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**BACKGROUND READING MATERIAL
ON THE
INTELLECTUAL PROPERTY SYSTEM
OF
PAKISTAN**



WORLD INTELLECTUAL PROPERTY ORGANIZATION

1991

PREFACE

The World Intellectual Property Organization (WIPO) is a specialized agency within the United Nations system of organizations. It is responsible for the promotion and protection of intellectual property throughout the world.

WIPO is cooperating with the developing countries of Asia and the Pacific in a comprehensive program of activities to facilitate the establishment and strengthening of intellectual property systems in the region. One of the components of this development cooperation program is the preparation and publication of guides, manuals and other training and information aids in the field of intellectual property.

In 1988 WIPO issued, under a development cooperation project funded by the United Nations Development Programme (UNDP) for countries of Asia and the Pacific, a publication entitled "Background Reading Material on Intellectual Property." The publication consisted of a collection of reading materials on various aspects of intellectual property law, administration and practice and was prepared as a reference work for university students, government officials, lawyers and businessmen.

To complement that basic reference work, WIPO has commissioned a number of leading intellectual property scholars in the Asian and Pacific region, each to write a commentary on the intellectual property laws of his country as a "national supplement" to the "Background Reading Material on Intellectual Property."

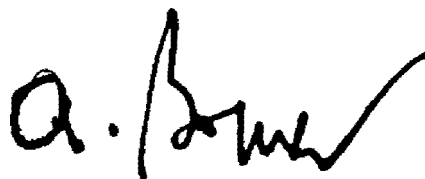
The author of the present book, entitled *Background Reading Material on the Intellectual Property System of Pakistan*, is Professor M. A. Mannan, Principal, University Law College, Punjab University, Lahore, who is an eminent author of a number of important writings on the substance and on the teaching of Pakistan intellectual property law.

While primarily intended for law students, this book may also be of use as a reference work to government officials, attorneys, and businessmen concerned with Pakistan intellectual property law or its administration.

Following a prefatory survey of the Pakistan intellectual property system, the topics addressed in this book are: patents, industrial designs, trademarks, copyright and intellectual property decisions. Reproduced as annexes are the Patents and Designs Act, 1911, the Trade Marks Act, 1940 and the Copyright Ordinance, 1962 and related legislation.

WIPO wishes to record its deep appreciation to Professor Mannan for his contribution which should significantly increase understanding of the working of the Pakistan intellectual property system.

The publication of this book has been financed by funds made available to WIPO by the United Nations Development Programme, for which WIPO is grateful, especially to UNDP's Regional Bureau for Asia and the Pacific.

A handwritten signature in black ink, appearing to read 'A. Bogoch', with a large, sweeping flourish at the end.

Arpad Bogoch

Director General

World Intellectual Property Organization

Geneva, December 1991

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*Abbreviations of Journals,
Law Reports and Courts Used in the Citation of Cases*

CLC	Civil Law Cases
Dacca	Dacca High Court
D.L.C.	Dacca Law Cases
D.L.R.	Dacca Law Reports
F.S.C.	Federal Shariat Court
Kar.	Karachi High Court
Lah.	Lahore High Court
MLD	Monthly Law Digest
P.C.	Privy Council
PLD	Pakistan Legal Decisions
PLJ	Pakistan Law Journal
S.C.	Supreme Court of Pakistan
S.C.M.R.	Supreme Court Monthly Review
Sind	Sind High Court

Addresses: Trade Mark, Patent and Copyright Offices

1. **The Trade Mark Registry**
68-E Market, Block-6
PECHS
Karachi 29
Pakistan

2. **The Patent Office**
Assad Chambers, 146 A.M.
Shambunath Street
Saddar
Karachi
Pakistan

3. **Central Copyright Office**
4th Floor, Hajra Mansion
Zaibunnisa Street, Saddar
Karachi
Pakistan

Administering Ministries

- (i) **The Trade Mark Registry is within the Federal Ministry of Commerce.**
- (ii) **The Patent Office is within the Federal Ministry of Industries.**
- (iii) **The Copyright Registry is within the Federal Ministry of Education.**

Pakistan's Membership in International Treaties and Conventions

1. *Multilateral:*

- (a) Convention Establishing the World Intellectual Property Organization (WIPO)
- (b) Universal Copyright Convention
- (c) Berne Convention for the Protection of Literary and Artistic Works

2. *Bilateral:*

- (i) Reciprocal Arrangement between Pakistan and the United Kingdom in respect of Patents and Designs, effective from August 14, 1947.
- (ii) Reciprocal Arrangement for the Mutual Protection of Inventions and Designs between Pakistan and New Zealand, effective from August 14, 1947 (Ministry of Industries Press Note of April 10, 1950).
- (iii) Reciprocal Arrangement for the Mutual Protection of Inventions and Designs between Pakistan and Australia, effective from August 14, 1947 (Ministry of Industries Press Note of September 28, 1949).
- (iv) Reciprocal Arrangement for the Mutual Protection of Inventions and Designs between Pakistan and Ceylon, effective from September 17, 1951 (Ministry of Industries Notification No. I-IV-18 (14)/50-Pat., of October 3, 1951).
- (v) Reciprocal Arrangement for the Mutual Protection of Inventions between Pakistan and Canada, effective from April 16, 1958 (Ministry of Industries, Notification No.I-II-34 (2)/58, of March 18, 1958).

CHAPTER 1

THE DEVELOPMENT OF INTELLECTUAL PROPERTY LAW IN PAKISTAN

SYNOPSIS

- 1.1 Sources of Intellectual Property Laws**
- 1.2 General Principles of Intellectual Property Law**
 - 1.2.1 Copyright**
 - 1.2.2 Trade Marks**
 - 1.2.3 Patents**

1.1 Sources of Intellectual Property Laws

Pakistan became an independent State on August 14, 1947. Previous to this, the territories now included in Pakistan, India, Bangladesh, Myanmar and Sri Lanka were part of the former British Indian Empire. The laws in British India, with the exception of personal laws, were generally derived from the laws of the United Kingdom. Either they were made by the British Parliament and extended in their application to India or, if made by the British Indian legislature, the basis of these laws was English law. The pattern of rights regarding intellectual property and the origin of the law relating to it is thus similarly to be found in the laws of the United Kingdom on the subject.

Successive British legislation in the field was made the basis by the Indian legislature for making new law or amending the existing law, from time to time. When independence came to the Indian sub-continent, in 1947, the laws relating to intellectual property which were in force in the country at that time continued to remain in force in Pakistan. These laws included the Patent and Designs Act, 1911, the Trade Marks Act, 1940, and the Copyright Act, 1914. The first two enactments, with some amendments, remain intact to this day but the Copyright Act has been superseded and replaced by the Copyright Ordinance, 1962.

Another statute which has a bearing on the subject of intellectual property is the Antiquities Act of 1976 (Act VII of 1976). The object of this Act is to preserve and protect, among other things, any ancient product of human activity, illustrative of art, architecture, craft, custom, literature, morals, politics, religion, warfare, science, civilization, culture or any ancient object of historical, ethnographic, anthropological, military or scientific interest. According to one of its provisions, no photograph, copy or reproduction falling under the definition of "antiquity" can be made or is permissible except with the consent of the owner of the object (Sections 2(c)(i) and (ii) and 6(3)).

1.2 General Principles of Intellectual Property Law

1.2.1 *Copyright*

Copyright law is a branch of that part of the law which deals with the rights of intellectual creators. Such rights are respected by the laws of most countries. The reasons for this respect of the rights of creators are the need to stimulate and foster the individual creativity of men and women and the need to make the results of that creativity available by disseminating it on the widest possible scale. Copyright law deals with particular forms of

creativity, concerned primarily with mass communication. It is concerned also with virtually all forms and methods of public communication, not only printed publications but also with such matters as sound and television broadcasting, films for public exhibition in cinemas, etc., and even computerized systems for the storage and retrieval of information.

The purpose of the granting of a copyright is to foster originality in literary production. The goal of the copyright law is to encourage creation of, and facilitate public access to, works of intellectual interest to society.

When an author releases a literary or artistic work, he exposes his personality and reputation to public perusal. An author, therefore, desires legal protection not only for his work's economic value, but also for the value of his artistic reputation expressed within his work. This principle has prevailed in Pakistan and may be traced in the general ethos of the Copyright Act of 1911 and its successor, the Copyright Ordinance of 1962.

Copyright thus deals with the rights of intellectual creators in their creation. Most artistic works, for example, books, paintings or drawings, exist only when they are embodied in a physical object. But some of them exist without embodiment in a physical object. For example, music or poems are artistic works even if they are not, or even before they are, written down by a musical notation or words.

Copyright law, however, protects only the form of expression of ideas, not the ideas themselves. The creativity protected by copyright law is creativity in the choice and arrangement of words, musical notes, colours, shapes and so on. Copyright law protects the owner of rights in artistic works against those who "copy," i.e., those who take and use the form in which the original work was expressed by the author.

Copyright protection is above all one of the means of promoting, enriching and disseminating the national cultural heritage. A country's development depends to a very great extent on the creativity of its people, and encouragement of national creativity is a *sine qua non* for progress.

1.2.2 Trade Marks

The primary and proper function of a trade mark is to identify the origin of the article to which it is affixed. A trade mark also allows the consumer to make an informed choice.

A trade mark must reflect a certain originality in respect to the goods it identifies. When a trade mark is favourably known, it will have a considerable monetary value.

A well-maintained trade mark, by ensuring the high and consistent quality of goods to which it relates, and by performing a clear distinguishing function, discourages imitation by inferior competitors. It helps to protect consumers' interests as well as those of the owner of the trade mark. It should be noted that there is a distinction between the registration of a trade mark on the one hand and, on the other hand, the registration of a design or the grant of a patent. As regards the industrial property law of Pakistan, the main difference is that, in the former case, the Trade Marks Act contemplates the publication of a prior public notice and hearing of objections to the application for registration, whereas under the Patents and Designs Act, the grant or registration is effected *ex parte* without any prior publication (*Plasticrafters Ltd. v. Maniar Industries Ltd.*, 1980 CLC 812).

1.2.3 Patents

The grant of a patent entitles the inventor to make, use or sell his invention for a limited period of time as a reward for the disclosure of his invention. The inventor furthermore gets the monopoly under which he can derive a benefit commensurate with the economic worth of his invention. The patent system fosters the spirit of inquiry and creative thinking by dissemination of technical knowledge and by the encouragement of inventors. An improvement on a patentable invention may itself be the subject matter of a patent, provided the elements of patentability are present. But the inventor's right to have a patent issued to him may be lost by an abandonment thereof.

The earlier history of the laws pertaining to intellectual property in Pakistan is, in fact, their history in the United Kingdom. The links with the past seem to be inseparable. Even today, while deciding cases relating to intellectual property, the courts make reference to English precedents and consider them of high authority and practically binding.

CHAPTER 2

PATENTS

SYNOPSIS

- 2.1 Introduction**
- 2.2 Current Legislation (Patents and Designs)**
- 2.3 Application for Grant of Patent**
- 2.4 Specification**
- 2.5 Proceedings**
- 2.6 Opposition to Grant of Patent**
- 2.7 Effect of Patent**
- 2.8 Term of Patent**
- 2.9 Maintenance**
- 2.10 Amendment**
- 2.11 Register of Patents**
- 2.12 Patent Binds Government**
- 2.13 Assignments and Licenses**
- 2.14 Employee Inventions**
- 2.15 Compulsory Licenses and Revocation**
- 2.16 Revocation of Patents Worked Outside Pakistan**
- 2.17 Revocation**
- 2.18 Infringement**
- 2.19 joint Patentees**
- 2.20 Public Use or Knowledge of Invention**
- 2.21 Exhibition Before Learned Societies**
- 2.22 Models for National Museum**
- 2.23 Foreign Vessels**

2.1 Introduction

The origin of the law in Pakistan, relating to patents and designs, can be traced back to English law. For instance, the English patent law of 1852 contained in the statute 16 and 17 Vic., c. 115 was the basis of the earliest law on the subject in the country in the form of an Act of 1856, which in turn was practically repeated three years later in Act XV of 1859. This last Act was superseded by "the Inventions and Designs Act, V of 1888."

Under the English statute of 1852, a patent was granted subject to the subsequent filing of a specification, but under the local Act of 1859 an advance in procedure was made in that the "exclusive privilege," which was the local equivalent to a patent, only accrued when a specification was filed. By a later English statute of 1883 (46 and 47 Vic., c. 57), the patent would not be granted until after the acceptance of a correct specification and the absence or failure of opposition by interested parties. This procedure was continued to be followed in the subsequent English statute, namely, the Patents and Designs Act, 1907 (7 Edw.VII, c.29).

Although the Inventions and Designs Act, 1888, was passed in British India five years after the United Kingdom statute of 1883, it was felt that the time was not yet ripe in the country for introducing the English practice in its entirety as the volume of patent work was then small. However, after this Act had been in use for more than 23 years, it was felt that the patent work in the country was growing and was likely to do so at a much greater rate in the future, and it was thought advisable to bring the practice in the country more into conformity with that of the United Kingdom, thereby following the example of most of the other British possessions. By postponing action during this period, it had become possible to take advantage of the consolidation of the English statutes which the Patents and Designs Act, 1907 (7 Edw. VII, c. 29), had effected. According to the proposers of the Bill for the 1911 Act, it was a very opportune time for undertaking legislation in the country. As a result, the British Indian legislature passed the Patents and Designs Act, 1911 (Act II of 1911). This Act, along with the Patents and Designs Rules, 1933, and the Secret Patent Rules, 1963, is the law governing this field in Pakistan.

The Act of 1911 aims to encourage the creation of utility or the production process through a system of granting a limited monopoly to the inventor over his work in return for the disclosure of his invention to the public. A patent monopoly is granted only for an invention which is novel and useful and capable of industrial application. The system of granting a monopoly tends to encourage the flow of inventions. The question whether a particular invention is new and useful depends upon the state of prior art or technology in the particular field which includes prior

publication on the subject and prior user. The invention must be of a patentable nature that is novel, and involves an inventive step.

Suits and other proceedings concerning matter that involve the interpretation and application of the law of patents is partly regulated by the statute itself and partly by the Code of Civil Procedure and the Specific Relief Act. Proceedings before the High Court are partly regulated by the Rules of the High Court. Details of these provisions follow.

2.2 Current Legislation (Patents and Designs)

The law relating to the protection of inventions and designs is basically contained in the Patents and Designs Act (II of 1911). An amendment to the Act of 1911 was added by the Patents and Designs (Amendment) Ordinance, 1983. Herein a provision has been made to enable reciprocal arrangements to be made with foreign countries in the domain of patents and designs (Ordinance XXXVIII of 1983). Thus, after this amendment, the Federal Government in Pakistan is empowered to make an arrangement with any foreign government for the mutual protection of any invention or design by providing that the patent granted and the design registered under this law shall have priority over other applicants (Section 78A of amended Ordinance). For the implementation of the provisions of this Act, the Patents and Designs Rules, 1933, were made. A summary of the important provisions of the law is given in the following pages under appropriate headings.

2.3 Application for Grant of Patent

There is a Controller of Patents and Designs appointed under the Act by the Federal Government. The Controller is in charge of the Patent Office and performs his functions under the law. There are Assistant Controllers and other staff to assist him.

An application for a patent can be made by any person whether a citizen of Pakistan or not, either alone or jointly with any other person. However, the requirement for the application is that it should be in the prescribed form. It must contain a declaration to the effect that the applicant or, in case of a joint application, at least one of the applicants, is the true and first inventor or the legal representative or assignee of such inventor. The application should be accompanied by either a provisional or complete specification and the prescribed fee. Where the true and first inventor is not a party to the application, the application must state his name and other particulars for his identification. The applicant, in any case, must show that he is the legal representative or assignee of the true and first inventor (Section 3).

2.4 Specification

An applicant for a patent is required to describe the nature of his invention in the provisional specification. However, a complete specification must particularly describe and ascertain the nature of the invention and the manner in which it is to be performed. A specification, whether provisional or complete, should commence with the title, and in the case of a complete specification should end with a distinct statement of the invention claimed. If the Controller deems it desirable, he may require that suitable drawings should be supplied before the acceptance of the application. These drawings shall be deemed to form part of the complete specification. If in any particular case the Controller considers that the application should be further supplemented by a model or sample of anything illustrating the invention or alleged to constitute an invention, such model or sample as he may require shall also be furnished before the acceptance of the application, but such model or sample shall not be deemed to form part of the specification. The Controller may, where the application was accompanied by a specification purporting to be a complete specification, on the request of the applicant, treat the specification as a provisional one and proceed with the application accordingly (Section 4).

If only a provisional specification is attached to the application, a complete specification may be provided within nine months from the date of the application. On the request of the applicant, however, the period may be extended up to another one month if the prescribed fee for this purpose is paid within the specified period. If the complete specification is not left with the Controller within the allowable period as indicated above, the application shall be deemed to have been abandoned at the expiration of 10 months from the date of application (Section 4A).

2.5 Proceedings

Every application which has a complete specification attached to it is referred to an Examiner by the Controller of Patents and Designs. If the Examiner reports that the required conditions for the grant of a patent are not fulfilled, the application may be refused. Against such refusal, an appeal to the Federal Government can be made (Section 5).

On acceptance of the application the Controller gives notice thereof to the applicant and advertises the acceptance. The application and specifications are then open to the public for inspection (Section 6).

Between the date of the acceptance of the application and the sealing of the patent, the applicant is entitled to the same privileges and rights as if a patent for the invention has been sealed. However, the applicant is not entitled to institute

any proceedings for infringement until the patent has actually been sealed (Section 7).

2.6 Opposition to Grant of Patent

Any person may, on payment of the prescribed fee, within four months of the date of advertisement of the acceptance of an application give notice to oppose the grant of the patent only on specified grounds. The Controller, after hearing the parties, decides the case. An appeal against his decision lies to the Federal Government (Section 9). If the applicant succeeds or if there was no opposition to the application, the patent shall be granted and sealed as of the date of application (Sections 10 and 11). The Register of Patents is open to public inspection and copies of any entries therein may be furnished, on payment of the prescribed fee to any person requiring them (Section 59).

2.7 Effect of Patent

A patent when sealed shall confer on the patentee the exclusive privilege of making, selling and using the invention throughout Pakistan.

Every patent is granted for one invention only, but the specification may contain more than one claim. No objection to a patent can be taken on the ground that it had been granted for more than one invention (Section 12).

Where the same applicant has put in two or more provisional specifications for inventions which are cognate or modifications of one or the other, and the Controller is of the opinion that the whole of such inventions are such as to constitute a single invention, he may allow one complete specification in respect of the whole of such inventions and grant a single patent thereon. (Section 13A).

A patent granted to the true and first inventor or his legal representative or assignee shall not be invalidated by an application of fraud on him, or by protection obtained thereon or by any use or publication of the invention subsequent to that fraudulent application during the period of protection. Where a patent has been revoked by the High Court as having been obtained by fraud on the true and first inventor, the Controller may, on application by or on behalf of the true inventor, grant the same to the true inventor effective from the original date (Section 13).

2.8 Term of Patent

A patent is originally granted for a period of 16 years (Section 14). However, having regard to the nature and merits of the invention in relation to the public, to the profits made on the patent and other circumstances of the case, the

term of the patent may be extended up to five years or in exceptional cases up to 10 years or a new patent may be granted for a period of 10 years (Section 15). Patents of addition last as long as the original patents even if granted later in time (Section 15A).

2.9 Maintenance

Maintenance fees are required for preserving patents, and failure to pay the prescribed fee within the prescribed period results in lapse of the patent. A period of grace of up to three months is allowed for late payment of the maintenance fee, subject to payment of an additional fee (Section 14; Rules, First Schedule and Form No. 4 of Second Schedule).

Where any patent has lapsed due to the failure of the patentee to pay any prescribed fee within the prescribed time, the patentee may apply to the Controller in the prescribed manner for restoration of the patent. The application should state the circumstances which caused the omission to pay the fee.

If it appears that the omission was unintentional or unavoidable and the application for restoration has been made without undue delay, the Controller advertises the application in the prescribed manner and any person may give notice of opposition at the Patent Office within the prescribed period. The applicant is informed of such notice. Thereafter, the Controller hears the case and, subject to an appeal to the Federal Government, issues an order either restoring the patent subject to any conditions and restrictions as may be deemed advisable or he dismisses the application. However, if the patent is restored, provisions can be inserted for the protection of persons who may have availed themselves of the subject matter of the patent after it has ceased (Section 16).

2.10 Amendment

An applicant may at any time, on the payment of the prescribed fee, request to seek leave to amend his application or specification by way of disclaimer, correction or explanation, stating the nature of, and the reasons for, the proposed amendment.

If the application for the patent is still pending acceptance when the above application for amendment is made, the Controller shall determine whether and subject to what conditions (if any) the amendment shall be allowed. On the other hand, if the application for a patent had already been accepted, the proposed amendment will have to be advertised allowing a three-month period for entering opposition to the amendment. Where an opposition has been made, it is notified to the applicant or the patentee, as the case may be, and the case is heard and decided

by the Controller. An appeal against this decision of the Controller lies to the Federal Government.

However, no amendment is allowed which would make the application or specification, as amended, claim an invention substantially larger than, or substantially different from, the invention claimed by the application or specification as it stood before that amendment.

Leave to amend is conclusive as to the right of the party to make the amendment allowed, except in case of fraud. Amendment when allowed is advertised and it becomes part of the original application or the specification.

These provisions for amendment, however, cannot be availed of when and so long as any suit for infringement or any proceeding before a court for the revocation of the patent is pending (Section 17). But the court itself may by order allow the patentee to amend his specification by way of disclaimer, correction or explanation in such manner and subject to such terms as to costs, advertisement or otherwise as the court may think fit, provided that the amendment will not be allowed if it would result in claiming an invention substantially larger than or substantially different from the invention as it originally stood (Section 18).

2.11 Register of Patents

The Register of Patents is kept at the Patent Office wherein the names and addresses of grantees of patents, notifications of assignments and of transmissions of patents, of licenses under patents, and of amendments, extensions, and revocations of patents and such other matters affecting the validity or proprietorship of patents as may be prescribed are entered. The Register of Patents is *prima facie* evidence of any matter that is entered in it (Section 20).

2.12 Patent Binds Government

The officers or authorities administering any department of the Government or their duly authorized agents may, after a patent has been applied for or granted and after giving notice to the applicant or patentee, make, use or exercise the invention for the services of the Government upon such terms as may be agreed upon between such officers or authorities and the applicant or patentee, or, failing such agreement, upon such terms as may be decided by the High Court (Section 21).

2.13 Assignments and Licenses

Assignments, licenses and other transactions affecting the proprietorship in a patent must be registered. A document or instrument in respect of which no entry has been made in the Register shall not be admitted in evidence in any court as

proof of title to any patent or any interest therein, unless the court otherwise orders (Sections 20 and 63).

2.14 Employee Inventions

Government servants whose duties involve carrying out scientific or technical research and employees of the Army, Navy, Air Force and the Railway Department may only file applications for patents upon being authorized by their employers. Such authorization may be given subject to conditions which may include, *inter alia*, the right of the Government to exploit the invention, the obligation to assign the patent to the Government and restrictions on the freedom of the inventor to obtain patents in foreign countries (Special Regulations Relating to Patents Applicable to Government Servants contained in Chapter VI of the Patent Office Handbook with references to the specific regulations and instruments applicable).

2.15 Compulsory Licenses and Revocation

Any person may apply to the Government of Pakistan, for the grant of a compulsory license, or, in the alternative, for the revocation of the patent alleging that the demand for a patented article in Pakistan is not being met to an adequate extent and on reasonable terms. The Government shall consider the application and in the absence of any arrangement between the parties, shall either dispose of the application itself or refer it to the High Court for decision. If it is found that the demand for the patented article in Pakistan is not being met to an adequate extent and on reasonable terms, the patentee may be ordered to grant licenses on just terms. If in the opinion of the Government or the High Court, as the case may be, the demand will not be adequately met by the grant of licenses, the patent may be revoked. However, an order of revocation cannot be made before the expiration of four years from the date of the patent, or if the patentee gives satisfactory reasons for his default (Section 22).

2.16 Revocation of Patents Worked Outside Pakistan

Any person may apply to the Government for the grant of a license or revocation of a patent on the ground that the patented article or process is being manufactured or carried out exclusively or mainly outside Pakistan. On inquiry, if his assertion is found to be correct, the patentee may be ordered to grant a license exclusively to the applicant or the patent may be revoked. However, an order of revocation shall not be made if it would be at variance with any treaty, convention, arrangement or engagement with any foreign country (Section 23).

2.17 Revocation

The Government may declare a patent or the mode in which it is exercised to be mischievous to the State or generally prejudicial to the public and thus it shall stand revoked (Section 25).

A patent may be revoked in whole or in part on any of the following grounds, namely, (a) that the invention has been the subject of a valid prior grant of a patent in Pakistan; (b) that the true and first inventor or his legal representative or assignee was not the applicant or one of the applicants for the patent; (c) that the patent was obtained in fraud of the rights of the person applying for the revocation or of any person under or through whom he claims; (d) that the invention was not, at the date of the patent, a manner of new manufacture or improvement; (e) that the invention does not involve any inventive step, having regard to what was known or used prior to the date of the patent; (f) that the invention is of no utility; (g) that the complete specification does not sufficiently and fairly describe and ascertain the nature of the invention and the manner in which the invention is to be performed; (h) that the complete specification does not sufficiently and clearly ascertain the scope of the invention claimed; (i) that the patent was obtained on a false suggestion or representation; (j) that the primary or intended use or exercise of the invention is contrary to law; (k) that the patentee has contravened, or has not complied with, the conditions contained in the patent; (l) that the complete specification does not disclose the best method of performance of the invention known to the applicant for the patent at the time when the specification was left at the Patent Office; (m) that prior to the date of the patent, the patentee or other persons secretly worked the invention on a commercial scale in Pakistan, and thereby made direct or indirect profits in excess of such amount which may be deemed reasonable; (n) that the invention claimed in the complete specification is not the same as that contained in the provisional specification, and that the invention claimed, so far as it is not contained in the provisional specification, was not new at the date when the complete specification was filed (Section 26).

2.18 Infringement

A patentee may institute a suit against any person who during the continuance of a patent acquired by him in respect of an invention, makes, sells or uses the invention without his license, or counterfeits it, or imitates it (Section 29). However, an innocent infringer will not be liable in damages, though injunction could be granted against him (Section 30).

Other remedies include obtaining of an injunction under the Specific Relief Act (Act I of 1877). Even before the Trade Marks Act, 1940, a person could be

criminally liable for the use or possession of counterfeit trade marks and punished with one year's imprisonment (Penal Code, Section 486).

If any person claiming to have an interest in a patent by circulars, advertisements or otherwise, threatens any other person with any legal proceedings or liability in respect of any alleged infringement of the patent, any person aggrieved thereby may bring a suit against him in a District Court and obtain an injunction against the continuance of such threats and may recover any damages (if any) as he may have sustained due to these threats, if the alleged infringement to which the threats related was not in fact an infringement of the patent. However, this remedy will not be available if an action for infringement of the patent is commenced and prosecuted with due diligence (Section 36).

2.19 Joint Patentees

Where a patent is granted to two or more persons jointly, they are treated as joint tenants for the purposes of devolution of the legal interest in the patent. If there is no contract to the contrary, each of such persons shall be entitled to use the invention for his own profit without accounting to the others, but shall not be entitled to grant a license without their consent, and if any such person dies, his interest in the patent devolves on his legal representatives (Section 37).

2.20 Public Use or Knowledge of Invention

The public use or knowledge of an invention in Pakistan before the date of the application for a patent does not invalidate the patent granted thereon if the knowledge had been obtained or communicated to the public, surreptitiously or in fraud of the true and first inventor or his legal representative or assignee or in breach of confidence, provided that such inventor has not acquiesced in the public use of the invention and he applies for a patent within six months after the commencement of such a use (Section 38).

2.21 Exhibition Before Learned Societies

Exhibition of an invention in an industrial or other exhibition or reading of a paper thereon before learned societies is not a bar to an application for a patent and the grant thereof provided that the application is made within six months and previous notice has been given to the Controller (Section 40).

2.22 Models for National Museum

The National Museum of Pakistan can require that a patentee should furnish it with a model or sample of his invention on payment of the cost of the

manufacture of the model or the sample. In case of dispute about the cost of manufacture, the Federal Government shall settle it (Section 41).

2.23 Foreign Vessels

A patent does not prevent the use of an invention for the purposes of the navigation of a foreign vessel within the jurisdiction of any court in Pakistan, or the use of an invention in a foreign vessel within that jurisdiction, if it is not used therein for or in connection with the manufacture or preparation of anything intended to be sold in or exported from Pakistan. However, these provisions do not extend to the vessels of any foreign State which does not have corresponding laws with respect to Pakistan vessels (Section 42).

CHAPTER 3

INDUSTRIAL DESIGNS



SYNOPSIS

- 3.1 Introduction**
- 3.2 Right to Register**
- 3.3 Registration in New Classes**
- 3.4 Registration Procedure**
- 3.5 Copyright on Registration**
- 3.6 Piracy of Registered Designs**

3.1 Introduction

Industrial designs in Pakistan are regulated in the same statutes which establish a regime for the protection of patents. These statutes are described at Parts 2.1 and 2.2 above.

Designs are defined as features of shape, configuration, pattern or ornament applied to any article by an industrial process or means, which in the finished article appeal to and are judged solely by the eye (Section 2(5)). The definition of "design," contained in the Act, however, excludes from protection any mode or principle of construction or any thing which is in substance a mere mechanical device (Section 2(5)).

3.2 Right to Register

Any person claiming to be the proprietor of any new or original design not previously published in Pakistan may apply to register the design. The application has to be made in a prescribed form and a fee must be paid for registration of the design. The same design may be registered in more than one class and, in case of doubt about the class, the Controller decides the question. If the Controller refuses to register a design, appeal lies to the Federal Government (Section 43).

3.3 Registration in New Classes

Where a design has been registered in one or more classes of goods, the application of the proprietor of the design to register it in one or more other classes cannot be refused nor can the registration be invalidated on the ground that (a) the design was not a new or original design by reason only that it was previously registered; or that (b) the design has been previously published in Pakistan, by reason only that it had been applied to goods of any class in which it was so previously registered, provided that such subsequent registration shall not extend the period of copyright in the design beyond that arising from the previous registration (Section 44).

Novelty is not lost by the disclosure of a design by the proprietor to any other person in such circumstances as would make it contrary to good faith for that other person to use or publish the design; or by the disclosure of a design in breach of good faith by any person; or by the acceptance of a first and confidential order for goods bearing a new or original textile design intended for registration (Section 49). However, the registration of a design may be cancelled on any of the following grounds, namely, (i) that the design has been previously registered in Pakistan; or (ii) that it has been published in Pakistan prior to the date of registration; or, (iii) that the design is not a new or original one (Section 51A). The

exhibition of a design at an industrial or any other exhibition cannot bar the registration of a design. There is no loss of novelty if the design, or any article to which it is applied, was exhibited by the proprietor at or in connection with an industrial or other exhibition to which the relevant provisions of the Act have been extended by the Government by notification in the Official Gazette (or disclosed in connection with such exhibition by any other person without the consent of the proprietor) provided that the proprietor has given to the Controller, in the prescribed form, prior notice of his intention to disclose the design thereat, and that an application for registration of the design is made within six months of the disclosure (Section 52).

