

ORDINANCE No. XIX OF 2001.

AN

ORDINANCE

to amend and consolidate the law relating to trade marks

WHEREAS it is expedient to amend and consolidate the law relating to trade marks and unfair competition and to provide for registration and better protection of trade marks and for the prevention of the use of fraudulent marks, and for matters ancillary thereto or connected therewith;

AND WHEREAS the National Assembly and the Senate stand suspended in pursuance of the Proclamation of the fourteenth day of October, 1999, and the Provisional Constitution Order No.1 of 1999;

AND WHEREAS the President is satisfied that circumstances exist which render it necessary to take immediate action;

NOW, THEREFORE, in pursuance of the Proclamation of Emergency of the fourteenth day of October, 1999, and the Provisional Constitution Order No.1 of 1999, read with the Provisional Constitution (Amendment) Order No.9 of 1999, and in exercise of all powers enabling him in that behalf, the President of the Islamic Republic of Pakistan is pleased to make and promulgate the following Ordinance:-

CHAPTER I.-PRELIMINARY

1. **Short title, extent and commencement.**- (1) This Ordinance may be called the Trade Marks Ordinance, 2001.

(2) It extends to the whole of Pakistan.

(3) This section and section 132 shall come into force at once and the remaining provisions of the Ordinance shall come into force on such date as the Federal Government may, by notification in the official Gazette, appoint in this behalf.

2. **Definitions.**- In this Ordinance, unless there is anything repugnant in the subject or context,-

- (i) "advertising" means the making of representation in any form in connection with a trade, business or profession in order to promote the supply of goods or services;
- (ii) "assignment" in relation to a trade mark, means an assignment in writing by act of the parties concerned;
- (iii) "authorized user" means a person authorised to use a trade mark in relation to goods or services under the control of the owner of the trade mark and includes a licensee;
- (iv) "certification mark" means a certification mark as defined in sub-section (1) of section 83;
- (v) "collective mark" means a collective mark as defined in sub-section (1) of section 82;
- (vi) "comparative advertisement" means an advertisement which explicitly or by implication identifies a competitor or goods or services offered by a competitor;
- (vii) "Convention application" means an application as defined in sub-section (1) of section 25;
- (viii) "Convention country" means a Convention country as defined in clause (b) of section 85;
- (ix) "counterfeit trade mark goods" means any goods including packaging bearing without authorization a trade mark which is identical to the trade mark validly registered in respect of such goods or which cannot be distinguished in its essential aspects from such a trade mark and thereby infringes the rights of the owner of the trade mark under this Ordinance;
- (x) "date of filing" means-
 - (a) in relation to an application for the registration of a trade mark, the day on which the application is filed pursuant to sub-section (1) of section 23; or
 - (b) in relation to a divisional application for the registration of a trade mark, the day on which the initial application within the meaning of sub-section (1) of section 32 is filed; or
 - (c) in relation to an application to provide temporary protection during exhibition, the day referred to in sub-section (1) of section 26; or
 - (d) in relation to a Convention application, the day referred to in clause (a) of sub-section (2) of section 25;
- (xi) "date of registration", in relation to the registration of a trade mark in respect of particular goods or services, means the day from which the registration of the trade mark in respect of those goods or services is taken to have had effect under sub-section (3) of section 33;

- (xii) "deceptively similar" in relation to a trade mark, means such near resemblance between it and another trade mark that it is likely to deceive or cause confusion;
- (xiii) "dilution" means the lessening of the capacity of a well known trade mark to identify and distinguish the goods or services, regardless of the presence or absence of competition between owner of the well known trade mark or other parties, or likelihood of confusion or deception;
- (xiv) "District Court" has the meanings assigned to that expression by the Code of Civil Procedure, 1908 (Act V of 1908);
- (xv) "divisional application" means a divisional application as defined in sub-section (1) of section 32;
- (xvi) "domain name" means the domain name as defined in sub-section (1) of section 84;
- (xvii) "earlier trade mark" means an earlier trade mark as defined in sub-section (1) of section 18;
- (xviii) "false trade description" means-
 - (a) a trade description which is untrue or misleading in a material respect as regards the goods or services to which it is applied;
 - (b) any alteration of a trade description as regards the goods or services to which it is applied whether by way of addition, effacement or otherwise where that alteration makes the description untrue or misleading in a material respect;
 - (c) any mark or arrangement or combination thereof when applied-
 - (i) to goods in such a manner as to be likely to lead persons to believe that the goods are the manufacture or merchandise of some person other than the person whose merchandise or manufacture they really are; or
 - (ii) in relation to services in such a manner as to be likely to lead persons to believe that the services are provided or rendered by some person other than the person whose services they really are;
 - (d) any false name or initials of a person applied to goods or services in such a manner as if such name or initials were a trade description in any case where the name or initials,-
 - (i) is or are not a trade mark or part of a trade mark;
 - (ii) is or are identical with or deceptively similar to the name or initials of a person carrying on business in connection with goods or services of the same description or both and who has not authorized the use of such name or initials; and

- (iii) is or are either the name or initials of a fictitious person or of some person not bona fide carrying on business in connection with such goods or services; and the fact that a trade description is a trade mark or part of a trade mark shall not prevent such trade description being a false trade description within the meaning of this Ordinance; or
- (e) to any false name, initials or description of a person used in relation to goods or services in a manner to suggest that the said person authenticates or guarantees the nature or fitness for the purpose of the goods or services;
- (xix) "geographical indication". in relation to goods originating in a particular country or in a region or locality of that country, means a mark recognized in that country as a mark indicating that the goods-
- (a) originated in that country, region or locality; and
- (b) have a quality, reputation or other characteristic attributable to their geographical region;
- (xx) "goods" means anything which is subject of trade, commerce or manufacture;
- (xxi) "Journal" means the Trade Marks Journal published under the authority of the Registrar;
- (xxii) "licensee" means a person using a registered trade mark by virtue of a transaction;
- (xxiii) "limitations" with its grammatical variations, means any limitations of the exclusive right to the use of a trade mark given by the registration of a person as proprietor thereof, including limitations of that right as to mode of use, as to use in relation to goods or services to be sold or otherwise traded in within Pakistan, or as to use in relation to goods or services to be exported to any market outside Pakistan;
- (xxiv) "mark" includes, in particular, a device, brand, heading, label, ticket, name including personal name, signature, word, letter, numeral, figurative element, colour, sound or any combination thereof;
- (xxv) "misleading advertising" means any advertising which in any way, including its presentation, deceives or is likely to deceive the persons to whom it is addressed or whom it reaches and which, by reason of its deceptive nature, is likely to affect their behaviour or which, for those reasons, injures or is likely to injure a competitor;
- (xxvi) "name" includes any abbreviation of name;
- (xxvii) "notify" means to notify in the Journal;
- (xxviii) "opponent" in relation to the registration of a trade mark, means the person who has filed under sub-section (2) of section 28, a notice of opposition to the registration of the trade mark;

- (xxix) "packaging" includes, in particular, any case, box, container, covering, folder, receptacle, vessel, casket, bottle, wrapper, band, reel, frame, capsule, cap, lid, stopper and cork;
- (xxx) "Paris Convention" means the Paris Convention as defined in clause (a) of section 85;
- (xxxi) "permitted use", in relation to a trade mark, means the use of the trade mark by an authorised user;
- (xxxii) "predecessor in title", in relation to a person who claims to be the proprietor of a trade mark, means-
- (a) if the trade mark was assigned or transmitted to one or more than one persons before it was assigned or transmitted to the first-mentioned person, that other person or any of those other persons; or
 - (b) if sub-clause (a) does not apply, the person who assigned the trade mark, or from whom the trade mark was transmitted to the first-mentioned person;
- (xxxiii) "prescribed" means prescribed by rules made, in relation to proceedings before a High Court, by such High Court, and in other cases, made under this Ordinance;
- (xxxiv) "proprietor", in relation to a registered trade mark, means the person who is for the time being entered in the Register as proprietor of that trade mark;
- (xxxv) "proprietor of earlier right" in relation to a trade mark, means a person entitled to prevent the use of a trade mark;
- (xxxvi) "Register" means the Register of Trade Marks maintained under sub-section (1) of section 10;
- (xxxvii) "Registrar" means the Registrar of Trade Marks appointed under section 7;
- (xxxviii) "registered", with its grammatical variations, means registered under this Ordinance or the Trade Marks Act, 1940 (V of 1940);
- (xxxix) "registered trade mark" means a trade mark which is actually on the Register:
- (xl) "rules" means the rules made under this Ordinance;
 - (xli) "Schedule" means a Schedule to this Ordinance;
 - (xlii) "seized goods" means goods seized under section 56;
 - (xliii) "service" means service of any description which is made available to users or potential users and includes the provision for services in connection with business of any industrial or commercial nature, and without limitation, includes banking, retailing, communication including telecommunication, education, law, financing, insurance, chit funds, real estate, transport, storage, material treatment, processing, supply of goods including electrical or other energy, boarding, lodging, entertainment, amusement, construction, repair, conveying of news or information and advertising;
 - (xliv) "similar goods" includes goods which are of the same description;
 - (xlv) "similar services" include services which are of the same description;

(xlvi) "trade description" means any description, ~~statement or other~~ indication, ~~direct or~~ indirect-

- (a) as to the number, quantity, measure, gauge or weight of any goods; or
- (b) as to the standard of quality of any goods or ~~services according to~~ classification commonly used or recognized in the trade; or
- (c) as to fitness for the purpose, strength, performance or behaviour of any goods, being drugs or foods; or
- (d) as to the place or country in which or the time at which any ~~goods or services~~ were made, produced or provided, as the case may be; or
- (e) as to the name and address or other indication ~~of the~~ identity of the manufacturer or of the person providing the services or of the persons for whom the goods are manufactured or services provided; or
- (f) as to the mode of manufacture or producing any goods or providing services; or
- (g) as to the material of which any goods are composed; or
- (h) as to any goods being the subject of an existing patent, privilege or copyright, and includes-
 - (a) any description as to the use of any mark which according to the custom of the trade is commonly taken to be an indication of any of the above matters;
 - (b) any description as to any imported goods contained in any bill of entry or shipping bill; and
 - (c) any other description which is likely ~~to be~~ misunderstood or mistaken for all or any of the said matters;

(xlvii) "trade mark" means any mark capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings;

(xlviii) "Trade Marks Registry" means the Trade Marks Registry established under section 9;

(xlix) "trade names" means names used by a person to denote his trade or calling and includes

firms' and companies' names:

- (i) "transmission" means transmission by operation of law, devolution on the personal representative of a deceased person and any other mode of transfer, not being assignment;
- (ii) "tribunal" means the Registrar or, as the case may be, the High Court or a District Court before which the proceedings concerned are pending;

- (lii) "unfair competition" means an unfair competition as defined in section 67; and
- (liii) "word" includes an abbreviation of a word.

3. Goods and services when associated, etc.- (1) For the purposes of this Ordinance-

- (a) goods and services shall be associated with each other if it is likely that those goods might be sold or otherwise traded in and those services might be provided by the same business and so with descriptions of goods and descriptions of services;
- (b) a trade mark shall be taken used on goods if the trade mark is used on any goods including second-hand goods, material or thing if it is woven in, impressed on, worked into, or affixed or annexed to, the goods, material or thing.
- (c) a trade mark shall be taken used in relation to goods or services if the trade mark is used-
 - (i) on any covering, packaging, document, label, band, ticket, reel or thing in or with which the goods are, or are intended to be, dealt with or provided in the course of trade;
 - (ii) in a manner likely to lead persons to believe that it refers to, describes or designates the goods or services;
 - (iii) on a signboard or in an advertisement; or
 - (iv) in an invoice, list, catalogue, business letter, business paper, price list or other commercial document.

(2) Where the owner of a trade mark exercises quality control over goods or services-

- (a) dealt with or provided in the course of trade by another person; and
- (b) in relation to which the trade mark is used.

the other person shall be taken to use the trade mark in relation to the goods or services under the control of the owner.

(3) Where another person deals with or provides, in the course of trade, goods or services in relation to which a trade mark is used and the owner of the trade mark exercises financial control over the other person's relevant trading activities, the other person shall be taken to use the trade mark in relation to the goods or services under the control of the owner.

4. Reference to use of a trade mark, etc.-In this Ordinance, unless the context otherwise requires, any reference-

- (a) to use of a trade mark shall include reference to use of the trade mark in relation to goods, as well as, on goods;
- (b) to use of a trade mark in relation to goods shall include reference to use of the trade mark on goods, or vice versa;

- (c) to the Registrar shall be construed as including a reference to any officer when discharging the functions of the Registrar in pursuance of sub-section (2) of section 7; and
- (d) to the Trade Marks Registry shall be construed as including a reference to any branch of the Trade Marks Registry.

5. Decision by tribunal regarding use of a trade mark.- (1) A tribunal may, having regard to the circumstances of a case, if it thinks fit, decide that a person has used a trade mark if it is established that the person has used the trade mark with additions or alterations that do not substantially affect the identity of the trade mark.

Explanation.- For removal of doubts, it is clarified that if a trade mark consists of any combination of any letter, word, name or numeral, any aural representation of the trade mark shall be, for the purposes of this Ordinance, a use of the trade mark.

(2) The application in Pakistan of a trade mark to goods or services to be exported from Pakistan and any other act done in Pakistan in relation to goods or services to be so exported which, if done in relation to goods or services to be sold or otherwise traded in within Pakistan would constitute use of a trade mark therein, shall be deemed to constitute use of the trade mark in relation to those goods or services for any purpose for which such use is material under this Ordinance or any other law for the time being in force.

(3) The use of a registered trade mark in relation to goods or services between which and the person using the mark any form of connection in the course of trade subsists shall not be deemed to be likely to cause deception or confusion on the ground only that the mark has been or is used in relation to goods or services between which and the person using the mark or any predecessor in his business, different form of connection in the course of trade subsisted or subsists.

6. Application of other laws not barred.- The provisions of this Ordinance shall be in addition to, and not in derogation of any other law for the time being in force.

CHAPTER II.- REGISTRAR, TRADE MARKS REGISTRY AND REGISTRATION OF TRADE MARKS

7. Appointment of Registrar and other officers.- (1) The Federal Government may by notification in the official Gazette, appoint an officer who shall be called the Registrar of Trade Marks.

(2) The Federal Government may appoint such other officers with such designations as it deems fit for performing under the superintendence and direction of the Registrar, such function of the Registrar, under this Ordinance as he may, from time to time, authorise them to discharge.

8. Power of Registrar to review, withdraw or transfer cases.- The Registrar may, by order in writing-

- (a) review any function, matter, case or decision of any officer; or
- (b) withdraw any function, matter or case from any officer or staff.

and deal with such function, matter or case himself either *de novo* or from the stage it was so withdrawn, or transfer the same to another officer or staff at any stage.

9. Trade Marks Registry and branches thereof.- (1) For the purposes of this Ordinance, there shall be established a Trade Marks Registry:

The Trade Marks Registry established under the Trade Marks Act, 1940 (V of 1940), shall be the Trade Marks Registry for the purposes of this Ordinance.

(2) For the purpose of facilitating registration of trade-marks, there may be established at such places, as the Federal Government may think fit, branch offices of the Trade Marks Registry.

(3) There shall be a seal of the Trade Marks Registry.

10. Register of Trade Marks.-(1) For the purposes of this Ordinance, a record called the Register of Trade Marks shall be kept at the Trade Marks Registry wherein shall be entered particulars of all registered trade marks with the names, addresses and description of the proprietors, notifications of assignments and transmissions, the names, addresses and descriptions of licensees, disclaimers, conditions, limitations and such other matters relating to registered trade marks as may be prescribed, but there shall not be entered in the Register any notice of any trust express, implied or constructive, nor shall any such notice be receivable by the Registrar.

(2) Subject to the superintendence and direction of the Federal Government, the Register shall be kept under the control and management of the Registrar.

(3) The Register may be kept in whole, or in part, by using a computer any *bona fide* record of a particular or other matter made by using a computer for the purposes of keeping the Register shall, for the purposes of this Ordinance, constitute an entry in the Register.

(4) There shall be kept at each branch office of the Trade Marks Registry, a copy of the Register and such of the other documents as the Registrar may, by notification in the Journal, direct:

Provided that if the Register in whole, or any part thereof, is kept by using a computer and access to a computer terminal from which a person in a branch office can read a screen, or obtain a printed copy of, the particulars or other matters recorded in the Register or that part of the Register, requirement under this sub-section of keeping a copy of the Register at that branch office shall be satisfied.

(5) The Register shall at all convenient times be open to the inspection of the public subject to such conditions and restrictions as may be prescribed.

(6) If the Register in whole, or any part thereof, is kept by using a computer, the requirements of sub-section (5) shall be satisfied if a person who wants to inspect the Register or that part of the Register is given access to a computer terminal from which he can read a screen, or obtain a printed copy of, the particulars or other matters recorded in the Register or that part of the Register.

11. Evidence of entries in Register and things done by Registrar.- (1) A printed, written or computer generated copy of any entry in the Register purporting to be certified by the Registrar and sealed with the seal of the Trade Marks Registry, shall be admitted in evidence in all High Courts or District Courts in Pakistan and in all proceedings without further proof or production of the original.

(2) A certificate purporting to be issued under the hand of the Registrar as to any entry, matter or thing that he is authorised by this Ordinance or the rules to make or do shall be *prima facie* evidence of the entry having been made and of the contents thereof, or of the matter or thing having been done or not done.

12. Classification of goods and services.- (1) A trade mark may be registered in accordance with the provisions of this Ordinance in respect of-

- (a) goods;
- (b) services; or
- (c) both goods and services,

comprised in the prescribed classification of goods or services in accordance with the international classification of goods and services.

(2) Any question arising as to the class within which any goods or services fall shall be determined by the Registrar whose decision in the matter shall be final.

