

[TO BE INTRODUCED IN THE NATIONAL ASSEMBLY]

A

Bill

to amend the Trade Marks Ordinance, 2001

WHEREAS it is expedient to amend the Trade Marks Ordinance, 2001 (XIX OF 2001), for the purposes hereinafter appearing;

It is hereby enacted as follows: -

1. Short title and commencement. - (1) This Act shall be called the Trade Marks (Amendment) ~~Ordinance, 2022.~~ **Act, 2023.**

(2) It shall come into force at once.

2. Amendment of section 2, Ordinance XIX OF 2001.- In the Trade Marks Ordinance, 2001 (XIX OF 2001), hereinafter referred to as the said Ordinance, in section 2, -

(a) clause (i) shall be re-numbered as clause (ib) and before that, the following new clauses shall be inserted, namely: -

“(i) “Act” means the Intellectual Property Organization of Pakistan Act, 2012 (Act No. XXII of 2012);

“(ia) “administrative division” means the division to which business of this Ordinance stands allocated;”;

(b) for clause (ix) the following shall be substituted, namely:-

“(ix) “counterfeit trade mark goods” means any goods including packaging bearing without authorization a trade mark which is identical or deceptively similar 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 infringes rights of the owner of the trade mark under this Ordinance;”;

(c) clause (xiv) shall be omitted;

(d) for clause (xix), the following shall be substituted, namely:-

“(xix) “geographical indication” shall have the same meaning as assigned thereto in the Geographical Indications (Registration and Protection) Act, 2020 (XVIII of 2020);”;

(e) after clause (xx), the following new clauses shall be inserted, namely:-

“(xxa) “IP Tribunal” means the Tribunal established under section 16 of the Act;

“(xxb) “international application” means an application for the international registration of trademarks in accordance with Madrid Protocol;”;

(f) after clause (xxiii), the following new clause (xxiiia) shall be inserted, namely:-

“(xxiiia) “Madrid Protocol” means the Protocol as defined in section 92B;”;

(g) after clause (xxvii), the following new clause (xxviiia) shall be inserted, namely:-

“(xxviiia) “Organization” means the Intellectual Property Organization of Pakistan established under section 3 of the Act;” and

(h) for clause (li), the following shall be substituted, namely; -

“(li) “Tribunal” means the Registrar, as the case may be, the High Court or IP Tribunal before which the proceedings concerned are pending;”.

3. **Amendment of section 7, Ordinance XIX OF 2001.-** In the said Ordinance, for section 7, the following shall be substituted, namely; -

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

(2) The Organization may appoint such other officers with such designations as it may deem 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, authorize them to discharge.”.

4. **Amendment of section 9, Ordinance XIX OF 2001.-** In the said Ordinance, in section 9, in sub-section (2), for the words “Federal Government”, the words “the IPO Policy Board” shall be substituted.

5. **Amendment of section 10, Ordinance XIX OF 2001.-** In the said Ordinance, in section 10, in sub-section (2), for the words “Federal Government”, the word “Organization” shall be substituted; and

6. **Insertion of new section 10A, Ordinance XIX of 2001.-** in the said Ordinance, after section 10, amended as aforesaid the following new section 10A, shall be inserted, namely; -

“10A.-Validity of electronic documents. - The electronic receipts and issuance of all the documents under this Ordinance shall be valid and accepted for the purposes of evidence.”

7. **Amendment of section 11, Ordinance XIX OF 2001.-** In the said Ordinance, in section 11, in sub-section (1), for the words “all High Courts or District Courts in Pakistan, the words “the High Court or IP Tribunal” shall be substituted.