3.4 Registration Procedure

The application for registration of a design is examined. If the Controller finds the application in order, the design is registered and a certificate of registration issued. Any objections of the Controller are communicated in writing to the applicant who may apply to the Controller for a hearing. An appeal from the Controller's decision lies to the Government (Sections 43 and 45(1); Rules 39 to 42).

During the existence of copyright in a design, or such shorter period not being less than two years from the registration of the design as may be prescribed, the design is not open to inspection except by the proprietor or a person authorized in writing by him, or a person authorized by the Controller or by the court, and except in the presence of the Controller, or of an officer acting under him. The person making the inspection may not take any copy of the design, or of any part thereof. After the expiration of the copyright in a design, or such shorter period as aforesaid, the design is open to inspection, and copies thereof may be taken by any person on payment of the prescribed fee (Section 50(1) and (2)).

3.5 Copyright on Registration

Once a design is registered, the registered proprietor of the design acquires a copyright in it for a period of five years. The period may be extended for further successive five year periods on application and payment of the prescribed fee (Section 47).

3.6 Piracy of Registered Designs

During the existence of copyright in any design, it is unlawful (a) for the purpose of sale to apply to any article the design or any fraudulent or obvious imitation of it except with the license of the registered proprietor; or (b) to import

for the purposes of sale, without the consent of the registered proprietor, any article belonging to the class in which the design has been registered, and having applied to it the design or any fraudulent or obvious imitation of it; or, (c) knowing that the design or any fraudulent or obvious imitation of it has been applied to any article in any class of goods in which the design has been registered without the consent of the registered proprietor, to publish or expose for sale that article. Any person contravening these provisions is liable to pay a certain sum of money as a contract debt and also damages to the registered proprietor of the design. An injunction can also be issued against him for further violating the rights of the registered proprietor of the design (Section 53).

CHAPTER 4

TRADE MARKS

SYNOPSIS

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- 4.2 Current Legislation**
- 4.3 Conditions for Registration of Trade Marks**
 - 4.3.1 Distinctiveness**
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4.1 Introduction

In May 1879, the Government of British India introduced a Bill in the Imperial Legislative Council for the registration of trade marks in British India, but legislation was not proceeded with due to lack of support from commercial bodies. Thereafter, the question of undertaking legislation was considered by the then Government of India on several occasions. Until 1928, commercial opinion in the country was formed, either unanimously or on the balance, to be against the proposal. However, during the 1930s, the demand for legislation had strengthened due to the growth of industry and trade in India and due to the increasing realization that, without a system of statutory registration, trade marks could not enjoy adequate protection at home or abroad. Hence the proposals, based on the United Kingdom's Trade Act, 1938, were made in the Bill which was eventually passed by the legislature as the Trade Marks Act (V of 1940).

This Act was passed to provide for the registration and more effective protection of trade marks. The provisions of the Act were in addition to and not in derogation of the provisions of any other law for the time being in force. The Act did not affect right of action against any person for passing off goods as the goods of another person, or the remedies in respect thereof.

This Act has been the basic law on trade marks and trade names since it was passed in 1940. No doubt, some amendments in it have been made from time to time. The matters relating to trade marks are basically governed by the provisions of this Act together with some other provisions contained in several other cognate statutes. They include the Revised Trade Marks Rules, 1963; the Merchandise Marks Act, 1889; the Trade Marks (Invalidation and Summary Registration) Act, 1950; Trade Marks (Invalidation and Summary Registration) Rules, 1950; Rules framed by the High Court for regulating the conduct and procedure of trade mark proceedings; and some provisions of the Pakistan Penal Code, relating to infringement of trade, property and other marks. These provisions are as follows.

4.2 Current Legislation

The law relating to trade marks in Pakistan is governed by the provisions of the Trade Marks Act, 1940 and the rules made thereunder. The Merchandise Marks Act (IV of 1889) is also relevant. A summary of the law can be described under the following headings: (i) Conditions for Registration of Trade Marks; (ii) Procedure and Duration of Registration; (iii) Effect of Registration; (iv) Assignment and Transmission of Trade Marks; (v) Use of Trade Marks and Registered Users; (vi) Special Provisions for Textile Goods; (vii) Miscellaneous; and (viii) the Merchandise Marks Act.

4.3 Conditions for Registration of Trade Marks

There is a Registrar of Trade Marks who maintains a Register of Trade Marks. Deputy Registrars assist him and he can delegate some particular functions to some other officers.

A trade mark may be registered in respect of particular goods or class of goods. The questions with regard to class of goods are decided as final by the Registrar (Section 4). "Mark" includes a device, brand, heading, label, ticket, name, signature, word, letter or numeral or any combination thereof (Section 2(1)(f)).

4.3.1 "*Distinctiveness*"

Distinctiveness is a pre-requisite for the registration of a trade mark which means adapted, in relation to the goods in respect of which a trade mark is proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is proposed to be registered subject to limitations, in relation to use within the extent of the registration.

A trade mark may be registered only in respect of particular goods or class of goods. As to the determination of the class of goods, the decision of the Registrar is final (Section 5). A proposed trade mark is required to contain or consist of one of the following particulars: (a) the name of a company, individual, or firm, represented in a special or particular manner; (b) the signature of the applicant or a predecessor in business; (c) one or more invented words; (d) one or more words having no direct reference to the character or quality of goods and no geographical name or surname or name of a sect, caste or tribe in Pakistan (Section 6).

4.3.2 *Limitation to Colour*

A trade mark may be limited wholly or in part to one or more specified colours. If it has been registered without such limitation, it shall be deemed to be registered for all colours (Section 7).

4.3.3 *Prohibition of Registration*

No trade mark can be registered which contains any scandalous design or any matter the use of which is likely to deceive or cause confusion or be likely to or hurt religious susceptibilities of any class of citizens of Pakistan or contrary to any law for the time being in force or contrary to morality (Section 8).

4.3.4 *Names of Chemical Elements*

No word which is commonly used and is the accepted name of any single chemical element or single chemical compound (as distinguished from a mixture) can be registered as a trade mark (Section 9).

4.3.5 *Identical or Similar Trade Marks*

A trade mark similar to another which is already registered will not normally be allowed. However, where an honest concurrent use or some other special circumstances so warrant, the Registrar may permit the registration (Section 10). See some cases in Chapter V.

4.3.6 *Parts of Trade Marks and as Series*

Where the proprietor of a trade mark claims to be entitled to the exclusive use of any part thereof separately, he may apply to register the whole and the part as separate trade marks. In such a case, each separate trade mark will have to satisfy all the conditions and incidents of an independent trade mark. However, these separate trade marks will be deemed to be associated trade marks and will be registered as such. Where the claim is to the proprietorship of several trade marks in respect of the same goods or description of goods which, while resembling each other in the material particulars yet differ in respect of statements of the goods in relation to which they are respectively used or proposed to be used, or statements of number, price, quality or names of places, or other matter of a non-distinctive character which does not substantially affect the identity of the trade mark or colour, may be registered as a series in one registration but shall be deemed as associated trade marks and shall be registered as such (Sections 11 and 12).

4.3.7 *Associated Trade Marks*

Where a trade mark which is registered or is to be registered in respect of any goods is identical with another trade mark in the name of the same proprietor in respect of the same goods or description of goods, or so nearly resembles it as to be likely to deceive or cause confusion if used by a person other than the proprietor, the Registrar may require it to be entered as an associated trade mark. However, on application by the registered proprietor of two or more associated trade marks the Registrar may dissolve the association if he is satisfied that there is no likelihood of deception or confusion being caused by their use (Section 12).

4.3.8 *Registration Subject to Disclaimer*

If a trade mark contains any part which is not separately registered as a trade mark in the name of the proprietor, nor any application for its registration has been made, or if the trade mark contains any matter common to the trade or otherwise of a non-distinctive character, it may be required of the proprietor that he shall either disclaim any right to the exclusive use of such part or of all or any portion of such matter, to the exclusive use of which he is not entitled, or make such other disclaimer as may be necessary for the purpose of defining the rights of the proprietor under the registration. However, no disclaimer affects any rights of the proprietor of a trade mark except those that arise out of the registration of the trade mark in respect of which the disclaimer is made (Section 13).

4.4 **Procedure and Duration of Registration**

4.4.1 *Application*

Upon receipt of a trade mark application, a search is carried out among registered marks and pending applications for identical or deceptively similar marks in respect of the same goods or description of goods. After considering the application, any person using or proposing to use a trade mark may apply in writing for its registration in the prescribed manner. The Registrar may permit it either absolutely or subject to any amendments, modifications, conditions or limitations. If the Registrar refuses to allow registration of the trade mark, he is required to state in writing the grounds for such refusal (Section 14; Rules 23 and 108).

As regards certification trade marks, applications must be accompanied by a draft of regulations governing the use of the mark. After considering the application, the Registrar may authorize it to proceed. The Federal Government then examines the application to determine whether the applicant is competent to certify the goods concerned, whether the draft regulations deposited are satisfactory and whether the registration would be to the public advantage. After examination, the Federal Government may direct the Registrar to refuse the application or to accept it and the corresponding regulations, unconditionally or subject to limitations or amendments (Section 54).

4.4.2 *Opposition to Registration*

After the application has been accepted by the Registrar, it is required to be advertised and any person may oppose it giving his reasons therefor. The grounds of both the parties, that is the applicant and the opposer, are brought to each others notice (Sections 15 and 55; Rule 30).

Where there is no opposition, or where the opposition proceedings are determined in favour of the applicant, the mark is registered and a certificate is issued. With respect to certification trade marks, the regulations approved by the Central Government are deposited in the Registry and are open to public inspection in like manner as the Register (Sections 16(2) and 56(1)).

4.4.3 *Duration and Renewal*

Registration is initially for seven years from the date of filing of the application. It is renewable indefinitely, for periods of 15 years, upon application to the Registrar, made not more than six months before the expiration of the last registration and upon payment of a fee and subject to compliance with any other conditions imposed by the Registrar. The latter has discretion to restore a registration removed for non-payment of the renewal fee (Sections 16 and 18; Rules 46 to 49).

4.4.4 *Jointly Owned Trade Marks*

Two or more persons may be registered as joint proprietors of a trade mark where such a mark is to be used on behalf of both or all of them, or where it is in relation to an article with which both or all of them are connected in the course of trade (Section 17).

4.5 Effect of Registration

Registration of the mark gives the proprietor the exclusive right to the use of the mark in relation to the goods in respect of which it is registered. Without prejudice to the generality of the foregoing statement, the exclusive right is deemed to be infringed by a person who, not being the proprietor of the trade mark or a registered user using it by way of the permitted use—or, in the case of a certification trade mark, not being the proprietor or a person authorized by him under the relevant regulations and using it in accordance therewith—uses a mark identical with it or so nearly resembling it as to be likely to deceive or cause confusion, in the course of trade, in relation to any goods in respect of which it is registered, and in such manner as to render the use of the mark likely to be taken either:

- as being used as a trade mark; or
- as importing a reference to some person having the right either as proprietor or as registered user to use the trade mark, or to goods with which such person is connected in the course of trade—or, in the case of a certification trade mark, as importing a reference to some person having

the right either as proprietor, or by his authorization under the relevant regulations, to use the trade mark or to goods certified by the proprietor (Sections 21(1) and 58(1)).

The exclusive right is not deemed to be infringed by the use of a trade mark (a) in relation to goods which are connected in the course of trade with the proprietor or a registered user or, in the case of a certification trade mark, which are certified by the proprietor if, as to those goods or a bulk of which they form part, the proprietor or other person entitled to do so had applied the trade mark and has not subsequently removed it, or has expressly or impliedly consented to such use (provided, in the case of a certification mark, that any use by application of the trade mark is not contrary to the relevant regulations), or (b) in relation to goods adapted to form part of, or to be accessory to, other goods in relation to which the trade mark has been or might be used without infringement, if the use of the mark is reasonably necessary in order to indicate that the goods are so adapted and neither the purpose nor the effect of the use is to indicate, otherwise than in accordance with the fact, that there is a connection in the course of trade between any person and the goods or, in the case of a certification trade mark, that the goods are certified by the proprietor (Sections 22(2) and 58(2)).

The use of a registered mark, being one of two or more registered marks that are identical or nearly resemble each other, in exercise of the exclusive right conferred by registration is not deemed to be an infringement of the exclusive right conferred with respect to any other of those trade marks (Sections 22(3) and 58(3)).

The exclusive right conferred by registration with respect to a trade mark does not give the right to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it in relation to goods in relation to which that person or a predecessor in title of his has continuously used the trade mark from a date prior to the use of the first-mentioned trade mark in relation to those goods by the proprietor or a predecessor in title of his, or to the registration of the first-mentioned trade mark in respect of the goods concerned in the name of the proprietor or a predecessor in title, whichever is the earlier; moreover, in such a case the exclusive right cannot prevent the prior used mark from being registered in respect of the goods concerned (Section 25).

The exclusive right does not affect any *bona fide* use by a person of his own or a predecessor's name or of the name of his or a predecessor's place of business, or the use by any person of any *bona fide* description of the character or quality of his goods, not being a description that would be likely to be taken as importing a reference to some person having the right to use the trade mark (Section 26).

4.6 Assignment and Transmission

Registered trade marks are assignable and transmissible with or without the goodwill of the business concerned and in respect of all or only some of the goods for which they are registered. Unregistered trade marks are not assignable or transmissible except with the goodwill of the business concerned unless they are used in the same business as a registered mark, transferred at the same time as the registered mark and to the same person, and relate to goods in respect of which the registered mark is transferred. Assignments without the goodwill do not take effect until they have been advertised in accordance with the directions of the Registrar (Sections 29, 30 and 33).

Assignments and transmissions are invalid if, as a result, exclusive rights would subsist in more than one person to the user, in relation to the same goods or description of goods, of identical or nearly resembling trade marks if, having regard to the similarity of the goods and the trade marks, the use of the trade marks in the exercise of those rights would be likely to deceive or cause confusion. If, however, the exclusive rights, due to limitations imposed on them, are not such as to be exercisable by more than one person in relation to goods to be sold, or otherwise traded, within Pakistan or in relation to goods to be exported to the same foreign market, the assignment or transmission is not to be deemed invalid. Assignments or transmissions are, in principle, invalid if they would result in different persons having exclusive rights limited to different parts of Pakistan and relating to the use of identical or nearly resembling trade marks in relation to the same goods or description of goods. Such assignments and transmissions may be approved by the Registrar if the use of the trade marks in the exercise of the rights would not be contrary to the public interest, in which case the transfer is not to be deemed invalid provided, in the case of a registered trade mark, an application is made to the Registrar for the registration of the transferee's title (Sections 31(1) and 32).

The above provisions of the Act relating to invalidity of assignments and transmissions and to the advertisement of assignments without the goodwill do not apply to certification trade marks. However, such trade marks are not assignable or transmissible otherwise than with the consent of the Federal Government (Sections 34(1) and 50).

Trade marks that are registered as, or are deemed to be, associated trade marks are assignable and transmissible only as a whole and not separately. Where a trade mark that is the subject of an application or registration is identical with another trade mark that is the subject of an application or registration in the name of the same proprietor in respect of the same goods or description of goods, or so nearly resembles it as to be likely to deceive or cause confusion if used by a

person other than the proprietor, the Registrar may require the trade marks to be registered as associated trade marks. Moreover, the following are deemed to be associated trade marks: parts of a trade mark separately registered in addition to the whole trade mark, trade marks registered as a series in one registration, and the well-known trade mark and its related defensive trade marks (Sections 12(1) to (3), 34(2) and 38(3)).

The transferee under an assignment or transmission of a registered trade mark must apply to the Registrar to be registered as the proprietor of the trade mark in respect of the goods concerned. Such registration must be effected on proof of title to the Registrar's satisfaction. The direct consequences of failure to register are: inadmissibility, as evidence in proof of title, of the instrument of transfer unless the Registrar or the court otherwise directs (Section 35).

4.7 Use of Trade Marks and Registered Users

A registered trade mark may be taken off the Register in respect of any of the goods for which it is registered on application (which can normally be made either to the court or to the Registrar) by any person aggrieved, on the ground either:

- that the trade mark was registered without any *bona fide* intention on the part of the applicant for registration that it should be used in relation to those goods by him, and that there has in fact been no *bona fide* use of the trade mark in relation to those goods by any proprietor thereof up to one month before the date of application; or
- that up to one month before the date of the application a continuous period of five years or longer elapsed during which the trade mark was registered and during which there was no *bona fide* use thereof in relation to those goods by any proprietor thereof (Section 37(1)).

Where the matters referred to above are shown so far as regards non-use of the trade mark in relation to goods to be sold, or otherwise traded in, in a particular place in Pakistan (otherwise than for export) or in relation to goods to be exported to a particular market abroad, and a person has been permitted (or might properly be permitted) to register an identical or nearly resembling mark in respect of those goods under a registration extending to use in relation to goods to be sold, or otherwise traded in, in that place (otherwise than for export), or in relation to goods to be exported to that market, the registration of the first-mentioned trade mark may be limited, upon application to the court or the Registrar by the proprietor of the other trade mark, so as no longer to extend to the use referred to above (Section 37(2)).

An application for the removal of a trade mark on the ground of non-use may be refused in relation to any goods if there has been, at the relevant time, *bona fide* use of the trade mark by any proprietor thereof for the time being in relation to goods of the same description, being goods in respect of which the trade mark is registered (this exception does not apply if the person making the application for removal has been permitted, or might properly be permitted, under the Act, to register an identical or nearly resembling trade mark in respect of the goods in question on the basis of honest concurrent use) (Section 37(1), proviso).

An applicant for removal of a trade mark, or for the imposition of limitations, on the ground of non-use may not rely on any non-use that is shown to have been due to special circumstances in the trade and not to any intention not to use or any intention to abandon the trade mark in relation to the goods concerned (Section 37(3)).

Where a trade mark consisting of any invented word has become so well known as regards any goods in relation to which it is registered and has been used that the use thereof in relation to other goods would be likely to be taken as indicating a connection in the course of trade between those goods and a person entitled to use the trade mark in relation to the first-mentioned goods, then, notwithstanding the fact that the trade mark is not used or proposed to be used in relation to those other goods, it may be registered, in the name of the proprietor of the trade mark, as a defensive trademark in respect of those other goods and, while so registered, may not be removed in respect of those goods on the ground of non-use (Section 38(1)).

The use of a trade mark by a registered user of it is deemed to be used by the proprietor of the trade mark (Section 39(2)).

The court and the Registrar have discretion to accept use of an associated registered trade mark, or of a trade mark with additions or alterations not substantially affecting its identity, as an equivalent for any use required to be proved under the Act (Section 44(1)).

The use of the whole of a registered trade mark is deemed to be also a use of any trade mark, being a part thereof, registered in the name of the same proprietor (Section 44(2)).

The application in Pakistan of a trade mark for goods to be exported and any other act done in Pakistan in relation to such goods which would constitute use in that country if the goods were for the domestic market are deemed to constitute use in relation to those goods (Section 45(1)).

No person may import, sell or distribute any drug under any brand name. The Federal Government may, in the public interest, exempt any drug or class of

drug from the application of this prohibition (Drugs (Generic Names) Sections 7(1) and 13).

4.8 Licenses

In the case of a trade mark other than a certification trade mark, a person may be registered as a registered user thereof in respect of all or any of the goods in respect of which it is registered (otherwise than as a defensive trade mark) and with or without conditions or restrictions (Section 39(1)).

The proprietor and the proposed registered user of the mark must apply to the Registrar and furnish him with a declaration giving particulars of their existing or proposed relationship (including particulars showing the degree of control by the proprietor over the permitted use) and specifying the terms governing the relationship (including any conditions or restrictions imposed). The Registrar may register the licensee as a registered user in respect of all or some of the proposed goods if he is satisfied that the use of the trade mark in relation to those goods, subject to any conditions or restrictions that he thinks proper, is not contrary to the public interest. He must refuse such registration if it would tend to facilitate trafficking in a trade mark (Section 41(1) to (3)).

4.9 Export Trade

The use of a mark on goods which are meant for export constitutes use of the mark in relation to those goods which are for use within the country and such a use against the registered proprietor or user will be an infringement of the trade mark (Section 45).

4.10 Textile Goods

With regard to textile goods, the Government has prescribed classes of such goods for the purposes of trade marks. Some restrictions are also placed on the registration of textile goods. For instance, no mark consisting of a line heading alone can be registered as a trade mark; a line heading is not deemed to be adapted to distinguish; the registration of a trade mark does not give any exclusive right to the use of a line heading. Similarly, in respect of textile of textile goods, the registration of letters or numerals or any combination thereof can be restricted (Section 64).

4.11 Miscellaneous

4.11.1 *Use of State Emblems, etc.*

No person is allowed, without due authority, to use in connection with any trade, business, calling or profession the Government arms or any mark closely resembling thereto, which is calculated to deceive. Similarly, the name, title and semblance of the founder of Pakistan is also not allowed to be used. The emblem, the official seal and the name or any abbreviation of the name of the United Nations or any subsidiary body thereof indicating authorization by the Secretary General of the U.N. or Director of an agency is also prohibited. A person so authorized to use these marks however, may seek an injunction against the unauthorized users (Section 69).

Falsification of entries in the Register of Trade Marks and falsely representing a trade mark as registered when it is not registered are offences under the law. These offences are punishable with varying terms of imprisonment and fines (Sections 67 and 68).

4.11.2 *Reciprocal Arrangements*

The Government of Pakistan is authorized to make reciprocal arrangements for the registration of trade marks with other countries (Section 83).

4.11.3 *The Merchandise Marks Act (IV of 1889)*

The object of this Act was to bring the law of British India relating to fraudulent marks on merchandise into accord, as far as local circumstances admitted, with the law of England as enacted in the Merchandise Marks Act, 1887 (50 & 51 vict. c.28). The main provisions are with respect to false trade descriptions. The Act also recasts that part of the Penal Code which relates to trade marks and property marks and that part of the Sea Customs Act, 1878, which relates to the prohibition of the importation into British-India of goods bearing false descriptions or marks. The main object of the legislation contained in this Act, as in similar other enactments, is to prevent a trader from passing off his own goods as those of another.

On the establishment of Pakistan in 1947 as an independent State, the Merchandise Marks Act was adopted with necessary changes as part of the law in Pakistan.

4.12 Infringement

Suits for the infringements of trade marks are instituted before the District Court and appeals therefrom lie before the High Court (Section 73 and 76).

4.12.1 *Jurisdiction*

4.12.2 *Penal Liability for Infringement of Trade, Property and Other Marks*

Even before the Trade Marks Act, 1940, and the Patents and Designs Act, 1911, the Pakistan Penal Code (Act XLV of 1860) had defined "Trade Mark" and "Property Mark." Penalties were provided for the infringement of such marks. Sections 478 to 489 deal with this subject matter. A summary of these provisions is given below.

A trade mark, according to the Penal Code, is a mark which is used for denoting that goods are the manufacture or merchandise of a particular person and it includes any trade mark which was registered in the Register of Trade Marks kept under the Patents, Designs and Trade Marks Act, 1883 (U.K. Act). A property mark is a mark used for denoting that movable property belongs to a particular person. The Penal Code further provides that whoever marks any movable property or goods or any case, package or other receptacle containing movable property or goods, or uses any case, package or other receptacle having any mark thereon, in a manner reasonably calculated to cause it to be believed that the property or goods so marked, or any property or goods contained in any such receptacle so marked, belonging to a person to whom they do not belong, will be using a false property mark. And whoever uses any false trade mark or any false property mark, unless he proves that he acted without intent to defraud, is punishable with imprisonment up to one year, or with a fine or with both.

4.12.3 *Counterfeiting*

Whoever counterfeits any trade mark or property mark used by any other person is punishable with imprisonment up to two years, or with a fine or with both. If anybody counterfeits any property mark or any mark used by a public servant to denote that any property has been manufactured by a particular person or at a particular time or place, or that the property is of a particular quality or has passed through a particular office, or that it is entitled to any exemption, or uses as genuine any such mark knowing the same to be counterfeit, is punishable with imprisonment up to three years and is also liable to a fine.

Making or possession of counterfeiting instrument. Making or possession of any die, plate or other instrument for the purpose of counterfeiting a trade or property mark or possessing such a mark for the purpose of denoting that any goods are the manufacture or merchandise of a person whose they are not, or that they belong to a person to whom they do not belong, is punishable with imprisonment up to three years, or with a fine or with both.

Selling goods with counterfeited marks. Whoever sells, or exposes or has in his possession for sale or any purpose of trade or manufacture, any goods or thing with a counterfeit trade or property mark affixed to or impressed upon the same or to any case, package or other receptacle in which such goods are contained, is punishable with imprisonment for one year, or with a fine or with both. He can avoid liability, however, if he proves that he had taken all reasonable precautions against the commission of this offence and had no reason to suspect the genuineness of the mark and that, on demand, he gave all information to the prosecutor about persons from whom he had obtained such goods and that otherwise he had acted innocently.

Making of false mark. Whoever makes any false mark upon any case, package or other receptacle containing goods, in a manner reasonably calculated to cause any public servant or any other person to believe that such receptacle contains goods which it does not contain or that it does not contain goods which it does contain, or that the goods contained in such receptacle are of a nature or quality different from the real nature or quality thereof, is punishable with imprisonment up to three years, or with a fine or with both, unless he proves that he acted without intent to defraud. Likewise, whoever makes use of such a false mark is also liable to the same punishment unless he proves that he acted without intent to defraud.

4.12.4 *Tampering to Cause Injury*

Whoever removes, destroys, defaces or adds to any property mark intending or knowing it to be likely to cause injury thereby to any person is punishable with imprisonment for one year, or with a fine or with both.

CHAPTER 5

COPYRIGHT

SYNOPSIS

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5.1 Introduction

In 1842, the Literary Copyright Act, 1842 (5 and 6 Vic., ch. 45) was passed by the British Parliament to amend and consolidate the law of copyright in the United Kingdom. It extended throughout the British Dominions. Being a British possession, it was also extended to British India. It granted protection to copyright in books published on British soil.

From the middle of the eighteenth century up to the time of the enactment of the Literary Copyright Act, 1842, protection of copyright in India, if at all afforded, was by the Common Law of England or by virtue of the principles of equity, justice and good conscience. After the Act of 1842, copyright protection in published books could be enforced under the said Act, in British India. "Books" under this Act included every volume, pamphlet, letter and press-sheets, music-sheets, maps, charts and plans. It directed registration of every book at Stationer's Hall in London.

The Act of 1842 extended the term of copyright to the life of the author and seven years after his death, or for a term of 42 years from the first publication, whichever should be longer. This Act remained the governing statute in British India until it was repealed by the Copyright Act, 1911.

In 1908, a Conference was held in Berlin, the object of which was to bring the domestic laws of all countries concerned into harmony with one another and, in order to as to obtain international uniformity of treatment, the United Kingdom ratified the Berlin Act of the Berne Convention for the Protection of Literary and Artistic Works. As a consequence, it necessitated certain changes in the English law. Subsequently, in 1910, an Imperial Copyright Conference was convened in London which was attended by the British Dominions, India Office and British Colonial Office. The Conference recommended a new law so as to incorporate the recommendations of the Berlin Convention. Consequently, the British Parliament passed the Imperial Copyright Act, 1911 (1 and 2 Geo. V, ch. 46).

The important changes made by the Act of 1911 in the previous law included (a) the abolition of the formality of registration of copyright; (b) the extension of the term of copyright from 42 years to one of life of the author plus 50 years after his death; and (d) substitution of one Act for several on the subject.

The Copyright Act, 1911, of England was extended to British India. The Indian Legislature, however, had a very limited power of modification and addition, conferred on it by Section 27 of the Act. It was limited to procedure and remedies, save in relation to the work of authors who were residents of India and in regard to their works first published in India.

In this state of affairs, the British Indian Legislature passed the Copyright Act, 1914, which in fact continued the Imperial Copyright Act, 1911, with certain amendments.

On the independence of Pakistan on August 14, 1947, the Copyright Act, 1914, continued in force until it was replaced by the Copyright Ordinance, 1962 (No. XXXIV of 1962), which came into force on February 27, 1967.

The Copyright Ordinance, 1962, has consolidated the provisions of earlier statutes in this field. It aims to protect new developments in the media of expression, such as photography and audio recording. Radical developments in the reproduction system, such as micro-publication and video displays, have increased the capability of reproducing copyrighted works, and copyright laws therefore can no longer be confined within a small sphere of publishers of written works but have been extended to a larger group capable of republishing copyrighted works.

The detailed provisions of the Ordinance and their present application in the country is discussed below.

5.2 Current Legislation (The Copyright Ordinance, 1962)

This Ordinance came into force on February 27, 1967, and currently governs the copyrights in Pakistan. A summary of the important provisions of the Ordinance is given below.

5.3 Copyright Office, Registrar and Board

The Ordinance has established a Copyright Office which is under the immediate control of the Registrar of Copyrights and the Registrar in turn acts under the direction and supervision of the Federal Government which appoints the Registrar and may also appoint one or more Deputy Registrars. The Registrar signs all entries made in the Register of Copyrights, all certificates of registration and exercises, all other powers conferred on him by the law. He is also Secretary to the Copyright Board. The Deputy Registrar acts under the directions of the Registrar (Section 44).

The Copyright Board is appointed by the Federal Government. The Chairman is to be a person who is or has been a judge of a High Court, or is qualified to be appointed as such judge. The Registrar is an *ex-officio* member and secretary. Other members, not less than three and not more than five, are appointed after consultation with the representative bodies of authors, publishers, the cinematograph industry and any other interest relating to copyright (Section 45). The Board regulates its own procedure and decides cases by majority but, in case of balance,

the Chairman's opinion prevails. The Board and the Registrar have the powers of a civil court under the Code of Civil Procedure, 1908, in respect of: (a) summoning and enforcing the attendance of any person and examining him on oath; (b) requiring the discovery and production of any document; (c) receiving evidence on affidavits; (d) issuing commissions for the examination of witnesses or documents; and (e) requisitioning any public record or copy thereof from any court or office (Section 78) Any order for payment of money passed by the Registrar or Copyright Board is executable as a decree of a civil court (Section 79).

5.4 Works in Which Copyrights Subsist¹

Copyright subsists throughout Pakistan in the following classes of works, that is, (a) original literary, dramatic, musical and artistic works; (b) cinematographic works; and records, provided that (i) in the case of a published work, the work is first published in Pakistan, or where the work is first published outside Pakistan, the author is at the date of such publication, or in a case where the author was dead at that date, was at the time of his death a citizen of Pakistan or domiciled in Pakistan; (ii) in the case of an unpublished work other than an architectural work of art, the author is at the date of the making of the work a citizen of Pakistan or domiciled in Pakistan; and (iii) in the case of an architectural work of art, the work is located in Pakistan (Section 10). However, the Government of Pakistan may extend, by notification, the subsistence of copyright throughout Pakistan to the works of certain international organizations of which one or more sovereign powers of the Government or Governments are members, where otherwise there would have been no copyright (Section 10 and 53).