13. Publication of an alphabetical index of classification of goods and services.-(1) The Registrar may publish in the prescribed manner an alphabetical index of classification of goods and services.

(2) Where any goods or services are not specified in the alphabetical index of goods and services, published under sub-section (1), the classification of goods and services shall be determined by the Registrar in accordance with sub-section (2) of section 12.

14. **Absolute grounds for refusal of registration.**- (1) The following shall not be registered, namely:-

- (a) marks which do not satisfy the requirements of clause (xlvii) of section 2;
- (b) trade marks which are devoid of any distinctive character;
- (c) trade marks which consist exclusively of marks or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services; and
- (d) trade mark which consist exclusively of marks or indications which have become customary in the current language or in the *bona fide* and established practices of the trade;

Provided that a trade mark shall not be refused registration by virtue of clause (b), (c) or (d) if, before the date of application for registration, it has, in fact, acquired a distinctive character as a result of the use made of it or is a well known trade mark.

(2) A mark shall not be registered as a trade mark if it consists exclusively of-

- (a) the shape which results from the nature of the goods themselves;
- (b) the shape of goods which is necessary to obtain a technical result; or
- (c) the shape which gives substantial value to the goods.

(3) No trade mark nor any part thereof in respect of any goods or services shall be registered which consists of, or contains, any scandalous design, or any matter the use of which would-

- (a) by reasons of its being likely to deceive or to cause confusion or otherwise, be disentitled to protection in a High Courts or a District Court;
- (b) be likely to hurt the religious susceptibilities of any class of citizens of Pakistan, per se, or in terms of goods or services it is intended to be so registered; or
- (c) be contrary to any law, for the time being in force, or morality.

(4) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

15. **Limitation as to colour.**- (1) A trade mark may be limited wholly or in part to one or more specified colours, and any such limitation shall be taken into consideration by any tribunal having to decide on the distinctive character of the trade mark.

(2) So far as a trade mark is registered without limitation of colour it shall be deemed to be registered for all colours.

16. **Use of names of chemical compounds barred.**- (1) No word which is the commonly used and accepted name of any single chemical element or single chemical compound as distinguished from a mixture or which is declared by the World Health Organization and notified in the prescribed manner by the Registrar, from time to time, as an international non-proprietary name shall be registered as a trade mark in respect of a chemical substance or preparation, and any such registration shall, notwithstanding anything in section 44, be deemed for the purposes of section 98 to be an entry made in the Register without sufficient cause or an entry wrongly remaining on the Register, as the circumstances may require.

(2) This section shall not apply to a word which is used to denote only a brand or make of the element or compound as made by the proprietor or a licensee of the trade mark, as distinguished from the element or compound as made by others, and in association with a suitable name or description open to the public use.

17. **Relative grounds for refusal of registration.**- (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services, for which the trade mark is applied for, are identical with the goods or services for which the earlier trade mark is registered.

(2) A trade mark shall not be registered because-

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is registered; or
- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is registered,

and there exists a likelihood of confusion on the part of the public which includes the likelihood of association with the earlier trade mark.

(3) A trade mark which-

- (a) is identical with or similar to an earlier trade mark; and
- (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in Pakistan and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

(4) A trade mark shall not be registered if, or to the extent that, its use in Pakistan is liable to be prevented-

- (a) by virtue of any law, in particular, the law of passing off, protecting an unregistered trade mark or other mark used in the course of trade; or

- (b) by virtue of an earlier right other than those referred to in sub-sections (1), (2) and (3) or clause (a) of this sub-section, in particular by virtue of the law of copyright, design right or registered designs.

(5) Nothing in this section shall prevent the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration.

(6) Where separate applications are made by different persons to be registered as proprietors respectively of trade marks which are identical or nearly resemble each other, in respect of the same goods or description of goods, the Registrar, if thinks fit, may refuse to register any of them until their rights have been determined by the High Court or a District Court.

18. Meaning of "earlier trade mark".- (1) In this Ordinance, "earlier trade mark" means-

- (a) a registered trade mark or a Convention trade mark as per the Paris Convention which has a date of application for registration earlier than that of the trade mark in question, taking account, where appropriate, of the priorities claimed in respect of the trade marks;
- (b) a trade mark filed under sub-section (1) of section 26; or
- (c) a trade mark which, on the date of application for registration of the trade mark in question, or where appropriate, of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark.

(2) References in this Ordinance to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of clause (a) or (b) of sub-section (1), subject to its being so registered.

(3) A trade mark shall, within clause (a) or (b) of sub-sections (1) whose registration expires, continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry unless the Registrar is satisfied that there was no *bona fide* use of the mark during two years immediately preceding the expiry.

19. Raising of relative grounds in case of honest concurrent use.- (1) Where on application for the registration of a trade mark it appears to the Registrar that there is-

- (a) an earlier trade mark in relation to which the conditions set out in sub-section (1), (2) or (3) of section 17 obtain; or

- (b) an earlier right in relation to which the condition set out in sub-section (4) of section 17 is satisfied,

but the applicant proves to the satisfaction of the Registrar that there has been honest concurrent use of the trade mark for which registration is sought, the Registrar shall not refuse the application by reason of the earlier trade mark or other right unless objection on that ground is raised in opposition proceedings by the proprietor of that earlier trade mark or other earlier right.

(2) For the purposes of this section, "honest concurrent use" means such use in Pakistan, by the applicant or with his consent, as would formerly have amounted to honest concurrent use for the purposes of sub-section (2) of section 10 of the Trade Marks Act, 1940 (V of 1940).

(3) Nothing in this section shall affect-

- (a) the refusal of registration on the grounds mentioned in section 14; or
- (b) the making of an application for a declaration of invalidity under sub-section (2) of section 80.

20. Registration of parts of trade marks and of trade marks as a series.- (1) Where the proprietor of a trade mark claims to be entitled to exclusive use of any part thereof separately, he may apply to register the whole and the part as separate trade marks.

(2) Each such separate trade mark shall satisfy all the conditions applying to, and have all the incidents of, an independent trade mark.

(3) Where a person claiming to be the proprietor of several trade marks in respect of the same goods or services or description of goods or description of services which while resembling each other in the material particulars thereof are yet different in respect of-

- (a) statements or representations as to the goods or services in relation to which the trade marks are respectively used or proposed to be used;
- (b) statements or representations as to number, price, quality or names of places;
- (c) other matter of a non-distinctive character which does not substantially affect the identity of the trade mark; or
- (d) the colour or any part of the trade mark.

seeks to register those trade marks, they may be registered as a series in one registration.

21. Registration subject to disclaimer.- If a trade mark contains-

- (a) any part not separately registered as a trade mark in the name of the proprietor;
- (b) any part for the separate registration of which no application has been made; or

(c) any matter common to the trade, or otherwise of a non-distinctive character; the tribunal, in deciding whether the trade mark shall be entered or shall remain on the Register, may require, as a condition of its being on the Register, that the proprietor shall either disclaim any right to the exclusive use of such part or of all or any portion of such matter, as the case may be, to the exclusive use of which the tribunal holds him not to be entitled, or make such other disclaimer as the tribunal may consider necessary for the purpose of defining the rights of the proprietor under the registration:

Provided that no disclaimer shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made.

CHAPTER III.- PROCEDURE FOR, AND DURATION OF, REGISTRATION

22. Application for registration.- (1) An application for registration of a trade mark shall be made in writing to the Registrar in the prescribed manner.

(2) Without limiting the particulars that may be included in an application, the application shall contain-

- (a) a request for registration of a trade mark;
- (b) full name and address of the applicant;
- (c) a statement of goods or services in relation to which it is sought to register the trade mark;
- (d) international classification of goods or services;
- (e) a representation of the trade mark; and
- (f) full name, address and contact details of agent, in case the application, on behalf of the applicant, is made by his agent.

(3) The application shall state that the trade mark is being used by the applicant, or with his consent, in relation to goods or services, or that he has a *bona fide* intention that it should be used.

(4) The Registrar may refuse to admit an application if it does not contain all the particulars required under sub-sections (2) and (3).

(5) The application shall be subject to the payment of the application fee as may be prescribed.

23. Date of filing.- (1) The date of filing of an application for registration of a trade mark shall be the date on which documents containing particulars specified in section 22 are furnished to the Registrar.

(2) References in this Ordinance to the date of application for registration shall be to the date of filing of the application.

24. Co-ownership of trade mark.- (1) Where the relations between two or more persons interested in a trade mark are such that none of them is entitled to use the trade mark except-

- (a) on behalf of both or all of them; or
- (b) in relation to goods or services or both with which all of them are connected in the course of trade,

the persons may jointly apply for its registration under section 22.

(2) Where a trade mark is registered in the name of two or more persons jointly, each of them shall be entitled, subject to any agreement to the contrary, to an equal undivided share in the registered trade mark.

(3) The following provisions shall apply where two or more persons are co-proprietors of a registered trade mark, by virtue of sub-section (2) or otherwise.

(4) Subject to any agreement to the contrary, each co-proprietor shall be entitled, by himself or his agents, to do for his own benefit and without the consent of or the need to account to the others, any act which would otherwise amount to an infringement of the registered trade mark.

(5) One co-proprietor may not, without the consent of the other or others,

- (i) grant a licence to the use of the registered trade mark; or
- (ii) assign or charge his share in the registered trade mark.

(6) Infringement proceedings may be brought by any co-proprietor but he may not, without the leave of the High Court or District Court, proceed with the action unless the other, or each one of the others, is either joined as a plaintiff or added as a defendant.

(7) A co-proprietor who is thus arraigned as a defendant shall not be made liable for any costs in the action unless he takes part in the proceedings.

(8) Nothing in sub-sections (6) and (7) shall affect the granting of interlocutory relief on the application of a single co-proprietor.

(9) Nothing in this section shall affect the mutual rights and obligations of trustees or personal representatives, or their rights and obligations as such.

25. Meaning of Convention application, and right to priority.- (1) A "Convention application" means an application duly made by a person for registration of a trade mark in one or more than one Convention country.

(2) If-

- (a) a person has duly made a "Convention application"; and
- (b) within six months from the date on which the Convention application or first of the Convention applications was made, that person or another person hereinafter referred to as the "successor in title" of whom that person is a predecessor in title applies to the Registrar in the prescribed manner for the registration of the same trade mark under this Ordinance in respect of some or all of the same goods or services or both in respect of which registration was sought in that Convention country or those Convention countries,

that person or that person's successor in title may, when filing the application under this Ordinance, or within the prescribed period after filing the application under this Ordinance, but before the application is accepted, has a right to priority for the registration of the trade mark.

(3) If the application for registration under this Ordinance is made within the prescribed priority period mentioned in sub-section (2) -

- (a) the relevant date for the purposes of establishing which rights take precedence shall be the date of filing of the first Convention application; and
- (b) the registrability of the trade mark shall not be affected by any use of the mark in Pakistan in the period between that date and the date of the application under this Ordinance.

(4) Any filing which in a Convention country is equivalent to a regular national filing, under its domestic legislation or an international agreement, shall be treated as giving rise to the right of priority.

Explanation.- For the purposes of this sub-section, a "regular national filing" means a filing which is adequate to establish the date on which the application was filed in that country, whatever may be the subsequent fate of the application.

(5) A subsequent application concerning the same subject as the first Convention application, filed in the same Convention country, shall be considered the first Convention application of which the date of filing is the starting date of the period of priority, if at the time of the subsequent application-

- (a) the previous application has been withdrawn, abandoned or refused, without having been laid open to public inspection and without leaving any rights outstanding; and
- (b) it has not yet served as a basis for claiming a right of priority.

(6) The previous application referred to in sub-section (5), may not thereafter serve as a basis for claiming a right of priority.

(7) The manner of claiming a right to priority on the basis of a Convention application shall be such as may be prescribed.

(8) A right to priority arising as a result of a Convention application may be assigned or otherwise transmitted, either with the application or independently.

(9) The reference in sub-section (2) to the applicants "successor in title" shall be construed accordingly.

26. Application to provide temporary protection during exhibition.- (1) The applicant for registration of a trade mark who has exhibited goods bearing the mark or has rendered services under the trade mark at an official or officially recognized exhibition and who applies for registration of that trade mark, within six months from the day on which the goods bearing the trade mark or the services rendered under the trade mark were first exhibited in the exhibition, shall, on his request, be deemed to have applied for registration of the trade mark on that day.

(2) Evidence of the exhibition of goods bearing the trade mark or services rendered under the trade mark must be given by a certificate issued by the competent authorities of the exhibition, stating the date on which the trade mark was first used in connection with goods or services included in the exhibition.

(3) The provision of this section shall not extend any other priority rights to the applicant in respect of the same trade mark.

(4) The grant of temporary protection in respect of goods or services during exhibition shall be subject to such conditions as may be prescribed.

27. Examination of application.-(1) The Registrar shall, as soon as practicable, examine whether an application for registration of a trade mark satisfies the requirements prescribed under this Ordinance.

(2) For the purposes of sub-section (1), the Registrar shall carry out a search, to the extent as he considers necessary, of earlier trade marks.

(3) If it appears to the Registrar that the requirements for registration are not met, he shall inform the applicant and give him an opportunity, within such period as the Registrar may specify, to make representation or to amend the application.

(4) If the applicant fails to satisfy the Registrar that those requirements are met, or to amend the application so as to meet them, or fails to respond before the end of the specified period, the Registrar shall refuse to accept the application.

(5) If it appears to the Registrar that the requirements for registration are met, he shall accept the application absolutely or subject to such conditions or limitations, if any, as he may think fit.

(6) In the case of a refusal or conditional acceptance, the Registrar shall state in writing the grounds of his decision and the materials used by him in arriving thereat.

(7) If the tribunal is of opinion that it is fair and reasonable in all the circumstances of the case to do so, may at any time, whether before or after acceptance, correct any error in, or in connection with, the application or may permit the applicant to amend his application upon such terms as it may think fit:

Provided that no amendment or correction shall be permitted in the application which substantially affects the identity of the trade mark or extends the goods or services covered by the application:

Provided further that if the amendment or correction in the application is permitted after the application has been advertised, the amendment or correction shall also be published.

28. Publication, opposition proceedings and observations.- (1) When an application for registration of a trade mark has been accepted, whether absolutely or subject to conditions or limitations, the Registrar shall, as soon as may be after acceptance, cause the application as accepted, together with the conditions and limitations, if any, subject to which it has been accepted, to be advertised in the Journal, and for all legal purposes, advertisement of the trade mark in the Journal shall constitute sufficient notice of acceptance of the trade mark:

Provided that the Registrar may cause an application to be advertised before acceptance where it appears to him that it is expedient by reason of any exceptional circumstances so to do, and where an application has been so advertised the Registrar may, if he thinks fit, advertise it again when it has been accepted, but shall not be bound so to do:

Provided further that where an application is advertised by reason of any special circumstances under the above proviso, the Registrar shall simultaneously notify the exceptional circumstances which led him so to do.

(2) Any person may, within two months from the date of the advertisement or re-advertisement of an application for registration or within such further period not exceeding two months in the aggregate, as the Registrar, on application made to him in the prescribed manner and on payment of the prescribed fee, may allow, give notice to the Registrar of opposition to the registration.

(3) The notice under sub-section (2), shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.

(4) The Registrar shall serve in the prescribed manner a copy of the notice on the applicant, and within one month from the receipt by the applicant of such copy of the notice of opposition, or within such further period not exceeding two months in the aggregate, as the Registrar, on application made to him in the prescribed manner and on payment of the prescribed fee, may allow, the applicant shall send to the Registrar in the prescribed manner a counter-statement of the grounds on which he relies for his application, and, if he does not do so he shall be deemed to have abandoned his application.

(5) If the applicant sends the counter-statement referred to in sub-section (4), the Registrar shall serve in the prescribed manner a copy of the counter-statement on the opponent. If the opponent deems necessary, he may within one month from the receipt of such copy of the counter-statement, or within such further period not exceeding two months in the aggregate, as the Registrar, on application made to him in the prescribed manner and on payment of the prescribed fee, may allow, send to the Registrar in the prescribed manner a rejoinder.

(6) If the opponent sends a rejoinder, the Registrar shall send in the prescribed manner a copy of the rejoinder to the applicant.

(7) Any evidence upon which the opponent and the applicant may rely shall be submitted in the prescribed manner and within the prescribed time to the Registrar, and the Registrar shall give an opportunity to them to be heard, if they so desire.

(8) The Registrar shall, unless the proceedings are discontinued or dismissed, after giving to the opponent and to the applicant an opportunity of being heard, decide whether, and subject to what conditions or limitations, if any, registration is to be permitted.

(9) If the Registrar is of opinion that it is fair and reasonable in all circumstances of the case to do so, he may, on request made in the prescribed manner, permit correction of any error in, or any amendment of, a notice of opposition, a counter-statement, or a rejoinder on such terms as he thinks just.

29. Grounds of opposition.- (1) The registration of a trade mark may be opposed on any of the grounds on which an application for the registration of a trade mark may be rejected under this Ordinance except the ground that the trade mark cannot be represented graphically.

(2) The registration of a trade mark may be opposed on the ground that the applicant does not intend-

- (a) to use, or authorize the use of, the trade mark in Pakistan; or
- (b) to assign the trade mark to a body corporate for use by the body corporate in Pakistan,

in relation to goods, services or both specified in the application.

(3) The registration of a trade mark may be opposed on any of the following grounds that:

- (a) the applicant is not the proprietor of the trade mark;
- (b) the application, or a document filed in support of the application, was amended contrary to the provisions of this Ordinance;
- (c) the Registrar accepted the application for registration on the basis of evidence or representations that were false in material particulars; or
- (d) the pre-acceptance advertisement of the application under exceptional circumstances is without sufficient cause or reason.