- 8. Amendment of section 14, Ordinance XIX OF 2001.-** In the said Ordinance, in section 14, in sub-section (3), in clause (a), for the words "High Court or District Court", the words "the High Court" shall be substituted.
- 9. Amendment of section 17, Ordinance XIX OF 2001.-** In the said Ordinance, in section 17, in sub-section (6), after the expression, "description of goods", the words "services or description of services" shall be inserted and thereafter the words "or a District Court" shall be omitted.
- 10. Amendment of section 24, Ordinance XIX OF 2001.-** In the said Ordinance, in section 24, in sub-section (6), for the words "District Courts", the words "IP Tribunal" shall be substituted.
- 11. Amendment of section 33, Ordinance XIX OF 2001.-** In the said Ordinance, in section 33, in sub-section (2), for the words "withdrawn", the words "abandoned" shall be substituted.
- 12. Amendment of section 47, Ordinance XIX OF 2001.-** In the said Ordinance, in section 47, for the words "District Court" and "a District Court", wherever occurring, the words "IP Tribunal" and "an IP Tribunal" shall be substituted respectively.
- 13. Amendment of section 48, Ordinance XIX OF 2001.-** In the said Ordinance, in section 48, for the words "District Court" and "a District Court", wherever occurring, the words "IP Tribunal" and "an IP Tribunal" shall be substituted respectively.
- 14. Amendment of section 51, Ordinance XIX OF 2001.-** In the said Ordinance, in section 51, for the words "a District Court", wherever occurring, the words "an IP Tribunal" shall be substituted.

- 15. Amendment of section 53, Ordinance XIX OF 2001.-** In the said Ordinance, in section 53, for the words "Collector of Customs", wherever occurring, the expression "Director General, IPR (Enforcement), Director, IPR (Enforcement) or Collector of Customs" shall be substituted.
- 16. Amendment of section 54, Ordinance XIX OF 2001.-** In the said Ordinance, in section 54, for the words "Collector of Customs", the expression "Director General, IPR (Enforcement), Director, IPR (Enforcement) or Collector of Customs" shall be substituted.
- 17. Amendment of section 55, Ordinance XIX OF 2001.-** In the said Ordinance, in section 55, for the words "Collector of Customs", the expression "Director General, IPR (Enforcement), Director, IPR (Enforcement) or Collector of Customs" shall be substituted.
- 18. Amendment of section 56, Ordinance XIX OF 2001.-** In the said Ordinance, in section 56, for the words "Collector of Customs", wherever occurring, the expression "Director General, IPR (Enforcement), Director, IPR (Enforcement) or Collector of Customs" shall be substituted.
- 19. Amendment of section 57, Ordinance XIX OF 2001.-** In the said Ordinance, in section 57, for the words "Collector of Customs", wherever occurring, the expression "Director General, IPR (Enforcement), Director, IPR (Enforcement) or Collector of Customs" shall be substituted and for the words "a District Court", the words "an IP Tribunal" shall be substituted.
- 20. Amendment of section 58, Ordinance XIX OF 2001.-** In the said Ordinance, in section 58, for the expression "Collector of Customs", wherever occurring, the expression "Director General, IPR (Enforcement), Director, IPR (Enforcement) or Collector of Customs" shall be substituted.
- 21. Amendment of section 59, Ordinance XIX OF 2001.-** In the said Ordinance, in section 59, for the words "Collector of Customs", wherever occurring, the expression "Director General, IPR (Enforcement), Director, IPR (Enforcement) or Collector of Customs" shall be substituted.

- 22. Amendment of section 60, Ordinance XIX OF 2001.-** In the said Ordinance, in section 60, for the words "Collector of Customs", wherever occurring, the expression "Director General, IPR (Enforcement), Director, IPR (Enforcement) or Collector of Customs" shall be substituted and for the words "a District Court", the words "an IP Tribunal" shall be substituted.
- 23. Amendment of section 62, Ordinance XIX OF 2001.-** In the said Ordinance, in section 62, for the words "Collector of Customs", wherever occurring, the expression "Director General, IPR (Enforcement), Director, IPR (Enforcement) or Collector of Customs" shall be substituted.
- 24. Amendment of section 63, Ordinance XIX OF 2001.-** In the said Ordinance, in section 63, for the words "Collector of Customs", wherever occurring, the expression "Director General, IPR (Enforcement), Director, IPR (Enforcement) or Collector of Customs" shall be substituted and for the words "a District Court", the words "an IP Tribunal" shall be substituted.
- 25. Amendment of section 64, Ordinance XIX OF 2001.-** In the said Ordinance, in section 64, for the words "Collector of Customs", the expression "Director General, IPR (Enforcement), Director, IPR (Enforcement) or Collector of Customs" shall be substituted.
- 26. Amendment of section 65, Ordinance XIX OF 2001.-** In the said Ordinance, in section 65, for the words "Collector of Customs", the expression "Director General, IPR (Enforcement), Director, IPR (Enforcement) or Collector of Customs" shall be substituted.
- 27. Amendment of section 66, Ordinance XIX OF 2001.-** In the said Ordinance, in section 66, for the words "Collector of Customs", the expression "Director General, IPR (Enforcement)" shall be substituted.
- 28. Amendment of section 67, Ordinance XIX OF 2001.-** In the said Ordinance, in section 67, in subsection (3), for the words "a District Court", the words "an IP Tribunal" shall be substituted.