Similarly, the Government may extend copyright to foreign works, that is, (a) to works first published in a foreign country; (b) to unpublished works, authors of which are foreign subjects; (c) to any work where the author, at the time of his death, was a foreign citizen (Sections 10 and 54). However, if it appears to the Government that a foreign country does not give, or has not undertaken to give, adequate protection to the works of Pakistani authors, the Government may restrict rights of authors of such foreign country even relating to his works first published in Pakistan, for the purpose of conferring copyrights (Section 55).

Copyright does not subsist (a) in any cinematographic work, if a substantial part of the work is an infringement of the copyright in any other work; (b) in any record made in respect of a literary, dramatic or musical work, if in making the record, copyright in such work has been infringed (Section 10(3)).

¹ For exceptions, see Act II of 1973 which amended the Ordinance of 1962. A summary is given at the end of this Chapter.

5.5 Work of Joint Authors

In a case of joint authorship, if one or more of the joint authors do not satisfy the conditions conferring copyright, the work is to be considered, for the purposes of copyright, as being by that or those authors who satisfy the conditions under the law for acquiring the copyright (Section 11).

5.6 Registered Designs

If any design is registered under the Patents and Designs Act, 1911, copyright does not subsist in such a design. If the design is registrable but has not been registered, copyright in any such design ceases as soon as any article to which the design has been applied has been produced more than 50 times by an industrial process by the owner of the copyright or, with his license, by any other person (Section 12).

5.7 Assignment of Copyright

The owner of the copyright in an existing work or the prospective owner of the copyright in a future work may assign to any person the copyright either wholly or partially and either generally or subject to limitations and either for the whole term of the copyright or any part thereof. In the case of the assignment of copyright in any future work, it takes effect only when the work comes into existence. However, if the owner of the copyright in a work is the author of the work himself, no assignment of the copyright in the work or of any interest in such copyright can be made (except where the assignee is the Government or an educational charitable, religious or non-profit-making institution) for a period of more than 10 years. If so made, on the expiry of 10 years, the copyright reverts to the author or, if he is dead, to his representatives in interest (Section 14).

5.8 Transmission by Testamentary Disposition

Where under a bequest a person is entitled to the manuscript of a literary, dramatic or musical work, or to an artistic work, and the work was not published before the death of the testator, unless a contrary intention is indicated in the testator's will or any codicil thereto, the bequest is to be construed as including the copyright in the work insofar as the testator was the owner of the copyright immediately before his death (Section 16).

5.9 Relinquishment of Copyright by Owner

The owner of a copyright in a work may relinquish all or any of the rights comprised in copyright by informing the Registrar of Copyrights (Section 17).

5.10 Term of Copyright (General)

A copyright subsists in any literary, dramatic, musical or artistic work (other than a photograph) published in the lifetime of the author until 50 years from the beginning of the calendar year next following the year in which the author dies. In the case of a work of joint authorship, death of the joint author who dies last shall be the basis for counting the 50 years (Section 18).

5.11 Others

5.11.1 *Posthumous Works*

In the case of a literary, dramatic or musical work or an engraving, in which copyright subsists at the date of the death of the author, or of the author who dies last in case of joint authorship, but the work had not been published before such death, the copyright shall subsist until 50 years from the beginning of the calendar year next following the year in which the work is first published. Publication means that it has been performed in public or, if any records of the work are made, the same have been sold or offered for sale to the public (Section 19).

5.11.2 *Cinematographic Works, Records and Photographs*

The copyright subsists until 50 years from the beginning of the calendar year next following the year in which a cinematographic work, a record or a photograph, as the case may be, is published (Section 20).

5.11.3 *Anonymous or Pseudonymous Work*

The copyright in a literary, dramatic musical or artistic work (other than a photograph), which is published anonymously or pseudonymously subsists for a period of 50 years counting from the beginning of the calendar year next following the year in which the work is first published. But if the identity of the author is disclosed before the expiry of this period, the copyright shall subsist for 50 years after the death of the author and in case of joint authorship, of the author who dies last. The identity can be disclosed publicly both by the author and the publisher or can be established by the author to the satisfaction of the Board of copyright (Section 21).

5.11.4 *Works of Government or International Organizations*

Copyrights in such works subsist for a period of 50 years after their first publication, those 50 years being counted from the next calendar year as in other cases (Section 22).

5.11.5 *Unpublished Works*

If a work, whose author's identity is known, is not published posthumously within 50 years after the death of the author or where the author's identity is not known, is not published within 50 years of its creation, such works will fall in the public domain 50 years after the author's death or its creation, as the case may be (Section 23).

5.12 **Rights of Broadcasting Organizations**

The broadcasting organizations have the right to authorize: (a) the re-broadcasting of their broadcasts; (b) the fixation of their broadcasts; and (c) the copying of fixations made of their broadcasts. This right subsists for a period of 25 years to be counted from the beginning of the calendar year next following the year in which the broadcast took place (Section 24).

5.13 **Rights in Published Editions**

The publisher of an edition of a work has the exclusive right to authorize the making, by a photographic or similar process, of copies, intended for sale in commerce, of the typographical arrangement of the edition and this right subsists for a period of 25 years (Section 28).

5.14 **Licenses**

An owner of the copyright in any existing work or the prospective owner of the copyright in any future work may grant any interest in the copyright by license. A license relating to a future work, however, takes effect only when such work comes into existence (Section 35).

5.15 **Compulsory License**

If at any time during the term of copyright in any Pakistani work which has been published or performed in public, an application is made to the Board of Copyright that the owner of the copyright, (a) has refused to republish or allow the republication of the work or has refused to allow the performance in public of the work and by such refusal the work is withheld from the public; or (b) has refused to allow communication to the public by radio diffusion of such work or, in the case of a record, the work recorded in such record, on terms which the applicant considers reasonable, the Board after giving a reasonable opportunity to the owner of copyright of being heard and holding an enquiry may, if satisfied that such refusal is not in the public interest, grant a license to republish the work, perform the work in public or communicate the work to the public by radio-diffusion, as

the case may be, subject to payment of compensation to the owner of the copyright (Section 36).

5.16 License for Translation

On the application of a citizen of Pakistan or any other person domiciled in Pakistan, the Board may, after holding an enquiry, grant a license to produce and publish a translation of a literary or dramatic work in any Pakistani language. It shall not be an exclusive license and the licensee will have to pay to the owner of the copyright royalties as determined by the Board in respect of the copies of the translation of the work sold to the public. However, such a license is not to be granted, unless (a) a translation of the work has not been published by the owner of the copyright or any person authorized by him within seven years of the first publication, or if so published, it has been out of print; (b) or the owner has refused such authorization to the applicant or the owner cannot be found and the publishers have been sent the request; (c) the Board has satisfied itself after consulting the representative body of authors that the applicant is competent to produce and publish a correct translation of the work and possesses the means to pay the royalties to the owner of the copyright; (d) the author has not withdrawn from circulation the copies of the work; and (e) the opportunity of being heard has been given wherever practicable to the owner of the copyright and the Board is satisfied that the grant of the license is in the public interest (Section 37).

5.17 Registration of Copyright

There is a Register of Copyrights kept at the Copyright Office. The Register contains the names, addresses of authors, publishers and the owners of copyrights and other particulars related to copyrights. The Register is kept in four parts, namely, (I) Literary, Dramatic and Musical Works, (II) Artistic Works, (III) Cinematograph Works and (IV) Records. (Rule 3). Indexes of the Register are also maintained. For each part of the Register the following indexes are kept: (a) a general Author Index; (b) a general Title Index; (c) an Author Index of works in each language; and (d) a Title Index of works in each language.² Every index is arranged alphabetically in the form of cards (Rule 6). The Register and indexes are open to inspection and every person is entitled to take copies of, or make extracts from the Register or index subject to any conditions if prescribed. A fee is chargeable for it (Section 38).

An author or a publisher, or the owner of, or any other person interested in the copyright in any work may apply in a prescribed form, accompanied by the

² English and Urdu.

prescribed fee to the Registrar for entering particulars of a work in the Register of Copyrights. On the receipt of such an application, the Registrar enters the particulars and issues a certificate to this effect. The Registrar may, however, refuse to enter the particulars for certain reasons and in such a case he is required to record the reasons for the refusal (Section 39).

Similarly, a grantee or a licensee of a copyright may also apply to the Registrar for entering the particulars of the grant or the license in the Register of Copyrights. The applicant pays a prescribed fee and shows the original instrument of the grant or license. The Registrar, after holding such enquiry as he deems fit, makes these entries. He may also refuse for reasons to be recorded. Certified copies of such entries are then issued to the applicant (Section 40).

The Registrar has the authority in prescribed cases and subject to the prescribed conditions to amend or alter the Register of Copyrights and the indexes by correcting any error in any name, address or particulars or any other error which may have arisen therein by accidental slip or omission. Similarly, the Copyright Board on application of the Registrar or of any aggrieved person may order the rectification of the Register by making any entry wrongly omitted to be made in the Register, or by expunging any entry wrongly made, or by correcting any error or defect in the Register (Section 41).

The Register of Copyrights and the indexes are *prima facie* evidence of the particulars entered therein. Any documents purporting to be copies of any entry in the Register or extracts therefrom certified by the Registrar and sealed with the seal of the Copyright Office are admissible in evidence in all courts without further proof or production of the original. Similarly, a certificate of registration of copyright in a work is *prima facie* evidence that copyright subsists in the work and the person shown in the certificate as the owner of the copyright is the owner of such copyright (Section 42).

5.18 Copyright Office, Registrar and Copyright Board

The Copyright Office is established under the Ordinance. At present it is located in Karachi. The Copyright Office functions under the immediate control of the Registrar of Copyrights who in turn is under the superintendence and direction of the Federal Government. The Copyright Office has its seal the impression of which is judicially noticed (Section 43).

5.19 Registrar and Deputy Registrar

The Federal Government appoints the Registrar and may also appoint one or more Deputy Registrars of Copyright. The Registrar signs all entries made in the

Register of Copyrights, all certificates of registration and certified copies of the Copyright Board and performs any other functions that may be prescribed under the Ordinance. The Deputy Registrar is assigned functions by the Registrar who performs them under the superintendence and directions of the Registrar (Section 44).

5.20 Copyright Board

There is a Copyright Board. It has a Chairman and between three and five other members appointed by the Federal Government. The Registrar is an *ex-officio* member and acts as Secretary of the Board. The Chairman is a person who is, or has been a judge of a High Court or is qualified for appointment as such judge. The other members are appointed after consultation with representative bodies of authors, publishers, the cinematograph industry and any other interest relating to copyright. Adequate representation on the Board, as far as possible, is given to the residents of each province of the Federation. The Chairman and the other members hold office for a prescribed period (Section 45). The appointment is for not more than three years. The Chairman and other members are, however, eligible for re-appointment (Rule 20).

The Board regulates its own procedure, place and time of sitting. In case of a difference of opinion among the members, matters are decided by majority opinion. But in case of a tie, the opinion of the Chairman prevails. The Board is deemed to be a civil court for the purposes of powers to punish for contempt of court and all proceedings before the Board are deemed to be judicial proceedings for the purposes of punishment for false evidence and also for intentional insult or interruption to a public servant sitting in judicial proceedings. A member having some personal interest in a matter may not take part in the proceedings of that case (Section 46). Appeals against the orders of the Registrar go before the Board (Section 76). The Copyright Board possesses powers of a civil court for the purposes of summoning and enforcing the attendance of any person on oath, requiring the discovery and production of any document, receiving evidence on affidavits, issuing commissions for the examination of witnesses or documents and requisitioning of any public record or copy thereof from any court or office (Section 78).

5.21 Delivery of Books and Newspapers to Public Libraries

The publisher of every book published in Pakistan is required to deliver, at his own expense, one copy of the book to each of the three public libraries within 30 days from the date of its publication. This does not apply to subsequent editions if the book remains the same as first published (Section 47). It may be pointed

out that the Press and Publications Ordinance, 1963, separately applicable in all the provinces of the country also requires by its Section 43 that the printer of every book in Pakistan is to deliver four copies of every book, at his own expense, to the government specified officer. Similarly, the publisher of every newspaper published in Pakistan is required to deliver, at his own expense, one copy of each issue of such newspaper as soon as it is published to each of the three public libraries (Section 48). The penalty for non-compliance with these requirements is punishment of the publisher by a fine of up to 50 rupees and, in case of a book, the equivalent of the value of the book. The fine or a part of it may be paid to the public library which was to receive the publication in question (Section 50). The court can take cognizance of these cases only on the complaint of an officer empowered in this behalf by the Federal Government and no court inferior to that of a magistrate of the First Class can try any offence of non-delivery of a book or newspaper (Section 51). The books or newspapers published under the authority of the Government have no exemption from the delivery to the library provisions, of the Ordinance (Section 52).

5.22 International Copyright

For the purposes of recognizing copyright in respect of works belonging to certain international organizations, the Federal Government declares by notification in the Official Gazette specifying such organizations of which one or more sovereign powers or the government thereof are members. Where any work is made or first published by or under the direction or control of any such organization as declared in the notification, and where there would, apart from the Government notification under these provisions, be no copyright in the work in Pakistan at the time of its making or its first publication and where either the work is published as aforesaid in pursuance of an agreement in that behalf with the author, being an agreement which does not reserve to the author the copyright in the work or any copyright in the work from the beginning belongs to the organization, there shall subsist copyright in the work throughout Pakistan (Section 53). However, there shall be no copyright as respects its reprint, translation, adaptation or publication, by or under the authority of the Federal Government, as a textbook for the purposes of teaching, study or research in educational institutions (Copyright "Amendment" Act II of 1973).

5.23 Copyright to Foreign Works

The Federal Government may, by order published in the Official Gazette, direct that all or any of the provisions of the Copyright Ordinance shall apply: (a) to works first published in a foreign country to which the order relates in like

manner as if they were first published within Pakistan; (b) to unpublished works, the authors whereof were, at the time of making the work, subjects or citizens of a foreign country to which the order relates, in like manner as if the authors were citizens of Pakistan; (c) in respect of domicile in a foreign country to which the order relates in the like manner as if such domicile were in Pakistan; (d) to any work of which the author was, at the date of the first publication thereof, or in a case where the author was dead at that date, was at the time of his death, a subject or citizen of a foreign country to which the order relates in like manner as if the author was a citizen of Pakistan at the date or time, and thereupon subject to the order, the Copyright Ordinance shall apply accordingly. However, the following are the provisions to its application: (i) that before making an order in respect of any foreign country (other than a country with which Pakistan has entered into a treaty or which is a party to a convention relating to copyright to which Pakistan is also a party), the Federal Government should be satisfied that the foreign country has made or has undertaken to make provisions for the protection in that country of works entitled to copyright under the provisions of the Ordinance (that is, Pakistan law); (ii) that the order may provide for the provisions of the Ordinance to apply generally or specifically; (iii) that the order may provide that the term of copyright in Pakistan shall not exceed that conferred by the law of the foreign country to which the order relates; (iv) the order may exempt the delivery of copies of books to the public libraries; (v) in applying the provisions of the Ordinance as to ownership of copyright, the order may make such modification as appears necessary having regard to the law of the foreign country; (vi) the order may provide that this Ordinance or any part thereof shall not apply to works made, or first published, before the commencement of the order. The provisions discussed above with regard to international copyright are under Sections 53 and 54 of the Ordinance. As indicated at the beginning of this paragraph, Section 54 empowers the Federal Government to make an order for this purpose and, in pursuance of this authorization, the Federal Government has made an order.

5.24 The International Copyright Order, 1968

It was published in the Official Gazette on March 13, 1968. It provides that all the provisions of the Copyright Ordinance, 1962, except, those relating to the rights of broadcasting organizations and those which apply exclusively to Pakistan works, shall apply:

- (a) to any work first published in a country mentioned in the schedule to this order, in like manner as if it was first published within Pakistan;
- (b) to any work first published in a country other than a country mentioned in the schedule, the author of which was at the date of such publication,

or where the author was dead at that date, was at the time of his death, a subject or citizen of a country party to the Universal Copyright Convention in like manner as if the author was a citizen of Pakistan at that date or time;

- (c) to an unpublished work, the author whereof was at the time of the making of the work, a subject or citizen of, or domiciled in, any country mentioned in the schedule in like manner as if the author was a citizen of, or domiciled in, Pakistan; and
- (d) in relation to a body incorporated under any law of a country mentioned in the schedule, in like manner as if it was incorporated under a law in force in Pakistan.

However, the term of copyright for a work is not to exceed that enjoyed by it in its country of origin; and the Ordinance or any part thereof is not to apply to a work published before the commencement of this order in a country party to the Universal Copyright Convention or a country of the Berne Union.

On December 15, 1972, the International Copyright Order, 1968, was amended by the Federal Government so as to accommodate the amendment made in the Ordinance in respect of the printing of books for educational institutions. Thus the amendment in the International Copyright Order also did not allow copyright to any foreign publication as respects its reprint, translation, adaptation or publication by or under the authority of the Federal Government, as a textbook for the purpose of teaching, study or research in educational institutions.

The term "country of origin" used in the order has been explained in detail. It means:

- (a) in the case of a work first published in a country of the Berne Union or a country party to the Universal Copyright Convention, that country;
- (b) in the case of a work published simultaneously in a country of the Berne Union and a country which is not so, the former country;
- (c) in the case of a work which is published simultaneously in a country party to the Universal Copyright Convention and a country which is neither a country of the Berne Union nor a country party to the Universal Copyright Convention, the former country;
- (d) in the case of a work which is published simultaneously in several countries of the Berne Union, the country whose laws give the shortest term of copyright in such a work;

- (e) in the case of a work which is published simultaneously in several countries parties to the Universal Copyright Convention, the country whose laws give the shortest term of copyright in such a work; and
- (f) in the case of an unpublished work or a work first published in a country other than a country of the Berne Union or a country party to the Universal Copyright Convention, the country of which the author was a subject or citizen or the country in which he was domiciled at the time of making the work or a substantial part of it or, as the case may be, at the time of its first publication, whichever gives the longer term of copyright.

5.25 Infringement

Copyright in a work is infringed: (a) when any person without the consent of the owner of the copyright or without a license from such an owner or the Registrar, or in contravention of the conditions of a license so granted or of any conditions imposed by a competent authority, (i) does anything the exclusive right to do which is conferred upon the owner of the copyright; or (ii) permits for profit any place to be used for the performance or the work in public where such performance constitutes an infringement of the copyright in the work unless he was not aware, and had no reasonable ground for suspecting, that such performance would be an infringement of copyright; or (b) when any person, (i) makes for sale or hire, or sells or lets for hire, or by way of trade displays or offers for sale or hire, or (ii) distributes either for the purpose of trade to such an extent as to affect prejudicially the owner of the copyright, or (iii) by way of trade exhibits in public, or (iv) imports into Pakistan any infringing copies of the work. "Infringing copy" includes, the reproduction of a literary, dramatic, musical or artistic work in the form of a cinematographic work (Section 56). Importation into the country of infringing copies is prohibited (Section 58) and, if found, can be detained and confiscated (Section 58 and Sections 19 and 19A, Sea Customs Act, 1978).

5.26 Non-infringement

Some of the acts which do not constitute an infringement of copyright include: (a) fair dealing with a literary, dramatic, musical or artistic work for the purpose of research or private study, criticism or review of that work or any other work; (b) fair dealing for the purpose of reporting current events in a newspaper, magazine or periodical, or by radio diffusion, or in a cinematographic work or by means of photographs; (c) the reproduction for the purpose of judicial proceedings or reports thereof; (d) the publication in a newspaper of a report of an address of a political nature delivered at a public meeting unless expressly prohibited by

conspicuous notices; (e) the reproduction in the certified copy in accordance with the law; (f) the reading or recitation in public of any reasonable extract from a published literary or dramatic work; (g) the publication in a collection, mainly composed of non-copyright matter, *bona fide* intended for the use of educational institutions and so described in the title and in any advertisement issued by or on behalf of the publisher of short passages from published literary or dramatic works not themselves published for the use of educational institutions, in which copyright subsists; (h) the reproduction or adaptation of a work in the course and for the sole purpose of instruction whether at an educational institution or elsewhere where the reproduction or adaptation is made by a teacher or a pupil otherwise than by the use of a printing press, or if the reproduction is as a part of the questions to be answered in an examination or in answers to such questions; (i) the performance, in the course of activities of an educational institution, of a literary, dramatic or musical work by the staff and students of the institution, or of a cinematographic work or a record, if the audience is limited to such staff and students, the parents and guardians of the students and persons directly connected with the activities of the institutions; (j) the making of records, if records recording the work have previously been made by or with the license or consent of the owner of the copyright in the work and the person making the records has notified his intention to do so and has paid the royalties to the owner of the copyright; (k) the playing of the record to be heard in public at any premises where people reside as part of the amenities provided exclusively or mainly for residents therein or as part of the activities of a club, society or other organization which is not conducted or established for profit; (l) the performance by an amateur club or society to a non-paying audience or for the benefit of a religious, charitable or educational institution; (m) reproduction in a newspaper, magazine or other periodical of an article on current economic, political, social or religious topics unless the owner of copyright has expressly reserved the right of reproduction; (n) the publication of a report of a public lecture; (o) the making of not more than three copies of a book by or under the direction of a person in charge of a public library or a non-profit library available for use by the public free of charge or a library attached to an educational institution for the use of such library if the book is not available for sale; (p) the reproduction for the purpose of research or private study or with a view to publication of an unpublished work kept in a library or museum to which the public has access but, if the identity of the author is known, it can be reproduced only 50 years after his death; (q) the reproduction and publication of matters already published by the Government in any Official Gazette, unless it is prohibited by the Government and, similarly, judgments of courts unless prohibited by the court; (r) the making or publishing of a painting, drawing, engraving or photograph of an architectural work of art, or of a sculpture if situated in a public place; (s) inclusion in a cinematographic work of any artistic work permanently

situated in a public place or any other artistic work if it is only incidental to the principal matter represented in the work; (t) the use by the author of an artistic work of any mould, cast, sketch, plan, model or study made by him for the purpose of the work; (u) the making of an object of any description in three dimensions of an artistic work in two dimensions, if the object would not appear, to persons who are not experts in relation to objects of that description, to be a reproduction of the artistic work; (v) the reconstruction of a building or structure in accordance with the architectural drawings or plans by reference to which the building or structure was originally constructed, provided that the original construction had been made with the consent of the owner of the copyright in such drawings or plans; and (w) the reproduction of any work after the expiration of the term of copyright therein (Section 57).

5.27 Remedies for Infringement of Copyright

Infringement of copyright is a wrong of civil nature as well as an offence under the law in Pakistan. Therefore, civil remedies and also penal responsibility are provided.

5.27.1 Civil Remedies

Where copyright in any work has been infringed, the owner of the copyright is entitled to all such remedies by way of injunction, damages, accounts and otherwise as are or may be conferred by law for the infringement of a right. However, if in the infringement he was not aware that copyright subsisted in the work and he had reasonable ground for believing that copyright did not subsist, the plaintiff shall only be entitled to an injunction in respect of the infringement and a decree for the whole or part of the profits made by the defendant by the sale of the infringing copies as the court may determine to be reasonable in the circumstances. Costs in the proceedings are in the discretion of the court (Section 60).

5.27.2 Protection of Separate Rights

Where several rights comprising the copyright in any work are owned by different persons, the owner of any such right is, to the extent of that right, entitled to the remedies provided by the Ordinance and may individually enforce such right by means of any suit, action or other proceeding without making the owner of any other right a party to such suit or proceeding (Section 61).

5.27.3 Author's Special Rights

Despite the fact that the author of a work may have assigned or relinquished the copyright in the work, the law gives him the right to restrain, or claim damages

in respect of any distortion, mutilation or other modification of the said work, or any other action in relation to the said work which may be prejudicial to his honour or reputation. This right of the author can also be exercised by his legal representatives (Section 62).

5.27.4 Rights of Owners Against Persons Possessing or Dealing with Infringing Copies

All infringing copies of any work in which copyright subsists, and all plates used or intended to be used for the reproduction of such infringing copies, are deemed to be the property of the owner of the copyright, who accordingly may take proceedings for the recovery or possession thereof or in respect of the conversion thereof. However, remedy in respect of the conversion of any infringing copies is not available if the defendant proves: (a) that he was not aware of the copyright or had reasonable ground for believing that copyright did not subsist in the work of which such copies are alleged to be infringing copies; or (b) that he has reasonable ground for believing that such copies or plates do not involve infringement of the copyright in any work (Section 63).

5.27.5 Architecture and Restriction on Remedies

Where the construction of a building or other structure which infringes or, if completed, would infringe the copyright in some other work has been commenced, the owner of the copyright is not entitled to obtain an injunction to restrain the construction of such building or structure or to order its demolition (Section 64). It does not mean that other remedies such as damages are not available to him.

5.28 Jurisdiction in Suits

All civil proceedings with regard to infringement of copyright are instituted and tried in the court of the District Judge. (This is the principal court of original jurisdiction.) However, where the parties to a suit mutually agree to refer the dispute to the Copyright Board, the jurisdiction of all other courts is excluded. The decision of the Board, subject to appeal, becomes final (Section 65). Any person who knowingly infringes or abets the infringement of the copyright in a work or any other right conferred by the Copyright Ordinance, commits an offence, and is punishable with a fine up to 5,000 rupees or with imprisonment up to two years or with both. However, the construction of a building or other structure which infringes or which, if completed, would infringe the copyright in some other work, is not an offence under this provision (Section 66).

5.29 Possession of Plates for Making Infringing Copies

Similarly, if any person knowingly makes or has in his possession any plate for making infringing copies of any work in which copyright subsists, or knowingly and for his private profit causes any such work to be performed in public without the consent of the owner of the copyright, he is punishable with a fine or imprisonment up to two years or with both (Section 67).

5.30 Penalty for False Entries or False Evidence

Any person who (a) makes or causes to be made a false entry in the Register of Copyrights, or (b) makes or causes to be made a writing falsely purporting to be a copy of any entry in the Register, or (c) produces or tends or causes to be produced or tendered as evidence any such entry or writing, knowing the same to be false, is liable to a fine or imprisonment up to two years or both (Section 68). Similarly, making false statements for deceiving or inducing or influencing any authority or officer in the performance of his duties under the Copyright Ordinance shall be punishable by a fine or two years imprisonment or both (Section 69).

5.31 False Attribution of Authorship

Inserting or affixing the name of any person on a work of which he is not the author, in such a way as to imply that he is the author of that work, is punishable with a fine or imprisonment up to two years or both. Similarly, the publishing, selling, letting for hire or exhibiting in public, distribution, reproduction or broadcasting by any body with the knowledge that the work is implied to be that of a person who is not the author of the work, also carries the same penalty of a fine and imprisonment (Section 70).

5.32 Offences by Companies

Where any of the offences indicated above has been committed by a company, which includes partnership or association, every person who at the time the offence was committed was in charge of and was responsible to the company for the conduct of its business, both he and the company shall be deemed guilty of the offence. However, if such a person proves that the offence was committed without his knowledge or that he had exercised due diligence to prevent it, he will not be liable to punishment. Furthermore, where such an offence is committed with the consent or connivance of or is attributable to the negligence on the part of

any director, manager, secretary or other officer, he shall be guilty of the offence and punishable accordingly (Section 71).

5.33 Fate of Infringing Copies

Irrespective of whether the alleged offender has been convicted or not, the court may order that all copies of the work or all plates in the possession of the alleged offender, which appear to the court to be infringing copies, be destroyed or be delivered to the owner of the copyright or otherwise dealt with as the court may think fit (Section 73). No court below that of a magistrate of the First Class can try any offence under the Copyright Law (Section 72).

5.34 Powers of Police to Seize Infringing Copies

Where a court has taken cognizance of any offence in respect of the infringement of copyright in any work, a police officer not below a sub-inspector, with a warrant from the court, may seize all copies of the work which appear to him to be infringing copies and produce them before the court as soon as practicable. However, no such copy as is owned by a public library, or a library attached to an educational institution or a non-profit library available for use to the public free of charge or is in the possession of any person for his *bona fide* use, can be seized. Any person may, within 15 days of such seizure, claim these copies by applying to the court. The court, after hearing the parties and inquiring into the matter, may make any order with respect to the seized copies (Section 74).

5.35 Powers of Civil Court Conferred on Registrar and Board

The Registrar of Copyrights and the Copyright Board, when dealing with copyright cases, have the powers of a civil court in respect of: (a) summoning and enforcing the attendance of any person and examining him on oath. The local limits of the jurisdiction of the Registrar or the Board, as the case may be, extend throughout Pakistan; (b) requiring the discovery and production of any document; (c) receiving evidence on affidavits; (d) issuing commissions for the examination of witnesses or documents; (e) requisitioning any public record or a copy thereof from any court or office; and (f) any other matter or procedure that may be prescribed (Section 78).

5.36 Appeals Against Orders

Appeals from the orders of the Registrar lie to the Copyright Board and from the Board to the High Court, in both cases within three months (Section 76 and

77). Appeals from the orders of a magistrate lie to the next higher court, normally, the District Judge, within 30 days (Section 75).

5.37 Order of Registrar or Board

The order for payment of money made by the Registrar or the Copyright Board is executable like a decree of a civil court (Section 79). No suit or any legal proceedings lie against any person in respect of anything done in good faith or is intended to be so done under the Copyright Ordinance (Section 80). The Federal Government has been authorized to make rules for carrying out the purposes of the Copyright Ordinance (Section 82).

Thus, the rules were framed in 1987. The important ones have been referred to in the discussion on the copyright law in this Chapter. Fixing of the fees payable under the Copyright Ordinance also falls in the rule-making power of the Government.

5.38 Printing and publishing of Foreign Books

There are two significant pieces of legislation in respect of foreign works in the area of intellectual property. One is the West Pakistan Ordinance No. XV of 1969 and the other is the Copyright (Amendment) Act, 1973. The first Ordinance, after the dissolution of one unit of West Pakistan into four provinces of the Punjab, the North West Frontier Province, Baluchistan and Sindh, is equally applicable in all the four provinces. The purpose of this Ordinance is to check the piracy of foreign books by publishers in Pakistan and not to let this illegal trade go on with impunity. However, with the permission of the Government or such officer as may be specially empowered in this behalf by the Government, printing or publishing of any book which was first printed or published in any foreign country may be allowed (Section 3). The Government may by notification exempt any book from the provisions of this Ordinance (Section 6). That means, permission cannot be requested for the printing or publishing of such exempted books. If somebody prints or publishes a foreign book without such permission from the Government, the penalty is severe: up to two years imprisonment, or a fine or both (Section 7). The offence is made cognizable and non-bailable (Section 9).

The second legislation in this respect, that is, Act II of 1973, has amended the Copyright Ordinance, 1962, so as not to recognize the subsistence in Pakistan of copyrights in any foreign work if such a work is reprinted, translated, adapted or published by or under the authority of the Federal Government as a textbook for the purpose of teaching, study or research in educational institutions. These amended provisions apply to any work published abroad whether by an individual author or by an international organization (Copyright (Amendment) Act, 1973).

