to establish infringement or non-infringement of IP rights.

24. **How does the court acquire any necessary information (fact or**

**technical) and in what circumstances does it do so? In particular a) Is there a technical judge, a judge with technical experience, a court appointed expert, an expert agreed by the parties, and/or parties' expert witness evidence? b) What mechanisms are available for compelling the obtaining and protecting of evidence? Is disclosure or discovery available?**

**a) Is there a technical judge, a judge with technical experience, a court appointed expert, an expert agreed by the parties, and/or parties' expert witness evidence?**

In any suit for infringement or in any proceedings before the Tribunal, it may at any time, and whether or not an application has been made by any party for the purpose, appoint an independent adviser to assist the Tribunal or to inquire and report upon any such question of fact or of opinion, not involving a question of interpretation of law, as it may formulate for the purpose.

**b) What mechanisms are available for compelling the obtaining and protecting of evidence? Is disclosure or discovery available?**

The Tribunal can order relevant documents or materials to be provided to an adversary.

25. **How is information and evidence submitted to the court scrutinised? For example, is cross-examination available and if so, how frequently is it employed in practice?**

Cross examination of witnesses takes place during the trial.

26. **What defences to infringement are available?**

Patents: The defendant can challenge validity of the patent on grounds such as:

- the applicant obtained the invention from the person of whom the opponent is the legal

representative;

- invention is not patentable, unclear and incomplete specification, unclear claims or beyond the scope of the disclosure;
- specification claiming invention other than that described in provisional specification and such other invention either forms the subject of an application made by the opponent for a patent which 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;
- damages are not to be awarded against a defendant who proves that at the date of infringement he was not aware and had no reasonable ground for supposing, that the patent existed and a person shall not be deemed to have been aware or to have had reasonable grounds for supposing as aforesaid by reason only of the application to an article of the word 'patent', "patented", or any word or words expressing or implying that a patent has been obtained for the article, unless the number of the patent accompanied the word or words in question.

Trade Marks: A claim of infringement can be rebutted by virtue of the fact that the trade mark is used in good faith e.g. it is the person's name or the name of the person's place of business, so long as such use does not result in a likelihood of confusion or otherwise interfere with an existing trade mark or other property right or the name of the predecessor in business of the person or the name of the predecessor's place of business; the person uses a mark in good faith to indicate the kind, quality, quantity, intended purpose, value, geographical origin, or some other characteristic, of goods or services or the time of production of goods or of the rendering of services; the person uses the trade mark in good faith to indicate the intended purpose of goods, in particular as accessories or spare parts, or services; or the person uses the trade mark for the purposes of comparative advertising.

If the right to the use of a trade mark is subject to any conditions or limitations entered on the Register, such right shall not be deemed to be infringed by the use of any such trade mark in any mode, in relation to goods to be sold or otherwise traded in or in relation to services provided by, in any place, or in relation to goods or services to be exported to any market, or in any other circumstances to which, having regard to any such limitations, the registration does not extend. Where registration of a trade mark is subject to a disclaimer, a person shall not infringe the trade mark by using a disclaimed part of the trade mark.

Copyright: The defence available to the infringer in copyright includes fair dealing, such as for educational purposes, judicial proceedings and legislative proceedings etc.

Designs: All grounds available to a person seeking cancellation of a design may be adopted as a defence in infringement proceedings such as the specific substantive requirements not fulfilled, contrary to public order or morality and/or person whose name the industrial design is registered has no right to it.

27. **Who can challenge each of the intellectual property rights described above?**

Any interested party may challenge the IP rights and commence invalidation proceedings.

28. **When may a challenge to these intellectual property rights be made (e.g. during any registration process or at any time during the subsistence of the right)?**

A challenge to the IP rights may be made after publication as well as during the subsistence of the right.

29. **Briefly, what is the forum and the procedure for challenging each of these intellectual property rights and what are the grounds for a finding of invalidity of each of these intellectual property rights?**

Intellectual Property rights can be challenged before the relevant IP offices or in court.

In order to challenge an IP right in the relevant IP office an application is made in the



prescribed form together with a statement of the grounds. Whereas, to challenge such a right through the court a petition for invalidation along with affidavit and evidence is filed.

A patent may be declared invalid if it was registered in breach of the same grounds such as the patent was wrongfully obtained, the invention is not patentable, the disclosure is unclear and incomplete, claims are unclear, claims extend beyond the scope as originally filed, the invention is not fairly based, the invention is not novel.

A trade mark may be declared invalid if it was registered in breach of either absolute grounds for refusal of registration or relative grounds for refusal of registration.

30. **Are there any other methods to remove or limit the effect of any of the intellectual property rights described above, for example, declaratory relief or licences of right?**

Declaratory reliefs i.e. removing or limiting the effect of IP rights can be granted by the court upon filing a petition by an aggrieved party. Furthermore, the IP rights may also be restricted/transferred to the licensee by entering into a license agreement.

31. **What remedies (both interim and final) are available for infringement of each of the intellectual property rights described above?**

In all intellectual property right matters the reliefs which a court may grant in any suit for infringement can be an interim injunction followed by permanent injunction subject to such terms, if any, as the court thinks fit and at the option of plaintiff, either damages or account of profits.

**32. What are the costs of enforcement proceedings and is any kind of costs recovery available for successful parties? Is there a procedural mechanism enabling or requiring security for costs?**

The costs generally consist of two heads, one being the official fee and the other being professional fee.

Official fees(in PKR) for various aspects are given hereunder:

Description	Patents	Trade Marks	Copyright	Designs
Notice of opposition/objection	1,500	6,000	3,000	750
A counter-statement in answer to a notice of opposition	Nil	1,000	Nil	Nil
Notice of intention to attend hearing	1,500	400	Nil	750
Application for cancellation	Nil	400	Nil	750

As far as professional fee is concerned it depends upon the matter and the forum chosen. There is no standard fee for such procedures and the same is decided by each firm/individual handling the matter.