- 29. Amendment of section 70, Ordinance XIX OF 2001.-** In the said Ordinance, in section 70, in sub-section (2), in clause (e), for the words "District Court", the words "IP Tribunal" shall be substituted.
- 30. Amendment of section 73, Ordinance XIX OF 2001.-** In the said Ordinance, in section 73,
- (a) in sub-section(4), the words "or a District Court", and the words "District Court", wherever occurring, shall be omitted and the expression "or, as the case may be, the" shall be omitted; and
 - (b) in sub-section (6), in clause (b), for the expression " , the High Court or a District Court", the words "or the High Court" shall be substituted.
- 31. Amendment of section 77, Ordinance XIX OF 2001.-** In the said Ordinance, in section 77, for the words "a District Court", wherever occurring, the words "an IP Tribunal" shall be substituted.
- 32. Amendment of section 78, Ordinance XIX OF 2001.-** In the said Ordinance, in section 78, for the words "or a District Court", wherever occurring, the words "an IP Tribunal" shall be substituted.
- 33. Amendment of section 80, Ordinance XIX OF 2001.-** In the said Ordinance, in section 80.-
- (a) in sub-section (4), the words "or a District Court", wherever occurring, shall be omitted; and
 - (b) sub-section (5) shall be omitted.
- 34. Insertion of new chapter, Ordinance XIX OF 2001.-** In the said Ordinance, after chapter X, the following new Chapter XA shall be inserted, namely:-

CHAPTER XA

INTERNATIONAL REGISTRATION OF TRADEMARKS

92A. International registration under Madrid Protocol. - The provisions of this Chapter shall apply to international applications and international registrations under the Madrid Protocol.

92B. Definitions. In this Chapter, unless the context otherwise requires,

(i) "application", in relation to a Contracting State or a Contracting Organization means an application made by a person who is a citizen of, or is domiciled in, or has a real and effective industrial or commercial establishment in, that Contracting State or a State which is a member of that Contracting Organization as the case may be.

Explanation: - For the purposes of this clause, "real and effective industrial or commercial establishment" means and includes any establishment where some bona fide industrial or commercial activity takes place and need not necessarily be the principal place of business;

(ii) "basic application" means an application for the registration of a trade mark filed under section 22 and which is used as a basis for applying for an international registration;

(iii) "basic registration" means the registration of a trade mark under section 33 and which is used as a basis for applying for an international registration;

(iv) "common regulations" means the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement;

(v) "contracting organization" means a Contracting Party that is an inter- governmental organization;

(vi) "contracting party" means a Contracting State or Contracting Organization party to the Madrid Protocol;

(vii) "contracting state" means a country party to the Madrid Protocol;

(viii) "designation", with its grammatical variations, is a request for the extension of protection under Article 3ter(1) or (2) of the Madrid Protocol, as the case may be; it also means such extension as recorded in the International Register;

(ix) "designated contracting party" is a Contracting Party for which the extension of protection has been requested under Article 3ter(1) or (2) of the Madrid Protocol, as the case may be, or in respect of which such extension has been recorded in the International Register;

(x) "international application" means an application for international registration or for extension of the protection resulting from an international registration to any Contracting Party made under the Madrid Protocol;