By virtue of these provisions, many books of foreign authors, published abroad, have been reprinted in Pakistan with the permission of the Federal Government.

The background to the making of the 1969 Ordinance and the Amendment Act of 1973 was that certain textbooks prescribed for schools and colleges in Pakistan that had been printed and published in foreign countries were very expensive by Pakistani standards and virtually beyond the means of an average student in Pakistan. Thus, these provisions of law allow controlled printing and publishing of such works with the strict permission of the Federal Government for educational purposes only.

One more piece of legislation perhaps relevant to intellectual property is the Publication of Textbooks (Regulation and Control) Ordinance, 1970 (West Pakistan Ordinance No. XXVII of 1970). This Ordinance, after the dissolution of the one unit of West Pakistan into four provinces, is applicable in all the four provinces of the country. The purpose of this Ordinance is to regulate and control the printing, publication and sale of textbooks. Each Provincial Government has set up a Textbook Board. No person is allowed, except with the permission of the Board, or such officer as may be specially empowered in this behalf by the Board, to print, publish or sell any textbook which is or has been printed, published or sold by or under the authority or with the permission of the Board. An application, however, for such permission may be made to the Board in the prescribed form and on the payment of a prescribed fee (Section 3). However, the Government may, on the recommendation of the Board, by a notification in the Official Gazette, exempt any textbook from all or any of the provisions of this Ordinance (Section 8). Violation of the above provision is an offence punishable with one year's imprisonment or with fine or both (Section 4). If a person has been convicted for this offence, all copies of the textbooks in respect of which the offence had been committed shall stand forfeited to the Board (Section 5). Cognizance of the offence can be taken only on a report in writing made by an officer authorized for the purpose by the Board. The offence is cognizable and non-bailable and no court inferior to that of a magistrate of the First Class can try the offence (Section 6).

CHAPTER 6

INTELLECTUAL PROPERTY DECISIONS OF SUPERIOR COURTS AND REGISTRAR OF TRADE MARKS

SYNOPSIS

- 6.1 Introduction
- 6.2 Copyright Cases (Supreme Court and the High Courts)
- 6.3 Cases on Patents and Designs (Supreme Court and the High Courts)
- 6.4 Cases on Trade Marks (Supreme Court and the High Courts)
- 6.5 Specimen Cases Decided by the Registrar of Trade Marks

6.1 Introduction

Although the statutes discussed earlier provide full protection to intellectual property if an aggrieved party were to resort to a legal remedy, but it has been noticed that the tradition for the protection of these rights has not developed as much in Pakistan as in some other countries which are more advanced in technology and industry. Perhaps the awareness of the value of these rights develop alongside industrial development. The factual position is that the amount of litigation in the areas of copyright and patents and designs is very small indeed. For instance, during a period of 42 years, that is, from 1947, when Pakistan became an independent State, up to July 1989, only a very limited number of cases on copyright and patents and designs came up for adjudication before the superior courts of the country. The present author was able to trace only about 12 cases concerning copyrights and less than 30 cases on patents and designs laying down some legal questions which have been decided by the superior courts during the last 42 years of the country's existence and have been reported in the law reports.

One may perhaps remark that the tradition of protecting inventions and copyrights is not as deep-rooted in this country as in the industrialized world where inventors and authors seem to be more conscious of their rights. Certainly, these rights are more valuable in economic terms in those countries, whereas in Pakistan, the authors of books, works of art, music and other such material perhaps do not get as high returns from their publications as elsewhere in the advanced countries. Therefore, less attention is paid to the protection of these rights. Another factor is the plain-paper photocopiers of this age. Their unrestricted use has made it extremely difficult to protect and preserve the copyrights of the authors of books. One has only to see it to believe it. In the countries of the sub-continent including Pakistan, photocopiers are installed in their hundreds just on pavements on the roadside by private petty entrepreneurs.

When a copyright is infringed, the aggrieved party is very reluctant to go to court due to the high cost of litigation, waste of time and perhaps with the net result of spending more on a law suit than the expected gain from the protection of the copyright. This is even more true to a foreign copyright holder. To litigate in another country in the case of infringement of his rights will be very expensive and time consuming. He may not even be able to pinpoint or name the infringer and yet the infringing copies may be everywhere. No doubt the provisions of the law provide full protection for these rights but the outcome of a litigation cannot be certain and the net material gain may not be sufficient to justify the efforts undertaken by the aggrieved party.

The position of trade marks in this respect is, however, much better. This is indicated by the litigation in this respect. Perhaps, the business and trading

community is more conscious and aware of their rights as compared to the authors and inventors. As such, a fairly large number of cases on trade marks have come up for adjudication before the superior courts. A summary of important reported cases which decided some legal question is given herein for the interest of the readers. Similarly, brief notes on specimen cases before the Registrar of Trade Marks to demonstrate the criteria that prevailed with the Registrar for allowing the registration of a trade mark or refusing the same are also appended.

6.2 Copyright Cases (Supreme Court and the High Courts)

1. *Mahmud Shaukat v. Abdul Ghafur, PLD 1952, Lah. 364*: In respect of works existing at the time of passing of the Copyright Act, 1914, the law was contained in S. 24 of the Imperial Copyright Act which provided that if any person was, immediately before the commencement of the Act, entitled to copyright under the old Act, he would from the date of the present Act be entitled to copyright as defined by the new Act and to no other right or interest and that this right would subsist for the term for which it would have subsisted if the new Act had been in force at the date when the book was published. But if the author had, before the commencement of the Act, assigned the right for the whole term of the right, then, "at the date when, but for the passing of this Act, the right would have expired, the substituted right conferred by this section shall, in the absence of express agreement, pass to the author of the work, and any interest therein created before the commencement of this Act and then subsisting shall determine." Where, therefore, the plaintiff's assignees had a total right of publication, their right expired in 1914 and the copyright then passed to the author or his heirs.

2. *East Pakistan School Text Book Board v. Debabrata Chaki, PLD 1968, Dacca 455*: Where an infringing book contained more material than that which was taken from the infringed book, the assessment of damages on the basis of royalties recoverable by the copyright owner in the usual course is difficult. Furthermore, if the copyright owner allowed notes and solutions to be published unrestrained by persons proceeded against and others, and the book complained of being a note-book for school students, which though not desirable yet a necessary evil, the court only awarded token damages against the author and the publishers. An injunction prohibiting further printing and publication, however, was issued against all.

Where proceedings for infringement of copyright are initiated in respect of subsequent editions but not in respect of earlier editions, mere toleration of infringement of earlier editions does not amount to waiver of right.

Where the copyright has been infringed by several persons, but the owner has proceeded only against one of them, it was held that he has the right to pursue a civil remedy against anyone he likes.

3. *Abbas Husain Farooqi v. Royal Printing Press, PLD 1970, Kar. 554*: Originality is a criteria for acquiring copyright. Even a reprint of a selected passage from a non-copyright work may be an "original literary work." All compilations are capable of having copyright on them and there is no reason as to why a diary should not be considered as original. Though the amount of "originality" may not be much, even that small amount is protected by law. The quality of being "original" has nothing to do with the literary or artistic merit of the work. Even a piece of bad writing will be protected by the law as long as it is original. Copyright is given to the first producer of a work irrespective of the fact that the work is wise or foolish, accurate or inaccurate or of literary merit or of no merit at all.

4. *Sibtain Fazli v. Star Film Distributors, PLD 1964 S.C. 337*: Equity, justice and good conscience is not the foundation for copyright. It has to have origin in a law. For instance, the Copyright Act, 1914, was the law in British India but on Independence in 1947, India and Pakistan became two independent countries though the same Act remained the law in each country separately, but the copyright in one could not be protected automatically in the other.

5. *Re: Islamization of Laws, PLD 1985, F.S.C. 221*: A copyright has been held a right in property according to Islamic law and therefore accorded protection as such by the Federal Shariat Court.

Note: Federal Shariat Court was set up in Pakistan by an amendment of the Constitution in 1979. Its functions include the scrutiny of existing laws in Pakistan and examining the proposed laws to judge whether any of them is in violation of the injunctions of Islam and to advise the Government accordingly. In a period of about eight years, the court has scrutinized almost all the existing laws in the country. The constitutional status of the court is equivalent to that of a High Court. Appeals from its decisions go to the Supreme Court.

6.3 Cases on Patents and Designs (Supreme Court and the High Courts)

1. *Minerals Separation North American Corporation v. Noranda Mines Ltd., PLD 1952, P.C. 53*: Ambiguous Specifications: Where patentees' specifications are ambiguous, the patent is invalid. It is the duty of a patentee to state clearly and distinctly, either in direct words or by clear and distinct reference, the nature and limits of what he claims. If he uses language which, when fairly read, is avoidably obscure or ambiguous, the patent is invalid whether the defect is due to

design, or carelessness or to want of skill. Where the invention is difficult to explain, due allowance will, of course, be made for any resulting difficulty in the language. But nothing can excuse the use of ambiguous language when simple language can easily be employed, and the only safe way is for the patentee to do his best to be clear and intelligible.

2. *Silver Cotton Textile Mills Ltd. v. Bawany Violin Textile Mills Ltd.*, PLD 1963, Kar. 79: Where a suit is filed against the infringement of a design and a temporary injunction is requested during the pendency of the suit, the mere fact of its only recent registration or doubts about its validity are not enough to refuse the request. The common law rule that defence of invalidity of registration can be raised without applying for cancellation or rectification was held not applicable in Pakistan.

3. *Khurshid Industrial Corporation v. Habib Metal Industries*, 1969, D.L.C. 521: In a suit for damages and injunction, although the Act says nothing as to any kind of a declaration, it is, however, impossible to conceive of remedies by way of damages or injunction without first determining the question whether the plaintiff is actually the registered proprietor of the design, which is the subject matter of the suit. The necessity of determination and therefore declaration as to the registered proprietorship is inherent in the remedies allowable by the Act.

4. *Mont Blanc Industry v. Abdul Aziz*, 1980 CLC 396: A question of revocation of a patent in respect of a perforating press came up before the court on the ground that the grantee of the patent was not the "true and first inventor." It was found that since the process of manufacture of the machine in dispute is widely known and many advanced foreign machines are found to have been in the field for a long time, therefore, such a machine was not an invention nor can the grantee of the patent be called the true and first inventor. Hence the patent was revoked. However, if the process or the manner of production in which the inventive genius exercised was different from the process used in other similar machines, it would be an invention.

5. *Gulam Hussain Rajwany v. Paramount Glass Industries*, 1982 CLC 2476: The plaintiff was a registered proprietor of letters patent in respect of a machine invented by him. The defendant made an imitation of such machine and was producing similar goods. The plaintiff filed a suit and the defendant was served with the notice to which he never replied. The patentee's evidence therefore remained unchallenged. It was held that the defendant infringed and continued to infringe the patentee's registered letters patent by using an invention without the patentee's consent or license.

6. *Sandoz Ltd. v. Pakistan Pharmaceutical Products Limited*, 1987, CLC 157: The defendant had infringed the patent of a drug. The plaintiff made an

application for restraining the defendant from manufacturing, importing, marketing, selling or offering for sale, the product which infringed the plaintiff's patent. The expert opinion was that by reading the description on the defendant's packet an impression was created that the base of the defendant's drug was similar to the drug which is associated with the name of the plaintiff as their exclusive product and which had earned a worldwide reputation. The plaintiff's case was a strong case and the defendant had not given any plausible explanation for using the plaintiff's patent name. In such a case, the court held that the mischief should be suppressed as early as possible and the piracy causing financial losses to the plaintiff and a health hazard to the public at large which remained unexplained should not be allowed to continue. A mere registration of the drug with the Ministry of Health under the Drugs Act 1976 could not immunize the defendant against the claims of the aggrieved party under the Patents and Designs Act, 1911. The defendants were thus restrained from importing, marketing or publicizing any product under the name of the plaintiff or reproducing the chemical or structural formulae or the said drug on any of their products in any form.

7. *Nouruddin Hussain v. Diamond Vacuum Bottle Manufacturing Co. Ltd., PLD 1981, Kar. 720*: Where the plaintiffs were able to make out a *prima facie* case establishing commission of breach of contract by the defendants, an injunction was issued restraining them, their contractors and their employees from using the machine concerned for infringing the plaintiff's patent.

8. *Karachi Textile Works v. Multan Handloom Factory, PLD 1955, Sind 351*: Where the registration of a design was not challenged when advertised, it can still be challenged by plea in answer to a suit on the basis of infringement.

6.4 Cases on Trade Marks (Supreme Court and the High Courts)

1. *S. Muhammad Din and Sons v. Sh. Nabi Bakhsh and Sons, 1987, C.L.C. 759*: The plaintiffs were the owners of a registered design, shape and trade mark of "National Fans," manufactured by them. The defendant imitated their design and shape after being conscious of the popularity of the product of that name in the market and they manufactured their product under the name "Pak National Fans." The plaintiffs applied for an injunction, which was granted. The court found that the trade mark used by the defendant was similar to the plaintiff's trade mark that an ordinary customer asking for a "National" fan was likely to be supplied with a fan manufactured by the defendant and in fact there was documentary proof to this fact. The plaintiff was, therefore, clearly entitled to an injunction against the defendant.

2. *Rexona Proprietary Ltd. v. Majid Soap Works, PLD 1956, Sind 1*: In a case of infringement of a trade mark, the question of resemblances and differences

must be decided by contrasting the striking resemblances with striking differences, and where the conclusion is that one is intended to pass for the other, there is a case for a interim injunction. Where infringement is a fraud on the public, an interim injunction would be granted in spite of a certain amount of delay.

3. *Anwar v. Golden Pen Manufacturing Company, PLD 1955, Sind 345*: The prior user of a trade mark was given preference over the owner of a registered trade mark of a later date. The plaintiff's suit was based on the fact that he was the sole agent of a certain firm which manufactures Raja Nibs and that he had been dealing with the same since 1921. The defendant was the owner of a registered trade mark in respect of Raja Fountain Pens, since 1953. The plaintiff had challenged the defendant's registration before the Registrar and had applied for registration in his own favour of Raja Nibs. It was held that the plaintiff had a *prima facie* case for an injunction against the defendant and it was granted accordingly.

4. *Aluminium Products Ltd. v. Registrar, PLD 1958, Dacca 481*: In deciding whether a particular trade mark is likely to deceive or cause confusion, it is not necessary to see if both the trade marks are absolutely identical. The question of resemblance and the likelihood of deception are to be considered by reference not only to the whole mark, but also to its distinguishing or essential features if any. The court has to consider (a) what are the essential and distinguishing features of the trade marks and (b) whether they are used on the same description of goods. Where the marks are plainly calculated to lead to confusion and deception and the similarities are so close as to make it impossible to suppose that such marks were devised independently of each other, the Registrar would be justified in refusing to register a trade mark.

5. *Insaf Soap Factory v. Lever Brothers, PLD 1959, Lah. 381*: In case of infringement of trade marks, the test is whether the unwary purchaser is likely to be deceived into purchasing the goods of the person infringing the trade mark as the goods of the owner of the trade mark.

6. *Bengal Oil Mills Ltd. v. Deputy Registrar, PLD 1963, Kar. 920*: The test for deception for the purposes of trade marks is not what the thinking person would take it to be but how the mind of the common consumer is affected by an impugned mark.

7. *A & F Pears Ltd. v. Ghulam Haider, PLD 1959, Kar. 154*: The mark "Pears" on toilet soap was held to be infringed by the mark "Paras" on laundry soap. The court "remarked that even innocent use of another's trade mark is objectionable.

8. *Abdul Gani v. Registrar, PLD 1961, Kar. 158*: Where rights have been acquired by the owner of a trade mark by long use, of its trading style, conditions

curtailing such rights cannot be imposed. There is a distinction between a "trade name" and "trade mark." A trade mark is used on goods and identifies the origin of the goods, whereas a trade name identifies the business. A trade name need not have a bodily existence, unless it is written on something, and may exist abstractly, but a trade mark must always have a body because it is always a mark on something. The former has primarily a phonetical existence and the latter has primarily a visual existence.

9. *N.V. Phillips v. Electric Lamp Manufacturers Ltd. PLD 1962, Kar. 690:* A manufacture *simpliciter* does not affect the right to the trade mark under which the manufactured goods are sold. A person may order a manufacturer to manufacture goods according to his order and direction and upon the goods being so manufactured, if the person who ordered the goods, sells them under his own trade mark which he has acquired either by long user or by registration, the manufacturer does not acquire any right in the trade mark.

10. *New Light Chemical Industries Ltd. v. Registrar PLD 1963, Dacca 75:* Where the law imposes a restriction on registration of identical or similar trade marks, the evidence of user is entirely irrelevant. The only test that has to be applied is the test of identity or resemblance. Even if the applicant could establish a long user, if the respondent could establish no user at all, and if there was resemblance between the marks of the applicant and the respondent, and if there was likelihood of deception, and if the respondent was first in the field and had his trade mark registered, the applicant's trade mark could not be registered.

11. *Crescent Pak. Soap and Oil Mills v. Deputy Registrar, PLD 1965 S.C. 292:* The Registrar is authorized to impose a limitation as to the area of use of the trade mark. Such limitation can be imposed at the time of granting the registration or afterwards. Similarly, it is equally possible for a person to apply for the registration of a trade mark to be effective within a limited area if he is not interested in the trade in any other area.

12. *S.M. Taufiq v. National Biscuit Co., New York, PLD 1962, Kar. 355:* Proprietary right in a trade mark cannot be asserted on the basis of user unless one can establish such right by a sufficiently long user. *PLD 1965, S.C. 292:* Furthermore, user of trade mark only "in Pakistan" is ordinarily to be considered for this purpose. A having user of trade mark in Pakistan since 1951 and B having no market in Pakistan, though enjoying an international user, was not given any preference over A. A was held entitled to registration in preference to B.

13. *New Light Chemical Industries v. Registrar, PLD 1963, Dacca 75:* While considering an application for the registration of a trade mark which is identical or similar to another one, the main duty of the court is towards the public and maintenance of purity of the Register. When a case is sought to be made out

that a particular trade mark is likely to deceive and create confusion, the contest is not so much between the parties to the legislation as it is a contest between a party defending his right to a particular trade mark and the public. If the Registrar has exercised his discretion properly in this regard, the High Court would not interfere with his order.

14. *Société de fabrication et de distribution v. Deputy Registrar, PLD 1979, Kar. 83*: Strictly speaking, there can be no property in a trade mark which has never been used in Pakistan, nor which is on the Register. The expression "claiming to be proprietor" only means that the applicant claims to be entitled to be registered as the proprietor. Nevertheless, the claim must be made in good faith and the applicant must be able to justify it if his claim is challenged. If the applicant knew or the circumstances showed that he was aware that another person is the proprietor of the mark, his claim to proprietorship would be false and his assertion in the application would be regarded as a deliberate attempt on his part to deceive the Registrar, and if he succeeds in obtaining a registration, it would be liable to be expunged on the ground of fraud.

15. *Re: Trade Marks Act, 1940, CLC 660; PLJ 1980, Kar. 403: Registration*: For the registration of a trade mark, it is the applicant who has to satisfy the Registrar that the word qualified for registration has no reference to the character or quality of the goods. The trade mark has to be distinctive. Where the applicant fails to discharge this burden of proof and merely produces an Australian certificate of registration, the Registrar is not bound to follow registration granted in foreign countries, even where trade mark law may be similar. Such foreign registration though may have persuasive value before the Registrar, but it will depend on the circumstances of each case.

16. *Bashir Ahmad v. Registered Firm Hafiz Habibur Rehman, 1980, CLC 1268: Infringement*: In determining the question of infringement of a trade mark it has to be seen whether the public at large and not an intelligent section of the public would be confused and misled. Whether the wrapper is calculated to induce a buyer to purchase the products packed therein, as the one manufactured by the respondent, the common purchaser not being conversant with the distinction in the two products, should serve as a criterion. The person who is already aware will not be deceived.

17. *Syed Muhammad Maqsood v. Naeem Ali Muhammad, 1985, CLC 3015*: Where calligraphy, complexion, the get up and colour scheme of cartons of disputed trade marks is found likely to deceive the mind of an unwary purchaser and where such products are manufactured without a registered trade mark as compared to those with a registered trade mark, the court granted an injunction restraining the unregistered trade mark products.

18. *Württembergische Parfumerie GmbH v. Assistant Registrar Trade Marks, PLD 1986, Kar. 371*: Geographical names in Pakistan are now allowed to be registered as trade marks, but a geographical name in another country will not be restricted. Therefore, the trade mark "Lady Manhattan" for a cosmetic product could not be rejected on the ground that it was associated with a geographical name in the United States of America.

19. *Phillip Morris Incorporated v. Lakson Tobacco Company Ltd., PLD 1986, Kar. 482*: Where opposition is entered and the application for the registration of a trade mark is contested, the court held that the Registrar is required to give his reasons for the grant or refusal of the application for registration or else the aggrieved party while filing an appeal will be prejudiced by not being aware of the reasons for the rejection of his application due to non-inclusion of such reasons in the order of rejection.

20. *Ahmed v. Unilever Ltd., 1983, CLC 258*: The question arose as to whether "trade mark," "patent" or "copyright" is "property" according to Islamic law. The court traced the history, definition and concept of "ownership" and "property" according to classical jurists of Islam of a thousand years ago and found that jurists of those days had included in the category of "property" everything which has a money value such as "trade mark," "patent" or a copyright. It corresponds to the most modern definition. Thus the provisions of these statutes were held not to be against the injunctions of Islam.

21. *Burney's Industrial and Commercial Co. Ltd. v. Rehman Match Works, PLD 1983, Kar. 357*: The test for infringement of a trade mark was once again reiterated, as to whether an unwary or incautious or careless or unguarded purchaser was likely to be misled or deceived into purchasing goods of a person infringing a trade mark as goods of a proprietor of a trade mark keeping in mind the vast difference in literacy ratio and conditions of life in Pakistan as compared to developed countries. However, if the plaintiffs could not prove any actual damage suffered by them due to infringement of this trade mark, they were entitled to nominal damages only.

22. *Multani Sohan Halva v. Registrar, 1987 CLC 1448*: The question arose as to whether the word "Hafiz" could be registered as a trade mark. The word means, a protector, a preserver, a guardian, a governor. The word is commonly used by Muslims for a man who preserves the Holy Koran in his memory and can recite it as such. The court found that it was not a work which cannot be accepted as a trade mark. Its acceptance as such will not violate any provisions of the Trade Marks Act, 1940, nor would hit injure the religious feelings of Muslims or of any Muslim sect if used as a trade mark.

23. *Rolex Montres v. Khyber Tobacco Company Ltd., 1987 MLD 2433:* The registration of a trade mark was opposed by a foreign company on the ground that the mark was distinctive of its goods; it had the registration of that mark and sale of such goods with that mark in foreign countries. The trade mark in question was "Rolex". The court found that under Pakistan law, what was relevant in such cases was the fact that the goods were sold by the foreign company (applicant) with the foreign mark thereon in the local market. There was no evidence on record to show that the appellant being the registered proprietor of the trade mark "Rolex" had any market of that trade mark in respect of any goods in Pakistan, neither was there any evidence to establish the sale of "Rolex" watches by the appellant in Pakistan, nor any other material to establish that "Rolex" mark was so well known among the general public in Pakistan that it had become a household word. Mere advertisement of a product in newspapers and journals without evidence of its actual sale in the local market would not be sufficient to hold that a product had acquired goodwill in local market.

24. *Beecham Group v. Ahmad Ismail, PLD 1987, Kar. 366:* Trade mark "MACLEAN" was registered in favour of the respondent for manufacturing toothbrushes. The applicants opposed it on the ground that "MACLEANS" being their trade mark for toothpaste and allied products of international fame, there was a likelihood of confusion if such trade mark was used by the respondent. They further argued that the import of foreign toothbrushes not having been prohibited in Pakistan, there was a likelihood of confusion if and when the applicant company sells its toothbrushes in Pakistan, the applicant company having registered its trade mark in respect of toothbrushes in a foreign country. If toothbrushes under the same name manufactured by the respondent were exported to such foreign country or to any other part of the world, the likelihood of confusion resulting in loss to the applicant could not be ruled out. Furthermore, the conduct of the respondent in appropriating the trade mark of the applicants who are foreign owners was not proper and the respondents had applied for the registration of their products with unclean hands. Trade in toothpaste, toothbrushes and allied goods of dental hygiene was of an international character. The trade mark "MACLEANS" in respect of toothbrushes could not be registered in favour of the respondents unless it was clear from evidence that the foreign owners of such trade mark had no intention of making or introducing its products of toothbrushes in Pakistan. The court accepted these arguments and allowed the application for de-registering of the trade mark "MACLEANS."

25. *Premier Tobacco Industries Ltd. v. Registrar, 1988 CLC 934:* An application was made for the registration of a trade mark "Kingston." The Registrar refused the registration holding that the word had geographical connection. However, on appeal the High Court reversed this view on the ground that

“Kingston” had no geographical connotation with reference to Pakistan where the application was being made. And that is the requirement of the law. The context of a foreign territory is irrelevant as far as the law in Pakistan is concerned.

26. *Cluett Peabody & Co. Inc. v. Assistant Registrar, 1988 CLC 880*: Extra-territorial use of a trade mark by a party was not relevant under the Trade Marks Act which only recognized its use within the territory of Pakistan.

27. *K.S. Sulemanji Ismaili & Sons Ltd. v. M. Sulemanji & Co. Ltd., PLD 1988, Kar. 569*: For determining whether one trade mark resembles another so much that it can cause deception and confusion, the two marks should not be compared side by side and the question in cases of alleged conflict between two marks always would be whether a person would be deceived when he sees one mark in the absence of the other.

28. *Formica Corporation v. Pakistan Formica Ltd., 1989 S.C.M.R. 361*: An American company manufacturing and selling laminated plastic under the registered trade mark “Formica,” applied for an injunction against the respondent to stop him from using a trade name with the word “Formica” in his trade mark. The respondent was using the trade name “Pakistan Formica Ltd.”

The crucial question was as to whether the use of the word “Formica” in the trading style of the respondent had infringed the trade mark of the appellant. No evidence was produced to establish that the trading style adopted by the respondent was causing confusion or deception or was likely to cause confusion or deception to the consumers of laminated sheets. Such possibility hardly existed and the appellant had failed to show that, by using trade name “Pakistan Formica Ltd.,” the respondent had deceived the public into thinking that its products were those of the appellant or were likely to do so. Neither a strong *prima facie* case was made out by the appellant nor the balance of convenience existed in their favour for granting an injunction.

Therefore, the Supreme Court upheld the order of the court below where the injunction had been refused.

29. *English Biscuit Manufacturing Ltd. v. The Registrar, 1989 CLC 340*: The appellants, a Pakistani company, applied to the Registrar for the registration of their trade mark “ENGLISH BISCUITS,” claiming to be the proprietors of the mark which was in use since 1970 (that is for over 18 years). The Registrar refused the registration on the ground that the mark was descriptive and the word “English” gives an impression to the consumers that the biscuits originate from England or have been manufactured according to an English specification or the appellant has some affiliation with some British company.

The High Court did not agree with the Registrar. The court found from the appellant's affidavit of user that their product was on the market since 1970. They had been making expensive advertisements and had extensive sales and had thus acquired popularity and goodwill in Pakistan. Thus the evidence was clear and rebutted that in the trade circles the words "ENGLISH BISCUITS" were connected to the biscuit preparations being sold by the appellants. It could not be doubted that by the constant use of the trade mark "ENGLISH BISCUITS" for such a long time the appellant could legitimately claim that the trade mark was almost exclusively connected with their products. The court observed that, in every such case, the question is a question of fact, that is, where the evidence proves conclusively that the descriptive word had lost its primary meaning and had acquired a secondary meaning, it is a question of fact whether the registration of that mark will or will not cause confusion. The word is not merely incapable of registration by reason of the fact that it is a descriptive word. It has to be proved to be confusing, which had not been done in this case.

30. *Punjab Engineering Cop. v. Muhammad Yaqoob and another, 1989 CLC 368*: The appellant raised objection to the registration of the respondents' trade mark "KING FU" on the ground that the appellants' mark "KING," which already stood registered, would be confused with that of the appellant if allowed. The court, upholding the view of the Registrar, found that there was no descriptive similarity between the two marks. "KING" and "KING FU" are not similar in sound nor by their look when written down. There is no resemblance between the two. Therefore, they are not likely to confuse any person.

31. *National Electric Fans Manufacturers, Gujrat v. S. Muhammad Din & Sons Ltd., Lahore, 1980, S.C.M.R. 97*: The respondent was denied the right to register its mark in view of the finding that the mark was dishonestly copied because the idea underlying the law of registration of trade marks in Pakistan is the prevention of fraudulent use of marks of one proprietor by another.

It was also observed by the Supreme Court of Pakistan that the Registrar of Trade Marks is not only free to take into account social and economic considerations while exercising his discretion in allowing or disallowing registration of a trade mark but is also bound to take into consideration the public interest observing that it was "obvious that public interest can never be furthered by doing anything which would encourage dishonesty." (*Cooper's Incorporated v. Pakistan General Stores Ltd.*, 1981 S.C.M.R. 1039)

32. *Lipton Ltd. v. Frontier Carnellia, PLD 1954, Sind 124*: In judging the probability of deception the test is not whether an ignorant or unconscious purchaser is likely to be misled. The court has to approach the matter from the view point of the average purchaser of an article with ordinary caution. The

resemblance between respective labels and monograms in order to be actionable must be such as might deceive an average cautious purchaser.

33. *Abdul Hamid v. Abdur Rahim, PLD 1973, S.C. 104*: The question was whether the words "Daigon" and "Dragon" could be refused registration as trade marks when the word "Saigon" was already on the Register of Trade Marks. It was held by the Supreme Court of Pakistan that the first syllables "Dai," and "Dra" are dissimilar from the first syllable "Sai," which syllable was important for deciding the question of deception and confusion. Since the word "Saigon," an important geographical entity, had become well known in connection with the Vietnam War, the word "Daigon" was not likely to cause confusion or deception and it could be registered.

34. *The Seven-Up Co., U.S.A. v. Abdul Aziz Noor Muhammad, PLD 1976, Kar. 895*: It was held that the theory of common trace activity was the correct approach to find out if deception could be caused by use of identical or similar trade marks on their goods. If a multi-activity company had got a trade mark registered for its goods in one class and had acquired a great reputation in respect of the same, then it cannot prevent other traders from using the same in respect of other class of goods, unless it secures defensive trade mark registration in respect of the other class as well.

It was held also that a trade connection or common field of activity was necessary in order to determine whether the proposed identical trade mark of "7Up PAN Supari" (chewing beetle leaf) was likely to deceive a purchaser into believing that he was purchasing the goods which originated with the famous makers of "7 Up" refreshing drink which was a registered trade mark in respect of different goods. The goods being of different character, there could be no likelihood of confusion. Thus the trade mark was allowed to be registered.