(4) The registration of trade mark in respect of particular goods or services may be opposed on the grounds that-

- (a) it is substantially identical with, or deceptively similar to, a well known trade mark, or a trade mark that, before the priority date for the registration of the first-mentioned trade mark in respect of those goods or services, had acquired a reputation in Pakistan; and
- (b) because of the reputation of that other trade mark, the use of the first-mentioned trade mark would cause dilution or would be likely to deceive or cause confusion.

(5) The registration of a trade mark in respect of particular goods may be opposed on the ground that the trade mark contains or consists of a mark that is a geographical indication for goods originating in-

- (a) a country, or in a region or locality in a country, other than the country in which the relevant goods originated; or
- (b) a region or locality in the country in which the relevant goods originated other than the region or locality in which the relevant goods originated.

(6) The provisions of clause (b) of sub-section (2) of section 17 shall remain in abeyance if the earlier trade mark application is under opposition.

30. Circumstances in which opposition may proceed in the name of a person other than the person who filed the notice of opposition.- If-

- (a) after a person has given a notice of opposition, the right or interest on which the person relies while giving the notice of opposition becomes vested in another person; and
- (b) the other person-
 - (i) notifies the Registrar in the prescribed manner that the right or interest is vested in him; and
 - (ii) does not withdraw the opposition.

the opposition may proceed as if the notice of opposition had been given in that other person's name.

31. Withdrawal of application.-(1) The applicant may at any time withdraw his application or restrict the goods or services covered by the application.

(2) In case the application has been advertised, the withdrawal or restriction under sub-section (1) shall also be published.

32. Definition of divisional application.- (1) A divisional application means an other application by a person who has already made an application under section 22 for registration of a trade mark in respect of certain goods, services or both and made, in accordance with this section for -

- (a) the registration of a part only of the trade mark in respect of any or all those goods, services or both; or
- (b) the registration of the trade mark in respect of some only of the goods, services or both in respect of which registration is sought under the application made under section 22.

(2) A divisional application for registration of a trade mark or a part of a trade mark may be made only if the application under section 22 for registration of the trade mark is pending.

(3) A divisional application shall proceed as an application made under section 22:

Provided that a divisional application shall be taken to have been filed on the day on which the application under section 22 was filed.

33. Registration.-(1) Where an application has been accepted and-

- (a) no notice of opposition has been given within the period referred to in sub-section (2) of section 28; or
- (b) all opposition proceedings have been withdrawn or decided in favour of the applicant,

the Registrar shall, within such period as may be prescribed, register the trade mark, unless it appears to him having regard to matters coming to his notice since he accepted the application that it was accepted in error.

(2) A trade mark shall not be registered unless any fee prescribed for the registration is paid within the prescribed period. If the fee is not paid within the prescribed period, the application shall be deemed to have been withdrawn.

(3) A trade mark when registered shall be registered as of the date of filing of the application for registration and that date shall be deemed for the purposes of this Ordinance to be the date of registration.

(4) On the registration of a trade mark the Registrar shall publish the registration in the prescribed manner and issue to the applicant a certificate in the prescribed form of registration, sealed with the seal of the Trade Marks Registry.

(5) Where registration of a trade mark is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Registrar may, after giving notice to the applicant in the prescribed manner, treat the application as abandoned unless it is completed within the time specified in that behalf in the notice.

34. Duration and renewal of registration.- (1) A trade mark shall be registered for a period of ten years from the date of registration.

(2) The registration may be renewed under section 35 for a further period of ten years.

35. Renewal of registration.-(1) The registration of a trade mark may be renewed at the request of the proprietor subject to payment of such renewal fee as may be prescribed.

(2) The Registrar shall inform the proprietor of a registered trade mark, before the expiry of the registration, of the date of expiry and the manner in which the registration may be renewed as may be prescribed.

(3) A request for renewal shall be made, along with the renewal fee, before the expiry of the registration, as may be prescribed, failing which the request may be made and the renewal fee paid within such further period of not less than six months as may be prescribed in which case an additional renewal fee shall be paid within that period.

(4) Renewal shall take effect from the expiry of the previous registration.

(5) Except at the time of first renewal, the Registrar may require that request for renewal be accompanied with evidence of use of the trade mark in Pakistan.

(6) If the registration is not renewed in accordance with the provisions of this section, the Registrar shall remove the trade mark from the Register:

Provided that the Registrar may restore the registration of a trade mark which has been removed from the Register, subject to such conditions, if any, as may be prescribed.

(7) The renewal or restoration of the registration of a trade mark shall be published in the Journal.

36. Effect of removal from Register for failure to pay fee for renewal.- Where a trade mark has been removed from the Register, under this Ordinance, for failure to pay the fee for renewal, it shall nevertheless, for the purposes of any application for the registration of another trade mark during one year next after the date of the removal, be deemed to be a trade mark already on the Register, unless the tribunal is satisfied either-

- (a) that there has been no *bona fide* use of the trade mark which has been removed during the two years immediately preceding its removal; or
- (b) that no deception or confusion would be likely to arise from the use of the trade mark which is the subject of the application for registration by reason of any previous use of the trade mark which has been removed.

37. Alteration of registered trade mark.- (1) Subject to sub-section (2), a registered trade mark shall not be altered in the Register, during the period of registration or on renewal.

(2) The Registrar may, at the request of the proprietor, allow the alteration of a registered trade mark where the mark includes the proprietor's name or address and the alteration is limited to alteration of that name or address and does not substantially affect the identity of the mark.

(3) In case any alteration is made under sub-section (2), the Registrar shall publish such alteration and the objections by any person claiming to be affected by it, in such manner as may be prescribed.

38. Surrender of registered trade mark.- (1) A registered trade mark may be surrendered by the proprietor in respect of some or all of the goods or services for which it is registered.

- (2) The Federal Government may by rules to be published in the official gazette, provide-
- (a) as to manner and effect of a surrender, and
 - (b) for protecting the interests of other persons having a right in the registered trade mark.

CHAPTER IV. REGISTRATION AND EFFECT THEREOF

39. Rights conferred by registration.- (1) A registered trade mark shall be a personal property.

(2) The proprietor of a registered trade mark shall have exclusive rights in the trade mark which are infringed by use of the trade mark in Pakistan without his consent.

(3) Without prejudice to the rights of the proprietor of a registered trade mark to obtain any relief under any other law for the time being in force, the proprietor shall also have the right to obtain relief under this Ordinance if the trade mark is infringed.

(4) References in this Ordinance to the infringement of a registered trade mark shall be to any such infringement of the rights of the proprietor.

(5) The rights of the proprietor shall have effect from the date of registration:

Provided that no infringement proceedings shall begin before the date on which the trade mark is in fact registered.

(6) The rights conferred by registration of trade marks under this Ordinance shall extend to trade marks registered under the Trade Marks Act, 1940 (V of 1940).

40. Infringement of registered trade mark.- (1) A person shall infringe a registered trade mark if such person uses in the course of trade a mark which is identical with the trade mark in relation to goods or services which are identical with those for which it is registered.

(2) A person shall infringe a registered trade mark if such person uses in the course of trade a mark where because-

- (a) the mark is identical with the trade mark and is used in relation to goods or services similar to the goods or services for which the trade mark is registered; or
- (b) the mark is deceptively similar to the trade mark and is used in relation to goods or services identical with or similar to the goods or services for which the trade mark is registered,

there exists a likelihood of confusion on the part of public, which includes the likelihood of association with the trade mark.

(3) A person shall infringe a registered trade mark if the person uses in the course of trade a mark which is identical with, or deceptively similar to, the trade mark in relation to-

- (a) goods of the same description as that of goods in respect of which the trade mark is registered;
- (b) services that are closely related to goods in respect of which the trade mark is registered;
- (c) services of the same description as that of services in respect of which the trade mark is registered; or
- (d) goods that are closely related to services in respect of which the trade mark is registered.

(4) A person shall infringe a registered trade mark if the person uses in the course of trade a mark which-

- (a) is identical with or deceptively similar to the trade mark; and
- (b) is used in relation to goods or services which are not similar to those for which the trade mark is registered,

where the trade mark is a well known trade mark, or has a reputation in Pakistan, and the use of the mark, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.

(5) A person shall infringe a registered trade mark if the person uses such registered trade mark as his trade name or part of his trade name.

(6) A person shall infringe a registered trade mark if the person uses such registered trade mark as his domain name or part of his domain name or obtains such domain name without the consent of the proprietor of the registered trade mark, with the intention of selling such domain name to another including the proprietor of the registered trade mark.

(7) A person who applies a registered trade mark to material intended to be used for labeling or packaging goods shall be treated as a party to any use of the material which infringes the registered trade mark if when he applied the mark he knew or had reason to believe that the application of the mark was not duly authorised by the proprietor or a licensee.

(8) In all legal proceedings, a person who sells or offers or exposes goods for sale, or puts them on the market or has in possession for sale or any purpose of trade or manufacture any goods bearing a mark which infringes a registered trade mark shall be treated as a party to infringement of a registered trade mark, unless he proves that -

- (a) having taken all reasonable precautions, he had no reasons to suspect the genuineness of the mark; and
- (b) on demand made by tribunal, he gave all the information in his power with respect to the persons from whom he obtained such goods; or
- (c) he had otherwise acted innocently.

41. Infringement of trade mark by breach of certain restrictions.- Subject to the provisions of section 42, if the proprietor of a registered trade mark or a licensee having power to do so, has caused to be displayed on goods the words "registered goods" in respect of which a trade mark is registered, or on their packaging, or on the container in which they are offered to the public, a notice prohibiting any of the following acts-

- (a) apply the trade mark to registered goods or using the trade mark in physical relation to them, after the state, condition, get-up or packaging in which they were originally offered to the public has been altered;
- (b) altering, or partially removing or obliterating, any representation of the trade mark applied to registered goods and used in physical relation to them;
- (c) if the trade mark has been applied to registered goods, or used in physical relation to them, together with other matter indicating that the proprietor or the licensee has dealt with the goods, removing or obliterating, totally or in part, any representation of the trade mark without totally removing or obliterating the other matters;
- (d) applying another trade mark to registered goods or using another trade mark in physical relation to them; or
- (e) if the trade mark has been applied to registered goods, or used in physical relation to them, using on the goods, or on the packaging or container of the goods, any matter that is likely to injure the repute of the trade mark.

a person who does or authorizes someone to do any of the foregoing prohibiting acts shall be liable for infringement of the trade mark:

Provided that the trade mark shall not be infringed if the owner of the goods acquired them in good faith and without being aware of the notice of prohibition, or became the owner of the goods by virtue of a title derived from a person who has so acquired them.

42. When a trade mark is not infringed.- (1) A person shall not infringe a registered trade mark when-

- (a) the person uses in good faith-
 - (i) 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
 - (ii) the name of the predecessor in business of the person or the name of the predecessor's place of business;
- (b) the person uses a mark in good faith to indicate-
 - (i) the kind, quality, quantity, intended purpose, value, geographical origin, or some other characteristic, of goods or services; or
 - (ii) the time of production of goods or of the rendering of services;
- (c) 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
- (d) the person uses the trade mark for the purposes of comparative advertising.

(2) If the right to the use of a trade mark given under section 39 by registration 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 as aforesaid 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.

(3) Where registration of a trade mark is subject to a disclaimer, a person shall not infringe the trade mark by using disclaimed part of the trade mark.

43. Registration to be prima facie evidence of validity.- In all legal proceedings relating to a trade mark registered under this Ordinance or under the Trade Marks Act, 1940 (V of 1940), the fact that a person is registered as proprietor thereof shall be *prima facie* evidence of the validity of the original registration of the trade mark and of all subsequent assignments and transmissions thereof.

44. Registration to be conclusive as to validity after five years.- In all legal proceedings relating to a registered trade mark, the original registration of the trade mark shall, after the expiration of five years from the date of its original registration, be taken to be valid in all respects unless such registration was obtained by fraud, or unless the trade mark offends against the provisions of sub-section (3) of section 14.

45. Saving for words used as name or description of an article or a substance.- (1) The registration of a trade mark shall not be deemed to have become invalid by reason only of any use after the date of the registration of any word which the trade mark contains or of which it consists as the name or description of an article, substance or service:

Provided that if it is proved either-

- (a) that there is a famous and established use of the said word as the name or description of the article, substance or service by a person or persons carrying on trade therein, not being use in relation to goods or services connected in the course of trade with the proprietor or a licensee of the trade mark or in the case of a certification trade mark in relation to goods or services certified by the proprietor; or
- (b) that the article or substance has been manufactured under a patent in force at or granted after the commencement of this Ordinance, that a period of two years or more after the cesser of the patent has elapsed and that the said word is the only practicable name or description of the article or substance.

the provisions of sub-section (2) shall apply.

(2) Where the facts mentioned in clause (a) or (b) of the proviso to sub-section (1) are proved with respect to any words, then-

- (a) for the purposes of any proceedings under section 96, if the trade mark consists solely of such words, the registration of the trade mark, so far as regards registration in respect of the article or substance in question or of any goods of the same description, or of the service or of any services of the same description, as the case may be, shall be deemed to be an entry wrongly remaining on the Register; or
- (b) for the purposes of any other legal proceedings relating to the trade mark-
 - (i) if the trade mark consists solely of such words, all rights of the proprietor under this Ordinance or any other law for the time being in force to the use of the trade mark; or
 - (ii) if the trade mark contains such words and other matter, all such rights of the proprietor to the use of such words,

in relation to the article or substance or to any goods of the same description, or to the service or to any services of the same description, as the case may be, shall be deemed to have ceased on the date on which the use mentioned in clause (a) of the proviso to sub-section (1) first became famous and established or at the expiration of the period of two years mentioned in clause (b) of the said proviso.

CHAPTER V.- INFRINGEMENT PROCEEDINGS

46. **Action for infringement.**- (1) Save as otherwise provided in this Ordinance, an infringement of a registered trade mark shall be actionable by the proprietor of the trade mark.

(2) In an action for infringement all such relief by way of damages, injunctions, accounts or otherwise shall be available to the proprietor of the trade mark as is available in respect of the infringement of any other property right.

(3) Nothing in this Ordinance shall be deemed to affect rights of action against any person for passing off goods as the goods of another person or services as services provided by another person, or the remedies in respect thereof.

47. **Order for erasure of offending mark.**- (1) Where a person is found to have infringed a registered trade mark, the High Court or a District Court may make an order requiring him-

- a) to cause the offending trade mark to be erased, removed or obliterated from any infringing goods, material or articles in his possession, custody or control; or
- b) to secure the destruction of the infringing goods, material or articles, if it is not reasonably practicable for the offending trade mark to be erased, removed or obliterated.

(2) If an order under sub-section (1) is not complied with, or it appears to the High Court or District Court likely that such an order would not be complied with, the High Court or a District Court may order that infringing goods, material or articles be delivered to such person as the High Court or a District may direct for erasure, removal or obliteration of the mark, or for destruction, as the case may be.

48. Order for delivery up of infringing goods, material or articles.- (1) The proprietor of a registered trade mark may apply to the High Court or a District Court for an order for the delivery up to him, or such other person as the High Court or a District Court may direct, of any infringing goods, material or articles which a person has in his possession, custody or control in the course of a business.

(2) An application shall not be made after the expiry of the period specified in section 50, and no order shall be made unless the High Court or a District also makes, or it appears to the High Court or a District Court that there are grounds for making, an order under section 51.

(3) A person to whom any infringing goods, material or articles are delivered in pursuance of an order under this section shall, if an order under section 51 has not been made, retain them pending the making of an order, or the decision not to make an order, under that section.

(4) Nothing in this section shall affect any other power of the High Court or a District .

49. Meaning of "infringing goods, material or articles".- (1) Subject to sub-section (2), goods shall be "infringing goods" in relation to a registered trade mark, if they or their packaging bear a mark identical or deceptively similar to that mark and-

- (a) the application of the mark to the goods or their packaging was an infringement of the registered trade mark;
- (b) the goods are proposed to be imported into Pakistan and the application of the mark in Pakistan to them or their packaging would be an infringement of the registered trade mark; or
- (c) the mark has otherwise been used in relation to the goods in such a way as to infringe the registered trade mark.

(2) Nothing in sub-section (1) shall be construed as affecting the importation of goods which may be lawfully imported into Pakistan.

(3) Material shall be "infringing material" in relation to a registered trade mark, if it bears a mark identical or deceptively similar to that mark and either it is-

- (a) used for labeling or packaging goods, as a business paper, or for advertising goods or services, in such a way as to infringe the registered trade mark; or
- (b) intended to be so used, and such use would infringe the registered trade mark.

(4) "Infringing articles" in relation to a registered trade mark, means such articles which-

- (a) are specifically designed or adapted for making copies of a mark identical or similar to that mark; and
- (b) a person has in his possession, custody or control, knowing or having reason to believe that they have been or are to be used to produce infringing goods or material.

50. Period after which remedy of delivery be not available.- (1) An application for an order under section 48 shall not be made after the expiry of three years from,

- (a) in the case of infringing goods, the date on which the trade mark was applied to the goods or their packaging;
- (b) in the case of infringing material, the date on which the trade mark was applied to the material; or
- (c) in the case of infringing articles, the date on which they were made.

except as provided in sub-section (2).

(2) If during the whole or part of the period specified in sub-section (1), the proprietor of the registered trade mark-

- (a) is under a disability; or
- (b) is prevented by fraud or concealment from discovering the facts entitling him to apply for an order,

an application may be made at any time before the expiry of three years from the date on which he ceased to be under a disability or, as the case may be, could with reasonable diligence have discovered those facts.

Explanation .-In this sub-section the expression "disability" shall have the same meaning as in the Limitation Act, 1908 (IX of 1908).

51. Order as to disposal of infringing goods, material or articles.- (1) Where infringing goods, material or articles have been delivered up in pursuance of an order under section 48, an application may be made to the High Court or a District Court-

- (a) for an order that they be destroyed or forfeited to such person as the High Court or a District may think fit; or
- (b) for a decision that no such order should be made.