(xi) "International Bureau" means the International Bureau of the World Intellectual Property Organization;

(xii) "international registration" means the registration of a trade mark in the register of the International Bureau effected under the Madrid Protocol;

(xiii) "Madrid Agreement" means the Madrid Agreement Concerning the International Registration of Marks adopted at Madrid on the 14th day of April, 1891, as subsequently revised and amended;

(xiv) "Madrid Protocol" means the Protocol relating to the Madrid Agreement Concerning the International Registration of Marks adopted at Madrid on the 27th day of June, 1989, as amended from time to time; and

(xv) "office of origin" means the Office through the intermediary of which the international application is filed in accordance with Article 2(2) of the Madrid Protocol.

92C. Trade Marks Registry to deal with international applications. - An international application shall be dealt with by the Trade Marks Registry or such branch offices of the Registry, as the Organization may specify.

92D. International application originating from Pakistan. - (1) Where an application for the registration of a trade mark has been made under section 22 or a trade mark has been registered under section 33, the applicant or the registered proprietor may make an international application on the form prescribed by the Common Regulations for international registration of that trade mark.

(2) A person holding an international registration may make an international application on the form prescribed by the Common Regulations for extension of the protection resulting from such registration to any other Contracting Party.

(3) An international application under sub-section (1) or sub-section (2) shall designate the Contracting Parties where the protection resulting from the international registration is required.

(4) The Registrar shall certify in the prescribed manner that the particulars appearing in the international application correspond to the particulars appearing, at the time of the certification, in the application under section 22 or the registration under section 33, and shall indicate the date and number of that application or the date and number of that registration as well as the date and number of the application from which that registration resulted, as the case may be, and shall within the

prescribed period, forward the international application to the International Bureau for registration, also indicating the date of the international application.

(5) Where at any time before the expiry of a period of five years of an international registration, whether such registration has been transferred to another person or not, the application under section 22 or the registration under section 33, as the case may be, has been withdrawn or cancelled or has expired or has been finally refused in respect of all or some of the goods or services listed in the international registration, the protection resulting from such international registration shall cease to have effect:

Provided that where an appeal is made against the decision of registration and an action requesting for withdrawal of application or an opposition to the application has been initiated before the expiry of the period of five years of an international registration, any final decision resulting into withdrawal, cancellation, expiration or refusal shall be deemed to have taken place before the expiry of five years of the international registration.

(6) The Registrar shall, during the period of five years beginning with the date of international registration, transmit to the International Bureau every information referred to in sub-section (5).

(7) The Registrar shall notify the International Bureau the cancellation to be effected to an international registration keeping in view the current status of the basic application or the basic registration, as the case may be.

92E. International registrations where Pakistan has been designated.- (1) The Registrar shall, after receipt of a notification from the International Bureau about any international registration where Pakistan has been designated, keep a record of the particulars of that international registration in the prescribed manner.

- (2) Where, after recording the particulars of any international registration referred to in sub-section (1), the Registrar is satisfied that in the circumstances of the case the protection of trade mark in Pakistan should not be granted or such protection should be granted subject to conditions or limitations or to conditions additional to or different from the conditions or limitations subject to which the international registration has been accepted, he may, after hearing the applicant if he so desires refuse grant of protection and inform the International Bureau in the prescribed manner within eighteen months from the date on which the notification referred to in sub-section (1) was received.
- (3) Where the Registrar finds nothing in the particulars of an international registration to refuse grant of protection under sub-section (2), he shall within the prescribed period cause such international registration to be advertised in the prescribed manner.
- (4) The provisions of sections 14 to 31 (both inclusive), 82 and 83 shall apply *mutatis mutandis* in relation to an international registration as if such international registration was an application for registration of a trade mark under section 22.
- (5) When the protection of an international registration has not been opposed and the time for notice of opposition has expired, the Registrar shall within a period of eighteen months of the receipt of notification under subsection (1) notify the International Bureau its acceptance of extension of protection of the trade mark under such international registration and, in case the Registrar fails to notify the International Bureau, it shall be deemed that the protection has been extended to the trade mark.
- (6) International registration designating Pakistan shall enjoy the right of priority provided for in Article 4 of the Paris Convention and are exempt from the need to comply with the formalities prescribed in section D of that Article.