35. *Palm Soap v. Chittagong Soap, PLD 1970 SC 460*: On the question of deception, the Supreme Court of Pakistan warned that the unwary purchaser should not shut his eyes. The court did not find that any deception could be caused by use of the numeral "1947" on washing soap of another factory. The court observed that one little difference in the third digit makes all the difference which focuses their respective identity in the mind of the purchasing public.

"Instead of creating any confusion, it should prevent any such confusion even in the mind of an unwary purchaser. An unwary purchaser is not expected to exercise waryness, but he is expected also not to keep his eyes shut." The mark "1947" was therefore allowed to be registered.

36. *Sony Kabushiki Kaisha v. Registrar of Trade Marks PLD 1978 Kar. 161*: On the facts and evidence it was found that there was no likelihood of confusion or deception in registering the trade mark "Sony" for sports goods

although exactly the same mark "Sony" had already been registered in Pakistan for the sophisticated electrical goods of the Japanese Company Sony Kabushiki.

37. *Kaiser Jeep Corporation v. Saber Saleem Textile Mills Ltd.*, PLD 1969, Kar. 376: It was found that there was no trade connection between motor cars and thread and yarn as they were different goods before the word "Jeep" the mark of a car which had already been registered for the cars of appellant Kaiser Corporation of the United States of America, was allowed to be registered for the thread yarn produced by the respondent.

38. *Bubble Up Company Inc., U.S.A.*, PLD 1975, Kar. 582: It was held that only such meaning of the words as exist in Pakistan shall be pertinent for ascertaining the distinctiveness of mark. Thus the word "up" was held not to convey by itself any idea of effervescence or sparkling, and was hence not descriptive.

39. *Boots Pure Drug Co. Ltd. v. Registrar of Trade Marks*, PLD 1973, Note 7 at 15: On the question of "distinctiveness," courts in Pakistan have also held that besides proof of long and wise use there should also be a considerable volume of business to establish distinctiveness. Thus, a business of 300,000 rupees spread over a period of eight years would not establish the word (in that case, the word "sweetex") as having become distinctive of the applicant's goods.

40. *Zenith Laboratory (Pak) Ltd. v. British Drug House*, (20 D.L.R. 1171): The courts have consistently refused registration if a trade mark is likely to cause deception or confusion. Thus, the Dacca High Court, in the case of a pharmaceutical company, refused registration to a party applying to have one of its products registered under the trade mark "Livatogen." The court observed that a product under the trade mark "Livogen" stood registered since 1942 and had a wide circulation. As the words "Livatogen" and "Livogen" were likely to create confusion in the public mind and a purchaser of ordinary prudence was likely to be deceived, registration was refused.

41. *Monsanto Co. v. Gul Ahmad Textile Mills Ltd.*, PLD 1968, Kar. 369: The High Court accepted the appeal of the appellant who was using the word "Resloom" as its trade mark on a chemical preparation, which was a liquid and was used for treating textiles for giving a finish and resistance to shrinkage of such goods. This business of the appellant was carried on in the United States of America. The respondent imported 2,375 lbs. of this preparation from the appellant for using it on the textile piece goods manufactured by him. Subsequently, the respondent decided to adopt the word "Resloom" as the trade mark of his textile piece goods and also applied to the Registrar for its registration as a trade mark. The appellant opposed it. But as the evidence disclosed that neither party had acquired any reputation for this trade mark in the Pakistan market, the Registrar

rejected the appellant's opposition. On appeal before the High Court, the respondent disputed the appellant's contention that there was a likelihood of deception or confusion if the same trade mark was used on goods of two different classes. The court rejected the respondent's plea, observing that the real point is not whether the goods belonged to the same class or to different classes, but whether there is any trade relation between them of such a nature as to create an impression that the manufacturer of one might be the manufacturer of the other; or the products of the goods of the other manufacturer might have been used in the production of the goods of the other manufacturer. As there was a likelihood of deception and confusion, the appeal was allowed.

42. *Jamia Industries Ltd. v. Caltex Oil (Pakistan Ltd)*, PLD 1973, Kar. 246: The application of Jamia for a device of a five-point star in a crescent almost forming a circle was opposed by Caltex on the ground that their registered mark consisted of the device of a star within a circle in respect of the same class of goods. It was held that the proposed trade mark was not distinctive as the essential characteristic of the mark, in spite of the use of the word "Jamia" would be the star. The courts in Pakistan are of the view that in cases of competing trade marks, the Trade Marks Registry, while ascertaining the issue of distinctiveness, should lay emphasis on their leading features and characteristics.

It has also been held that the onus of proving that the new proposed trade mark is distinct from a trade mark already on the Register is on the applicant. (*Wagner Electric Corporation v. Paramount Oil Chemical Co.*, PLJ 1973 Kar. 29).

6.5 Specimen Cases Decided by the Registrar of Trade Marks.

1. An application was made for the registration of the word "MAZBUT," which, in the Urdu language means "Strong," in Class 14 in respect of horological and chronometric instruments and parts thereof. The applicant stated in his affidavit that goods with the mark had been advertised and sold in the country since before 1937 and that the mark was well known in the country. It was held that the mark was highly objectionable and therefore refused. Any trader was entitled to describe his watches, clocks, chronometrics, generally as "MAZBUT," i.e., "Strong" or "Unbreakable." The public also were entitled to ask for watches which were "MAZBUT."

2. An application was made for the registration of the word "MARVEL" in Class 14 in respect of horological and chronometric instruments and parts thereof. It was held that the word "MARVEL" was on the same footing as the word "MARVELLOUS" and was purely a laudatory theme and it was within the principle of the "Perfection" case. The application was accordingly refused.

3. An application was made for the registration of the word "GENTLEMAN" in Class 3 in respect of soaps, perfumes and hair oils. The applicant stated that the mark was not likely to cause confusion to the public and embarrassment to other traders inasmuch as the goods in respect of which the mark was used could be used and was being used by men or women. The Registrar held that if words like "Gentleman" and "Ladies" were to be registered as trade marks there would be no saying what confusion and embarrassment they would bring to ordinary *bona fide* traders. Traders would be debarred from saying they were selling "Soaps for Gentlemen" or "Gentlemen's Soaps" or that their perfumes were meant particularly for gentlemen or that the hair oil they sold was for gentlemen and not for ladies. The mark was, therefore, not adapted to distinguish and not registrable.

4. An application was made for registration of the word "GHALLAK" in Class 3 in respect of a motor polish. The word "GHALLAK" in Urdu meant "Shining" or "Bright." It was held that the word "GHALLAK" was purely descriptive of the goods and under the Trade Marks Act such a word could not be considered to be adapted to distinguish.

5. An application was made for the registration of the word "MODEL" in Class 16 in respect of fountain pens, nibs, pencils (propelling), pen holders (not of precious metal) and paper cutters. The applicant filed an affidavit in order to prove that the mark had become distinctive of his goods. It was held that "MODEL" was an ordinary descriptive or laudatory word, which not only every trader would be entitled to use in respect of his goods, but a word which one would consider natural for the traders to use on goods they trade in, having regard to the manner in which they puff their wares. The application was refused accordingly.

6. An application was made for the registration of the words "CAMEL HAIR" in Class 7 with reference to woven machine driving belting. The applicant filed an affidavit as to the distinctiveness of the mark. It appeared that the words "CAMEL HAIR" belting were associated in the minds of public with the goods of the applicant. It was held that the words "CAMEL HAIR" were admittedly descriptive of belting made of camel hair. If the words were used in respect of belting not made of camel hair, they would be deceptive and would fall under Section 8 of the Trade Marks Act. Although the words might be distinctive for the purpose of a passing off action, the words "CAMEL HAIR" were not adapted to distinguish.

7. An application was made under Section 11(1) of the Trade Marks Act for registration of the words "WHITE LABEL" in Class 30 in respect of tea. The applicant filed 60 affidavits by persons from all over Pakistan stating that the words "WHITE LABEL" were associated in the minds of the public with the goods of the applicant. It was held that the words "WHITE LABEL" were purely

descriptive of a common get up of packets of tea and if registered would cause difficulty and embarrassment to innocent traders. Although the words might be distinctive for the purpose of a passing off action under certain circumstances, the words "WHITE LABEL" under the circumstances did not have the essentials of a trade mark.

8. An application was made in Class 4 for the registration of the word "STANDARD" in respect of "illumination oils, burning oils, diesel oils and oils for operating internal combustion engines, fuel oils, lubricating oils and greases, motor spirit, dust laying materials and substances, industrial oils (except edible and essential oils), industrial greases in Class 4." An affidavit was filed to show that the word "STANDARD" had become associated in the minds of the public with the goods of the applicant. The application admitted that the word "STANDARD" was used descriptively by other merchants in advertisements, conversations and catalogues but that in such a case the expression used was "standard quality." It was held that the word "STANDARD" was admittedly a word which merchants might use in a descriptive sense with regard to their goods and registration of the word would be embarrassing to the trade. Furthermore, with regard to petrol and lubricating oil, Government might at any time issue orders that they should be of standard specifications. The mark was, therefore, not adapted to distinguish.

9. An application was made for registration of the word "KALA" in Class 2 in respect of shellacs and lacs for use in manufacture. It appeared that the mark had been used since 1909. It was held that: "KALA" meant "dark" or "black" and with reference to shellac it indicated the colour. A word which was descriptive of the nature of the colour of the goods was not registrable.

10. An application was made for registration of the word "DELUX" in Class 28 in respect of playthings, sporting articles and goods including their accessories. The applicant claimed that although *prima facie* the mark was descriptive of the character or quality of the goods, it had in fact become adapted to distinguish by reason of its use or other circumstances. It was held that "DELUX" was a mere misspelling of the word "DE LUXE" and that "De Luxe" was one of those words which would ordinarily be required by traders to describe the excellent character of their goods and therefore it was not proper to give a monopoly of the word to any one trader.

11. An application was made for the registration of the word "SUPREME" in Class 19 in respect of "85% Magnesia compound." The applicant stated that the goods were in respect of "boiler composition" and the applicant was informed that the goods fell in Class 17 and not in Class 19. The application was refused having regard to the fact that the word "SUPREME" was merely a laudatory expression

which should be open to other traders to use and that registration of such a word was likely to embarrass other traders.

12. An application was made for the registration of the word "ALL WEATHER" in Class 12 in respect of tyres composed wholly or principally of rubber and threads or parts thereof and inner tubes therefor. The applicant submitted that the words "ALL WEATHER" had no direct reference to the character or quality of the goods as all tyres were adapted for all weathers. It was held that the words "ALL WEATHER" were clearly descriptive with reference to the goods and was not adapted to distinguish.

13. An application were made for the registration of the word "PAIN KILLER" in Class 5 in respect of medicinal preparations for internal use. The applicant submitted that, although the word was *prima facie* descriptive of the goods, it had become distinctive by long user in Pakistan. It appeared that the word "PAIN KILLER" had never been used in this country separately in connection with the goods but it always formed part of the trade marks which formed the subject matter of two other applications made by the applicant. It was held that the word "PAIN KILLER" was admittedly a combination of the two ordinary common English words "Pain" and "Killer" and that the combination "PAINKILLER" itself appeared in standard dictionaries with a specific descriptive meaning in reference to medicines. The word "PAINKILLER" had not been used separately as a trade mark. Even if the mark had become associated in the minds of the public with the goods of the applicant, by virtue of its long user, the mark was still not adapted to distinguish within the meaning of Section 6 of the Act. Registration of the word would affect the legitimate right of other manufacturers and traders to describe their goods and would cause substantial difficulty and confusion in the trade.

14. An application was made for the registration of the word "SUMMERKNIT" in Class 25 in respect of ganji of all types, underdrawers, socks, swimming costumes, caps, pullovers and sweaters. The applicant submitted that the mark had become distinctive by use in connection with his goods. It was held that the mark applied for registration consisted of two well-known words which indicated clearly that the goods in question were knitted goods for summer use. Registration of the word "SUMMERKNIT" would unduly interfere with the rights of the existing and future traders in applying a legitimate and appropriate description to their goods and would hamper fair trade.

15. An application was made to register the word "FINELINE" in Class 16 in respect of mechanical pencils and leads therefore, fountain pens, fountain pen desk sets and dip pen desk sets. The Trade Marks Registry took objection to the mark on the ground that it was descriptive of the goods. The applicants submitted

that the word had no direct reference to the character or quality of the goods as it was written in script form as in handwriting. They, however, admitted that they could not stop legitimate descriptive use of the words "Fine Line" by other traders in respect of their pencils. It was held that the word "FINELINE" was descriptive of the character or quality of the goods as it indicated that the pencil wrote fine lines. Furthermore, since other traders could legitimately use the word for describing their goods, it would cause confusion to the public if the word were to be registered. The application was refused.

16. An application was made to register the word "TROIQUES" in Class 3 in respect of toilet preparations and perfumery. The Trade Marks Registry took objection to the mark on the ground that the word "TROIQUES" was equivalent to the word "tropics" and had a direct reference to the character or quality of the goods. The applicant argued that the word had no direct reference to the character or quality of the goods. It was held that the French word *tropiques* was phonetically equivalent to the English word "TROPICS" and presumably meant the same both in English and in French. For the purpose of the Trade Marks Act, the substantive use of a word was also taken to be on the same footing as the adjectival use of the word and, therefore, the word "TROIQUES" might be taken on the same footing as the word "TROPICAL." The expression "Tropical Lotion" or "Tropical Hair Oil" would readily be understood by anyone as being hair oil or lotion specially made to be used by people living in a tropical climate. Furthermore, it was common knowledge that perfumes lose their scent more readily in a hot climate than in a cold climate and, therefore, a perfume which was called "TROPICAL" would be understood to be a perfume specially meant for tropical climates. The word, therefore, had a direct reference to the character or quality of the goods. The application was refused.

17. An application was made for the registration of the word "PETROKEROS" in Class 11 in respect of installations for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes. The proprietor of the mark "KEROS" which was registered in respect of lighting and heating apparatus and appliances and parts thereof and incandescent mantles opposed this application on the ground that the applicant's mark was likely to cause confusion with his mark. The opponent stated that his goods had been sold all over the world including Pakistan for about the past 25 years and were well known under the trade mark "KEROS." It appeared that the applicant had not used his mark but only proposed to use it. It was held that *prima facie* the word "PETRO-KEROS" was likely to be confused with "KEROS." Furthermore, the word "PETRO-KEROS" might be written in such a way that "KEROS" might be more visible than the word "PETRO." The application was, therefore, refused.

18. An application was made for the registration of the numeral "101" in Class 3 in respect of all kinds of soaps, bleaching preparations and substances for laundry use. The proprietor of the registered mark "501" opposed this application on the ground that the applicant's mark was a colourable imitation of his mark. The opponent admitted that there was no similarity between the get up of his goods and the goods of the applicant, but he seemed to claim a monopoly in all figures with three numerals where any two of them corresponded with any two numerals of his mark. It was held that the opponent was going too far in claiming a monopoly in all figures ending with 01 and that the applicant's trade mark was not so similar to the opponent's trade mark as to be likely to deceive or cause confusion.

19. An application was made for registration of the words "STERN'S TISSUE BUILDER" in Class 5 in respect of medicines. An opposition was filed to this application on the ground that the applicant had no right to the word "STERN'S." The case of the applicant was that in the year 1914 he had entered into an agreement with the predecessors of the opponents who were manufacturers of pharmaceutical goods in the United States of America, that the latter should manufacture the goods according to the formula of the applicant and that the goods should be called "STERN'S TISSUE BUILDER." The applicant took charge of the goods and by personal canvassing sold the goods, informing the public that the goods were his and that the formula was his. It was clear from the case set up by the opponents that they did claim the right in the words "TISSUE BUILDER." It was also clear that at no time had the opponent sold the medicine "STERN'S TISSUE BUILDER" to anybody except the applicant. In fact, if the opponents had sold these goods to anybody else in any part of the world the applicant would have been entitled to object. It appeared, therefore, that the opponents had allowed the applicant to assume the mark "STERN'S TISSUE BUILDER" as his own. The applicant was in no sense the agent of the opponents and, but for the applicant, such a medicine would never have been put on the market. Under the circumstances, the opposition was dismissed.

20. An application was made for the registration of a label the essential feature of which was the word "Jam-bo" in Class 5 in respect of "pharmaceutical preparations, namely, herbal balm (medicinal) for eczema and burns, pain balm, and plasters (medicated)." An opposition was filed to this application on the ground that the applicant's mark closely resembled the mark of the opponent, viz., "ZAM-BUK," which was registered for "Ointments and Suppositories." The opponent proved that he had used his mark for a long period, certainly since 1912. But there was no indication as to whether the applicant's goods were on the market or whether his mark had ever been used. The Registrar held that apart from

the general appearance they appeared to be phonetically similar. The application was, therefore, refused.

21. An application was made to register a mark consisting of a label containing the word "FIXORA" in Class 3 in respect of hair cream. The application was opposed by the proprietors of the mark "ANZORA," on the ground that the word "FIXORA" was confusingly similar to the word "ANZORA," particularly in view of the fact that the two words had the same termination "ORA." The Registrar held that there was no similarity between "ANZORA" and "FIXORA." It also appeared that the suffix "ORA" was used by many other traders. The opposition was dismissed.

22. An application was made to register a mark consisting of a label containing a device of a head of a man in a top hat smoking a cigarette and the words "Passing Show" in Class 25 in respect of hosiery. The application was opposed by the proprietors of a mark which consisted of a similar device together with the words "Passing Show" but which was used in respect of cigarettes. The opponents first based their case upon the provisions of Section 8 of the Act and stated that because of the great reputation acquired by them in the "Passing Show" mark, people would connect the hosiery goods also with the opponent when those goods had the "Passing Show" mark affixed thereon. However, at the first hearing the grounds of opposition were amended by the addition of a new ground, *viz.*, that the applicant's mark amounted to a breach of copyright in the picture. It appeared that a certain press in the United Kingdom had brought out a weekly magazine under the name of *The Passing Show* and a well-known artist was commissioned to draw a picture of a showman which always appeared on the front page of the magazine *The Passing Show*. The predecessors of the opponents were given a license to use a copy of that picture known as "Passing Show by the Press" and thereafter the opponents' predecessors assigned their rights to the opponents. The applicant argued that the picture was not a work of art and therefore there could be no copyright therein and that even if there was a copyright in the showman his mark was not an infringement of the picture as it contained only the head of the showman and not the entire picture. The Registrar came to the conclusion that a copyright existed in the picture of the showman and that the applicant's mark was an infringement on that copyright. The application was accordingly refused.

23. An application was made to register a mark consisting of the word "TAPTON" in Class 30 in respect of tea. The application was opposed by the proprietors of the registered mark "LIPTONS" under the provisions of Sections 8 and 10(1) of the Act on the grounds that the mark conflicted with the registered mark and that the use of the mark was likely to deceive or cause confusion. The applicants denied that the two marks were similar and relied on a decision of the District Court of Peshawar in a passing off action between the parties. They urged

that the decision in the passing off action should be treated as *res judicata* between the parties and the opposition dismissed on that ground. The Deputy Registrar who heard the case held, following the judgment in the case of *National Sewing Thread Co. Ltd. v. James Chadwick Bros., Ltd.*, that an action for passing off was not an action on the trade mark and could not be considered as *res judicata* in the opposition proceedings, that the applicants' mark was within the prohibited degree of similarity with the opponents' mark and that the two marks visually and phonetically so nearly resembled each other as to be likely to deceive or cause confusion. He also held that the evidence produced by the applicants did not prove that they were entitled to registration under Section 10(2) of the Act by reason of honest concurrent use or other special circumstances. The application was accordingly refused.

24. An application was made to register a mark in Class 32 in respect of mineral aerated waters and other non-alcoholic drinks and syrups and other preparations for making beverages. The mark consisted of a device of a bottle with the word "Parle's" written across the body of that bottle and device of a cork with the word "Gluco-Cola" written thereon in script. The goods set out in the application were subsequently restricted to "non-alcoholic drinks." On the application being advertised in the *Trade Marks Journal*, it was opposed by the Coca Cola Company who were the proprietors of the registered mark "Coca-Cola" written in script. The opposition was based on the grounds that the applicants' mark conflicted with the opponents' mark under the provisions of Section 10(1) of the Act, that the applicants' mark was likely to cause confusion or deception under the provisions of Section 8 of the Act, that the user of the applicants' mark would constitute an infringement of the opponents' mark and, therefore, be disentitled to protection in a court of law and be contrary to the law for the time being in force and that the applicants were not the proprietors of the mark, nor was the mark propounded by the applicant a "trade mark" within the definition contained in Section 2(1) of the Act. The Registrar held that, although there was no visual resemblance between the applicants' mark as applied for considered as a whole and the opponents' mark, there was such a degree of phonetic resemblance between the word "Gluco-Cola," which was the material feature of the applicants' mark, and the word "Coca-Cola" that the applicants' mark was likely to deceive or cause confusion within the meaning of Section 10(1) of the Act. The applicants had not made out a case for invoking Section 10(2) of the Act nor did they prove that the use of their mark was not likely to cause confusion or deception within the meaning of Section 8(a) of the Act. The application was accordingly refused.

25. An application was made to register the word "BENAPLEXON" in Class 5 in respect of pharmaceutical and medical preparations. The application was opposed by the registered proprietors of the mark "PLEXAN" on the ground

that "BENAPLEXON" so nearly resembled "PLEXAN" as to be calculated to deceive or cause confusion in the trade or to enable goods to be mistaken or sold or passed off as goods of the opponents' manufacture. The opponents' mark was registered in respect of pharmaceutical preparations of liver extracts. It was argued by the opponents that it was a practice of pharmaceutical manufacturers to use the same name with small variations for different products manufactured by them and therefore the public might come to the conclusion that "BENAPLEXON" and "PLEXAN" had the same origin of manufacture. The Registrar held that both visually and phonetically the words "PLEXAN" and "BENAPLEXON" were dissimilar and that if normal user of the mark was to be taken into account, the goods of the opponents being "injection containing liver extract" and that of the applicants being "medicinal preparations in the form of tablets containing Vitamin B Complex," there could be no possibility of confusion. The opposition was dismissed.

26. An application was made for registration of the word "ALLWITE" in Class 3 in respect of shoe polishes, shoe-cleaning preparations and leather preservatives not included in Class 4. The Registrar held that "ALLWITE" was but a misspelling of "ALL WHITE" and that if the word were to be registered in respect of the goods some of which were admittedly white, it would lead to embarrassment and confusion. The mark was, therefore, not adapted to distinguish the application and was accordingly refused.

CHAPTER 7

CONCLUDING REMARKS

7. CONCLUDING REMARKS

It will have been noticed from the preceding chapters that the laws of Pakistan not only accord legal recognition to rights in intellectual property but also provide adequate protection against their infringement. Comprehensive provisions are made for the acquisition, preservation, protection and transfer of these rights. As indicated in the introductory part of each chapter, the law in Pakistan has closely followed English law in this field as most of the laws governing intellectual property were inherited by Pakistan on its birth in 1947 and the amendments or changes made in them thereafter are not different from the developments in English law on the subject. The protection of intellectual property is no doubt provided by legislation which is quite comprehensive in all respects. But the real test is to be gathered from the practical results. The provisions of law will be of little use if they do not accomplish the results or achieve the purpose for which they are made.

Recent developments in reprographic technology make it much easier for individuals to make unauthorized copies of all types of copyrighted works, whether they be in print, sound, film or computer form.

The Government is aware of the problem. It is ready and willing to provide assistance for the protection of the rights in case of infringement. In isolated cases, despite strict action having been taken, the practice seems to continue.

It has been noticed that during the past 42 years of its existence as an independent State, issues pertaining to intellectual property have arisen mostly in its industrial and commercial city, Karachi. But issues in this field are now also emerging in the other fast-growing industrial centres of the country. As industrialization progresses, issues pertaining to intellectual property will, in like measure, also spread to the other sectors of Pakistan society.

It has also been noticed that so far, most of the disputes and litigation in the field of intellectual property have arisen in relation to infringement of trade marks, but copyrights, patents and designs and other forms of intellectual property are also gradually coming to the fore and are being brought to the attention of the courts. In Pakistan, the courts, the legislature and the administration are no doubt cognizant of the importance of intellectual property and are fully conscious of the fact that like other property, this too must be adequately protected. However, the right being a private right is accorded protection against infringement only on the complaint of the aggrieved party.

On the academic side, this subject has not so far been given as much attention as it deserved. Amongst the 19 universities and dozen law schools in the country, only one offers intellectual property law as a separate course of study. Elsewhere, the subject is taught only as a part of other courses such as Commer-

cial Law, Law of Contract, Property Law and Procedure. In October 1990, the University Law College, Punjab University, Lahore, introduced a course "Diploma in Intellectual Property Law." This is a one-year course open to candidates who already hold a law degree.

Thanks to the efforts of the World Intellectual Property Organization (WIPO), through seminars, conferences, meetings and workshops organized in the last few years either in Pakistan, or in the region where Pakistani delegations of lawyers and teachers of law have been invited to attend, the subject is becoming familiar and an interest is being created in its study.

Further Progress

The Government of Pakistan has constituted a High Powered Committee in April 1989 to review the Trade Marks Act, 1940, and its administration in Pakistan. The Committee is also contemplating modes and measures to be adopted to check the delays experienced in the registration of trade marks. In this connection, use of computers in the Trade Marks Registry, micro filming of the records and increasing the staff are being considered by the Review Committee. It is expected that the recommendations of the Committee will help in the improvement and efficiency of the Trade Marks Registry and particularly in the expeditious disposal of the cases.

Since 1989, the World Intellectual Property Organization has been executing a UNDP-funded project entitled, "Strengthening of the Patent System, including the Establishment of Patent Information Services." The project includes the computerization of services and records of the Patent Office, Karachi, which will greatly improve the services to the public, the industrial sector and R & D institutions.



ANNEX I

**THE PATENTS AND DESIGNS ACT,
1911**

The Patents and Designs Act, 1911
(Act II of March 2, 1911, as last amended by
Ordinance No. XXXVIII of 1983)*

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* *Entry into force* (of last amending law): December 31, 1983.

Source: Consolidated version established by WIPO on the basis of the *Patent Office Hand Book*, 3rd ed., 1971, and subsequent communications from the Patent Office of Pakistan.

Note: The Patents and Designs Act, 1911, has been amended by the following texts: Acts Nos. XVII of 1914; XXIX of 1920; XI of 1923; XII of 1927; VII of 1930; Ordinance of 1937; Acts Nos. XX of 1937; XII of 1939; XV of 1944; IX of 1945; Ordinances Nos. XXI of 1960; 4 of 1975; XXVII of 1981; XXXVII of 1983.

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Preliminary

(Short title, extent and commencement)

1.—(1) This Act may be called the Patents and Designs Act, 1911.

(2) It extends to the whole of Pakistan.

(3) It shall come into force on the first day of January 1912.

(Definitions)

2. In this Act, unless there is anything repugnant in the subject or context, —

(1) “Advocate General” includes the Attorney General for Pakistan;

(2) “article” means (as respects designs) any article of manufacture and any substance, artificial or natural, or partly artificial and partly natural;

(3) “Controller” means the Controller of Patents and Designs appointed under this Act;

(4) “copyright” means the exclusive right to apply a design to any article in any class in which the design is registered;

(5) “design” means only the features of shape, configuration, pattern or ornament applied to any article by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye; but does not include any mode or principle of construction or anything which is in substance a mere mechanical device, and does not include any trade mark as defined in Section 478 as amended from time to time, or property mark as defined in Section 479 of the Pakistan Penal Code;

(6) “District Court” has the meaning assigned to that expression by the Code of Civil Procedure, 1908;

(7) *[repealed]*

(8) “invention” means any manner of new manufacture and includes an improvement and an alleged invention;

(9) “legal representative” means a person who in law

represents the estate of a deceased person;

(10) "manufacture" includes any art, process or manner of producing, preparing or making an article, and also any article prepared or produced by manufacture;

(11) "patent" means a patent granted under the provisions of this Act;

(12) "patentee" means the person for the time being entered on the Register of Patents kept under this Act as the grantee or proprietor of the patent;

(13) "prescribed" includes prescribed by rules under this Act; and

(14) "proprietor of a new or original design":—

(a) where the author of the design, for good consideration, executes the work for some other person, means the person for whom the design is so executed; and

(b) where any person acquires the design or the right to apply the design to any article, either exclusively of any other person or otherwise, means, in the respect and to the extent in and to which the design or right has been so acquired, the person by whom the design or right is so acquired; and

(c) in any other case, means the author of the design: and where the property in, or the right to apply, the design has devolved from the original proprietor upon any other person, includes that other person.

Part I: Patents

Application for and Grant of Patent

(Application)

3.—(1) An application for a patent may be made by any person whether he is a citizen of Pakistan or not, and whether alone or jointly with any other person.

(2) The application must be made in the prescribed form, and must be left at the Patent Office in the prescribed manner.

(3) The application must contain a declaration to the effect that the applicant is in possession of an

invention, whereof, he, or in the case of a joint application one at least of the applicants, claims to be the true and first inventor or the legal representative or assignee of such inventor and for which he desires to obtain a patent, and must be accompanied by either a provisional or complete specification and by the prescribed fee.

(4) Where the true and first inventor is not a party to the application, the application must contain a statement of his name, and such particulars for his identification as may be prescribed, and the applicant must show that he is the legal representative or assignee of such inventor.

(Specifications)

4.—(1) A provisional specification must describe the nature of the invention.

(2) A complete specification must particularly describe and ascertain the nature of the invention and the manner in which the same is to be performed.

(3) A specification, whether provisional or complete, must commence with title, and in the case of a complete specification must end with distinct statement of the invention claimed.

(4) Where the Controller deems it desirable, he may require that suitable drawings shall be supplied at any time before the acceptance of the application, and such drawings shall be deemed to form part of the complete specification.

(5) If in any particular case the Controller considers that an application should be further supplemented by model or sample of anything illustrating the invention or alleged to constitute an invention, such model or sample as he may require shall be furnished before the acceptance of the application, but such model or sample shall not be deemed to form part of the specification.

(6) The Controller may, where the application was accompanied by a specification purporting to be a complete specification, if the applicant so requests, treat

the specification as a provisional specification and proceed with the application accordingly.

(Time for leaving complete specification)

4A.—(1) If the applicant does not leave a complete specification with his application, he may leave it at any subsequent time within nine months from the date of the application:

Provided that the said nine months shall be extended to such period, not exceeding 10 months from the date of the application, as may be specified in a request made by the applicant to the Controller, if the request is made and the prescribed fee is paid within the period so specified.

(2) If the complete specification is not left within the period allowable under sub-section (1), the application shall be deemed to be abandoned at the expiration of 10 months from the date thereof.

(Provisional protection)

4B.—(1) An invention may, during the period between the date of an application for a patent therefor and the date of sealing a patent on that application, be used and published without prejudice to that patent and such protection from the consequences of use and publication is in this Act referred to as provisional protection.

(2) In this Section, the expression “date of an application for a patent” means, as respects an application which is post-dated or ante-dated under this Act, the date to which the application is so post-dated or ante-dated, and means, as respects any other application, the date on which it is actually made.