(2) In considering what order, if any should be made, the High Court or a District Court shall consider whether other remedies available in an action for infringement of the registered trade mark would be adequate to compensate the proprietor and any licensee and protect their interests.

(3) Where there are more persons than one interested in the goods, materials or articles, the High Court or a District Court shall make such order as it thinks just.

(4) If the High Court or a District Court decides that no order should be made under this section, then the person, in whose possession, custody or control the goods, material or articles were before being delivered shall be entitled to their return.

52. Remedy for groundless threats of infringement proceedings.- (1) Where a person threatens to bring an action against another person on the ground that the other person has infringed-

- (a) a registered trade mark; or
- (b) a trade mark alleged by the person to be registered,

any person aggrieved by the threat may bring proceedings for relief against the person making the threat.

(2) The relief may be applied for any of the following, namely:-

- (a) a declaration that the threats are unjustifiable;
- (b) an injunction against the continuance of the threats; or
- (c) damages in respect of any loss he has sustained by the threats.

(3) The plaintiff shall be entitled to any relief specified in sub-section(2) unless the defendant shows that the acts in respect of which proceedings were threatened constitute, or if done would constitute, an infringement of the registered trade mark concerned.

(4) If that is shown by the defendant, as provided under sub-section (3), the plaintiff shall be entitled to any relief specified in sub-section (2), if he shows that the registration of the trade marks is invalid or liable to be revoked in a relevant respect.

(5) The mere notification that a trade mark is registered, or that an application for registration has been made, shall not constitute a threat of proceedings for the purposes of this section.

(6) The provisions of this section shall not make a lawyer, advocate or attorney liable to an action for an act done in his professional capacity on behalf of a client.

CHAPTER VI.- IMPORTATION OF INFRINGING GOODS, MATERIAL OR ARTICLES

53. Infringing goods, material or articles may be treated as prohibited.- (1) The proprietor of the registered trade mark may give notice in writing to the Collector of Customs that-

- a) he is the proprietor of the registered trade mark;
- b) at a time and place specified in the notice, goods which, in relation to that registered trade mark are infringing goods, material or articles, or bear false indications as to their source or the identity of their manufacturer are expected to arrive in Pakistan from outside Pakistan and that they are subject to the control of the customs authorities under the Customs Act, 1969 (IV of 1969); and
- c) he requests the Collector of Customs to treat such goods as prohibited goods.

54. Notice for intervention by customs authorities.- When any notice to the Collector of Customs is made under section 53, it shall be accompanied by an undertaking by the person sending the notice to indemnify the customs authorities concerned and to compensate any importer, consignee or owner of the goods for loss or damage resulting from the wrongful suspension of clearance of goods.

55. Furnishing of security or equivalent assurance to customs authority.- The Collector of Customs may require an applicant to provide a security or equivalent assurance sufficient to protect the importer, consignee or owner of the goods but such security or equivalent assurance shall not be such as to unreasonably deter recourse to these procedures.

56. Collector of Customs may seize goods bearing infringing trade mark.- If goods to which section 53 applies-

- (a) bear on them a trade mark which, in the opinion of the Collector of Customs, is identical with, or deceptively similar to the registered trade mark; and
- (b) are goods in respect of which the trade mark is registered,

the Collector of Customs shall seize the goods unless he is satisfied that there are no reasonable grounds of believing that the trade mark shall be infringed by the importation of the goods and the seized goods shall be kept in a secure place as directed by the Collector of Customs.

57. Notice of seizure.- The Collector of Customs shall, as soon as practicable-

- (a) give, either personally or by urgent post, to the importer, consignee or owner of the goods a notice of seizure in writing identifying the goods and stating that they have been seized under section 56; and
- (b) give to the applicant a notice in writing-
 - (i) identifying the goods and stating that they have been seized under section 56;

- (ii) giving the full name and address of the importer, consignee or owner of the goods and any information that the Collector of Customs has and believes, on reasonable grounds, to be likely to help the applicant to identify the importer or the owner of the goods; and
- (iii) stating that the goods shall be released to the importer, consignee or owner of the goods unless the applicant brings an action for infringement of the registered trade mark in respect of goods before a District Court having jurisdiction in the matter and gives the Collector of Customs notice in writing of the action, within the period of ten working days after the applicant has been given the notice, or if the Collector of Customs extends the period under sub-section (1) of section 60, within such extended period.

58. **Forfeiture of goods.**- If the importer, consignee or owner of any seized goods, at any time before the applicant starts an action for infringement of the trade mark in respect of goods, by notice in writing to the Collector of Customs, gives consent to the goods being forfeited by the Collector of Customs, the goods shall be so forfeited by the Collector of Customs.

59. **Release of goods.**- (1) The Collector of Customs shall release the seized goods to their designated importer, consignee or owner if, within the specified period, the applicant has not-

- (a) brought an action for infringement of the registered trade mark in respect of the goods; and
- (b) given to the Collector of Customs notice in writing of the action.

(2) The Collector of Customs shall also release the seized goods to their designated importer, consignee or owner if-

- (a) before the end of the prescribed period, the applicant, by notice in writing to the Collector of Customs, consented to the release of the goods; and
- (b) at that time,
 - (i) the applicant has not brought an action for infringement of the registered trade mark in respect of the goods; or
 - (ii) the action brought by the applicant has been withdrawn.

(3) The Collector of Customs may release the seized goods to their designated importer, consignee or owner before the end of the specified period if,

- (a) having regard to information that has come to his knowledge after the goods were seized, he is satisfied that there are no reasonable grounds of believing that the registered trade mark has been infringed by the importation of the goods; and
- (b) the applicant has not so far brought an action for infringement of the registered trade mark in respect of the goods, or has not informed him of such an action.

60. **Action for infringement against importation of infringing goods.-** (1) The applicant may bring an action for infringement of a registered trade mark in respect of the seized goods and give a notice to the Collector of Customs, subject to the provisions of clause (b), within ten working days specified in the notice given to the applicant in respect of the goods, under section 57 or if-

- (i) the applicant has, before the expiry of the specified period, applied in writing to the Collector of Customs for an extension of the specified period; and
- (ii) the Collector of Customs, being satisfied that in the circumstances of the case it is fair and reasonable to do so, has extended the specified period for a number of working days not exceeding ten days,

within that period so extended by the Collector of Customs.

(2) A District Court hearing the action-

- (a) may, on the application of any person, allow that person to be joined as a defendant in the case; and
- (b) shall allow the Collector of Customs, or his duly authorised officer, to appear and be heard.

(3) Subject to sub-section (4), in addition to any relief that a District Court may grant apart from the provisions of this section, the Court may-

- (a) at any time, if it thinks it just, order that the seized goods be released to their designated owner subject to such conditions that the Court considers fit to impose; or
- (b) order that the seized goods be forfeited.

(4) A District Court shall not make any order which may facilitate-

- (a) re-exporting of the counterfeit trade mark goods;
- (b) removing of the trade marks which have been affixed to the counterfeit trade mark goods without authorization; and
- (c) local sale of such goods.

(5) If a District Court decides that the registered trade mark was not infringed by the importation of the goods and the designated importer, consignee or owner of the goods, satisfies the Court that he has suffered losses or damage because the goods were seized, the Court may order the applicant to pay the defendant compensation, in the amount determined by the Court, for any part of the loss or damage that is attributable to any period beginning on or after the day on which the action was brought.

(6) If, after three weeks from the day on which the action was brought, there is not in force at any time an order of a District Court preventing the goods from being released, the Collector of Customs shall release the goods to their designated importer, consignee or owner.

(7) If a District Court orders that the goods be released, the Collector of Customs shall, subject to section 63, comply with the order

61. **Action for infringement by licensee in relation to any seized goods.**- If an exclusive licensee of a registered trade mark is an applicant in relation to any seized goods, the licensee may commence an action for the infringement of the registered trade mark in respect of the goods within the required period without first ascertaining whether the proprietor is willing to bring the action.

62. **Disposal of forfeited goods.**- (1) Subject to sub-section (2), any goods forfeited under the provisions of this Chapter shall be disposed of by the Collector of Customs in the manner as if the goods were forfeited under the Customs Act, 1969 (IV of 1969)

(2) The Collector of Customs shall not dispose of goods in a manner which may facilitate-

- (a) re-exporting of the counterfeit trade mark goods;
- (b) removing of the trade marks which have been affixed to the counterfeit trade mark goods without authorization; and
- (c) local sale of such goods.

63. **Power of the Collector of Customs to retain control of goods.**- Notwithstanding anything contained in this Chapter, the Collector of Customs shall not-

- (a) release, or dispose of, any goods; or
- (b) take any action in relation to the goods to give effect to any order of a District Court under section 60,

and Collector of Customs shall apply to the District Court to request that the goods are required and he may be allowed to retain control of the goods under any law for the time being in force.

64. **Insufficient security.**- If security given under section 55 by the applicant who gave notice in respect of a registered trade mark under section 53 or section 61 is not sufficient to meet the expenses incurred by the Federal Government as a result of the action taken by the Collector of Customs under this Chapter, because of the notice, the amount of the difference in the expenses and the amount of security-

- (a) shall be a debt due by the applicant to the Federal Government; and
- (b) shall be recovered by the Federal Government under section 202 of the Customs Act, 1969 (IV of 1969).

65. **The Federal Government not be liable to loss, etc., suffered because of seizure.**- The Federal Government shall not be liable to any loss, damage or delays suffered by a person-

- (c) because the Collector of Customs seized or failed to seize goods under this Chapter; or
- (d) because of release of any seized goods.

66. Power of the Collector of Customs to make regulations.- The Collector of Customs may make regulations prescribing the form in which notices shall be made and requiring the person making the notices to furnish evidence as to the ownership and to comply with such other conditions as may be specified which may include the payment of a fee to cover the administrative costs.

CHAPTER VII.- UNFAIR COMPETITION AND COMPARATIVE ADVERTISEMENT

67. Definition of unfair competition and provisions relating thereto.-(1) An "unfair competition" means any act of competition contrary to honest business practices in industrial or commercial matters and, without prejudice to the generality of the foregoing, such acts may include-

- (a) all acts of such nature as to create confusion by any means whatsoever with the establishment, goods, services or industrial or commercial activities of a competitor;
- (b) false allegations in the course of trade of such a nature as to discredit the establishment, goods, services or industrial or commercial activities of a competitor;
- (c) indications or allegations the use of which in the course of trade is liable to mislead the public as to the nature, manufacturing process, characteristics, constituents, quality or the suitability for their purpose of the goods or services;
- (d) any act or practice, in the course of industrial or commercial matters that results in the disclosure, acquisition or use by others of information without the consent of the person lawfully in control of that information in a manner contrary to honest industrial or commercial practice so long as such information relates to sale or manufacture of goods or provision of services and-
 - (i) is secret in the sense that it is not, as a body or in the precise configuration and assembly of its components, generally known among or readily accessible to persons within the circles that normally deal with the kind of information in question;
 - (ii) has commercial value because it is secret; and
 - (iii) has been subject to reasonable steps under circumstances, by the person lawfully in control of the information, to keep it secret;
- (e) making of false or deceptive statements in the course of trade;
- (f) misleading advertising; or
- (g) fraudulently registering or applying for registration of a trade mark.

Explanation.- For the purposes of clause (d) "a manner contrary to honest industrial or commercial practice" shall mean, at least, practices such as breach of contract, breach of confidence and inducement to breach, and includes the acquisition of undisclosed information by third parties who knew, or were grossly negligent in failing to know, that such parties were involved in the acquisition.

(2) Any act of unfair competition shall be unlawful.

(3) An action against unfair competition may be brought before a District Court of competent jurisdiction.

68. Misleading and comparative advertisement.- (1) Comparative advertisement shall, as far as comparison is concerned, be lawful subject to the following conditions, namely:-

- (a) it is not misleading according to clause (xxiv) of section 2, and sub-section (2);
- (b) it compares goods or services meeting the same needs or intended for the same purpose;
- (c) it objectively compares one or more material, relevant, verifiable and representative features of those goods and services, which may include price;
- (d) it does not create confusion in the market place between the advertiser and a competitor or between the advertiser's trade marks, trade names, other distinguishing marks, goods or services and those of the competitor;
- (e) it does not discredit or disparage the trade marks, trade names, other distinguishing marks, goods, services, activities or circumstances of a competitor;
- (f) for products with designation of origin, it relates in each case to products with same designation;
- (g) it does not take unfair advantage of the reputation of a trade mark, trade name or other distinguishing marks of a competitor or of the designation of origin of competing products; and
- (h) it does not present goods or services as imitations or replicas of goods or services bearing a protected trade mark or trade name.

(2) In determining whether an advertising is misleading, the tribunal shall take account of all its features, and in particular of any information it contains concerning-

- (a) the characteristics of goods or services, such as their availability, nature, execution, composition, method and date of manufacture or provision, fitness for purpose, uses, specification, geographical or commercial origin or the results to be expected from their use, or the results and material features of tests or checks carried out on the goods or services;

- (b) the price or the manner in which the price is calculated, and the conditions on which the goods are supplied or the services provided; and
- (c) the nature, attributes and rights of the advertiser, such as his identity and assets, his qualifications and ownership of industrial, commercial or intellectual property rights or his awards and distinctions.

(3) Any person having a legitimate interest in prohibiting misleading advertisement or regulating comparative advertising may institute legal action against such advertising before the tribunal.

(4) For all complaints made to the tribunal under sub-section (3), the tribunal shall take into account all the interests involved and in particular the public interest before it orders-

- (a) publication of a corrective statement by the advertiser;
- (b) cessation of misleading advertising or unpermitted comparative advertising; or
- (c) if the misleading advertising or unpermitted comparative advertising has not yet been published but publication is imminent, the prohibition of such publication.

(5) This section shall not exclude voluntary control of misleading or comparative advertisement by self-regulatory bodies and recourse to such bodies by the persons if proceedings before such bodies are in addition to the tribunal proceedings referred to in sub-section (3).

CHAPTER VIII.- ASSIGNMENT AND TRANSMISSION

69. Assignment of registered trade mark.- (1) A registered trade mark shall be transmissible by assignment, testamentary disposition or operation of law in the same way as other personal or movable property.

(2) A registered trade mark shall also be transmissible either in connection with the goodwill of a business or independently.

(3) An assignment or other transmission of a registered trade mark may be partial; that is, limited so as to apply-

- (a) in relation to some but not all of the goods or services for which the trade mark is registered; or
- (b) in relation to use of the trade mark in a particular manner or a particular locality.

(4) An assignment of a registered trade mark, or an assent relating to a registered trade mark shall not be effective unless it is in writing signed by, or on behalf of, the assignor or, as the case may be, a personal representative.

(5) The provisions of sub-section (4) shall apply to assignment by way of security as in relation to any other assignment.

(6) Assignment or other transmission of a registered trade mark shall be the subject of charge in the same way as other personal or movable property.

(7) Nothing in this Ordinance shall be construed as affecting the assignment or other transmission of an unregistered trade mark as part of the goodwill of a business.

70. Registration of transactions affecting registered trade mark.- (1) On application being made to the Registrar by-

- (a) a person claiming to be entitled to an interest in, or under, a registered trade mark by virtue of a registrable transaction; or
- (b) any other person claiming to be affected by such a transaction;

the prescribed particulars of the transaction shall be entered in the Register.

(2) The following shall be registerable transactions, namely:-

- (a) an assignment of a registered trade mark or any right in it;
- (b) the grant of a licence under a registered trade mark;
- (c) the granting of any security interest whether fixed or floating over a registered trade mark or any right in or under it;
- (d) the making by personal representatives of an assent in relation to a registered trade mark or any right in or under it; and
- (e) an order of the High Court, District Court or other competent authority transferring a registered trade mark or any right in or under it.

(3) Until an application has been made for registration of the prescribed particulars of a registerable transaction-

- (a) the transaction shall be ineffective as against a person acquiring a conflicting interest in, or under, the registered trade mark in ignorance of it; and
- (b) a person claiming to be a licensee by virtue of the transaction shall not have the protection of section 69, 77 or 79.

(4) Provisions may be made by rules as to-

- (a) the amendment of registered particulars relating to a licence so as to reflect any alteration of the terms of the licence; and
- (b) the removal of such particulars from the Register-
 - (i) where it appears from the registered particulars that the licence was granted for a fixed period and that period has expired; or

- (ii) where no such period is indicated and, after such period as may be prescribed, the Registrar has informed the parties of his intention to remove the particulars from the Register.

(5) Provision may also be made by rules as to the amendment or removal from the Register of particulars relating to a security interest on the application of, or with the consent of, the person entitled to the benefit of the interest.

71. Application for registration of trade mark as an object of property.- (1) The provisions of sub-section (1) of section 39, sub-sections (2) to (7) of section 24, section 69 and section 70 shall apply, with the necessary modifications, in relation to an application for the registration of a trade mark, as in relation to a registered trade mark.

(2) In section 70 as it applies in relation to a transaction affecting an application for the registration of a trade mark, the references to the entry of particulars in the Register, and to the making of an application to register particulars, shall be construed as references to the giving of notice to the Registrar of those particulars.

CHAPTER IX.- USE OF TRADE MARKS AND LICENSEES

72. Proposed use of trade mark by company to be formed.-(1) No application for the registration of a trade mark in respect of any goods or services shall be refused, nor shall permission for such registration be withheld, on the ground only that it appears that the applicant does not use or propose to use the trade mark, if the Registrar is satisfied that-

- (a) a company is about to be formed and registered under the Companies Ordinance, 1984 (XLVII of 1984), or any modification thereof and that the applicant intends to assign the trade mark to that company with a view to the use thereof in relation to those goods or services by the company; or
- (b) the applicant intends it to be used by way of permitted use.