(7) Where a same registered proprietor of a trade mark makes an international registration of trade mark with all goods or services in the national registration and designates Pakistan, the international registration from the date of the registration shall be deemed to replace the registration held in Pakistan without prejudice to any right acquired under such previously held registration and the Registrar shall, upon request by the applicant, make necessary entry in the register referred to in subsection (1) of section 6.

(8) A holder of international registration of a trade mark who designates Pakistan and who has not been extended protection in Pakistan shall have the same remedy which is available to any person making an application for the registration of a trade mark under section 22 and which has not resulted in registration under section 33.

(9) Where at any time before the expiry of a period of five years of an international registration, whether such registration has been transferred to another person or not, the related basic application or, as the case may be, the basic registration in a Contracting Party other than Pakistan has been withdrawn or cancelled or has expired or has been finally refused in respect of all or some of the goods or services listed in the international registration, the protection resulting from such international registration in Pakistan shall cease to have effect.

92F. Effects of international registration. - (1) From the date of the international registration of a trade mark where Pakistan has been designated or the date of the recording in the register of the International Bureau about the extension of the protection resulting from an international registration of a trade mark to Pakistan, the protection of the trade mark in Pakistan shall be the same as if the trade mark had been registered in Pakistan.

(2) The indication of classes of goods and services given by the applicant shall not bind the Registrar with regard to the determination of the scope of the protection of the trade mark.

92G. Duration and renewal of international registration. - (1) The international registration of a trade mark at the International Bureau shall be for a period of ten years and may be renewed for a period of ten years from the expiry of the preceding period.

(2) Subject to payment of a surcharge prescribed by the rules, a grace period of six months shall be allowed for renewal of the international registration.

92H. Transformation -The date of filing of an application for the registration of a trade mark made with the Registrar in accordance with Article 9quinquies of the Madrid Protocol shall be the date of the cancelled international registration and, if the international registration enjoyed the right of priority, the application shall enjoy the same priority.

92I. Extracts from the international Register - (1) Extracts from the International Register issued by the International Bureau shall be exempt from any legalization in Pakistan.

(2) In all legal proceedings relating to a trade mark in an international registration in which Pakistan is a designated contracting party, the fact that a person is recorded as proprietor thereof in the international register shall be prima facie evidence of the validity of the international registration of the trade mark and of all subsequent assignments and transmissions thereof.

35. Amendment of section 93, Ordinance XIX OF 2001.- In the said Ordinance, in section 93, for the words "Federal Government"; the words "administrative division" shall be substituted.

36. Amendment of section 95, Ordinance XIX OF 2001.- In the said Ordinance, in section 95, for the words “Federal Government”, the words “administrative division” shall be substituted.

37. Amendment of section 96, Ordinance XIX OF 2001.- In the said Ordinance, in section 96, for the words “a District Court”, wherever occurring, the words “an IP Tribunal” shall be substituted.

38. Amendment of section 105, Ordinance XIX OF 2001.- In the said Ordinance, in section 105, for the words “a District Court”, wherever occurring, the words “an IP Tribunal” shall be substituted.

39. Amendment of section 111, Ordinance XIX OF 2001.- In the said Ordinance, in section 111, in sub-section (1), for clause (b), the following shall be substituted namely;-

(b) evidence shall be given by affidavit.”.

40. Amendment of section 114, Ordinance XIX OF 2001.- In the said Ordinance, in section 114.-

(a) for the words “a District Court”, wherever occurring, the words “an IP Tribunal” shall be substituted; and

(b) in sub-section (1), for the words “that District Court”, the word “that IP Tribunal” shall be substituted.

41. Amendment of section 116, Ordinance XIX OF 2001.- In the said Ordinance, in section 116, for the words “or a District Court”, wherever occurring, the words “IP Tribunal” shall be substituted.