(Proceedings upon application)

5.—(1) The Controller shall refer to an Examiner every application in respect of which a complete specification has been filed and if satisfied on the report of the Examiner that—

(a) the nature of the invention or the manner in which it is to be performed is not particularly described and ascertained in the complete specification, or

(b) the application, specification and drawings have not been prepared in the prescribed manner, or

(c) the title of the specification does not sufficiently indicate the subject-matter of the invention, or

(d) the statement of claim does not sufficiently define the invention, or

(dd) where a complete specification has been left after a provisional specification, the invention particularly described in the complete specification is not substantially the same as that which is described in the provisional specification, or

(e) the invention as described and claimed is *prima facie* not a manner of new manufacture or improvement, or

(f) the specification relates to more than one invention, or

(g) in the case of an application claiming priority under Section 78A, the specification describes and claims an invention substantially larger than or substantially different from the invention disclosed in the specification filed with the application made outside Pakistan by virtue of which priority is claimed, or

(h) in the case of an application for a patent of addition under Section 15A, the invention described and claimed in the specification is not an improvement or modification of that described and claimed in the original specification,

he may refuse to accept the application or require that the application, specification or drawings be amended before he proceeds with the application; and in the latter case the application shall, if the Controller so directs, bear date as from the time when the requirement is complied with:

Provided that, when a specification comprises more than one invention, the application shall, if the Controller or the applicant so requires, be restricted to one invention and the other inventions may be made the subject-matter of fresh applications; and any such fresh application shall be proceeded with as a substantive application but the Controller may, in his discretion, direct that any such fresh application made before the acceptance of the original application shall

bear the date of the original application or such later date as he may fix, and the fresh application shall be deemed, for the purposes of this Act, to have been made on the date which it bears in accordance with such direction.

Provided further that where a complete specification is left after a provisional specification the Controller may, if the applicant so requests, cancel the provisional specification and direct that the application shall be deemed to have been made on the date on which the complete specification was left, and proceed with the application accordingly.

(1A) If the Controller considers, at any time before the acceptance of an application, that the invention claimed therein has been wholly or in part claimed in a specification published on or after the date which the patent applied for would bear if granted, appertaining to an application for a patent which if granted will be of prior date to the patent applied for, he may require that the applicant's specification be amended by the insertion of a reference to such other specification, by way of notice to the public.

(2) Where the Controller refuses to accept an application or requires an amendment or the insertion of a reference the applicant may appeal from his decision to the Federal Government.

(3) The investigations required by this Section shall not be held in any way to guarantee the validity of any patent, and no liability shall be incurred by the Federal Government or any officer by reason of, or in connection with, any such investigation, or any proceeding consequent thereon.

(4) Unless an application is accepted within 18 months from the date of the application, the application shall (except where an appeal has been lodged) be deemed to have been refused:

Provided that where, before, or within three months after, the expiration of the said period of 18 months, a request is made to the Controller for an extension of time, the application shall, on payment of the prescribed fee, be continued for any period so requested not exceeding in all three months from the expiration of the said period of 18 months.

(Advertisement on acceptance of application)

6. On the acceptance of an application the Controller shall give notice thereof to the applicant and shall advertise the acceptance; and the application and specifications with the drawing (if any) shall be open to public inspection.

(Effect of acceptance of application)

7. After the acceptance of an application and until the date of sealing a patent in respect thereof, or the expiration of the time for sealing, the applicant shall have the like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance of the application:

Provided that the applicant shall not be entitled to institute any proceedings for infringement until the patent has been sealed.

8. *[Repealed]*

(Opposition to grant of patent)

9.—(1) Any person may, on payment of the prescribed fee, at any time within four months from the date of the advertisement of the acceptance of an application, give notice at the Patent Office of opposition to the grant of the patent on any of the following grounds, namely:—

(a) that the applicant obtained the invention from him, or from a person of whom he is the legal representative or assignee, or

(b) that the invention has been claimed in any specification filed in Pakistan which is or will be of prior date to the patent, the grant of which is opposed; or

(c) that the nature of the invention or the manner in which it is to be performed is not sufficiently or fairly described and ascertained in the specifications; or

(d) that the invention has been publicly used in any part of Pakistan or has been made publicly known in any part of Pakistan; or

(e) that the complete specification describes or claims an invention other than that described in the provisional specification and that such other invention either forms the subject of an application made by the

opponent for a patent which if granted would bear a date in the interval between the date of the application and the leaving of the complete specification, or has been made available to the public by publication in any document published in Pakistan in that interval; but on no other ground.

(2) Where such notice is given, the Controller shall give notice of the opposition to the applicant, and shall, on the expiration of those four months, after hearing the applicant and the opponent, if desirous of being heard, decide on the case.

(3) The decision of the Controller shall be subject to appeal to the Federal Government.

(Grant and sealing of patent)

10.—(1) If there is no opposition, or, in a case of opposition, if the determination is in favour of the grant of a patent, a patent shall, on payment of the prescribed fee, be granted subject to such conditions (if any) as the Federal Government thinks expedient, to the applicant, or in the case of a joint application to the applicants jointly, and the Controller shall cause the patent to be sealed with the seal of the Patent Office.

(1A) Notwithstanding anything contained in subsection (1), where—

(a) an applicant has agreed in writing that on the grant to him of a patent he will assign it to another party or to a joint applicant and refuses to proceed with the application, or

(b) disputes arise between joint applicants as to proceeding with an application,

the Controller, if he is satisfied of the existence of such agreement, or, in any other case, that any joint applicant or applicants ought to be allowed to proceed alone, may direct that such other party or joint applicant or applicants may proceed with the application accordingly and may grant a patent to him or them, as the case may be:

Provided that—

(i) the Controller shall not give any such direction until every party interested has had an opportunity of being heard by him, and

(ii) an appeal from any such direction shall lie to the Federal Government.

(2) A patent shall be sealed as soon as may be, and not after the expiration of 24 months from the date of application:—

Provided that—

(a) where the Controller has allowed an extension of the time within which an application may be accepted, a further extension of four months after the said 24 months shall be allowed for the sealing of the patent;

(b) where the sealing is delayed by an appeal to the Federal Government or by opposition to the grant of the patent or by any proceedings taken for obtaining a direction of the Controller under the provisions of subsection (1A) the patent may be sealed at such time as the Controller may direct;

(c) where the patent is granted to the legal representative of an applicant who has died before the expiration of the time which would otherwise be allowed for sealing the patent, the patent may be sealed at any time within 12 months after the date of his death or at such later time as the Controller may think fit;

(d) where for any reason a patent cannot be sealed within the period allowed by any of the foregoing provisions of this Section, that period may, on payment of the prescribed fee and on compliance with the prescribed conditions, be extended to the extent applied for but not exceeding three months.

(Date of patent)

11. Except as otherwise expressly provided by this Act, a patent shall be dated and sealed as of the date of application:

Provided that no proceedings shall be taken in respect of an infringement committed before the advertisement of the acceptance of the application.

(Effect, extent and form of patent)

12.—(1) A patent sealed with the seal of the Patent Office shall, subject to the other provisions of this Act, confer on the patentee the exclusive privilege of making, selling and using the invention throughout Pakistan and of authorizing others so to do.

(2) Every patent may be in the prescribed form and shall be granted for one invention only, but the specification may contain more than one claim; and it shall not be competent for any person in a suit or other proceeding to take any objection to a patent on the ground that it has been granted for more than one invention.

(Fraudulent applications for patents)

13.—(1) A patent granted to the true and first inventor or his legal representative or assignee shall not be invalidated by an application in fraud of him, or by protection obtained thereon or by any use or publication of the invention subsequent to that fraudulent application during the period of protection.

(2) Where a patent has been revoked by the High Court on the ground that it has been obtained in fraud of the true and first inventor, or where the grant of a patent has been refused by the Controller under Section 9 on the ground stated in clause (a) of sub-section (1) of that Section, the Controller may, on the application of the true inventor or his legal representative or assignee made in accordance with the provisions of this Act, grant to him a patent for the whole or any part of the invention, and the patent so granted shall bear the same date as the patent so revoked or, in the case of a patent the grant of which has been refused, the same date as would have been borne by the patent if it had been granted:

Provided that no suit shall be brought for any infringement of the patent so granted committed before the actual date when such patent was granted.

(Single patent for cognate inventions)

13A.—(1) Where the same applicant has put in two or more provisional specifications for inventions which are cognate or modifications one of the other, and has obtained thereby concurrent provisional protection for the same, and the Controller is of opinion that the whole of such inventions are such as to constitute a single invention and may properly be included in one patent, he may allow one complete specification in respect of the whole of such applications and grant a single patent thereon.

(2) Such patent shall bear the date of the earliest of such applications, but in considering the validity of the same, and in determining other questions under this Act, the Court or the Controller, as the case may be, shall have regard to the respective dates of the provisional specifications relating to the several matters claimed in the complete specification.

Term of Patent

(Term of patent)

14.—(1) The term limited in every patent for the duration thereof shall, save as otherwise expressly provided by this Act, be 16 years from its date.

(2) A patent shall, notwithstanding anything therein or in this Act, cease if the patentee fails to pay the prescribed fees within the prescribed times:

Provided that where the patentee, before, or within three months after, the expiration of the time for payment, applies to the Controller for an extension of time the patent shall, on payment of such additional fee as may be prescribed, be continued or revived, as the case may be, for any period so applied for not exceeding in all three months from the expiration of the time for payment.

(3) If any proceeding is taken in respect of an infringement of the patent committed after a failure to pay any fee within the prescribed time, and before any enlargement thereof, the Court before which the proceeding is taken, may, if he thinks fit, refuse to award any damages in respect of such infringement.

(Extension of term of patent)

15.—(1) A patentee may present a petition to the Federal Government praying that his patent may be extended for a further term; but such petition must be left at the Patent Office at least six months before the time limited for the expiration of the patent and must be accompanied by the prescribed fee and must be advertised by the patentee within the prescribed time and in the prescribed manner.

(2) Any person may within such time as may be prescribed and on payment of the prescribed fee give notice to the Controller of objection to the extension.

(3) Where a petition is presented under sub-section (1), the Federal Government may, as it thinks fit, dispose of the petition itself or refer it to a High Court for decision.

(4) If the petition be referred to a High Court, then on the hearing of such petition under this Section the patentee, and any person who has given notice under sub-section (2) of objection, shall be made parties to the proceeding, and the Controller shall be entitled to appear and be heard.

(5) The Federal Government or the High Court to which a petition is referred shall in considering the petition have regard to the nature and merits of the invention in relation to the public, to the profits made on the patent and to all the circumstances of the case.

(6) If it appears to the Federal Government or to the High Court when the petition is referred to it, that the patent has not been sufficiently remunerative, the Federal Government or the High Court, as the case may be, may by order extend the term of the patent for a further term not exceeding five or in exceptional cases 10 years or may order the grant of a new patent for such term not exceeding 10 years as may be specified in the order and subject to any restriction, conditions and provisions which the Federal Government or the High Court, as the case may be, may think fit.

(Patents of addition)

15A.—(1) Where a patent for an invention has been applied for or granted, and the applicant or the patentee, as the case may be, applies for a further patent in respect of any improvement in or modification of the invention, he may in his application for the further patent request that the term limited in that patent for the duration thereof be the same as that of the original patent or so much of that term as is unexpired and, if he does so, a patent (hereinafter referred to as a patent of addition) may be granted for such term as aforesaid.

(2) Save as otherwise expressly provided by this Act, a patent of addition shall remain in force as long as the patent for the original invention remains in force, but no longer, and in respect of a patent of addition no fees shall be payable for renewal:

Provided that if the patent for the original invention is revoked, then the patent of addition shall, if the authority by which it is revoked so orders, become an independent patent, and the fees payable, and the dates when they become payable, shall be determined by its date, but its duration shall not exceed the unexpired term of the patent for the original invention.

(3) The grant of a patent of addition shall be conclusive evidence that the invention is a proper subject for a patent of addition, and the validity of the patent shall not be questioned on the ground that the invention ought to have been the subject of an independent patent.

(Restoration of lapsed patent)

16.—(1) Where any patent has ceased owing to the failure of the patentee to pay any prescribed fee within the prescribed time, the patentee may apply to the Controller in the prescribed manner for an order for the restoration of the patent.

(2) Every such application shall contain a statement of the circumstances which have led to the omission of the payment of the prescribed fee.

(3) If it appears from such statement that the omission was unintentional or unavoidable and that no undue delay has occurred in the making of the application, the Controller shall advertise the application in the prescribed manner, and within such time as may be prescribed any person may give notice of opposition at the Patent Office.

(4) Where such notice is given, the Controller shall notify the applicant thereof.

(5) After the expiration of the prescribed period the Controller shall hear the case and, subject to an appeal to the Federal Government, issue an order either restoring the patent subject to any conditions and restrictions deemed to be advisable or dismissing the

application:

Provided that in every order under this Section restoring a patent such provisions as may be prescribed shall be inserted for the protection of persons who may have availed themselves of the subject-matter of the patent after the patent had ceased.

Amendment of Application or Specification

(Amendment of application or specification by Controller)

17.—(1) An applicant or a patentee may at any time, by request in writing left at the Patent Office and accompanied by the prescribed fee, seek leave to amend his application or specification, including drawings forming part thereof, by way of disclaimer, correction or explanation, stating the nature of, and the reasons for, the proposed amendment.

(2) If the application for a patent has not been accepted, the Controller shall determine whether and subject to what conditions (if any) the amendment shall be allowed.

(3) In any other case the request and the nature of the proposed amendment shall be advertised in the prescribed manner and at any time within three months from its first advertisement any person may give notice at the Patent Office of opposition to the amendment.

(4) Where such a notice is given the Controller shall give notice of the opposition to the person making the request, and shall hear and decide the case.

(5) Where no notice of opposition is given, or the person so giving notice of opposition does not appear, the Controller shall determine whether and subject to what conditions, if any, the amendment ought to be allowed.

(6) The decision of the Controller in either case shall be subject to an appeal to the Federal Government.

(7) No amendment shall be allowed that would make the application or specification, as amended, claim an invention substantially larger than, or substantially different from, the invention claimed by the application or specification as it stood before amendment.

(8) Leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in case of fraud; and the amendment shall be advertised in the prescribed manner, and shall in all Courts and for all purposes be deemed to form part of the application or specification.

(9) This Section shall not apply when and so long as any suit for infringement or proceeding before a Court for the revocation of the patent is pending.

(Amendment of specification by the Court)

18. In any suit for infringement of a patent or proceeding before a Court for the revocation of a patent the Court may by order allow the patentee to amend his specification by way of disclaimer, correction or explanation in such manner and subject to such terms as to costs, advertisement or otherwise, as the Court may think fit:

Provided that no amendment shall be so allowed that would make the specification, as amended, claim an invention substantially larger than, or substantially different from, the invention claimed by the specification as it stood before the amendment, and where an application for such an order is made to the Court, notice of the application shall be given to the Controller, and the Controller shall have the right to appear and be heard.

(Restriction on recovery of damages)

19. Where an amendment of a specification by way of disclaimer, correction or explanation has been allowed under this Act, no damages shall be given in any suit in respect of the use of the invention before the date of the decision allowing the amendment unless the patentee establishes to the satisfaction of the Court that his original claim was framed in good faith and with reasonable skill and knowledge.

Register of Patents

(Register of Patents)

20.—(1) There shall be kept at the Patent Office a book called the Register of Patents, wherein shall be

entered the names and addresses of grantees of patents, notifications of assignments and of transmissions of patents, of licenses under patents, and of amendments, extensions, and revocations of patents and such other matters affecting the validity or proprietorship of patents as may be prescribed.

(2) The Register of Inventions and address book existing at the commencement of this Act shall be incorporated with, and form part of, the Register of Patents under this Act.

(3) The Register of Patents shall be *prima facie* evidence of any matters by this Act directed or authorized to be inserted therein.

(4) Copies of deeds, licenses and any other documents affecting the proprietorship in any patent or in any license thereunder, must be supplied to the Controller in the prescribed manner for filing in the Patent Office.

Government

(Patent to bind Government)

21.—(1) Subject to the other provisions of this Section, a patent shall have to all intents the like effect as against the Government as it has against any person.

(2) The officers or authorities administering any department of the Government may, by themselves or by such of their agents, contractors or others as may be authorized in writing by them in this behalf at any time after the application, and after giving notice to the applicant or patentee, make, use or exercise the invention for the service of Government on such terms as may, either before or after the use thereof, be agreed on, with the approval of the Federal Government, between such officers or authorities and the applicant or patentee, or, in default of agreement, as may be settled in the manner hereinafter provided. And the terms of any agreement or license concluded between the applicant or patentee and any person other than such officers or authorities, shall be inoperative so far as concerns the making, use or exercise of the invention by, or for Government.

(3) Where an invention which is the subject of any patent has, before the date of the patent, been duly recorded in a document by, or tried by or on behalf of, the officers or authorities administering any department of the Government (such invention not having been communicated directly or indirectly by the applicant or patentee), such officers or authorities, or such of their agents, contractors, or others, as may be authorized in writing by them, may, after giving notice to the applicant or patentee, make, use or exercise the invention so recorded or tried for Government free of any royalty or other payment to the applicant or patentee, notwithstanding the existence of the patent. If, in the opinion of such officers or authorities, the disclosure to the applicant or patentee, as the case may be, of the document recording the invention, or the evidence of the trial thereof, if required, would be detrimental to the public interest, it may be made confidentially to counsel on behalf of the applicant or patentee, or to any independent expert mutually agreed upon.

(4) In the event of any dispute as to the making, use, or exercise of an invention under this Section, or the terms therefor, or as to the existence or scope of any record or trial as aforesaid, the matter shall be referred to the High Court for decision, who shall have power to refer the whole matter or any question or issue of fact arising thereon to be tried before a special or official referee or an arbitrator upon such terms as it may direct. The Court, referee or arbitrator, as the case may be, may, with the consent of the parties, take into consideration the validity of the patent for the purposes only of the reference and for the determination of the issues between the applicant or patentee and such officers or authorities. The Court, referee, or arbitrator, further, in settling the terms as aforesaid, shall be entitled to take into consideration any benefit or compensation which the applicant or patentee, or any other persons interested in the patent, may have received directly or indirectly from Government or from such officers or authorities in respect of such patent:

Provided that, if the inventor or patentee is a Government servant and the subject-matter of the invention is certified by the Federal Government or

Provincial Government to be connected with work done in the course of such service, any such dispute shall be settled by the Federal Government after hearing the applicant or patentee and any other person having an interest in the invention or patent.

(5) The right to use an invention for the services of the Government under the provisions of this Section, or any provisions for which this Section is substituted, shall include, and shall be deemed always to have included, the power to sell any articles made in pursuance of such right which are no longer required for the services of the Government.

(6) Nothing in this Section shall affect the right of the Government or of any person deriving title directly or indirectly from the Government to sell or use any articles forfeited under any law for the time being in force relating to customs or excise.

(Assignment of patent to the Federal Government)

21A.—(1) The inventor of any improvement in instruments or munitions of war may (either for or without valuable consideration), assign to the Federal Government all the benefits of the invention and of any patent obtained or to be obtained for the invention; and the Federal Government may be a party to the assignment.

(2) The assignment shall effectually vest the benefit of the invention and the patent in the Federal Government and all covenants and agreements therein contained for keeping the invention secret and otherwise shall be valid and effectual (notwithstanding any want of valuable consideration), and may be enforced accordingly by or on behalf of the Federal Government.

(3) Where any such assignment has been made, the Federal Government may, at any time before the publication of the specification, certify to the Controller that, in the interest of the public service, the particulars of the invention and of the manner in which it is to be performed should be kept secret.

(4) If the Federal Government so certify, the application and specifications, with the drawings (if any) and

any amendment of the specification and any copies of such documents and drawings, shall, instead of being left in the ordinary manner at the Patent Office, be delivered to the Controller in a packet sealed by authority of the Federal Government.

(5) The packet shall, until the expiration of the term during which a patent for the invention may be in force, be kept sealed by the Controller, and shall not be opened save under the authority of an order of the Federal Government.

(6) The sealed packet shall be delivered at any time during the continuance of the patent to any person authorized by the Federal Government to receive it, and shall, if returned to the Controller, be again kept sealed by him.

(7) On the expiration of the term of the patent, the sealed packet shall be delivered to the Federal Government.

(8) Where the Federal Government certifies as aforesaid after an application for a patent has been left at the Patent Office but before the publication of the specification, the application and specifications, with the drawings (if any), shall be forthwith placed in a packet sealed by authority of the Controller, and the packet shall be subject to the foregoing provisions respecting a packet sealed by authority of the Federal Government.

(9) No proceeding by petition or otherwise shall lie for revocation of a patent granted for an invention in relation to which a certificate has been given by the Federal Government as aforesaid.

(10) No copy of any specification or other document or drawing, by this Section required to be placed in a sealed packet, shall in any manner whatever be published or open to the inspection of the public but, save as otherwise provided in this Section, the provisions of this Act, shall apply in respect of any such invention and patent as aforesaid.

(11) The Federal Government may at any time waive the benefit of this Section with respect to any particular invention, and the specifications, documents and drawings shall be thenceforth kept and dealt with in the ordinary way.

(12) The communication of any invention for any improvement in instruments or munitions of war to the Federal Government or to any person or persons authorized by the Federal Government to investigate the same or the merits thereof, shall not, nor shall anything done for the purposes of the investigation, be deemed use or publication of such invention so as to prejudice the grant or validity of any patent for the same.

Compulsory Licenses and Revocation

(Compulsory licenses and revocation)

22.—(1) Any person interested may present a petition to the Federal Government, which shall be left at the Patent Office, together with the prescribed fee, alleging that the demand for a patented article in Pakistan is not being met to an adequate extent and on reasonable terms and praying for the grant of a compulsory license, or, in the alternative, for the revocation of the patent.

(2) The Federal Government shall consider the petition, and if the parties do not come to an arrangement between themselves the Federal Government may, as it thinks fit, either dispose of the petition itself or refer it to a High Court for decision.

(3) The provisions of sub-section (4) of Section 15, prescribing the procedure to be followed in the case of references to the Court under that Section, shall apply in the case of references made to the Court under this Section.

(4) If the Federal Government is of opinion, or, where a reference has been made under sub-section (2) to a High Court, that Court finds that the demand for the patented article in Pakistan is not being met to an adequate extent and on reasonable terms, the patentee may be ordered to grant licenses on such terms as the Federal Government or the High Court, as the case may be, may think just, or, if the Federal Government or the High Court is of opinion that the demand will not be adequately met by the grant of licenses, the patent may be revoked by order of the Federal Government or the High Court:

Provided that an order of revocation shall not be made before the expiration of four years from the date of

the patent, or if the patentee gives satisfactory reasons for his default.

(5) For the purposes of this Section the demand for a patented article shall not be deemed to have been met to an adequate extent and on reasonable terms—

(a) if by reason of the default of the patentee to manufacture to an adequate extent and supply on reasonable terms the patented article, or any parts thereof which are necessary for its efficient working, or to carry on the patented process to an adequate extent or to grant licenses on reasonable terms, any existing trade or industry or the establishment of any new trade or industry in Pakistan is unfairly prejudiced or,

(b) if any trade or industry in Pakistan is unfairly prejudiced by the conditions attached by the patentee to the purchase, hire or use of the patented article or to the using or working of the patented process.

(Revocation of patents worked outside Pakistan)

23.—(1) At any time not less than four years after the date of a patent granted under this Act, any person may apply to the Federal Government for relief under this Section on the ground that the patented article or process is manufactured or carried on exclusively or mainly outside Pakistan.

(2) The Federal Government shall consider the application, and, if after inquiry, it is satisfied—

(a) that the allegations contained therein are correct; and

(b) that the applicant is prepared, and is in a position, to manufacture or carry on the patented article or process in Pakistan; and

(c) that the patentee refuses to grant a license on reasonable terms;

then, subject to the provisions of this Section, and unless the patentee proves that the patented article or process is manufactured or carried on to an adequate extent in Pakistan, or gives satisfactory reasons why the article or process is not so manufactured or carried on, the Federal Government may make an order—

(a) revoking the patent either—

(i) forthwith; or

(ii) after such reasonable interval as may be

specified in the order unless in the meantime it is shown to its satisfaction that the patented article or process is manufactured or carried on within Pakistan to an adequate extent; or

(b) ordering the patentee to grant a license to the applicant which may be a license exclusive to him or otherwise as the Federal Government may direct.

(3) No order revoking a patent shall be made under the last sub-section which is at variance with any treaty, convention, arrangement or engagement with any foreign country.

(4) The Federal Government may, on the application of the patentee, extend the time limited in any order made under sub-section (2), clause (ii), for such period not exceeding two years as it may specify in a subsequent order, or revoke any order made under sub-section (2), clause (ii), or any subsequent order if sufficient cause is in its opinion shown by the patentee.

(Operation of order under Section 22 or Section 23)

23A. An order of the High Court under Section 22 or of the Federal Government under Section 22 or Section 23, directing the grant of any license, shall, without prejudice to any other method of enforcement, operate as if it were embodied in a deed granting a license and executed by the patentee and all other necessary parties.

(Power of Controller to revoke surrendered patent)

24. A patentee may at any time, by giving notice in the prescribed manner to the Controller, offer to surrender his patent, and the Controller may, if after giving notice of the offer and hearing all parties who desire to be heard he thinks fit, accept the offer, and thereupon make an order for the revocation of the patent.

(Revocation of patent on public grounds)

25. A patent shall be deemed to be revoked if the Federal Government declares, by notification in the Official Gazette, the patent or the mode in which it is exercised to be mischievous to the State or generally prejudicial to the public.

Legal Proceeding

(Petition for revocation of patent)

26.—(1) Revocation of a patent in whole or in part may be obtained on petition to or on a counter claim in a suit for infringement before a High Court on all or any of the following grounds, namely:—

(a) that the invention has been the subject of a valid prior grant of a patent in Pakistan;

(b) that the true and first inventor or his legal representative or assignee was not the applicant or one of the applicants for the patent;

(c) that the patent was obtained in fraud of the rights, or the person applying for the revocation or of any person under or through whom he claims;

(d) that the invention was not, at the date of the patent, a manner of new manufacture or improvement;

(e) that the invention does not involve any inventive step, having regard to what was known or used prior to the date of the patent;

(f) that the invention is of no utility;

(g) that the complete specification does not sufficiently and fairly describe and ascertain the nature of the invention and the manner in which the invention is to be performed;

(h) that the complete specification does not sufficiently and clearly ascertain the scope of the invention claimed;

(i) that the patent was obtained on a false suggestion or representation;

(j) that the primary or intended use or exercise of the invention is contrary to law;

(k) that the patentee has contravened, or has not complied with the conditions contained in the patent;

(l) that the complete specification does not disclose the best method of performance of the invention known to the applicant for the patent at the time when the specification was left at the Patent Office;

(m) that prior to the date of the patent, the patentee or other persons (not being authorities administering any department of Government or the agents or contractors of, or any other persons authorized in that behalf by, the Federal Government) secretly worked the invention on a commercial scale (and not merely by way

of reasonable trial or experiment) in Pakistan, and thereby made direct or indirect profits in excess of such amount as the Court may in consideration of all the circumstances of the case deem reasonable;

(n) that the invention claimed in the complete specification is not the same as that contained in the provisional specification, and that the invention claimed, so far as it is not contained in the provisional specification, was not new at the date when the complete specification was filed;

Provided that this sub-section shall have effect in relation to the ground of revocation specified—

- (i) in clause (b), subject to the provisions of Section 78A, or
- (ii) in clause (d), subject to the provisions of sub-section (1) of Section 13, sub-section (12) of Section 21A, Section 38 and Section 40.

(2) A petition for revocation of a patent may be presented—

(a) by the Advocate General or any person authorized by him; or

(b) by any person alleging—

- (i) that the patent was obtained in fraud of his rights or of the rights of any person under or through whom he claims; or
- (ii) that he, or any person under or through whom he claims, was the true and first inventor of any invention included in the claim of the patentee; or
- (iii) that he, or any person under or through whom he claims an interest in any trade, business or manufacture had publicly manufactured, used or sold, within Pakistan before the date of the patent, anything claimed by the patentee as his invention.

(3) The High Court may, irrespective of any provisions of the Code of Civil Procedure, 1908 (V of 1908) in his behalf, require any person, other than the Advocate General or any person authorized by him, applying for the revocation of a patent to give security for the payment of all costs incurred or likely to be incurred by any person appearing to oppose the petition.

(Notice of proceedings to persons interested)

27.—(1) Notice of any petition for revocation of a patent under Section 26 shall be served on all persons appearing from the register to be proprietors of that patent or to have shares or interest therein, and it shall not be necessary to serve the notice on any other person.

(2) The notice shall be deemed to be sufficiently served if a copy thereof is sent by post in a registered letter directed to the person and place for the time being stated in the register.

(Framing issue for trial before other Courts)

28.—(1) A High Court may, if it thinks fit, direct an issue for the trial, before itself or any other High Court, or any District Court, of any question arising upon a petition to itself under Section 26, and the issue shall be tried accordingly.

(2) If the issue is directed to another High Court, the finding shall be certified by that Court to the High Court directing the issue.

(3) If the issue is directed to a District Court, the finding of that Court shall not be subject to appeal, but the evidence taken upon the trial shall be recorded and a copy thereof, certified by the Judge of the Court, shall be transmitted, together with any remarks which he may think fit to make thereon, to the High Court directing the issue, and the High Court may thereupon act upon the finding of the District Court, or dispose of the petition upon the evidence recorded, or direct a new trial, as the justice of the case may require.

(Suits for infringement of patents)

29.—(1) A patentee may institute a suit in a District Court having jurisdiction to try the suit against any person who during the continuance of a patent acquired by him under this Act in respect of an invention, makes, sells or uses the invention without his license, or counterfeits it, or imitates it:

Provided that where a counter claim for revocation

of the patent is made by the defendant, the suit, along with the counter claim, shall be transferred to the High Court for decision.

(2) Every ground on which a patent may be revoked under Section 26 shall be available by way of defence to a suit for infringement.

(Exemption of innocent infringer from liability for damages)

30. A patentee shall not be entitled to recover any damages in respect of any infringement of a patent granted after the commencement of this Act from any defendant who proves that at the date of the infringement he was not aware, nor had reasonable means of making himself aware, of the existence of the patent and the marking of an article with the word "patent," "patented," or any word or words expressing or implying that a patent has been obtained for the article, stamped, engraved, impressed on, or otherwise applied to the article, shall not be deemed to constitute notice of the existence of the patent unless the word or words are accompanied by the year and number of the patent:

Provided that nothing in this Section shall affect any proceeding for an injunction.

(Order for inspection, etc. in suit)

31. In a suit for infringement of a patent, the Court may, on the application of either party, make such order for an injunction, inspection of account, and impose such terms and give such directions respecting the same and the proceedings thereon, as the Court may see fit.

(Certificate of validity questioned and costs thereon)

32. In a suit for infringement of a patent the Court may certify that the validity of the patent came in question, and if the Court so certifies, then in any subsequent suit in that Court for infringement of the same patent the plaintiff, on obtaining a final order or judgement in his favour, shall, unless the Court trying the suit otherwise directs, have his full costs, charges

and expenses of and incidental to the said suit properly incurred.