(2) The provisions of section 73 shall have effect, in relation to a trade mark registered under this sub-section, as if for the reference, in clause (a) of sub-section (1) of that section to intention on the part of an applicant for registration that a trade mark should be used by him there were substituted a reference to intention on his part that it should be used by the company or the authorised user concerned.

(3) The tribunal may, in a case to which clause (a) of sub-section (1) applies, require the applicant to give security for the costs of any proceedings relating to any opposition or appeal, and in default of such security being duly given, may treat the application as abandoned.

(4) Where in a case to which clause (a) of sub-section (1) applies, a trade mark in respect of any goods or services is registered in the name of an applicant who relies on intention to assign the trade mark to a company, then unless within such period as may be prescribed or within such further period not exceeding six months as the Registrar may, on application being made to him in the prescribed manner, allow the company has been registered as the proprietor of the trade mark in respect of those goods or services, the registration shall cease to have effect in respect thereof at the expiration of that period and the Registrar shall amend the Register accordingly.

73. Revocation of registration.- (1) The registration of a trade mark may be revoked on any of the following grounds, namely:-

- (a) that within the period of five years following the date of completion of registration procedure it has not been put to *bona fide* use in Pakistan by the proprietor or by an authorised user thereof, in relation to the goods or services for which it is registered and there are no proper reasons for its non-use;
- (b) that the *bona fide* use has been suspended for an uninterrupted period of five years and there are no proper reasons for its non-use;
- (c) that in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered; and
- (d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

(2) For the purposes of sub-section (1), use of a trade mark shall include use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered.

(3) The registration of a trade mark shall not be revoked on the grounds specified in clause (a) or (b) of sub-section (1), if such use, as it referred to in those clauses, is commenced or resumed after the expiry of the five years' period and before the application for revocation is made:

Provided that any such commencement or resumption of use after the expiry of five years period but only three months before the application for revocation is made, shall only be regarded if the preparation for commencement or resumption began before the proprietor became aware that the application is made.

(4) An application for revocation may be made by an interested party to the Registrar, except that-

- (a) if proceedings concerning the trade mark in question are pending in the High Court or a District Court, the application shall be made to the High Court or, as the case may be, the District Court; and

- (b) in case the application is made to the Registrar, he may at any stage of the proceedings refer the application to the High Court or a District Court.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

- (a) the date of the application for revocation; or
(b) if the Registrar, the High Court or a District Court is satisfied that the grounds for revocation existed at an earlier date, that date.

(7) Where the registration of a trade mark is revoked or declared invalid on the ground that the registration was secured in bad faith, the applicant shall be barred from applying for registration of the identical or similar trade mark for two years from the date of revocation or invalidation, whatever the case may be.

74. Use of trade mark by a person other than the proprietor thereof.- (1) The permitted use of a trade mark shall be deemed to be use of the trade mark by the owner of the trade mark and shall be deemed not to be use of the trade mark by a person other than the owner for any purpose for which such use is material under this Ordinance or any other law for the time being in force.

(2) The tribunal while determining as to whom the benefit of use of a trade mark be passed, shall pass the benefit to none else, except to-

- (a) the proprietor of the trade mark, if the trade mark is registered; or
(b) the owner of the trade mark, if the trade mark is entitled to protection under the Paris Convention as a well known trade mark.

75. Licensing of registered trade mark.- (1) A license to use a registered trade mark may be general or limited.

(2) A limited license may, in particular, apply-

- (a) in relation to some but not all of the goods or services for which the trade mark is registered; or
(b) in relation to use of the trade mark in a particular manner or a particular locality.

(3) A license shall not be effective unless it is in writing signed by or on behalf of the grantor.

(4) Unless the license provides otherwise, it shall be binding on a successor in title to the grantor's interest.

(5) Where the license so provides, a sub-license may be granted by the licensee, and references in this Ordinance to a license or licensee shall include a sub-license or sub-licensee.

76. **Exclusive license defined.** - (1) In this Ordinance, an "exclusive license " means a license, whether general or limited, authorizing the licensee to the exclusion of all other persons including the person granting the license, to use a registered trade mark in the manner authorised by the license and the expression "exclusive licensee" shall be construed accordingly.

(2) An exclusive licensee shall have the same rights against a successor in title who is bound by the license as he has against the person granting the license.

77. **General provisions as to the rights of licensees in case of infringement.**- (1) Save as provided in section 61, a licensee shall be entitled, unless his licence, or any licence through which his interest is derived, provides otherwise, to call on the proprietor of the registered trade mark to take infringement proceedings in respect of any matter which affects his interests:

Provided that if the proprietor-

(a) refuses to do so; or

(b) fails to do so within two months after being called upon,

the licensee may bring the proceedings in his own name as if he were the proprietor.

(2) Where infringement proceedings are brought by a licensee under this section, the licensee may not, without the leave of the High Court or a District Court, proceed with the action unless the proprietor is either joined as a plaintiff or added as a defendant:

Provided that this shall not affect the granting of interlocutory relief on an application by a licensee alone.

(3) A proprietor who is added as a defendant as provided in sub-section (2) shall not be made **liable for any costs in the action unless he takes part in the proceedings.**

(4) In infringement proceedings brought by the proprietor of a registered trade mark any loss suffered or likely to be suffered by licensees shall be taken into account and the High Court or a District Court may give such directions as it thinks fit as to the extent to which the plaintiff shall hold the proceeds of any pecuniary remedy on behalf of licensees.

(5) The provisions of this section shall apply in relation to an exclusive licensee if or to the extent that he has, under sub-section (1) of section 78, the rights and remedies of an assignee as if he were the proprietor of the registered trade mark.

78. Exclusive licensee having rights and remedies of assignee.- (1) An exclusive license may provide that the licensee shall have, to such extent as may be provided by the license, the same rights and remedies in respect of matters occurring after the grant of the license as if the license had been assignment. Where or to the extent that such provision is made, the licensee shall be entitled, subject to the provisions of the license and to the following provisions of this section, to bring infringement proceedings, against any person other than the proprietor, in his own name.

(2) Any such rights and remedies of an exclusive licensee shall be concurrent with those of the proprietor of the registered trade mark, and references to the proprietor of a registered trade mark in this Ordinance relating to infringement shall be construed accordingly.

(3) In an action brought by an exclusive licensee by virtue of this section, a defendant may avail himself of any defence which would have been available to him if the action had been brought by the proprietor of the registered trade mark.

(4) Where proceedings for infringement of a registered trade mark brought by the proprietor or an exclusive licensee relate wholly or partly to an infringement in respect of which they have concurrent rights of action, the proprietor or, as the case may be, the exclusive licensee may not, without the leave of the High Court or a District Court, proceed with the action unless the other is either joined as a plaintiff or added as a defendant:

Provided that this shall not affect the granting of interlocutory relief on an application by a proprietor or exclusive licensee alone.

(5) A person who is added as a defendant as mentioned in sub-section (4) shall not be made liable for any costs in the action unless he takes part in the proceedings.

(6) Where an action for infringement of a registered trade mark is brought which relates wholly or partly to an infringement in respect of which the proprietor and an exclusive licensee have or had concurrent rights of action-

(a) the High Court or a District Court shall in assessing damages take into account-

- (i) the terms of the license; and
- (ii) any pecuniary remedy already awarded or available to either of them in respect of the infringement;

- (b) no account of profits shall be directed if an award of damages has been made, or an account of profits has been directed, in favour of the other of them in respect of the infringement; and
- (c) the High Court or a District Court shall if an account of profits is directed apportion the profits between them as it, subject to any agreement between them, considers just.

(7) The provisions of sub-section (6) shall apply whether or not the proprietor and the exclusive licensee are both parties to the action, the High Court or a District Court may give such directions as it thinks fit as to the extent to which the party to the proceedings shall hold the proceeds of **any pecuniary** remedy on behalf of the other.

(8) The proprietor of a registered trade mark shall inform any **exclusive licensee who has a** concurrent right of action before applying for an order under section 48, and the **High Court or a District** Court may, on the application of the licensee, make such order under that section as it thinks fit **having** regard to the license.

(9) The provisions of sub-sections (4) to (8) shall have effect subject to any agreement to the contrary between the exclusive licensee and the proprietor.

79. Surrender of registered trade mark.- (1) A registered trade mark may be surrendered by the proprietor in respect of some, or all, of goods or services for which it is registered.

- (2) Provisions may be made by rules,
 - (a) as to the manner and effect of a surrender; and
 - (b) for protecting the interests of other persons having right in the registered trade mark.

80. Grounds for invalidity of registration.- (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 14 or any of the provisions thereof.

(2) Where the trade mark was registered in breach of clause (b), (c) or (d) of sub-section (1) of section 14, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

- (3) The registration of a trade mark may be declared invalid on the ground that there is
 - (a) an earlier trade mark in relation to which the conditions set out in sub-section (1), (2) or (3) of section 17 obtain; or

(b) an earlier right in relation to which the condition set out in sub-section (4) of section 17 is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(4) An application for declaration of invalidity may be made by an interested party either to the Registrar or to the High Court or a District Court, except that-

- (a) if proceedings concerning the trade mark in question are pending in the High Court or a District Court, the application shall be made to the High Court or a District Court; and
- (b) in any other case, if the application has been made to the Registrar, he may at any stage of the proceedings refer the application to the High Court or a District Court.

(5) In the case of bad faith in the registration of a trade mark, the Registrar may apply to the High Court or a District Court for a declaration of the invalidity of the registration.

(6) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(7) Where the registration of a trade mark has been declared invalid to any extent, the registration shall to that extent be deemed never to have been made provided that this shall not affect the transactions past and closed.

81. Effect of acquiescence.- (1) Where the owner of an earlier trade mark, or other earlier rights, has acquiesced for a continuous period of five years from the date of registration in the use of a registered trade mark in Pakistan, being aware of that use, there shall cease to be any entitlement on the basis of that earlier trade mark or other right-

- (a) to apply for a declaration that the registration of the later trade mark is invalid; or
- (b) to oppose the use of the later trade mark in relation to the goods or services in relation to which it has been so used,

unless the registration of the later trade mark was applied for or used in bad faith.

(2) Where sub-section (1) applies, the proprietor of the later trade mark shall not be entitled to oppose the use of the earlier trade mark or, as the case may be, the exploitation of the earlier right, notwithstanding that the earlier trade mark or right may no longer be invoked against his later trade mark.

82. Collective marks.- (1) A collective mark shall be a mark distinguishing the goods or services of members of the association which is the proprietor of the mark from those of other undertakings.

(2) The provisions of this Ordinance shall apply to collective marks subject to the provisions of the First Schedule.

83. Certification marks.- (1) A certification mark shall be a mark indicating that the goods or services in connection with which it is used are certified by the proprietor of the mark in respect of origin, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics.

(2) The provisions of this Ordinance shall apply to certification marks subject to the provisions of the Second Schedule.

84. Domain names.- (1) A domain name shall be a mark which is a user friendly substitute for an Internet address.

(2) The provisions of this Ordinance shall apply to domain names subject to the provisions of the Third Schedule.

CHAPTER X. -THE PARIS CONVENTION

85. Meaning of "Paris Convention" and "Convention country".- In this Ordinance-

- (a) "Paris Convention" means the Paris Convention for the Protection of Industrial Property of the 20th March, 1883, as revised or amended from time to time; and
- (b) a "Convention country" means a country other than Pakistan which is a party to the Paris Convention.

86. Protection of well known trade mark.- (1) References in this Ordinance to a trade mark which is entitled to protection as a well-known trade mark shall be to a mark which is so entitled under the Paris Convention and which is well-known in Pakistan as being the mark of a person who-

- (a) is a national of a Convention country; or
- (b) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country,

whether or not that person carries on business, or has any goodwill, in Pakistan and references to the proprietor of such a mark shall be construed accordingly.

(2) For the purposes of this Ordinance, the tribunal while determining whether a trade mark is well known, without having to require registration or actual use in the form of sales of goods or services under the trade mark in Pakistan, shall consider the following factors as relevant criteria for establishing the well known status of the trade mark, namely:-

- (i) the amount of Pakistan or worldwide recognition of the trade mark;

- (ii) the degree of inherent or acquired distinctiveness of the trade mark;
- (iii) the Pakistan or worldwide duration of the use and advertising of the trade mark;
- (iv) the Pakistan or worldwide commercial value attributed to the trade mark;
- (v) the Pakistan or worldwide geographical scope of the use and advertising of the trade mark;
- (vi) the Pakistan or worldwide quality and image that the trade mark has acquired; and
- (vii) the Pakistan or worldwide exclusivity of use and registration attained by the trade mark and the presence or absence of identical or deceptively similar third party trade marks validly registered or used in relation to identical or similar goods and services.

(3) The owner of a trade mark which is entitled to protection under the Paris Convention as a well-known trade mark shall be entitled to restrain by injunction the use in Pakistan of a trade mark which, or the essential part of which, is identical or deceptively similar to the well-known trade mark-

- (a) in relation to identical or similar goods or services, where the use is likely to cause confusion; or
- (b) where such use causes dilution of the distinctive quality of the well-known trade mark.

(4) Rights conferred under sub-section (3) shall be subject to the provisions of section 81 and nothing in the said sub-section shall affect the continuation of any *bona fide* use of a trade mark begun before the commencement of this Ordinance.

87. National emblems of Convention countries.- (1) A trade mark which consist of or contains the flag of a Convention country shall not be registered without the authorization of the competent authorities of that country, unless it appears to the Registrar that use of the flag in the manner proposed is permitted without such authorization.

(2) A trade mark which consists of, or contains, the armorial bearings or any other state emblem of a Convention country which is protected under the Paris Convention shall not be registered without the authorization of the competent authorities of that country.

(3) A trade mark which consists of, or contains, official mark or hallmark adopted by a Convention country and indicating control and warranty shall not, where the mark or hallmark is protected under the Paris Convention, be registered in relation to goods or services of the same, or a similar kind, as those in relation to which it indicates control and warranty, without the authorization of competent authorities of the country concerned.

(4) The provisions of this section as to national flag and other state emblem, and official mark or hallmark, shall apply equally to anything which from a heraldic point of view imitates such flag or other emblem, mark or hallmark.

(5) Nothing in this section shall prevent the registration of a trade mark on the application of the national of a country who is authorized to make use of a state emblem, or official mark or hallmark, of that country, notwithstanding that it is similar to that of another country.

(6) Where by virtue of this section the authorization of competent authorities of a Convention country is or would be required for the registration of a trade mark, those authorities shall be entitled to restrain by injunction any use of the mark in Pakistan without their authorization.

88. Emblems of certain international organizations.-(1) A trade mark which consists of or contains any such emblem, abbreviations or name which is protected under the Paris Convention shall not be registered without the authorization of the international organization concerned, unless it appears to the Registrar that the use of the emblem, abbreviation or name in the manner proposed-

- (a) is not such as to suggest to the public that a connection exists between the organization and the trade mark; or
- (b) is not likely to mislead the public as to the extent of a connection between the user and the organization.

(2) The provisions of this section as to emblem of an international organization shall apply equally to anything which from a heraldic point of view imitates any such emblem.

(3) Where under this section the authorization of an international organization is, or would be, required for the registration of a trade mark, that organization shall be entitled to restrain by injunction any use of the mark in Pakistan without its authorization.

(4) Nothing in this section shall affect the rights of a person whose *bona fide* use of the trade mark in question began before the commencement of this Ordinance.

89. Notification under Article 6ter of the Paris Convention.- (1) For the purposes of section 87, state emblem of a Convention country, other than the national flag, and official marks and hallmarks, shall be regarded as protected under the Paris Convention only if, or to the extent that-

- (a) the country in question has notified Pakistan in accordance with Article 6ter(3) of the Paris Convention that it desires to protect that emblem, mark or hallmark;
- (b) the notification remains in force; and
- (c) Pakistan has not objected to it in accordance with Article 6ter(4) of the Paris Convention or any such objection has been withdrawn.

(2) For the purposes of section 88, the emblems, abbreviations and names of an international organization shall be regarded as protected under the Paris Convention only if, or to the extent that-

- (a) the organization in question has notified Pakistan in accordance with Article 6ter(3) of the Paris Convention that it desires to protect that emblem, abbreviation and name;
- (b) the notification remains in force; and
- (c) Pakistan has not objected to it in accordance with Article 6ter(4) of the Paris Convention, or any such objection has been withdrawn.

(3) A notification under Article 6ter(3) of the Paris Convention shall have effect only in relation to applications for registration made more than two months after the receipt of such notification.

(4) The Registrar shall keep and make available for public inspection by any person, at all reasonable hours and free of charge, a list of-

- (a) the state emblems and official marks or hallmarks; and
- (b) the emblems, abbreviations and names of international organizations,

which are for the time being protected under the Paris Convention by virtue of notification under Article 6ter(3) of the Paris Convention.

90. Acts of agent or representative.-(1) Where an application for registration of a trade mark is made by a person who is an importer, or an agent not being an agent under section 128, or a representative of a person who is the proprietor of the mark in a Convention country, then-

- (a) if the proprietor opposes the application, registration shall be refused; or
- (b) if the application, not being so opposed, is granted, the proprietor may-
 - (i) apply for the declaration of the invalidity of the registration; or
 - (ii) apply for the rectification of the Register so as to substitute his name as the proprietor of the registered trade mark.

(2) The proprietor may notwithstanding the rights conferred by this Ordinance, in relation to a registered trade mark, by injunction restrain any use of the trade mark in Pakistan which is not authorised by him.

(3) The provisions of sub-section (1) or (2) shall not apply if, or to the extent that, the agent or representative justifies his action.

(4) An application under clause (a) or (b) of sub-section (1) shall be made within three years of the proprietor becoming aware of the registration, and no injunction shall be granted under sub-section (2) in respect of a use in which the proprietor has acquiesced for a continuous period of three years or more.