42. Amendment of section 117, Ordinance XIX OF 2001.- In the said Ordinance, in section 117.-

(a) for the title "suits for infringement to be instituted before District Court", the title "Suits for infringement to be instituted before IP Tribunal," shall be substituted; and

(b) for the words, "any court inferior to District Court" the words, "an IP Tribunal" shall be substituted.

43. Amendment of section 118, Ordinance XIX OF 2001.- In the said Ordinance, in section 118.-

(a) for the words "a District Court", the words "an IP Tribunal" shall be substituted; and

(b) for the words "District Court", the words "the IP Tribunal" shall be substituted.

44. Amendment of section 122, Ordinance XIX OF 2001.- In the said Ordinance, in section 122, for the words "a District Court", the words "an IP Tribunal" shall be substituted.

45. Amendment of section 124, Ordinance XIX OF 2001.- In the said Ordinance, in section 124, for the words "a District Court", the words "an IP Tribunal" shall be substituted.

46. Amendment of section 125, Ordinance XIX OF 2001.- In the said Ordinance, in section 125, in sub-section (4), for the words "Collector of Customs", the expression "Director General, IPR (Enforcement), Director, IPR (Enforcement) or Collector of Customs" shall be substituted.

47. Amendment of section 126, Ordinance XIX OF 2001.- In the said Ordinance, in section 126, after sub-section (2), the following new sub-section (3) shall be added, namely: - "(3) An application filed under Madrid Protocol for international registration of marks shall be subject to such conditions as may be prescribed."

48. Amendment of section 129, Ordinance XIX OF 2001.- In the said Ordinance, in section 129, for the words "provincial government", wherever occurring, the words "provincial governments" shall be substituted.

49. Amendment of section 132, Ordinance XIX OF 2001.- In the said Ordinance, in section 132, in sub-section (2),

(a) in clause (xxvi), for the words "Collector of Customs", the expression "Director General, IPR (Enforcement), Director, IPR (Enforcement) or Collector of Customs" shall be substituted;

(b) in clause (xlii), the words "a District Court" shall be omitted; and

(c) in clauses (lix) and (lxi), for the words "Federal Government", the words "Organization" shall be substituted.

50. Amendment of the first schedule, Ordinance XIX OF 2001.- In the said Ordinance, in first schedule, in paragraph 12, in sub-paragraph (7), for the words "a District Court", the words "an IP Tribunal" shall be substituted.

51. Amendment of second schedule, Ordinance XIX OF 2001.- In the said Ordinance, in second schedule, in paragraph 14:-

(a) in title, for the words, "a District Court", the words, "an IP Tribunal" shall be substituted; and

(b) for the words, "a District Court", the words, "the IP Tribunal" shall be substituted.

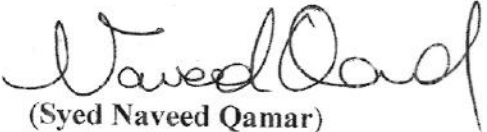
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Trade Marks Ordinance (Amendments) Bill, 2022

Statement of Objects and Reasons

President of Islamic Republic of Pakistan signed the "Instrument of Accession" of the Madrid Protocol on 23rd February, 2021 which was deposited by our Permanent Mission to UN, Geneva to World Intellectual Property Organization (WIPO) on 24th February, 2021 to make Pakistan, member of the Madrid System. The Protocol has been entered into force on 24th May 2021 for facilitating local brand owners of Pakistan to protect their trademarks in up to 128 countries by filing a single international application in one language and pay one set of fees with WIPO.

To comply with the Madrid Protocol, enabling provisions were incorporated in the Trademarks Ordinance, 2001 (TMO, 2001). In addition to enabling provisions of Madrid Protocol, certain amendments in TMO, 2001 were also required to implement best practices of trademarks registration, including to enable electronic services and for robust legal safeguards like IP Tribunals to provide quick and efficient court decisions of IPRs litigation. Accordingly, the Intellectual Property Organization of Pakistan has proposed amendments in the TMO, 2001 and prepared a draft Trade Marks Ordinance (Amendment) Bill, 2022.



(Syed Naveed Qamar)
Minister for Commerce

2nd / January, 2023