(Transmission of decree and orders to the Controller)

33. A Court making a decree in a suit under Section 29 or an order on a petition under Section 26 shall send a copy of the decree or order, as the case may be, to the Controller, who shall cause an entry thereof and reference thereto to be made in the Register of Patents.

(Power of High Court to stay proceedings, etc.)

34. A High Court to which a petition has been presented under Section 26 may stay proceedings on or dismiss the petition if in its opinion the petition would be disposed of more justly or conveniently by another High Court.

(Hearing with assessor)

35.—(1) In a suit or proceeding for infringement or revocation of a patent, the Court may, if it thinks fit, and shall on the request of all the parties to the proceedings, call in the aid of an assessor specially qualified, and try the case wholly or partially with his assistance.

(2) A Court exercising appellate jurisdiction in respect of such suit or proceeding may, if it thinks fit, call in the aid of an assessor as aforesaid.

(3) The remuneration, if any, to be paid to an assessor under this Section shall in every case be determined by the Court and be paid by it as part of the expenses of the execution of this Act.

(Grant of relief in respect of particular claims)

35A. Notwithstanding anything contained in Section 19, if the Court in any action for infringement of a patent finds that any one or more of the claims in the specification in respect of which the infringement is alleged are valid, it may, subject to its discretion as to costs and as to the date from which damages should be reckoned and to such terms as to amendment as it may deem desirable, grant relief in respect of any of such

claims which are infringed without regard to the invalidity of any other claim in the specification. In exercising such discretion the Court may take into consideration the conduct of the parties in inserting such invalid claims in the specification or permitting them to remain there.

(Remedy in case of groundless threats of legal proceedings)

36. Where any person claiming to have an interest in a patent by circulars, advertisements or otherwise, threatens any other person with any legal proceedings or liability, in respect of any alleged infringement of the patent, any person aggrieved thereby may bring a suit against him in a District Court having jurisdiction to try the suit, and may obtain an injunction against the continuance of such threats, and may recover such damages (if any) as he has sustained thereby, if the alleged infringement to which the threats related was not in fact an infringement of the patent:

Provided that this Section shall not apply if an action for infringement of the patent is commenced and prosecuted with due diligence.

Miscellaneous

(Grant of patents to two or more persons)

37. Where, after the commencement of this Act, a patent is granted to two or more persons jointly, they shall, unless otherwise specified in the patent, be treated, for the purpose of the devolution of the legal interest therein as joint tenants, but, subject to any contract to the contrary, each of such persons shall be entitled to use the invention for his own profit without accounting to the others, but shall not be entitled to grant a license without their consent, and, if any such person dies, his beneficial interest in the patent shall devolve on his legal representatives.

(Public use or knowledge of invention)

38. The public use or knowledge of an invention in Pakistan before the date of the application for a patent thereon shall not invalidate the patent granted thereon if

the knowledge has been obtained surreptitiously or in fraud of the true and first inventor or his legal representative or assignee or has been communicated to the public in fraud of such inventor or his legal representative or assignee or in breach of confidence:

Provided that such inventor or his legal representative or assignee has not acquiesced in the public use of his invention, and that he applies for a patent within six months after the commencement of such use.

(Disconformity)

38A. A patent shall not be held to be invalid on the ground that the complete specification claims a further or different invention to that contained in the provisional, if the invention therein claimed, so far as it is not contained in the provisional, was novel at the date when the complete specification was put in, and the applicant for the patent was the true and first inventor thereof, or the legal representative or assignee of such inventor.

(Loss or destruction of patent)

39. If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the Controller, the Controller may at any time, on payment of the prescribed fee, seal a duplicate thereof.

(Provisions as to exhibitions and readings before learned societies)

40. The exhibition of an invention at an industrial or other exhibition to which the provisions of this Section have been extended by the Federal Government by notification in the Official Gazette, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention or the publication of any description thereof, during or after the period of the holding of the exhibition, by any person elsewhere without the privity or consent of the inventor or the reading of a paper by an inventor before a learned society, or the publication of that paper in the society's transactions shall not prejudice the right of the inventor to apply for and obtain a patent in respect of

the invention, or the validity of any patent granted on the application:

Provided that—

(a) the exhibitor exhibiting the invention or the inventor reading the paper or authorizing the publication thereof, as the case may be, gives to the Controller previous notice in the prescribed form; and

(b) application for a patent is made before or within six months from the date of first exhibiting the invention or of the reading of the paper, as the case may be or when it has not been so read, of the said publication.

(Models to be furnished to the National Museum of Pakistan)

41. The National Museum of Pakistan may at any time require a patentee to furnish it with a model or sample of his invention on payment to the patentee of the cost of the manufacture of the model or sample, the amount to be settled, in case of dispute, by the Federal Government.

(Foreign vessels in Pakistan waters)

42.—(1) A patent shall not prevent the use of an invention for the purposes of the navigation of a foreign vessel within the jurisdiction of any Court in Pakistan, or the use of an invention in a foreign vessel within that jurisdiction, provided it is not used therein for or in connection with the manufacture or preparation of anything intended to be sold in or exported from Pakistan.

(2) This Section shall not extend to vessels of any foreign State of which the laws do not confer corresponding rights with respect to the use of inventions in Pakistan vessels while in the ports of that State or in the waters within the jurisdiction of its Courts.

Part II: Designs

Registration of Designs

(Application for registration of designs)

43.—(1) The Controller may, on the application of any person claiming to be the proprietor of any new or original design not previously published in Pakistan, register the design under this Part.

(2) The application must be made in the prescribed form and must be left at the Patent Office in the prescribed manner and must be accompanied by the prescribed fee.

(3) The same design may be registered in more than one class and, in case of doubt as to the class in which a design ought to be registered, the Controller may decide the question.

(4) The Controller may, if he thinks fit, refuse to register any design presented to him for registration; but any person aggrieved by any such refusal may appeal to the Federal Government.

(5) An application which, owing to any default or neglect on the part of the applicant, has not been completed so as to enable registration to be effected within the prescribed time shall be deemed to be abandoned.

(6) A design when registered shall be registered as of the date of the application for registration.

(Registration of design in new classes)

44. Where a design, has been registered in one or more classes of goods, the application of the proprietor of the design to register it in some one or more other classes shall not be refused, nor shall the registration thereof be invalidated—

(a) on the ground of the design not being a new or original design, by reason only that it was so previously registered; or

(b) on the ground of the design having been previously published in Pakistan, by reason only that it has been applied to goods of any class in which it was so previously registered:

Provided that such subsequent registration shall not extend the period of copyright in the design beyond that arising from previous registration.

(Certificate of registration)

45.—(1) The Controller shall grant a certificate of registration to the proprietor of the design when registered.

(2) The Controller may, in case of loss of the original certificate, or in any other case in which he deems it expedient, furnish one or more copies of the certificate.

(Register of Designs)

46.—(1) There shall be kept at the Patent Office a book called the Register of Designs, wherein shall be entered the names and addresses of proprietors of registered designs, notifications of assignments and of transmissions of registered designs, and such other matters as may be prescribed.

(2) The Register of Designs existing at the commencement of this Act shall be incorporated with and form part of the Register of Designs under this Act.

(3) The Register of Designs shall be *prima facie* evidence of any matters by this Act directed or authorized to be entered therein.

Copyright in Registered Designs

(Copyright in Registered Designs)

47.—(1) When a design is registered, the registered proprietor of the design shall, subject to the provisions of this Act, have copyright in the design during five years from the date of registration.

(2) If before the expiration of the said five years application for the extension of the period of copyright is made to the Controller in the prescribed manner, the Controller shall, on payment of the prescribed fee, extend the period of copyright for a second period of

five years from the expiration of the original period of five years.

(3) If before the expiration of such second period of five years application for the extension of the period of copyright is made to the Controller in the prescribed manner, the Controller may, subject to any rules under this Act, on payment of the prescribed fee, extend the ~~period of copyright for a third period of five years from the expiration of the second period of five years.~~

(Requirements before delivery on sale)

48.—(1) Before delivery on sale of any articles to which a registered design has been applied, the proprietor shall—

(a) (if exact representations or specimens were not furnished on the application for registration) furnish to the Controller the prescribed number of exact representations or specimens of the design; and, if he fails to do so, the Controller may erase his name from the register, and thereupon the copyright in the design shall cease; and

(b) cause each such article to be marked with the prescribed mark, or with the prescribed words or figures, denoting that the design is registered; and, if he fails to do so, the proprietor shall not be entitled to recover any penalty or damages in respect of any infringement of his copyright in the design unless he shows that he took all proper steps to ensure the marking of the article, or unless he shows that the infringement took place after the person guilty thereof knew or had received notice of the existence of the copyright in the design.

(2) Where a representation is made to the Federal Government by or on behalf of any trade or industry that in the interest of the trade or industry it is expedient to dispense with or modify as regards any class or description of articles any of the requirements of this Section as to marking, the Federal Government may, if it thinks fit, by rule under this Act, dispense with or modify such requirements as regards any such class or description of articles to such extent and subject to such conditions as it thinks fit.

(Effect of disclosure on copyright)

49. The disclosure of a design by the proprietor to any other person, in such circumstances as would make it contrary to good faith for that other person to use or publish the design, and the disclosure of a design in breach of good faith by any person other than the proprietor of the design, and the acceptance of a first and confidential order for goods bearing a new or original textile design intended for registration, shall not be deemed to be a publication of the design sufficient to invalidate the copyright thereof if registration thereof is obtained subsequently to the disclosure or acceptance.

(Inspection of registered designs)

50.—(1) During the existence of copyright in a design, or such shorter period not being less than two years, from the registration of the design as may be prescribed, the design shall not be open to inspection except by the proprietor or a person authorized in writing by him, or a person authorized by the Controller or by the Court, and furnishing such information as may enable the Controller to identify the design, and shall not be open to the inspection of any person except in the presence of the Controller, or of an officer acting under him and on payment of the prescribed fee, and the person making the inspection shall not be entitled to take any copy of the design, or of any part thereof:

Provided that, where registration of a design is refused on the ground of identity with a design already registered, the applicant for registration shall be entitled to inspect the design so registered.

(2) After the expiration of the copyright in a design, or such shorter period as aforesaid the design shall be open to inspection, and copies thereof may be taken by any person on payment of the prescribed fee.

(3) Different periods may be prescribed under this Section for different classes of goods.

(Information as to existence of copyright)

51. On the request of any person furnishing such

information as may enable the Controller to identify the design, and on payment of the prescribed fee, the Controller shall inform such person whether the registration still exists in respect of the design, and, if so, in respect of what classes of goods, and shall state the date of registration, and the name and address of the registered proprietor.

(Cancellation of registration)

51A.—(1) Any person interested may present a petition for the cancellation of the registration of a design—

(a) at any time after the registration of the design, to the High Court on any of the following grounds, namely:—

(i) that the design has been previously registered in Pakistan; or

(ii) that it has been published in Pakistan prior to the date of registration; or

(iii) that the design is not a new or original design;
or

(b) within one year from the date of the registration, to the Controller on either of the grounds specified in sub-clauses (i) and (ii) of clause (a).

(2) An appeal shall lie from any order of the Controller under this Section to the High Court, and the Controller may at any time refer any such petition to the High Court, and the High Court shall decide any petition so referred.

(Registration of designs to bind the Government)

51B. The provisions of Section 21 shall apply to registered designs as if those provisions were reenacted herein and in terms made applicable to registered designs.

Industrial and International Exhibitions

(Provisions as to exhibitions)

52. The exhibition of a design, or of any article to which a design is applied, at an industrial or other exhibition to which the provisions of this Section have been

extended by the Federal Government by notification in the Official Gazette, or the publication of a description of the design, during the period of the holding of the exhibition, or the exhibition of the design or the article or the publication of a description of the design by any person elsewhere during or after the period of the holding of the exhibition, without the privity or consent of the proprietor, shall not prevent the design from being registered or invalidate the registration thereof:

Provided that—

(a) the exhibitor exhibiting the design or article, or publishing a description of the design, gives to the Controller previous notice in the prescribed form; and

(b) the application for registration is made within six months from the date of first exhibiting the design or article or publishing a description of the design.

Legal Proceedings

(Piracy of registered design)

53.—(1) During the existence of copyright in any design it shall not be lawful for any person—

(a) for the purpose of sale to apply or cause to be applied to any article in any class of goods in which the design is registered the design or any fraudulent or obvious imitation thereof, except with the license or written consent of the registered proprietor, or to do anything with a view to enable the design to be so applied; or,

(aa) to import for the purposes of sale, without the consent of the registered proprietor, any article belonging to the class in which the design has been registered, and having applied to it the design or any fraudulent or obvious imitation thereof; or,

(b) knowing that the design or any fraudulent or obvious imitation thereof has been applied to any article in any class of goods in which the design is registered without the consent of the registered proprietor, to publish or expose or cause to be published or exposed for sale that article.

(2) If any person acts in contravention of this Section, he shall be liable for every contravention—

(a) to pay to the registered proprietor of the design a sum not exceeding 500 rupees recoverable as a contract debt, or

(b) if the proprietor elects to bring a suit for the recovery of damages for any such contravention, and for an injunction against the repetition thereof, to pay such damages as may be awarded and to be restrained by injunction accordingly:

Provided that the total sum recoverable in respect of any one design under clause (a) shall not exceed 1,000 rupees.

(3) When the Court makes a decree in a suit under sub-section (2), it shall send a copy of the decree to the Controller, who shall cause an entry thereof to be made in the Register of Designs.

(Application of certain provisions of the Act as to patents and designs)

54. The provisions of this Act with regard to certificates of the validity of a patent and to the remedy in case of groundless threats of legal proceedings by a patentee shall apply in the case of registered designs in like manner as they apply in the case of patents, with the substitution of references to the copyright in a design for references to a patent, and of references to the proprietor of a design for references to the patentee, and of references to the design for references to the invention.

Part III: General

Patent Office and Proceedings Thereat

(Patent Office)

55.—(1) The Federal Government may provide, for the purposes of this Act, an office which shall be called, and is in this Act referred to as, the Patent Office.

(2) The Patent Office shall be under the immediate control of the Controller of Patents and Designs, who shall act under the superintendence and direction of the Federal Government.

(3) There shall be a seal for the Patent Office.

(4) Any act or thing directed to be done by or to the Controller may be done by or to any officer authorized by the Federal Government.

(Officers and clerks)

56. The Federal Government may appoint the Controller, and so many officers and clerks, with such designations and duties, as it thinks fit.

Fees

(Fees)

57.—(1) There shall be paid in respect of the grant of patents and the registration of designs, and applications therefor, and in respect of other matters with relation to the patents and designs under this Act, such fees as may be prescribed by the Federal Government.

(2) A proceeding in respect of which a fee is payable under this Act or the rules made thereunder shall be of no effect unless the fee has been paid.

Provisions as to Registers and Other Documents in the Patent Office

(Notice of trust not to be entered in registers)

58. There shall not be entered in any register kept under this Act, or be receivable by the Controller, any notice of any trust, expressed, implied or constructive.

(Inspection of and extracts from registers)

59. Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to the provisions of this Act: and certified copies, sealed with the seal of the Patent Office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee.

(Information relating to patents)

59A. A person making a request to the Controller in the prescribed manner as respects any patent specified in the request or as respects any application for a patent

so specified, for information to be furnished to him by the Controller of any such matters as may be prescribed affecting that patent or application, shall be entitled, subject to the payment of the prescribed fee, to have information supplied to him accordingly.

(Privilege of reports of Controller)

60. Reports of or to the Controller made under this Act shall not in any case be published or be open to public inspection.

(Prohibition of publication of specification, drawing, etc., where application abandoned, etc.)

61.—(1) Where an application for a patent has been abandoned or deemed to have been refused, the specifications and drawings (if any), accompanying or left in connection with such application, shall not, save as otherwise expressly provided by this Act, at any time be open to public inspection or be published by the Controller.

(2) Where an application for a design has been abandoned or refused, the application and any drawings, photographs, tracings, representations or specimens left in connection with the application shall not at any time be open to public inspection or be published by the Controller.

(Power of Controller to correct clerical errors)

62. The Controller may, on request in writing accompanied by the prescribed fee,—

(a) correct any clerical error in or in connection with an application for a patent or in any patent or any specification;

(b) *{repealed}*

(c) correct any clerical error in the representation of a design or in the name or address of the proprietor of any patent or design, or in any other matter which is entered upon the Register of Patents or the Register of Designs.

(Entry of assignments and transmission in registers)

63.—(1) Where a person becomes entitled by assignments, transmission or other operation of law to a patent or to the copyright in a registered design, he may make application to the Controller to register his title, and the Controller shall, on receipt of such application and on proof of title to his satisfaction, register him as the proprietor of such patent or design, and shall cause an entry to be made in the prescribed manner in the register of the assignment, transmission or other instrument affecting the title.

(2) Where any person becomes entitled as mortgagee, licensee or otherwise to any interest in a patent or registered design, he may make application to the Controller to register his title, and the Controller shall, on receipt of such application and on proof of title to his satisfaction, cause notice of the interest to be entered in the prescribed manner in the Register of Patents or Designs, as the case may be, with particulars of the instrument, if any, creating such interest.

(3) The person registered as the proprietor of a patent or design shall, subject to the provisions of this Act and to any rights appearing from the register to be vested in any other person, have power absolutely to assign, grant licenses as to, or otherwise deal with, the patent or design and to give effectual receipts for any consideration for any such assignment, license or dealing:

Provided that any equities in respect of the patent or design may be enforced in like manner as in respect of any other movable property.

(4) Except in the case of an application made under Section 64, a document or instrument in respect of which no entry has been made in the register in accordance with the provisions of sub-sections (1) and (2) shall not be admitted in evidence in any Court in proof of the title to a patent or to copyright in a design or to any interest therein, unless the Court for reasons to be recorded in writing otherwise directs.

(Rectification of register)

64.—(1) The Controller may, on the application in

the prescribed manner of any person aggrieved by the non-insertion in or omission from the Register of Patents or Designs of any entry, or by any entry made in either such register without sufficient cause, or by any entry wrongly remaining on either such register, or by an error of defect in any entry in either such register, make such order for making, expunging or varying such entry as he thinks fit and rectify the register accordingly.

(2) The Controller may in any proceeding under this Section decide any question that it may be necessary or expedient to decide in connection with the rectification of a register.

(3) An appeal shall lie to the High Court from any order of the Controller under this Section; and the Controller may refer any application under this Section to the High Court for decision, and the High Court shall dispose of any application so referred.

(4) Any order of the Court rectifying a register shall direct that notice of the rectification be served on the Controller in the prescribed manner who shall upon the receipt of such notice rectify the register accordingly.

(5) Nothing in this Section shall be deemed to empower the Controller—

(a) to rectify the Register of Patents, or to decide any question relating to a patent, otherwise than for the purpose of correcting a mistake of fact apparent from a reference either to the patent itself or to some order of a competent authority made under any other provisions of this Act, or

(b) to make any such order cancelling the registration of a design as is provided for in Section 51A.

Powers and Duties of Controller

(Powers of Controller in proceedings under Act)

65. Subject to any rules in this behalf, the Controller in any proceedings before him under this Act shall have the powers of Civil Court for the purpose of receiving evidence, administering oaths, enforcing the attendance of witnesses, compelling the discovery and production of documents, issuing commissions for the examining of witnesses and awarding cost and such award shall be

executable in any Court having jurisdiction as if it were a decree of that Court.

(Publication of patented inventions)

66. The Controller shall issue periodically a publication of patented inventions containing such information as the Federal Government may direct.

(Exercise of discretionary power by Controller)

67. Where any discretionary power is by or under this Act given to the Controller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of an application or of a specification, or for registration of a design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard.

(Power of Controller to take directions of the Federal Government)

68. The Controller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to the Federal Government for directions in the matter.

(Refusal to grant patent, etc., in certain cases)

69.—(1) The Controller may refuse to grant a patent for an invention or to register a design, of which the use would, in his opinion, be contrary to law or morality.

(2) An appeal shall lie to the Federal Government from an order of the Controller under this Section.

(Appeals to the Federal Government)

70.—(1) Where an appeal is declared by this Act to lie from the Controller to the Federal Government, the appeal shall be made within three months of the date of the order passed by the Controller, and shall be in writing, and accompanied by the prescribed fee.

(2) In calculating the said period of three months the time (if any) occupied in granting a copy of the order appealed against shall be excluded.

(3) The Federal Government may, if it thinks fit, obtain the assistance of an expert in deciding such appeals, and the decision of the Federal Government shall be final.

Evidence, etc.

(Evidence before the Controller)

70A. Subject to any rules made under Section 77, in any proceeding under this Act before the Controller, the evidence shall be given by affidavit, in the absence of directions by the Controller to the contrary but in any case on which the Controller thinks it right so to do he may take evidence *viva voce* in lieu of or in addition to evidence by affidavit or may allow any party to be cross-examined on the contents of his affidavit.

(Certificate of Controller to the evidence)

71. A certificate purporting to be under the hand of the Controller as to any entry, matter or thing which he is authorized by this Act, or any rules made thereunder, to make or do, shall be *prima facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone.

(Evidence of documents in Patent Office)

71A. Printed or written copies or extracts, purporting to be certified by the Controller and sealed with the seal of the Patent Office, of or from patents, specifications and other documents in the Patent Office, and of or from registers and other books kept there, shall be admitted in evidence in all Courts in Pakistan, and in all proceedings, without further proof or production of the originals:

Provided that a Court may, if it has reason to doubt the accuracy or authenticity of the copies tendered in evidence, require the production of the originals or such further proof as it considers necessary.

(Transmission of copies of specifications, etc. and inspection thereof)

72. Copies of all such specifications, drawings and amendments left at the Patent Office, as become open to public inspection under the provisions of this Act, shall be transmitted, as soon as may be, after the printed copies thereof are available, to such authorities as the Federal Government may appoint in this behalf, and shall be open to the inspection of any person at all reasonable times at places to be appointed by those authorities and approved by the Federal Government.

(Application and notices by post)

73. Any application, notice or other document authorized or required to be left, made or given at the Patent Office or to the Controller, or to any other person under this Act, may be sent by post.

(Declaration by infant, lunatic, etc.)

74.—(1) If any person is, by reason of infancy, lunacy or other disability, incapable of making any statement or doing anything required or permitted by or under this Act, the lawful guardian, committee or manager (if any) of the person subject to the disability, or if there be none, any person appointed by any Court possessing jurisdiction in respect of his property, may make such statement or a statement as nearly corresponding thereto as circumstances permit and do such thing in the name and on behalf of the person subject to the disability.

(2) An appointment may be made by the Court for the purposes of this Section upon the petition of any person acting on behalf of the person subject to the disability or of any other person interested in the making of the statement or the doing of the thing.

(Security for costs)

74A. Where a person giving notice of any opposition under this Act or giving notice to the Court of Appeal for any decision of the Controller under this Act, neither

resides nor carries on business in Pakistan, the Controller or the Court, as the case may be, may require such person to give security for the payment of all costs incurred and likely to be incurred in the proceedings or appeal, as the case may be, and, in default of such security being given, may disallow the opposition or dismiss the appeal.

Agency

(Subscription and verification of certain documents)

75. The following documents, namely,—

- (1) applications for a patent,
- (2) notices of opposition,
- (3) applications for extension of term of a patent,
- (4) applications for the restoration of lapsed patents,
- (5) applications for leave to amend,
- (6) applications for compulsory license or revocation, and
- (7) notices of surrenders of patent,

shall be signed and verified, in the manner prescribed, by the person making such applications or giving such notices:

Provided that, if such person is absent from Pakistan, they may be signed and verified on his behalf by an agent resident in Pakistan authorized by him in writing in that behalf.

(Agency)

76.—(1) All other applications and communications to the Controller under this Act may be signed by, and all attendances upon the Controller may be made by or through a legal practitioner or by or through an agent authorized to the satisfaction of the Controller.

(2) The Controller may, if he sees fit, require—

- (a) any such agent to be resident in Pakistan;
- (b) any person not residing in Pakistan to employ an agent residing in Pakistan;
- (c) the personal signature or presence of any applicant, opponent or other person.

Powers, etc., of Federal Government

(Power for Federal Government to make rules)

77.—(1) The Federal Government may make such rules, as it thinks expedient, subject to the provisions of this Act—

(a) for regulating the practice of registration under this Act;

(b) for classifying goods for the purpose of designs;

(c) for making or requiring duplicates of specifications, drawings and other documents;

(d) for securing and regulating the publishing and selling of copies, at such prices and in such manner as the Federal Government thinks fit, of specifications, drawings and other documents;

(e) for securing and regulating the making, printing, publishing and selling of indexes to, and abridgments of, specifications and other documents in the Patent Office; and providing for the inspection of indexes and abridgments and other documents;

(ee) for the manner in which fees leviable under this Act may be paid;

(eee) for ensuring secrecy with respect to patents to which Section 21A applies;

(f) generally for regulating the business of the Patent Office, the conduct of proceedings before the Controller, and all things by this Act placed under the direction or control of the Controller or of the Federal Government; and

(g) generally for the purpose of carrying into effect the provisions of this Act.

(2) The power to make rules under this Section shall be subject to the condition of the rules being made after previous publication.

(2A) Nothing in sub-section (2) shall apply in the case of rules made for the purpose specified in clause *(eee)* of sub-section (1); and any such rules may modify any of the provisions of this Act so far as may be necessary for that purpose.

(3) All rules made under this Section shall be published in the Official Gazette, and on such publication shall have effect as if enacted in this Act.

*Offences***(Wrongful use of words "Patent Office")**

78. If any person uses on his place of business or on any document issued by him, or otherwise, the words "Patent Office," or any other words suggesting that his place of business is officially connected with, or is, the Patent Office, he shall be punishable with a fine which may extend to 200 rupees, and, in the case of a continuing offence, with a further fine of 20 rupees, for each day on which the offence is continued after conviction therefor.

(Reciprocal arrangements with foreign countries)

78A.—(1) Where the Federal Government has made an arrangement with the Government of any foreign State for mutual protection of inventions or designs, any person who has applied for protection for any invention or design in that State, or his legal representative or assignee, shall, either alone or jointly with any other person, be entitled to claim that the patent that may be granted to him under this Act, for the said invention, or the registration of the said design under this Act, shall be in priority to other applicants and shall have the same date as the date of the application in that State:

Provided that—

(a) the application is made, in the case of a patent, within 12 months, and, in the case of a design, within six months, from the application for protection in the foreign State; and

(b) nothing in this Section shall entitle the patentee or the proprietor of the design to recover damages for infringements happening prior to the actual date on which, in the case of a patent, his application is accepted, or, in the case of a design, the design is registered, in Pakistan.

(2) The patent granted for an invention or the registration of a design shall not be invalidated—

(a) in the case of a patent, by reason only of the publication of a description of, or use of, the invention, or

(b) in the case of a design, by reason only of the

exhibition or use of, or the publication of a description, or representation of, the design, in Pakistan during the period specified in this Section as that within which the application may be made.

(3) The application for the grant of a patent or the registration of a design under this Section must be made in the same manner as an ordinary application under this Act:

Provided that, in the case of a patent,—

(a) the application shall be accompanied by a complete specification; and

(b) if the application is not accepted within 18 months from the date of the application for protection in the foreign State, the specification shall, with the drawing (if any) supplied therewith, be open to public inspection at the expiration of that period.

(4) Where it is made to appear to the Federal Government that a foreign State has made satisfactory provision for the protection of inventions or designs patented or registered in Pakistan, the Federal Government may, by notification in the Official Gazette, direct that the provisions of this Section, with such variations or additions, if any, as may be set out in such notification, shall apply for the protection of inventions or designs patented or registered in that State.

Savings and Repeal

(Savings for prerogative)

79. Nothing in this Act shall take away, abridge or prejudicially affect the prerogative of the Federal Government in relation to the granting of any letters patent or to the withholding of a grant thereof.

80. *[Repealed]*

81. *[Repealed]*

ANNEX II

**THE PATENTS AND DESIGNS RULES,
1933**

55

CHAPTER II

(1)

PATENTS AND DESIGNS RULES, 1933¹*(As amended up to the 3rd March, 1961)*

Notification No. A197, Dated the 2nd February 1933.—In exercise of the powers conferred by sub-section (1) of section 57 and sub-section (1) of section 77 of the Patents and Designs Act, 1911 (II of 1911), the Central Government is pleased to make the following rules, the same having been previously published as ²required by sub-section (2) of the last named section, namely :—

PRELIMINARY

1.—(1) These rules may be called the ⁴Patents and Designs Rules, 1933.

Short title,
extent³ and
commence-
ment.

⁵(2) They extend to ⁶the whole of Pakistan.

⁷(3) They shall come into force on the 1st April 1933.

¹ These Rules were published in Part II of the *Gazette of India*, dated the 11th February 1933, under the late Department of Industries and Labour Notification No. A197, dated the 2nd February 1933. For subsequent amendments, see the late Department of Industries and Labour notifications, No. A197, dated the 16th January, 1935, published in Part II of the *Gazette of India*, dated the 26th January, 1935 No. A197, dated the 11th December 1935, published in Part II of the *Gazette of India*, dated the 14th December, 1935, and No. A75, dated the 26th May 1937, published in Part I of the *Gazette of India*, dated the 29th May 1937; Department of Commerce Notifications No. 209-S. & I. (2)/38, dated the 31st March 1939, published in Part I of the *Gazette of India*, dated the 1st April 1939, and No. 223, Ind.-(9)/41-A, dated the 6th September 1941; published in Part I of the *Gazette of India*, dated the 6th September 1941; the late Department of Industries and Civil Supplies Notifications No. 205-I. R. (1)/A-44, dated the 15th April 1944, published in Part I, section 1 of the *Gazette of India*, dated the 15th April 1944, No. 218-I. R. (1)/44, dated the 31st August, 1944, published in Part I, section 1 of the *Gazette of India*, dated the 2nd September 1944; No. 223-I. R. (7)/45, dated the 6th October, 1945, published in Part I section 1. of the *Gazette of India*, dated the 6th October, 1945; and Department of Industries and Supplies Notification No. 223-I. R. (34)/45, dated the 15th June 1946, published in Part I, section 1 of the of *Gazette of India*, dated the 15th June 1946.

² In the *Gazette of India*, Part II, dated the 2nd April, 1932.

³ The word "extent" was inserted by Department of Commerce, Notification, No. 223-Ind. (9) 41-A, dated the 6th September, 1941, see *Gazette of India*, Part I dated the 6th September, 1941.

⁴ The word "Indian" has been deleted from the title "Indian Patents and Designs" Rules, 1933, by Ministries of Industries, Notification No. 19(6)/S. & D. 11/55 dated 26th December, 1956.

⁵ This sub-rule (2) was inserted by Department of Commerce Notification No. 223-Ind. (9)/41-A, dated the 6th September, 1941, see *Gazette of India*, Part I, dated the 6th September, 1941.

⁶ The words "the whole of Pakistan" were substituted by Ministry of Industries Notification No. 19 (6)/S. & D. 11/55, dated 26th December, 1956.

⁷ The figure and brackets "(3)" were substituted for the original figure and brackets "(2)" by late Deptt. of Commerce Notfn. No. 23 Ind. (9)/41-A, dated the 6th September, 1941.