91. **Nature of goods or services to which a mark is to be applied.**- For the purposes of registration of a trade mark under this Ordinance, the nature of goods or services to which a trade mark is to be applied shall in no case form an obstacle to the registration of the trade mark.

92. **Trade name.**- A trade name shall be protected without the obligation of filing or registration under this Ordinance whether it forms part of a trade mark or not.

CHAPTER XI.- SPECIAL PROVISIONS FOR TEXTILE GOODS

93. **Textile goods.**- The Federal Government shall prescribe classes of goods, in this Chapter referred to as textile goods, to the trade marks used in relation to which the provisions of this Chapter shall apply, and subject to the said provisions, the other provisions of this Ordinance shall apply to such trade marks as they apply to trade marks used in relation to other classes of goods.

94. **Restrictions on registration of textile goods.**- (1) In respect of textile goods, being piece goods-

- (a) no mark consisting of a line heading alone shall be registerable as a trade mark;
- (b) a line heading shall not be deemed to be adapted to distinguish; and
- (c) the registration of a trade mark shall not give any exclusive right to the use of a line heading.

(2) In respect of any textile goods, the registration of letters or numerals, or any combination thereof, shall be subject to such conditions and restrictions as may be prescribed.

95. **Advisory Committees.**- (1) The Federal Government may, in such manner, as may be prescribed, constitute one or more Advisory Committees of persons well versed in the usages of the textile trade for the purposes of this Chapter.

(2) The Registrar shall consult any such Advisory Committee with respect to any circumstances peculiar to the textile trade arising on an application to register a trade mark in respect of textile goods.

(3) The place of meeting and the conduct of business of any such Advisory Committee shall be determined as may be prescribed.

CHAPTER XII.- RECTIFICATION AND CORRECTION OF THE REGISTER

96. Rectification or correction of Register.-(1) Any person having a sufficient interest may apply for the rectification of an error or omission in the Register:

Provided that an application for rectification may not be made in respect of a matter affecting the validity of the registration of a trade mark.

- (2) An application for rectification may be made to the Registrar, except that-
- (a) if proceedings concerning the trade mark in question are pending in the High Court or a District Court, the application shall be made to the High Court or a District Court; and
 - (b) in case the application is made to the Registrar, he may at any stage of the proceedings refer the application to the High Court or a District Court.

(3) Except where the Registrar or the High Court or a District Court directs otherwise, the effect of rectification of the Register shall be that the error or omission in question shall be deemed never to have been made.

(4) The Registrar may, on application made in such manner, as may be prescribed, by the proprietor of the registered trade mark, or a licensee, enter any change in his name or address as recorded in the Register.

97. Adoption of entries to new classification.-(1) The Registrar may, if he considers it necessary, implement any amended or substituted classification of goods or services for the purposes of the registration of trade marks as may be prescribed.

(2) The existing entries on the Register may be amended to record any new classification as may be prescribed.

(3) Any such power of amendment referred to in sub-sections (2) and (3), shall not be exercised so as to extend the rights conferred by the registration except where it appears to the Registrar that compliance with this requirement would involve undue complexity and that any extension would not be substantial and would not adversely affect the rights of any person.

(4) The Registrar may, -

- (a) require the proprietor of a registered trade mark, within such time as may be prescribed, to file a proposal for amendment of the Register; and

- (b) cancel or refuse to renew the registration of the trade mark in the event of his failing to do so.

(5) Any proposal, referred to in sub-section (4), shall be advertised and may be opposed in such manner as may be prescribed.

CHAPTER XIII. - OFFENCES, PENALTIES AND PROCEDURE

98. Meaning of applying a trade description.-(1) A person shall be deemed to apply a trade description to goods or services who-

- (a) applies a trade description to the goods themselves or uses it in relation to goods or services;
- (b) applies a trade description to any package in or with which the goods are sold, or exposed for sale, or had in possession for sale or for any purpose of trade or manufacture;
- (c) places, encloses or annexes any goods which are sold or exposed for sale, or had in possession for sale or for any purpose of trade or manufacture in or with any package or other thing to which a trade description has been applied;
- (d) uses a trade description in any manner reasonably likely to lead to the belief that the goods or services in connection with which it is used are designated or described by that trade description; or
- (e) in relation to the goods or services uses a trade description in any sign, advertisement, invoice, catalogue, business letter, price list or other commercial documents, and goods are delivered or services are rendered to a person in pursuance of a request or order made by reference to the trade description as so used.

(2) A trade description shall be deemed to be applied to goods whether it is woven in, impressed on, otherwise worked into, or annexed or affixed to, the goods or to any packaging or other thing.

99. Penalty for applying false trade description, etc.- Any person who-

- (a) applies any false trade description to goods or services; —
- (b) applies to any goods to which an indication of the country or place in which they were made or produced or the name and address of manufacturer or person for whom the goods are manufactured is required to be applied under section 126, a false indication of such country, place, name or address;
- (c) tampers with, alters or effaces an indication of origin which has been applied to any

goods to which it is required to be applied under section 126; or

(d) causes any of the aforementioned things to be done,

shall, unless he proves that he acted without intent to defraud, be punished with imprisonment of either description for a term which shall not be less than three months but which may extend to two years, or with fine which shall not be less than fifty thousand rupees, or with both.

100. Enhanced penalty on second or subsequent convictions.-Whoever having already been convicted of an offence under section 99 is again convicted of any such offence shall be punished for the second and every subsequent offence with imprisonment of either description for a term which shall not be less than six months but which may extend to three years, or with fine which shall not be less than one hundred thousand rupees, or with both.

101. Penalty for falsification of entries in Register.-Any person who makes, or causes to be made, a false entry in the Register, or a writing falsely purporting to be a copy of an entry in the Register, or produces or tenders, or causes to be produced or tendered, in evidence any such writing, knowing the entry or writing to be false, he shall be punishable with imprisonment for a term which shall not be less than three months but which may extend to two years, or with fine which shall not be less than fifty thousand rupees, or with both.

102. Penalty for falsely representing a trade mark as registered.- (1) No person shall make any representation-

- (a) with respect to a mark not being a registered trade mark, to the effect that it is a registered trade mark;
- (b) with respect to a part of a registered trade mark not being a part separately registered as a trade mark, to the effect that it is separately registered as a trade mark;
- (c) to the effect that a registered trade mark is registered in respect of any goods or services in respect of which it is not, in fact, registered; or
- (d) to the effect that the registration of a trade mark gives an exclusive right to the use thereof in any circumstances in which, having regard to limitations entered on the Register, the registration does not, in fact, give that right.

(2) If any person contravenes any of the provisions of sub-section (1), he shall be punishable with imprisonment for a term which shall not be less than one month but which may extend to six months, or with fine which shall not be less than twenty thousand rupees, or with both.

(3) For the purposes of this section, the use in Pakistan in relation to a trade mark of the word "registered", or of any other expression referring whether expressly or impliedly to registration, shall be deemed to import a reference to registration in the Register, except-

- (a) where that word or other expression is used in direct association with other words delineated in characters at least as large as those in which that word or other expression is delineated and indicating that the reference is to registration as a trade mark under the laws of a country other than Pakistan, being a country under the laws of which the registration referred to is, in fact, in force;
- (b) where that other expression is of itself such as to indicate that the reference is to such registration as is mentioned in clause (a); or
- (c) where that word is used in relation to a mark registered as a trade mark under the laws of a country other than Pakistan and in relation solely to goods or services to be exported to that country.

(4) The Registrar may, either *suo moto* or upon a complaint in writing made to him, call upon any person who is allegedly contravening any of the provisions of clauses (a) to (d) of sub-section (1) to show cause as to why action should not be taken against him:

Provided that power of the Registrar shall be limited to the imposition of fine as provided under sub-section (2) or, if pending, to refusal of application for registration of the trade mark, or if the trade mark is registered, to invalidation of the registration, or any combination thereof, as the case may be.

103. Restraint of use of Government Arms and State emblems.- If a person, without due authority, uses in connection with any trade, business, calling or profession-

- (a) the flag of Pakistan in such manner as to be misleading;
- (b) Government Arms or arms so closely resembling the same as to be calculated to deceive, in such manner as to be calculated to lead to the belief that he is duly authorised so to use the Government Arms;
- (c) name, title and semblance of Quaid-i-Azam Mohammad Ali Jinnah or Allama Dr. Mohammad Iqbal or any variations thereof, or any device, emblem or title in such manner as to be calculated to lead to the belief that he is employed by, or supplies goods to, or is connected with, the Federal Government or any Provincial Government or any department of any such Government; or
- (d) the emblem, the official seal and the name or any abbreviation of the name of the United Nations or any subsidiary body set up by the United Nations or of the World Health Organization or of the World Intellectual Property Organization or of the World Trade Organization in such manner as is to be calculated to lead to the belief that he is duly authorized by the competent authorities of these organizations to use the emblem, seal or name,

he may, at the suit of the Registrar or of any person who is authorized to use such Arms, device, emblem or title, be restrained by injunction from continuing so to use the same:

Provided that nothing in this section shall be construed as affecting the right, if any, of the proprietor of a trade mark containing such Arms, device, emblem or title to continue to use such trade mark.

104. Offences by companies.- (1) If the person committing an offence under this Ordinance is a company, the company as well as every person in charge of, and responsible to, the company for the conduct of its business at the time of the commission of the offence shall be deemed to be guilty of the offence and shall be liable to be proceeded against and punished accordingly:

Provided that nothing contained in this sub-section shall render any such person liable to any punishment if he proves that the offence was committed without his knowledge or that he exercised all due diligence to prevent the commission of such offence.

(2) Notwithstanding anything contained in sub-section (1), where an offence has been committed by a company and it is proved that the offence has been committed with the consent or connivance of, or that the commission of the offence is attributable to any neglect on the part of any director, manager, secretary or other officer of the company, such director, manager, secretary or other officer shall also be deemed to be guilty of that offence and shall be liable to be proceeded against and punished accordingly.

Explanation. - For the purposes of this section-

- (a) "company" means any body corporate and includes a partnership, firm or other association of individuals; and
- (b) "director" in relation to a firm, means a partner in the firm.

105. Powers to award compensation for offenses.- (1) In any prosecution under this Ordinance, the High Court or a District Court may, when passing a sentence of fine, direct that an amount not exceeding fifty per cent of the fine imposed by it but commensurate with the loss suffered by the party shall be paid as compensation to the person whose right has been infringed or to the heirs or legal representatives of such person.

(2) The payment of any compensation to any person under sub-section (1), shall be without prejudice to his right to any claim in a suit or other proceedings which may be instituted, or may be pending in the High Court or a District Court, in relation to the same matter.

106. Punishment of abetment in Pakistan of acts done out of Pakistan.- If any person, being within Pakistan, abets the commission, without Pakistan of any act which, if committed in Pakistan, would, under this Ordinance, be an offence, he may be tried for such abetment in any place in Pakistan in which he may be found and be punished therefor with the punishment to which he would be liable if he had himself committed in that place the act which he abetted.

107. Penalty for improperly describing a place of business as connected with the Trade Marks Registry.- If any person uses his place of business, or on any document issued by him, or otherwise, words which would reasonably lead to the belief that his place of business is, or is officially connected with, the Trade Marks Registry, he shall be guilty of an offence punishable with imprisonment for a term which may extend to two years, or with fine, or with both.

CHAPTER XIV.- MISCELLANEOUS AND GENERAL PROVISIONS

108. Power of Registrar to require use of forms.- (1) The Registrar may require the use of such forms as he may direct for any purpose relating to the registration of a trade mark or any other proceedings before him under this Ordinance.

(2) The forms and any directions of the Registrar with respect to their use shall be notified in the manner as may be prescribed.

109. Information about applications and registered trade marks.- (1) After publication of an application for registration of a trade mark the Registrar shall on request provide a person with such information and permit him to inspect such documents relating to the application, or to any registered trade mark resulting from it, as may be specified in the request, subject to such restrictions, as may be prescribed.

(2) Any request under sub-section (1) shall be made in the prescribed manner and be accompanied by the prescribed fee.

(3) Before publication of an application for registration of a trade mark, document or information constituting or relating to the application shall not be published by the Registrar or communicated by him to any person except-

- (a) in such cases and to such extent as may be prescribed; or
- (b) with the consent of the applicant,

but subject to the provisions of sub-section (4).

(4) Where a person has been informed that an application for registration of a trade mark has been made, and that the applicant will if the application is granted bring proceedings against him in respect of acts done after publication of the application, he may make a request under sub-section (1) notwithstanding that the application has not been published and that sub-section shall apply accordingly.

110. Costs, security for costs and fine.- (1) Provisions may be made by rules empowering the Registrar, in any proceedings before him under this Ordinance-

- (a) to award any party such costs as he may consider reasonable;
- (b) to impose fine as he may consider reasonable; and
- (c) to direct how and by whom costs or fines shall be paid.

(2) Any such order of the Registrar may be executable in the same way as a decree of a Civil Court.

(3) Provisions may be made by rules empowering the Registrar, in such cases as may be prescribed, to require a party to proceedings before him to give security for costs in relation to those proceedings or to proceedings on appeal and as to the consequences if security is not given.

111. Procedure before the Registrar.- (1) In all proceedings under this Ordinance before the Registrar-

- (a) the Registrar shall have all the powers of a Civil Court for the purposes of receiving evidence, administering oaths, enforcing the attendance of witnesses, compelling the discovery and production of documents, issuing commissions for the examination of witnesses and granting a certificate of contested validity;
- (b) evidence shall be given by affidavit, provided that the Registrar may, if he thinks fit, take oral evidence in lieu of, or in addition to, such evidence by affidavit.

(2) the Registrar shall not exercise any powers vested in him by this Ordinance or the rules made thereunder adversely to any party duly appearing before him, if required in writing within the prescribed time so to do, without giving such party an opportunity of being heard.

112. Certificate of validity of contested registration.- If in any legal proceedings in which the validity of the registration of a trade mark comes into question and a decision is given in favour of the proprietor of the trade mark, the tribunal may grant a certificate to that effect, and if such a certificate is granted, then in any subsequent legal proceedings in which the said validity comes into question, the said proprietor on obtaining a final order or judgement in his favour shall, unless the said final order or judgement for sufficient reason directs otherwise, be entitled to his full costs, charges and expenses as between legal practitioner and client.

113. Registrar's appearance in proceedings involving the Register.- (1) In all proceedings before the Court involving application for-

- (a) the revocation of the registration of a trade mark;
- (b) a declaration of the invalidity of the registration of a trade mark; or
- (c) the rectification of the Register,

the Registrar shall be entitled to appear and be heard and shall appear if so directed by the High Court.

(2) Unless otherwise directed by the High Court, the Registrar may instead of appearing submit to the High Court a statement in writing signed by him, giving particulars of-

- (a) any proceedings before him in relation to the matter in issue;
- (b) the grounds of any decision given by him affecting it;
- (c) the practice of the Trade Marks Registry in like cases; or
- (d) such matters relevant to the issues and within his knowledge as Registrar as he thinks fit.

and the statement shall be deemed to form part of the evidence in the proceedings

(3) Anything which the Registrar is or may be authorized or require to do under this section may be done on his behalf by a duly authorized officer by him.

114. Appeal against the decision of the Registrar.- (1) Save as otherwise expressly provided in this Ordinance, an appeal shall lie, within the prescribed period, against any decision of the Registrar under this Ordinance or rules made thereunder to the High Court having jurisdiction:

Provided that if any suit or other proceedings concerning the trade mark in question is pending before the High Court or a District Court, the appeal shall lie to that High Court or, as the case may be, to the High Court within whose jurisdiction that District Court is situated.

(2) In an appeal by an applicant for registration against a decision of the Registrar under section 21, 22 or 28, it shall not be open, save with the express permission of the High Court, to the Registrar or any party opposing the appeal to advance grounds other than those recorded in the said decision or advanced by the party in the proceedings before the Registrar, as the case may be, and where any such additional grounds are advanced, the applicant for registration may, on giving notice in the prescribed manner, withdraw his application without being liable to pay the costs of the Registrar or the parties opposing his application.

(3) Subject to the provisions of this Ordinance and of rules made thereunder, the provisions of the Code of Civil Procedure, 1908 (Act V of 1908), shall apply to appeal before the High Court or a District Court under this Ordinance.

115. Procedure before the Federal Government.- In all proceedings under this Ordinance before the Federal Government, evidence shall be given by affidavit, provided that the Federal Government may, if it thinks fit, take oral evidence in lieu of, or in addition to, such evidence by affidavit, and shall for that purpose have all the powers of a Civil Court referred to in clause (a) of section 111.

116. Procedure in certain cases of option to apply to the High Court, a District Court or the Registrar.- Where under this Ordinance, an applicant has the option of making an application either to the High Court or a District Court or to the Registrar-

- (a) if any suit or proceedings concerning the trade mark in question are pending before the High Court or a District Court, the application shall be made to the High Court or, as the case may be, the District Court; and
- (b) in any other case, if the application is made to the Registrar, he may at any stage of the proceedings refer the application to the High Court or a District Court.

117. Suits for infringement to be instituted before District Court.- No suit for the infringement of a trade mark or otherwise relating to any right in a trade mark shall be instituted in any court inferior to a District Court having jurisdiction to try the suit.

118. Costs of Registrar in proceedings before the High Court or a District Court.- In all proceedings under this Ordinance before the High Court or a District Court, the costs of the Registrar shall be in the discretion of the High Court or, as the case may be, the District Court, but the Registrar shall not be ordered to pay the costs of any of the parties.

119. Burden of proving use of trade mark.- If in any civil proceedings under this Ordinance, if a question arises as to the use to which a registered trade mark has been put, it shall be for the proprietor to show what use has been made of it.

120. Certain persons to be public servants.- Every person appointed under this Ordinance shall be deemed to be a public servant within the meaning of section 21 of the Pakistan Penal Code, 1860 (Act XLV of 1860).

121. Documents open to public inspection.- (1) Save as otherwise provided in this Ordinance -

- (a) the Register and any document upon which any entry in the Register is based;
- (b) every notice of opposition to the registration of a trade mark, application for rectification before the Registrar, counter-statement thereto, and any affidavit or documents filed by the parties in any proceedings before the Registrar;

(c) such other documents as the Registrar may, by notification in the Journal specify, shall, subject to such conditions as may be prescribed, be open to public inspection at the Trade Marks Registry.

(2) Any person may, on an application to the Registrar and on payment of such fees as may be prescribed, obtain a certified copy of any entry in the Register or any document referred to in sub-section (1).

122. Death of a party to any proceedings under this Ordinance.- If a person who is a party to any proceedings under this Ordinance, not being any proceedings before the High Court or a District Court, dies pending the proceedings, the Registrar may, on request, and on proof to his satisfaction of the transmission of the interest of the deceased person, substitute in the proceedings his successor in interest in his place, or if the Registrar is of opinion that the interest of the deceased person is sufficiently represented by the surviving parties, permit the proceedings to continue without the substitution of his successor in interest.

123. Extension of time.- (1) If the Registrar is satisfied, on application made to him in the prescribed manner and accompanied by the prescribed fee, that there is sufficient cause for extending the time for doing any act not being a time expressly provided in this Ordinance, whether the time so specified has expired or not, he may subject to such conditions as he may think fit to impose, extend the time and inform the parties accordingly.

(2) Nothing in sub-section (1) shall be deemed to require the Registrar to hear the parties before disposing of an application for extension of time and no appeal shall lie from any order of the Registrar under this section.

124. Registrar and other officers not compellable to produce Register, etc.- The Registrar or any officer of the Trade Marks Registry shall not, in any legal proceedings to which he is not a party, be compellable to produce the Register or any other document in his custody the contents of which can be proved by the production of a certified copy issued under this Ordinance or to appear as a witness to prove the matters therein recorded unless by order of the High Court or a District Court made for special case.

125. Power to require goods to show indication of origin.- (1) The Federal Government may, by notification in the official Gazette, require that goods of any description specified in the notification, which are made or produced beyond the limits of Pakistan and imported into Pakistan, or which are made or produced within the limits of Pakistan, shall from such date as may be appointed by the notification not being less than three months from its issue, have applied to them an indication of the county or place in which they were made or produced, and of the name and address of the manufacturer or the person for whom the goods were manufactured.

(2) The notification under sub-section (1) may specify the manner in which such indication shall be applied, that is to say, whether to goods themselves or in any other manner and the times or occasions on which the presence of the indication shall be necessary, that is to say, whether on importation only, or also at the time of sale, whether by wholesale or retail or both.

(3) The provisions of section 23 of the General Clauses Act, 1897 (X of 1897), shall apply to the issue of a notification under sub-section (1), as they apply to the making of a rule or by-law the making of which is subject to the condition of previous publication.

(4) A notification under sub-section (1), shall not apply to goods made or produced beyond the limits of Pakistan and imported into Pakistan, if in respect of those goods the Collector of Customs is satisfied at the time of importation that they are intended for exportation whether after transshipment in or transit through Pakistan or otherwise.

126. Address for service.- (1) Every applicant or opponent in any proceedings under this Ordinance, who does not reside or carry on business within Pakistan, shall give an address for service in Pakistan and such address may be treated as the actual address of that person for all purposes connected with the proceedings in question.

(2) The address for service shall be deemed to be address of the applicant or the opponent and all documents in relation to the application or notice of opposition may be served by leaving them at or sending them by registered post to the address for service of the applicant or opponent, as the case may be.

127. Trade mark agents.- (1) Where by or under this Ordinance any act, other than the making of an affidavit, is required to be done by any person, the act may, subject to such conditions as may be prescribed, be done, in lieu of by that person himself, by duly authorised agent whose is registered with the Trade Marks Registry in the prescribed manner as a trade mark agent.

(2) The Federal Government may, by notification in the official Gazette, make rules for providing qualifications, registration and conduct of trade mark agents.

128. Fees.-(1) There shall be paid in respect of applications and registration and other matters under this Ordinance such fees as may be prescribed.

(2) Provisions may be made by rules for-

- (a) the payment of a single fee in respect of two or more matters; and
- (b) the circumstances if any in which a fee may be repaid or remitted.

129. The Federal Government and a Provincial Government to be bound.- The provisions of this Ordinance shall be binding on the Federal Government and a Provincial Government.

130. Power to make reciprocal arrangements with any other Government.- Without prejudice to the provisions of Articles 3 and 4 of the Agreement on Trade Related Aspects of Intellectual Property Rights, 1994, the Federal Government may, by notification in the official Gazette, enter into reciprocal arrangements with other Governments for the purpose of this Ordinance.

131. Power of the High Court to make rules.- The High Court may make rules consistent with the provisions of this Ordinance as to the conduct and procedure of all proceedings under this Ordinance before it.

132. Power of the Federal Government to make rules:- (1) The Federal Government may, subject to the condition of previous publication, by notification in the official Gazette, make rules for carrying out the purposes of this Ordinance.

(2) In particular and without prejudice to the generality of the foregoing power, such rules may provide for all or any of the following matters, namely:-

- (i) the matters to be included in the Register under sub-section (1) of section 10;
- (ii) conditions and restrictions subject to which the Register shall be open to the inspection of the public under sub-section (5) of section 10;
- (iii) classification of goods and services in accordance with the international classification of goods and services under sub-section (1) of section 12;
- (iv) publication of alphabetical index of classification of goods and services under sub-section (2) of section 12;
- (v) the manner in which the Registrar may notify a word as an international non-proprietary name under section 16;
- (vi) the manner of making an application for registration of a trade mark under sub-section (1) of section 22;
- (vii) the manner and period for making a Convention application under clause (b) of sub-section (2) of section 25;
- (viii) the matters related to the manner of claiming a right to priority on the basis of a Convention application under sub-section (7) of section 25;
- (ix) conditions for grant of temporary protection in respect of goods or services during exhibition under sub-section (4) of section 26;

- (x) the manner of giving notice to the Registrar under sub-section (2) of section 28 for opposing an application for registration advertised or re-advertised under sub-section (1) of section 28 and the fee payable for such application, making an application for extension of time under sub-section (2) of section 28 and the fee payable for such application;
- (xi) the manner of serving a copy of the notice on the applicant, an application for extension of time under sub-section (4) of section 28 and the fee payable for such application, sending a counter-statement of the grounds and fee payable for such application;
- (xii) the manner of serving a copy of the counter-statement on the opponent, an application for extension of time under sub-section (5) of section 28 and the fee payable for such application, sending a rejoinder to the Registrar;
- (xiii) the manner of sending a copy of the rejoinder to the applicant under sub-section (6) of section 28;
- (xiv) the manner of submitting any evidence under sub-section (7) of section 28 and time limit for submitting such evidence;
- (xv) the manner of permitting correction of any error in, or any amendment of, a notice of opposition, a counter-statement, or a rejoinder under sub-section (9) of section 28;
- (xvi) the manner of notifying the Registrar under sub-clause (i) of clause (b) of section 30;
- (xvii) the time within which an application shall be registered under sub-section (1) of section 33;
- (xviii) the fee payable and the time within which such fee is payable under sub-section (2) of section 33;
- (xix) the manner of publication of the registration and the form of certificate of registration under sub-section (4) of section 33;
- (xx) the manner of giving notice under sub-section (5) of section 33;
- (xxi) the manner of informing the proprietor of a registered trade mark of the date of expiry within which the registration may be renewed under sub-section (2) of section 35;
- (xxii) the further period in which additional renewal fee shall be paid under sub-section (3) of section 35;
- (xxiii) the manner and conditions for restoration of the registration which has been removed from the Register under sub-section (6) of section 35;
- (xxiv) the matters related to the publication of alteration and the making of objections by any person claiming to be affected by it under sub-section (3) of section 37;
- (xxv) the matters related to manner and effect of a surrender, and for protecting the interests of other persons having a right in the registered trade mark under sub-section (2) of section 38;

- (xxvi) the time period within which the applicant, by notice in writing to the Collector of Customs, consents to the release of the goods under clause (a) of sub-section (2) of section 59;
- (xxvii) the particulars of the transaction which are to be entered in the Register under sub-sections (1) and (3) of section 70;
- (xxviii) the matters specified in sub-sections (4) and (5) of section 70;
- (xxix) the manner of making application and the fee payable for such application under sub-section (4) of section 72;
- (xxx) the classes of goods under section 93;
- (xxxi) the conditions and restrictions subject to which registration of letters or numerals, or any combination thereof in respect of textile goods may be allowed under sub-section (2) of section 94;
- (xxxii) the manner of constituting one or more Advisory Committees under sub-section (1) of section 95, and matters related to the place of meeting and conduct of business of such Committees under sub-section (3) of that section;
- (xxxiii) the manner of making an application under sub-section (4) of section 96;
- (xxxiv) the matters relating to empowering the Registrar to do such things as he considers necessary to implement any amended or substituted classification of goods or services for the purposes of the registration of trade marks under sub-section (1) of section 97;
- (xxxv) the time within which a proposal for amendment could be made under clause (a) of sub-section (4) of section 97;
- (xxxvi) the manner of opposition under sub-section (5) of section 97;
- (xxxvii) the manner of notification of the forms and any directions of the Registrar with respect to their use under sub-section (2) of section 108;
- (xxxviii) the restrictions imposed, manner of making application and fee payable under sub-section (1) of section 109;
- (xxxix) the cases and extent to which application for registration of a trade mark, documents or information constituting or relating to the application may be published by the Registrar or communicated by him to any person under sub-section (3) of section 109;
- (xl) the matters related to empowering the Registrar for the purposes of sub-section (1) of section 110;
- (xli) the matters related to empowering the Registrar to require a party to proceedings before him to give security for costs, in relation to those proceedings or to proceedings on appeal, and as to the consequences if security is not given under sub-section (3) of section 110;
- (xlii) the period within which an appeal from any decision of the Registrar under this Ordinance or rules made thereunder may lie to the High Court or a District Court having jurisdiction under sub-section (1) of section 114;

- (xliii) the manner of giving notice under sub-section (2) of section 114;
- (xliv) the conditions under which documents listed in sub-section (1) of section 121 may be open to public inspection under the said sub-section;
- (xlv) the fee payable for obtaining a certified copy under sub-section (2) of section 121;
- (xlvi) the manner of making an application and the fee payable therefor under sub-section (1) of section 123;
- (xlvii) the conditions under which any act other than the making of an affidavit may be done by duly authorized agent under sub-section (1) of section 127;
- (xlviii) the matters related to qualifications, registration and conduct of trade mark agents under sub-section (2) of section 127;
- (xlix) the fees payable for making applications, registrations and other matters under sub-section (1) of section 128;
 - (1) the matters related to the payment of a single fee in respect of two or more matters and the circumstances, if any, in which a fee may be repaid or remitted under sub-section (2) of section 128;
 - (li) the making of further requirements with which the regulations may have to comply under sub-para (2) of para 5 of the First Schedule;
 - (lii) the making of further requirements with which the regulations may have to comply under sub-para (2) of para 6 of the Second Schedule;
 - (liii) the procedure for identification and classification of computer related services associated with Internet under sub-para (3) of para 2 of the Third Schedule;
 - (liv) the making of procedure for putting entries under sub-para (2) of para 2, and sub-para (2) of para 9 of the Fourth Schedule;
 - (lv) the manner of making application and the fee payable for such application under sub-para (2) of para 11 of the Fourth Schedule;
 - (lvi) the entry of additional information in the Register;
 - (lvii) the regulation of awarding of costs by the Registrar under this Ordinance;
 - (lviii) the matters related to establishment of branches of the Trade Marks Registry;
 - (lix) the manner in which, in proceedings under this Ordinance before the Registrar or the Federal Government, application shall be made, notices given and matters advertised;
 - (lx) the matters related to times or periods required by this Ordinance to be advertised;
 - (lxi) any matters generally related to business of the Trade Marks Registry or its branches and for regulating all things by this Ordinance placed under the discretion of the Registrar or the Federal Government; and
 - (lxii) any other matter which is required to be, or may be prescribed.

133. **Transitional.**- The provisions of the Fourth Schedule shall have effect with respect to transitional matters, including the treatment of trade marks registered under the Trade Marks Act, 1940 (V of 1940), and applications for registration and other proceedings pending under that Act, on the commencement of this Ordinance.

134. **Repeal and savings.**- (1) The Trade Marks Act, 1940 (V of 1940), is hereby repealed.

(2) The Trade Marks Registry and its branches existing at the commencement of this Ordinance shall be continued as if they had been established under this Ordinance.

(3) The Registrar, other officers and any other person appointed to the Trade Marks Registry established under the Trade Marks Act, 1940 (V of 1940), shall be deemed to have been appointed to the Trade Marks Registry established under this Ordinance.

THE FIRST SCHEDULE

[See section 82(2)]

COLLECTIVE MARKS

1. **General.**- The provisions of this Ordinance shall apply to collective marks subject to the provisions contained in this Schedule.

2. **Signs of which a collective mark may consist.**- In relation to a collective mark the reference in clause (xlvii) of section 2 to distinguish goods or services of one undertaking from those of other undertakings shall be construed as a reference to distinguishing goods or services of members of the association which is the proprietor of the mark from those of other undertakings.

3. **Indication of geographical origin.**- (1) Notwithstanding the provisions of clause (c) of subsection (1) of section 14, a collective mark may be registered which consist of marks or indications which may serve, in trade, to distinguish the geographical origin of the goods or services.

(2) The proprietor of such a mark shall not be entitled to prohibit the use of the marks or indications in accordance with honest practices in industrial or commercial matters, in particular, by a person who is entitled to use a geographical name.

4. **Collective mark not to be misleading as to character or significance.**- (1) A collective mark shall not be registered if the public is liable to be misled as regards the character or significance of the mark, in particular, if it is likely to be taken to be something other than a collective mark.

(2) The Registrar may accordingly require that a mark in respect of which application is made for registration include some indication that it is a collective mark.

(3) Notwithstanding the provisions of sub-section (7) of section 27, an application may be amended so as to comply with any such requirement.

5. Regulations governing use of collective mark.- (1) An application for registration of a collective mark may be filed with the Registrar along with regulations governing the use of the mark.

(2) The regulations referred to in sub-para (1) shall specify the persons authorized to use the mark, the conditions of membership of the association and, where they exist, the conditions of the use of the mark, including any sanctions against misuse.

(3) Any further requirements with which the regulations referred to in sub-para (1) shall have to comply may be imposed as may be prescribed.

6. Approval of regulations by the Registrar.- (1) A collective mark shall not be registered unless the regulations governing the use of the mark-

(a) comply with the requirements of para (2) of para 5 and any further requirements as may be prescribed; and

(b) are not contrary to public policy or to accepted principles of morality.

(2) Before the end of the prescribed period after the date of the publication for registration of a collective mark, the applicant shall file the regulations with the Registrar and pay the prescribed fee failing which the application shall be deemed to have been withdrawn.

7. Procedure of acceptance or refusal of application.- (1) The Registrar shall consider whether the requirements specified in sub-para (1) of para 6 are duly met.

(2) If it appears to the Registrar that such requirements are not met, he shall inform the applicant and give him an opportunity, within such period as the Registrar may specify, to make representation or to file amended regulations.

(3) If the applicant fails to satisfy the Registrar that such requirements are met, or to file regulations amended so as to meet them, or fails to respond before the end of the specified period, the Registrar shall refuse the application.

(4) If it appears to the Registrar that such requirements, and the other requirements for registration, are met he shall accept the application and shall proceed in accordance with section 28.

8. Regulations to be published.- (1) The regulations governing the use of a collective mark shall be published and notice of opposition may be given, and observation may be made, relating to the matters specified in sub-para (1) of para 6.

(2) The provisions of sub-para (1) shall be in addition to any other grounds on which the application may be opposed or observations made.

9. Regulations to be open to inspection.- The regulations governing the use of a registered collective mark shall be open to public inspection in the same way as the Register.

10. Amendment of regulations.- (1) An amendment of the regulations governing the use of a registered collective mark shall not be effective unless and until the amended regulations are filed with the Registrar and accepted by him.

(2) Before accepting any amended regulations the Registrar may, in any case where it appears to him expedient to do so, cause them to be published.

(3) If the Registrar does so, a notice of opposition may be given, and observations may be made, relating to the matters specified in sub-para (1) of para 6.

11. Infringement of rights of authorized user.- The following provisions shall apply in relation to an authorized user of a registered collective mark as in relation to a licensee of a trade mark, namely:-

- (a) sub-section (7) of section 40;
- (b) sub-section (2) of section 51; and
- (c) section 53.

12. Infringement of a registered collective mark.- (1) The provisions of this para shall have effect as regards the rights of an authorized user in relation to infringement of a registered collective mark.

(2) An authorized user shall be entitled, subject to any agreement to the contrary between him and the proprietor, to call on the proprietor to take infringement proceedings in respect of any matter which affect his interests.

(3) If the proprietor-

- (a) refuses to do so; or
- (b) fails to do so within two months after being called upon.

the authorized user may bring the proceedings in his own name as if he were the proprietor.

(4) Where infringement proceedings are brought under this para, the authorized user may not, without the leave of the High Court, proceed with the action unless the proprietor is either joined as a plaintiff or added as a defendant.

(5) The provisions of para (4) shall not affect the granting of interlocutory relief on an application by an authorised user alone.

(6) A proprietor who is added as a defendant as provided in sub-para (4) shall not be made liable for any costs in the action unless he takes part in the proceedings.

(7) In infringement proceedings brought by the proprietor of a registered collective mark, any loss suffered or likely to be suffered by authorised user shall be taken into account, and the High Court or a District Court may give such directions as it thinks fit as to the extent to which the plaintiff shall hold the proceeds of any pecuniary remedy on behalf of such users.

13. Additional grounds for revocation of registration.- Apart from the grounds of revocation provided for in section 73, the registration of a collective mark may be revoked on any of the following grounds, namely:-

- (a) that the manner in which the mark has been used by the proprietor has caused it to become liable to mislead the public in the manner referred to in sub-para (1) of para 4;
- (b) that the proprietor has failed to observe, or to secure the observance of, the regulations governing the use of the mark; or
- (c) that an amendment of the regulations governing the use of mark has been made so that such regulations-
 - (i) no longer comply with the requirement of sub-para (2) of para 5, and any further conditions as may prescribed; or
 - (ii) are contrary to public policy or to accepted principles of morality.

14. Additional grounds for invalidity of registration.- Apart from the grounds of invalidity provided for in section 80, the registration of a collective mark may be declared invalid on the ground that the mark was registered in breach of the provisions of sub-para (1) of para 4, or sub-para (1) of para 6.

THE SECOND SCHEDULE
[See section 83 (2)]

CERTIFICATION MARKS

1. **General.-** The provisions of this Ordinance shall apply to certification marks subject to the provisions contained in this Schedule.

2. **Signs of which certification mark may consist.-** In relation to a certification mark the reference in clause (xlvii) of section 2 to distinguish goods or services of one undertaking from those of other undertakings shall be construed as a reference to distinguishing goods or services which are certified from those which are not.

3. **Indication of geographical origin.-** (1) Notwithstanding the provisions of clause (c) of sub-section (1) of section 14, a certification mark may be registered which consist of signs or indications which may serve, in trade, to designate the geographical origin of the goods or services.

(2) The proprietor of such a mark shall not be entitled to prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters, in particular, by a person who is entitled to use a geographical name.

4. **Nature of proprietor's business.-** A certification mark shall not be registered if the proprietor carries on a business involving the supply of goods or services of the kind certified.

5. **Certification mark not to be misleading as to character or significance.-** (1) A certification mark shall not be registered if the public is liable to be misled as regards the character or significance of the mark, in particular, if it is likely to be taken to be something other than a certification mark.

(2) The Registrar may, accordingly, require that a mark in respect of which application has been made for registration include some indication that it is a certification mark.

(3) Notwithstanding the provisions of sub-section (7) of section 27, an application may be amended so as to comply with any such requirement.

6. **Regulations governing use of certification mark.-** (1) An application for registration of a certification mark may be filed with the Registrar along with regulations governing the use of the mark.

(2) The regulations referred to in sub-para (1) shall indicate who shall be authorized to use the certification mark, the characteristics to be certified by the mark, how the certifying body shall test those characteristics and supervise the use of the mark, the fee, if any, to be paid in connection with the operation of the mark and the procedures for resolving disputes.

(3) Any further requirements with which the regulations referred to in sub-para (1) shall have to comply may be imposed as may be prescribed.

7. Approval of regulations by the Registrar.- (1) A certification mark shall not be registered unless-

- (a) the regulations governing the use of the mark-
 - (i) comply with the requirements of sub-para (2) of para 6, and any further requirements, as may be prescribed; and
 - (ii) are not contrary to public policy or to accepted principles of morality; and
- (b) the applicant is competent to certify the goods or services for which the mark is to be registered.

(2) Before the end of the prescribed period after the date of the application for registration of a certification mark, the applicant shall file the regulations with the Registrar and pay the prescribed fee, failing which the application shall be deemed to be withdrawn.

8. Procedure for acceptance or refusal of application.- (1) The Registrar shall consider whether the requirements specified in sub-para (1) of para 7 are met.

(2) If it appears to the Registrar that such requirements are not met, he shall inform the applicant and give him an opportunity, within such period as the Registrar may specify, to make representation or to file amended regulations.

(3) If the applicant fails to satisfy the Registrar that such requirements are met, or to file regulations amended so as to meet them, or fails to respond before the end of the specified period, the Registrar shall refuse the application.

(4) If it appears to the Registrar that such requirements, and the other requirements for registration, are met, he shall accept the application and shall proceed in accordance with section 28.

9. Regulations to be published.- The regulations governing the use of a registered certification mark shall be published and notice of opposition may be given, and observations may be made, relating to the matters specified in sub-para (1) of para 7, in addition to any other grounds on which the application may be opposed or observations made.

10. Regulations to be open to inspection.- The regulations governing the use of a registered certification mark shall be open to public inspection in the same way as the Register.

11. Amendment of regulations.- (1) An amendment of the regulations governing the use of a registered certification mark shall not be effective unless and until the amended regulations are filed with the Registrar and accepted by him.

(2) Before accepting any amended regulations the Registrar may, in any case where it appears to him expedient to do so, cause them to be published.

(3) If he does so, a notice of opposition may be given, and observations may be made, relating to the matters specified in sub-para (1) of para 7.

12. Consent to assignment of registered certification mark.- The assignment or other transmission of a registered certification mark shall not be effective without the consent of the Registrar.

13. Infringement of rights of authorised user.- The following provisions shall apply in relation to an authorised user of a registered certification mark as in relation to a licensee of a trade mark, namely:-

- (a) sub-section (7) of section 40;
- (b) sub-section (2) of section 51; and
- (c) section 53.

14. The High Court or a District Court to take into account loss suffered by authorised users.- In infringement proceedings brought by the proprietor of the registered certification mark any loss suffered or likely to be suffered by authorised user shall be taken into account and the High Court or a District Court may give such directions as it thinks fit as to the extent to which the plaintiff shall hold the proceeds of any pecuniary remedy on behalf of such users.

15. Additional grounds for revocation of registration.- Apart from the grounds of revocation provided for in section 73, the registration of a certification mark may be revoked on any of the following grounds, namely:-

- (a) that the proprietor has begun to carry on such a-business as is specified in para 4;
- (b) that the³manner in which the mark has been used by the proprietor has caused it to become liable to mislead the public in the manner referred to in sub-para (1) of para 5;
- (c) that the proprietor has failed to observe, or to secure the observance of, the regulations governing the use of the mark;
- (d) that an amendment of the regulations has been made so that the regulations-
 - (i) no longer comply with the requirements of sub-para (2) of para 6, and any further conditions as may be prescribed; or
 - (ii) are contrary to public policy or to accepted principles of morality; or
- (e) that the proprietor is no longer competent to certify the goods or services for which the mark is registered.

16. **Additional grounds for invalidity of registration.**- Apart from the grounds of invalidity provided for in section 80, the registration of a certification mark may be declared invalid on the ground that the mark was registered in breach of the provisions of para 4, sub-para (1) of para 5 or sub-para (1) of para 7.

THIRD SCHEDULE
[See section 84 (2)]

DOMAIN NAMES

1. **General.**- The provisions of this Ordinance shall apply to domain names subject to the provisions contained in this Schedule.

2. **Requirements for registration.**-(1) A domain name if used as a source identifier may be registered as a trade mark in respect of relevant goods or services.

(2) The applicant for registration of domain name shall show that he offers goods or services via Internet using the domain name. Such evidence shall be in the form of specimen showing use of the domain name as a source identifier.

Explanation. - For the purposes of this para, use of a domain name shall be taken as source identifier if it is used on Internet to distinguish goods or services of one undertaking from the other provided that use of a domain name as a mere directional reference, similar to use of a telephone number or business address shall not be taken as use of the domain name as a source identifier.

(3) Provisions may be made by rules for further identification and classification of computer related services associated with Internet.

3. Indication of geographical origin.- (1) Notwithstanding the provisions of clause (c) of sub-section (1) of section 14, a domain name may be registered which consist of marks or indications which may serve, in trade, to distinguish the geographical origin of the goods or services.

(2) The proprietor of such a mark shall not be entitled to prohibit the use of the marks or indications in accordance with honest practices in industrial or commercial matters, in particular, by a person who is entitle to use a geographical name.

4. Domain name not to be misleading as to character or significance.- (1) A domain name shall not be registered if the public is liable to be mislead as regards the character or significance of the mark, in particular, if it is likely to be taken to be something other than a domain name.

(2) The Registrar may, accordingly, require that a mark in respect of which application has been made for registration include some indication that it is a domain name.

(3) Notwithstanding the provisions of sub-section (7) of section 27, an application may be amended so as to comply with any such requirement.

5. Procedure for acceptance, opposition and registration.- The provisions of this Ordinance for acceptance, registration and opposition as they apply to trade marks shall also apply to the domain names.

6. Term of registration and renewal.- Notwithstanding the provisions of sections 32 and 33, a domain name shall be registered for a period of five years from the date of registration and may be renewed for further periods of like term, as long as, the domain name is in actual use on Internet.

7. Provisions of section 73 not to apply to domain names.- The provisions of section 73 shall not apply to domain names.

8. Rules.- Provisions may be made by rules for further identification and classification of computer related services associated with Internet.

THE FOURTH SCHEDULE
(See section 134)

TRANSITIONAL PROVISIONS

1. Introductory.-(1) In this Schedule,-

- (a) "existing registered mark" means a trade mark or certification mark registered under the Trade Marks Act, 1940 (V of 1940), immediately before the commencement of this Ordinance;
- (b) "1940 Act" means the Trade Marks Act, 1940 (V of 1940); and
- (c) "old law" means the 1940 Act and any law for the time being in force, applying to existing registered marks immediately before the commencement of this Ordinance.

(2) For the purposes of this Schedule,-

- (a) an application shall be treated as pending on the commencement of this Ordinance if it was made but not finally determined before such commencement; and
- (b) the date on which it was made shall be taken to be the date of filing under the 1940 Act.

2. Existing registered trade mark.- (1) The existing registered marks shall be transferred, on the commencement of this Ordinance, to the Register, and shall have effect, subject to the provisions of this Schedule, as if registered under this Ordinance.

(2) The existing registered marks registered as a series under sub-section (3) of section 11 of the 1940 Act shall be similarly registered in the new Register.

(3) Provisions may be made by rules for putting such entries in the same form as is required for entries under this Ordinance.

(4) In any other case notes indicating that the existing registered marks are associated with other marks shall cease to have effect on the commencement of this Ordinance.

3. Disclaimer, limitations and conditions.- A disclaimer, limitation or condition entered on the register kept under the 1940 Act in relation to an existing registered mark immediately before the commencement of this Ordinance shall be transferred to the Register and have effect as if entered on the Register in pursuance of section 15.

4. Effect of infringement.- (1) The provisions of sections 39 to 42 shall apply in relation to an existing registered mark as from the commencement of this Ordinance and the provisions of section 46 shall apply in relation to infringement of an existing registered mark committed after the commencement of this Ordinance, subject to sub-para (3).

(2) The old law shall continue to apply in relation to infringement committed before the commencement of this Ordinance.

(3) It shall not be an infringement of-

(a) an existing registered mark; or

(b) a registered trade mark of which the distinctive elements are the same or substantially the same as those of an existing registered mark and which is registered for the same goods or services,

to continue after the commencement of this Ordinance any use which did not amount to infringement of the existing registered mark under the old law.

5. Infringing goods, material and articles.- The provisions of section 48 shall apply to infringing goods, material or articles made before or after the commencement of this Ordinance.

6. Rights and remedies of licensee or authorised user.- (1) The provisions of section 75 shall apply to license granted before the commencement of this Ordinance, but only in relation to any infringement committed after such commencement.

(2) The provisions of para 14 of the Second Schedule shall apply only in relation to infringement committed after the commencement of this Ordinance.

7. Co-ownership of registered trade mark.- The provisions of section 24 shall apply as from the commencement of this Ordinance to an existing registered trade mark of which two or more persons were, immediately before such commencement, registered as joint proprietor:

Provided that so long as the relations between the joint proprietors remain such as are described in sub-section (2) of section 17 of the 1940 Act, there shall be taken to be an agreement to exclude the operation of sub-sections (2) and (3) of section 24.

8. Assignment of registered trade mark.- (1) The provisions of section 67 shall apply to transactions and events occurring after the commencement of this Ordinance in relation to an existing registered trade mark, and the old law shall continue to apply in relation to transactions and events occurring before such commencement.

(2) The existing entries under section 35 of the 1940 Act shall be transferred on the commencement of this Ordinance to the Register, and shall have effect as if made under section 70.

(3) An application for registration under section 35 of the 1940 Act, which is pending before the Registrar on the commencement of this Ordinance shall be treated as an application for registration under section 70 and shall proceed accordingly:

Provided that the Registrar may require the applicant to amend his application so as to conform with the requirements of this Ordinance.

(4) An application for registration under section 35 of the 1940 Act, which has been determined by the Registrar but not finally determined before the commencement of this Ordinance shall be dealt with under the old law, and the provisions of sub-para (2) shall apply in relation to any resulting entry in the Register.

(5) Whether before the commencement of this Ordinance, a person has become entitled by assignment or transmission to an existing registered trade mark but has not registered his title, any application for registration after such commencement shall be made under section 70.

(6) In cases to which the provisions of sub-para (3) or (5) applies, the provisions of sub-section (2) of section 35 of the 1940 Act shall continue to apply, and the provisions of sub-section (3) of section 68 shall not apply, as regards the consequences of failing to register.

9. Licensing of registered trade mark.- (1) The provisions of section 73 and sub-section (2) of section 74 shall apply only in relation to licences granted after the commencement of this Ordinance, and the old law shall continue to apply in relation to licences granted to authorised users before the commencement of this Ordinance.

(2) The existing entries under section 39 of the 1940 Act shall be transferred on the commencement of this Ordinance to the Register, and shall have effect as if made under section 70.

(3) Provisions may be made by rules for putting entries referred to in sub-para (2) in the same form as is required for entries made under this Ordinance.

(4) An application for registration as a registered user which is pending before the Registrar on the commencement of this Ordinance shall be treated as an application for registration of a licence under sub-section (1) of section 70 and shall proceed accordingly:

Provided that the Registrar may require the applicant to amend his application so as to conform with the requirements of this Ordinance.

(5) An application for registration as a registered user which has been determined by the Registrar but not finally determined before the commencement of this Ordinance shall be dealt with under the old law, and the provisions of sub-para (2) shall apply in relation to any resulting entry in the Register.

(6) Any proceedings pending on the commencement of this Ordinance under section 42 of the 1940 Act shall be dealt with under the old law and any necessary alteration shall be made to the Register.

10. Pending applications for registration.- (1) An application for registration of a mark under the 1940 Act which is advertised under sub-section (1) of section 15, or the proviso to that sub-section of the 1940 Act, or an order has been made for its advertisement before the commencement of this Ordinance shall be dealt with under the old law, subject as provided in the following paras, and if registered, the mark shall be treated for the purpose of this Schedule as an existing registered trade mark.

(2) The provisions of section 12 of the 1940 Act shall be disregarded in dealing, after the commencement of this Ordinance, with an application for registration.

11. Conversion of pending application.- (1) In the case of pending application for registration which has not been advertised under sub-section (1) of section 15, or the proviso to that sub-section of the 1940 Act, neither an order has been made for such advertisement before the commencement of this Ordinance, the applicant may give notice to the Registrar claiming to have the registrability of the mark determined in accordance with the provisions of this Ordinance.

(2) The notice under sub-para (1) shall be in the prescribed form, be accompanied by the appropriate fee and be given no later than twelve months after the commencement of this Ordinance.

(3) The notice under sub-para (1), duly given shall be irrevocable and have the effect that the application shall be treated as if made immediately after the commencement of this Ordinance.

12. Trade marks registered accordingly to old classification.- The Registrar may exercise his powers to secure that any existing registered trade marks which do not conform to the system of classification prescribed under section 12 are brought in conformity with that system.

13. Claim to priority from overseas application.- The provisions of section 25 shall apply to an application for registration under this Ordinance made after the commencement of this Ordinance notwithstanding that the Convention application was made before such commencement.

14. Duration and renewal of registration .-(1) The provisions of sub-section (1) of section 32 shall apply in relation to the registration of a mark in pursuance of an application made after the commencement of this Ordinance, and the old law shall apply in any other case.

(2) The provisions of sub-section (2) of section 32 and section 33 shall apply where the renewal falls due on or after the commencement of this Ordinance, and the old law shall continue to apply in any other case.

(3) In either case referred to in sub-para (2) or (3), it shall be immaterial when the fee is paid.

15. Pending application for alteration of registered trade mark.- An application under section 48 of the 1940 Act, which is pending on the commencement of this Ordinance shall be dealt with under the old law and any necessary alteration shall be made in the Register.

16. Revocation for non-use.- (1) An application under section 37 of the 1940 Act, which is pending on the commencement of this Ordinance shall be dealt with under the old law and any necessary alteration shall be made to the Register.

(2) An application made under clause (a) or (b) of sub-section (1) of section 73 may be made in relation to an existing registered mark at any time after the commencement of this Ordinance:

Provided that no such application for the revocation of the registration of an existing registered mark under section 38 of the 1940 Act may be made until more than five years after the commencement of this Ordinance.

17. Application for rectification.- (1) An application under section 46 or 47 of 1940 Act, which is pending on the commencement of this Act shall be dealt with under the old law and any necessary alteration shall be made to the Register.

(2) For the purpose of proceedings under section 80 as it applies in relation to an existing registered mark, the provisions of this Ordinance shall be deemed to have been in force at all material times:

Provided that no objection to the validity of the registration of an existing registered mark may be taken on the grounds specified in sub-section (3) of section 17 in conflict with earlier mark registered for different goods.

18. Regulations as to use of certification mark.- (1) Regulations governing the use of an existing registered certification mark deposited at the Trade Marks Registry under the 1940 Act shall be treated after the commencement of this Ordinance as if filed under para 6 of the Second Schedule.

(2) Any request for amendment of the regulations which was pending on the commencement of this Ordinance shall be dealt with under the old law.

MUHAMMAD RAFIQ TARAR,
President.

(MALIK HAKAM KHAN)
Draftsman/Additional Secretary.