Definitions.

2.—In these rules, unless there is anything repugnant in the subject or context,—

- (a) "Act" means the ¹Patents and Designs Act, 1911 ;
- (b) "British Application" means an application by any person for the protection, in any part of Her Majesty's dominions other than ¹⁰Pakistan of an invention ²or a design, as the case may be, for the protection of which in ¹Pakistan the provisions of section 78A of the Act are for the time being applicable ;
- (c) "Controller" means the Controller of Patents and Designs appointed under section 56 of the Act, and includes any officer appointed to act for him ;
- (d) "Office" means the Patent Office provided under section 55 of the Act ;
- (e) "Reciprocity Application" means an application in ¹Pakistan under section 78A of the Act ;
- (f) "Set" means a number of articles of the same general character ordinarily on sale together or intended to be used together, all bearing the same design, with or without modifications not sufficient to alter the character or substantially to affect the identity thereof.

¹ Leaving and serving documents.

3.—(1)⁴ Any application, notice or other document authorised or required to be left, made or given at the Office, or to the Controller ⁵or to any other person under the Act or these rules, may be sent by hand, or by a prepaid letter through the post, and, if sent by a prepaid letter shall be deemed to have been left, made or given at the time when the letter containing the same would be delivered in the ordinary course of post. In proving such sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

(2)⁶ Any written communication addressed to a patentee or to a registered proprietor of a design at his address as it appears on the register of patents⁷ or register of designs,⁸ as the case may be, or at his address for service,⁹ or to any applicant or opponent in any proceeding under the Act or these rules, at the address appearing on the application or notice of opposition, or given for service as hereinafter provided,⁹ shall be deemed to be properly addressed.

¹ *Vid:* Ministry of Industries Notification No. 19 (6) S & D II/55, dated the 26th December, 1956.

² The words and comma " or a design, as the case may be " were inserted by, *ibid.*

³ The marginal heading " Leaving and serving documents " was substituted for the original marginal heading " Communications to the Office " by the late Department of Industries and Civil Supplies Notification No. 223-I. R. (7)/45, dated the 6th October, 1945.

⁴ Rule 3 was renumbered as sub-rule (1) of that rule, and sub-rule (2) was inserted by, *ibid.*

⁵ The words " or to any other person under the Act or these rules " were inserted by, *ibid.*

⁶ See footnote 4 above.

⁷ See section 20 page 24.

⁸ See section 46, page 38.

⁹ See Rule 4 of the Patents and Designs Rules, 1933.

¹⁰ *Vid:* foot-note 10 at page 12.

4.—Every applicant or opponent in any proceeding under the Act or these rules, and every person who shall hereafter become a patentee or a registered proprietor of a design, shall give an address for service in ¹Pakistan and such address may be treated, for all purposes connected with the patent or the design as the actual address of such applicant, opponent, patentee or registered proprietor. Unless such an address is given, the Controller shall be under no obligation either to proceed with the application or the opposition, or to send any notice that may be required by the Act or these rules. Address for service.

5.—(1) The fees to be paid in respect of the grant of patents and the registration of designs, and applications therefor, and in respect of other matters with relation to patents and designs under the Act, shall be those specified in the ²First Schedule to these rules, hereinafter referred to as the prescribed fees : Fees.

Provided that no fees shall be payable in respect of any secret patent³, and every such patent, notwithstanding the non-payment of such fees shall remain in force for the full period of 16 years from its date.

(2) (a)⁴ Fees may be paid in cash⁵ at the Office, or may be sent by money order or postal order or cheque ⁶on a scheduled bank ¹as defined in the State Bank of Pakistan Act, 1956 (XXXIII of 1956) payable to the Controller at Karachi, ⁷and if sent through the post shall be deemed to have been paid at the time when the money order, or the properly addressed and prepaid letter containing the cheque or the postal order, would be delivered in the ordinary course of post.

(b)⁴ Cheques not carrying the correct addition for commission, and other cheques on which the full value cannot be collected in cash within the time allowed for payment of the fee, shall be accepted only at the discretion of the Controller.

(c)⁴ Stamps shall not be received in payment of fees.

6.—The forms set forth in the Second Schedule⁸ with such variations as the circumstances of each case require, shall be used for the respective purposes therein mentioned, and if used, shall be sufficient; Forms.

Provided that the Controller may, if he thinks fit, dispense with the use of Form 4⁹ in the case of an application for extension of time under sub-section (2) of section 14 of the Act.

¹ Vide Ministry of Industries Notification No. 19 (6)/S & D II/55, dated 26th December, 1956.

² See pages 79-84.

³ See section 21A of the Act (pages 26-27) and the Secret Patent Rules, 1933 (page 135-136).

⁴ This sub-rule was split up into paragraphs, numbered (a), (b) and (c) by the late Department of Industries and Civil Supplies Notification No. 223-I. R. (7)/45, dated the 6th October, 1945.

⁵ Fees should be paid in Pakistan currency.

⁶ The words and figures "on a scheduled bank II of 1934)" were inserted by the late Department of Industries and Civil Supplies Notification No. 218-I, R. (1)/44, dated the 31st August, 1944.

⁷ The words "and if sent through the post in the ordinary course of post" were inserted by the late Department of Industries and Civil Supplies Notification No. 223-I. R. (7)/45, dated the 6th October, 1945.

⁸ See pages 85-132.

⁹ See page 104.

Size etc., of documents.

7.—(1) All documents and copies of documents, except drawings,¹ sent to or left at the Office or otherwise furnished to the Controller, shall be written, typewritten, lithographed, or printed in the English language (unless otherwise directed), in large and legible characters with deep permanent ink upon one side only of strong white paper of a size of approximately 13 inches by 8 inches, with a margin of at least one inch and a half on the left-hand part thereof. Signatures thereto shall be written in a large and legible hand,² and any signature which is not legible or which is written in a script other than English shall be accompanied by a transcription of the name in English block letters.

(2) Duplicate documents shall be filed at the Office, if at any time required by the Controller.

(3) Names and addresses of applicants and other persons shall be given in full, together with their nationality³ and such other particulars, if any, of caste or calling as are necessary for identification.

Signature and verification of documents specified in section 75 of the Act.
Agency

8.—The documents specified in section 75 of the Act shall be dated and signed at the foot, and shall contain a statement that the facts and matters stated therein are true to the best of knowledge, information and belief of the person signing them.

9.—For all matters falling under the provisions of section 76 of the Act, any person may, unless otherwise directed by the Controller, authorise, under his personal signature, any other person to act as his agent and to receive all notices, requisitions and communications. The authority may be given on Form 31.⁴

PATENTS

Applications⁵ for Grant of Patents

Applications.

10.—(1) If the true and first inventor or any applicant for a patent is in the service of ⁶Pakistan, ⁷he shall disclose that fact in the application and shall state the office which he holds.

¹ See Rules 15-18 of the Patents and Designs Rules, 1933, pages 62-63.

² The words "and any signature.....in English block letters" were substituted for the words "and a vernacular signature shall be accompanied by a transcription in English", by Department of Industries and Supplies Notification No. 223-I. R. (34)/45, dated the 15th June 1946.

³ For Instructions, see paragraph 30 (c), Part II.

⁴ This form is liable to stamp duty. See footnote (b) on Form 31, page 132.

⁵ Forms 1, 1A, 1B, 1C, 1AC, 1BC, 1CC, 2, 2A, 2C, 2AC : Fee—see footnote 3 on page 9. Application for Secret patent, Form 1D ; see section 21A, pages 26-27 and the Secret Patent Rules, 1933, pages 135-136.

⁶ Vide Ministry of Industries Notification No. 19 (6)/S. & D. II/55, dated 26th December, 1956.

⁷ For regulations regarding Government servants employed in the Defence Services, or in the Pakistan Navy, or in the Pakistan Air Force, or on scientific or technical research or in the Railway Services, see pages 155-164.

(2) If the true and first inventor is not a party to an application for a patent, the applicant shall, except in the case of reciprocity applications,¹ produce the original deed of assignment² or other document from such true and first inventor, under which he is enabled to apply for a patent, unless the application³ itself is endorsed³ by the true and first inventor in the presence of two witnesses with a statement that the said inventor agrees that the application shall be made without his name as an applicant for a patent.

(3) If an application for a patent is made by the legal representative of a deceased inventor, the legal representative shall produce for inspection the probate of the will or the letters of administration of the estate of the inventor or a certified copy of such probate or letters, or such other evidence of his title as the Controller may require.

11.—(1) Every reciprocity application⁴ for a patent shall contain a declaration that a British application⁶ has been made for protection of the invention to which such reciprocity application relates, and shall specify every part of Her Majesty's dominions⁷ in which any such British application has been made and the official date or dates thereof respectively. The application shall be made within twelve months from the date of the first British application, * * *⁹ by the person by whom such first British applications was made or by his legal representative or assignee * * *¹⁰ either alone or jointly with any other person.

Reciprocity
application.

(2) If a reciprocity application is made by an assignee of the person who made the British application the applicant shall produce the original deed of assignment¹² or other document from such person, under which he is enabled to apply for a patent, unless the application itself is endorsed¹³ in the presence of two witnesses by the person who made the British application with a statement to the effect that the applicant is his assignee.

¹ For reciprocity applications, see Rule 11 (pages 59-60).

² No form is prescribed under the Patents and Designs Rules, 1933, for drawing up deeds of assignment.

³ Forms 1A (pages 88-89) and 1AC (pages 92-93). See the prescribed form of "endorsement" embodied in these Forms.

⁴ Forms 2, 2A, 2C and 2AC (pages 96-101).

⁵ The words "for a patent" were inserted by the late Department of Industries and Civil Supplies Notification No. 223-I. R. (7)/45, dated the 6th October, 1945.

⁶ For definition of the expression "British application", see Rule 2(b) of the Patents and Designs Rules, 1933 (page 56).

⁷ See page 138.

⁸ Vide Ministry of Industries Notification No. 19(6)/S. & D. II/55, dated 26th December, 1956.

⁹ The words "and shall be signed" were deleted by the late Department of Industries and Civil Supplies Notification No. 223-I. R. (7)/45, dated the 6th October, 1945.

¹⁰ The words "or by an agent resident in British India authorised in that behalf" were deleted by, *ibid.*

¹¹ The words "either alone or jointly with any other person" were inserted by, *ibid.*

¹² See foot note 2 above.

¹³ Forms 2A (page 97-98) and 2AC (page 100-101). See the prescribed form of endorsement" embodied in these Forms.

(3) If a reciprocity application is made by the legal representative of a deceased person who made the British application, the legal representative shall produce for inspection the probate of the will or the letters of administration of the estate of the deceased person or a certified copy of such probate or letters, or such other evidence of his title as the Controller may require.

(4) In addition to the specification left with every reciprocity application, a copy or copies of the specification or specifications, and drawings or documents filed or deposited by the applicant or his predecessor in title, as the case may be, in respect of the first British application, duly certified by the official chief or head of the Patent Office in which they were filed or deposited, or otherwise verified to the satisfaction of the Controller, shall be left at the Office at the same time as the reciprocity application or within such further time, not exceeding three months,¹ as the Controller may allow.

(5) If any specification or other document relating to the application is in a foreign language, a translation thereof shall be annexed thereto and shall be verified to the satisfaction of the Controller.

(6) Save as aforesaid and as provided by rule 50, all proceedings in connection with a reciprocity application shall be taken within the time and in the manner required by the Act or prescribed by these rules for ordinary applications.

Order of recording applications,

12.—Applications shall, on receipt by the Controller, be numbered² and dated in the order of their receipt.

SPECIFICATIONS³

Specification

13.—(1)⁴ Every specification, whether provisional⁵ or complete,⁶ shall commence with the title⁷ of the invention and the name of the applicant as in the application, and shall be signed and dated at the end by the applicant or his agent. Every complete specifications⁶ shall end with a clear and succinct statement of the invention claimed,⁸ distinct from the body of the specification.

¹ Form 4 (page 104) ; Fee, Rs. 15 for one month, Rs. 30 for 2 months, Rs. 45 for 3 months.

² *Vide* Ministry of Industries Notification No. 19 (6)/S. & D. II/55, dated 26th December, 1956.

³ Form 3 (page 102) for Provisional Specification ; and Form 3A (page 103) for Complete Specification. For guidance in drafting the specification, see Chapter XIV, Part II.

⁴ This sub-rule (1) was substituted for the original sub-rule (1), by Department of Industries and Supplies Notification No. 223-I. R. (34)/45, dated the 15th June, 1946.

⁵ See footnote 10 on page 9.

⁶ See footnote 1 on page 10.

⁷ See Instructions in paragraphs 33-(A) Part II.

⁸ See Instructions in paragraphs 39-40, Part II.

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(2) ¹A specification in respect of a patent of addition² shall contain a specific reference to the number³ of the main patent, and a definite statement that the invention comprises an improvement in, or a modification of, the invention claimed in the specification of the main patent.

(3) Where the invention is capable of representation by drawings, such drawings shall be prepared⁴ in accordance with rules 15 to 18 and shall be supplied with, and referred to in detail in, the specification :

⁵Provided that in the case of a complete specification if the applicant desires to adopt the drawings lodged with his provisional specification as the drawings or part of the drawings for the complete specification, it shall be sufficient to refer to them in the complete specification as those left with the provisional specification.

(4) Irrelevant or other matter, not necessary, in the opinion of the Controller, for elucidation of the invention, shall be excluded from the title, description, ⁶claims and drawings.

14.—(1) When ⁷a specification, or any drawing accompanying it, is defective and requires amendment,⁸ one copy shall be returned to the applicant or his agent and all alterations shall be made thereon as far as possible. Additional matter may be interpolated, if necessary, by rewriting such pages as are required to form a continuous document. Amendments shall not be made by slips pasted on, or as footnotes, or by writing in the margin.

Amendments
how to be
made.

(2) The amended documents shall be returned to the Controller together with the superseded pages or drawings, if any, duly marked, cancelled and initialled by the applicant or his agent, and with a duplicate of any pages that have been retyped or added and of any drawings that have been added or substantially amended. Amendments, alterations or additions shall be initialled in the margin by the applicant or his agent.

(3) No amendments, alterations or additions shall be made in a document returned for amendment, beyond those necessary to comply with the requirements of the Controller.

¹ The words " A specification " were substituted for the words " The specification " by Department of Industries and Supplies Notification No. 223-I. R. (34)/45, dated the 15th June 1946.

² See section 15A of the Act, pages 20-21.

³ See Rule 24 page 65.

⁴ See also special instructions in paragraph 38, Part II.

⁵ This proviso was added by Department of Industries and Supplies Notification No. 223-I. R. (34)/45, dated the 15th June 1946.

⁶ See Special instructions in paragraphs 33-(C) and 34-(B), Part II.

⁷ The words, " a specification " were substituted for the words " the specification ", by Department of Industries and Supplies Notification No. 223-I. R. (34)/45, dated the 15th June 1946.

⁸ Unless the requirements are satisfactorily met as to allow of acceptance of the applications within 18 months of the date of the application (or 21 months with an extra fee of Rs. 30 and a request on Form 4, page 104), the application will be deemed to have been refused, see section 5 (4) of the Act, pages 13-14.

General.

15.—(1) Drawings,¹ when furnished shall accompany² the specification to which they refer. No drawing or sketch, such as would require the preparation for the printer of a special illustration for use in the letter press of the specification when printed, shall appear in the specification itself.

(2) Drawings shall be delivered flat or so rolled as to be free from creases.

(3) At least one copy of the drawings shall be suitable for reproduction,³ and for that purpose, shall be prepared on tracing cloth or on smooth white paper which is not opaque.

Size of drawings and arrangement of figures.

16.—(1) Drawings shall be on sheets which measure 13 inches from top to bottom and are either from 8 inches to 8½ inches or from 16 inches to 16½ inches wide, the narrower sheets being preferable. A clear margin shall be left half an inch from the edges of the sheet.

(2) If there are more figures than can be shown on one of the smaller sized sheets, two or more of these sheets shall be used in preference to employing the larger size. When an exceptionally large figure is required, it shall be continued on subsequent sheets, of which any number that are required but not more than are required, may be employed. The figures shall be numbered consecutively throughout and without regard to the number of sheets. They shall be separated by a sufficient space to keep them distinct.

Drawing to be suitable for reproduction.

17.—Drawings shall be prepared in accordance with the following requirements :—

- (a) They shall be executed with absolutely black ink.
- (b) Each line shall be firmly and evenly drawn, sharply defined and of the same strength throughout.
- (c) Section lines, lines for effect, and shading lines shall be as few as possible, and shall not be closely drawn.
- (d) Shading lines shall not contrast too much in thickness with the general lines of the drawings.
- (e) Sections and shading shall not be represented by solid black or washes.
- (f) They shall be on a scale sufficiently large to show the inventions clearly and only so much of the apparatus, machine, etc., shall appear as effects this purpose. If the scale is given, it shall be drawn and not denoted by words. No dimensions shall be marked on the drawings.
- (g) The figures shall be drawn in an upright position in regard to the top and bottom of the sheet.
- (h) Reference letters and numerals, and index letters and numerals used in conjunction therewith, shall be bold,

¹ For sample drawings and instructions, see paragraph 38, Part II.

² See Proviso to Rule 13 (3), above.

³ See instructions in paragraph 38, Part II.

distinct and not less than one-eighth of an inch in height. The same letters or numerals shall be used to indicate the same parts in different views. Where the reference letters or numerals are shown outside the figure, they shall be connected by fine lines with the parts to which they refer.

18.—(1) Drawings shall bear :—

- (i) in the left hand top corner, the name of the applicant ;
- (ii) in the right hand top corner, the number of the sheets of drawings sent and the consecutive of each sheet ;
- (iii) in the right hand bottom corner, the signature of the applicant or his agent.

Drawings to bear name of applicant, etc., but no descriptive matter.

(2) Neither the title of the invention nor any descriptive matter shall appear on drawings.

19.—The Controller shall advertise the acceptance of every application in the *Gazette of Pakistan*.

Opposition¹ to Grant or Amendment, etc.

20.—Notice¹ of opposition to the grant, or to the amendment, etc., of a patent shall be given in duplicate. One copy of the notice shall be sent by the Controller to the applicant or his agent.

Notice of Opposition.

21.—(1) Within 14 days of giving notice of opposition, the opponent shall leave at the office a full written statement in duplicate, setting out fully the nature of the opponent's interest, the facts upon which he bases his case and the relief which he seeks.

Filing of statements and evidence.

(2) The Controller shall furnish the applicant with a copy of the statement filed by the opponent, and the applicant may leave at the office a reply statement dealing in full with the statement of the opponent and on so leaving shall deliver to the opponent a copy thereof.

(3) The opponent may, after delivery to him of the copy of the applicant's reply, leave at the Office evidence by way of affidavits² in support of his case and on so leaving shall deliver to the applicant a copy thereof.

(4) The applicant may, after delivery to him of the opponent's evidence, leave at the Office evidence by way of affidavits² ; in support

¹ Notice of opposition (Form 6, page 106 fee Rs. 10) may be given under section 9, 15, 16 or 17 of the Act or Rule 33 or 61 of the Patents and Designs Rules, 1933. Preferably the full statement which is required under Rule 21 (1) should accompany the notice. Statements and replies should be drawn up in clear and temperate language, avoiding personalities and side issues which have no bearing on the matter. See also instructions under the heading "Opposition to the grant of a patent" in Chapter XVI, Part II.

² This rule and the marginal heading thereto were substituted for Rule 21 of the Patents and Designs Rules, 1933 by the late Department of Industries and Civil Supplies Notification No. 223-I. R. (7)/45, dated the 6th October, 1945.

³ See Rule 63-B, page 77.

of his case and on so leaving shall deliver to the opponent a copy thereof. The opponent may, after delivery to him of such copy, leave at the Office affidavits¹ in reply and on so leaving shall deliver to the applicant a copy thereof. Such last mentioned affidavits shall be confined to matters strictly in reply.

(5) No further evidence shall be delivered by either party except by leave, or on requisition, of the Controller.

(6) Where a document in a language other than English is referred to in any statement or affidavit filed in connection with an opposition, an attested translation in duplicate shall be furnished.

(7) The time allowed for filing a reply statement or for producing evidence by way of affidavits shall ordinarily be one month.

Hearing.

22.—(1) On completion of these proceedings or at such other time as he may see fit, the Controller shall appoint a time for the hearing of the case, and shall give the parties not less than ten days' notice of such hearing.

(2) If either party desires to be heard, he shall leave Form 72 at the Office.

(3) The Controller may refuse to hear any party who has not left Form 7 prior to the date of hearing.

(4) If either party intends to refer at the hearing to any publication other than a specification already mentioned in the proceedings, he shall give to the other party and to the Controller not less than five days' notice of his intention, together with details of each publication to which he intends to refer.

(5) After hearing the party or parties desirous of being heard or if neither party desires to be heard, then without a hearing, the Controller shall decide the case and notify his decision to the parties.

Sealing³

Sealing.

23.—(1) If an applicant desires to have a patent sealed on his application, he shall, within the period allowed by sub-section (2) of section 10 of the Act, leave at the Office an application on Form 84.

¹ See Rule 63-B, page 77.

² Form 7, page 107; fee, Rs. 15 for each party.

³ A patent cannot be sealed before four months after the date of the advertisement in the *Gazette of Pakistan* of the acceptance of the application. If notice of opposition to the grant has been given, there may be a further delay. When the time for sealing is due, a notice with a copy of Form 8 is sent to the applicant or his agent. This form should then be filled in and returned to the Patent Office accompanied by the fee of Rs. 50. Attempts to obtain sealing prematurely are useless. Until the patent is sealed, the invention is not "a patent" and the inventor cannot bring a suit under section 29 of the Act. The applicant should also note that the time, within which sealing can be effected, is limited with certain exceptions to 24 months from the date of application under section 10 (pages 15-17).

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(2) Where for any reason a patent cannot be sealed within the period allowed, the applicant may apply¹ to the Controller for an extension of the period not exceeding three months. An application for such an extension shall be accompanied by a fee of Rs. 15, Rs. 30, or Rs. 45 for an extension of one, two or three months, respectively.¹

24.—The patent shall be in the form given in the Third Schedule² to these rules, with such modifications as the circumstances of each case may require³ and shall bear the number accorded to the application, ⁴after acceptance.

Form of patent.

Extension⁵

25.—(1) A petition⁵ for the extension of the term of a patent shall set forth clearly the nature and merits of the invention in relation to the public,⁶ the profits made on the patent and all the circumstances of the case.

Extension of terms of patent.

(2) The Controller shall advertise every such petition in the *Gazette of Pakistan*.

(3) Every such advertisement shall state the object of the petition and the address within Pakistan⁷ for service on the patentee of any document requiring service under this rule. It shall also specify that notices of objections shall be lodged on Form 6⁸ within two months from the date of the notification.

(4) Every such petition shall also be advertised by the patentee,⁹ in not less than two newspapers named by the Controller, within 14 days from the date of the notification in the *Gazette* and in the manner described in sub-rule (3). Copies of the newspapers containing these advertisements shall be supplied to the Controller.

(5) The petitioner shall, within three weeks of filing the petition, lodge a duplicate of the petition with two copies of the balance sheet of expenditure and receipts relating to the patent in question, which accounts shall be proved on oath. He shall also, upon receiving two days' notice, give the Controller or any person deputed by him for the purpose, reasonable facilities for inspecting and taking extracts from

¹ Form 4 (page 104) ; Fee, Rs. 15 for an extension of one month ; Rs. 30 for two months ; Rs. 45 for three months.

² See page 133.

³ The words " and shall bear to the earliest of such applications, " were added by Department of Industries and Supplies Notification No. 223-I.R. (34)/45, dated the 15th June 1946.

⁴ The words " after acceptance " were substituted for the words " or if the patent is granted under section 13A of the Act on more than one application, the number accorded to the earliest of such applications " by the Ministry of Industries ; see *Gazette of Pakistan*, dated the 27th April, 1951, Part II, Section I, page 157.

⁵ Form 9 (page 109) ; Fee, Rs. 75.

⁶ The words " the profits made on the patent " were substituted for the words " the profits made by the patentee as such " by the late Department of Industries and Civil Supplies Notification No. 223-I. R. (7)/45, dated the 6th October, 1945.

⁷ Vide Ministry of Industries Notification No. 19(6)/S. & D. II/55, dated 26th December, 1956.

⁸ Form 6 (page 106), Fee, Rs. 10.

⁹ See section 2 (12), page 8.

the books of accounts, by reference to which he proposes to verify the said balance sheet or from which the materials for making up the said balance sheet have been derived.

(6) Any person desirous of opposing the prayer of the petition shall lodge with the Controller a notice on Form 6¹ accompanied by a fee of Rs. 15. Such person shall at the same time serve a copy of such notice upon the petitioner. Such notices shall be lodged and served within two months from the date of the notification of the petition in the *Gazette of Pakistan*.

(7) The petitioner shall, within one week of the receipt of such notice, serve a copy of his petition upon each person giving such notice.

(8) Every person giving such notice as aforesaid shall, within 14 days from the service of the petition upon him, serve upon the petitioner one copy and lodge with the Controller two copies of particulars of the objections upon which he intends to rely against the granting of the prayer of the petition.

(9) Any person who shall not, within the said 14 days, lodge and serve such particulars of objections as aforesaid shall be deemed to have abandoned his opposition.

(10) No person who has delivered such particulars of objections shall be entitled to oppose the granting of the prayer of the petition on any grounds not stated in such particulars.

(11) Any person who has delivered particulars of objections shall be entitled, at his own expense, to obtain copies of the accounts which have been lodged by the petitioner.

(12) The Controller may excuse petitioners and opponents from compliance with any of the requirements of sub-rules (5), (7), (8) and (10) and may give such directions in matters of procedure and practice as he shall consider to be just and expedient.

(13) Service of any document requiring service under this rule may be made by enclosing such document in a prepaid registered letter and posting such letter to the person required to be served at his address for service².

(14) On completion of these proceedings, if any, or at such other time as he may see fit, the Controller shall forward one copy of the documents left by the party or parties to ³the Central Government.

Restoration⁴

26. If the Controller entertains an application⁴ under section 16 of the Act for the restoration of a lapsed patent, he shall advertise it in the *Gazette of Pakistan*.

Restoration
of lapsed
patent.

¹ Form 6 (page 106) ; Fee, Rs. 10.

² See Rule 3, page 56.

³ The words " the Central Government " were substituted for the words " the Governor-General in Council through the Secretary in the Department of Industries and Labour ", by the late Department of Industries and Civil Supplies Notification No. 223-I. R. (7)/45, dated the 6th October, 1945.

⁴ Form 10 (page 110) ; Fee, Rs. 15).

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27.—Notice of opposition¹ to the restoration may be given within six weeks of the advertisement, and the procedure for the disposal of such opposition shall be regulated by the provisions of rules, 20, 21 and 22. Opposition.

228.—(1) In every order of the Controller restoring a patent, provisions shall be inserted for restraining the patentee from commencing or prosecuting any action or other proceeding, and from recovering any damage— Conditions on restoration.

(a) in respect of making, selling or using the invention, or

(b) in respect of selling or using at any time thereafter any article made.

in infringement of the patent between the date of the lapsing of the patent and the date of the order of restoration.

(2) The order shall further provide that if any person within one year after the date thereof makes an application to the Controller for compensation in respect of money, time, or labour expended by the applicant upon the subject matter of the patent, in the *bona fide* belief that such patent had become and continued to be void, it shall be lawful for the Controller after hearing the parties concerned, and subject to an appeal to the ³Central Government to assess the amount of such compensation, if in his opinion the application ought to be granted, and to specify the party by whom and the day on which such compensation shall be paid; and if default shall be made in payment of the sum awarded, then the said patent shall become void, but the sum awarded shall not in that case be recoverable as a debt or damages.

Amendment of application or Specification⁴

29.—A request⁴ under section 17 of the Act for the amendment of an application, or a specification including drawings shall be accompanied by a copy of the application, specification, or drawings showing in red ink the proposed amendment in such a manner as to indicate clearly the alteration desired. Amendment.

30.—If the request relates to an application for a patent which has been accepted, the request and the nature of the proposed amendment shall be advertised by notification in the *Gazette of Pakistan* and in such other manner, if any, as the Controller may in each case direct. The Controller shall also notify all persons whose names, at the time of the request, are entered on the register⁵ as claiming an interest in the patent. Procedure when application for a patent has been accepted.

¹ Form 6 (page 106) : Fee, Rs. 10.

² This rule was substituted for Rule 28 of the Patents and Designs Rules, 1933, by the late Department of Industries and Labour, Notification No. A197, dated the 16th January, 1935.

³ The words "Central Government" were substituted for the words "Governor-General in Council" by the late Department of Industries and Civil Supplies, Notification No. 223-I. R. (7)/45, dated the 6th October, 1945.

⁴ Form 11 (page 111) ; Fee, Rs. 15 before acceptance, or Rs. 30 after acceptance.

⁵ See section 20, page 24.

Opposition. 31.—Rules 20, 21 and 22 shall be applicable to the disposal of any opposition to the amendment, of which notice¹ may be given in accordance with sub-section (3) of section 17 of the Act.

Requirements on amendment. 32.—(1) Where leave to amend is given, the applicant shall, if the Controller so requires, and within a time to be specified by him, leave at the Office a new specification and amended drawings which shall be prepared in the manner prescribed in rules 15 to 18.

(2) Amendments allowed by the Controller, after an application for a patent has been accepted,² shall be advertised by him in the *Gazette of Pakistan*.

Surrender³

Surrender of patents. 33.—(1) If an offer³ is made for the surrender of a ⁴patent under section 24 of the Act, the Controller shall advertise it in the *Gazette of Pakistan* and shall notify all persons whose names, at the time of the offer, are entered on the register⁵ as claiming an interest in the patent.

(2) Notice of opposition¹ to the revocation of a patent offered for surrender shall be given within six weeks of the advertisement, and the procedure for the disposal of such opposition shall be regulated by the provisions of rules, 20, 21 and 22.

DESIGNS⁵

Classification of goods. 34.—(1) For the purposes of the registration of designs and of these rules, goods shall be classified in the manner specified in the Fourth Schedule⁶ hereto.

(2) If any doubt arises as to the class to which any particular description of goods belongs, it shall be determined by the Controller.

Application for Registration⁷

Application. 35.—(1) An application⁷ under section 43 of the Act for the registration of a design shall be accompanied by four copies⁸ of the design and ⁹the application and each of the copies of the design shall be dated and signed by the applicant or his agent.

¹ Form 6 (page 106) ; Fee, Rs. 10.

² See section 5 (4), page 13.

³ Form 12 (page 112) ; Fee, Rs. 15.

⁴ *Vide* Ministry of Industries Notification No. 19(6)/S. & D. II/55, dated 26th December, 1956.

⁵ For instructions regarding designs, see Chapter XIX, Part II.

⁶ See page 134.

⁷ Form 15, 16 or 17 (pages 115—117) : Fee, Rs. 5 for classes 1—12, and Rs. 5 for classes 13 and 14. When the design is to be applied to a set in a class, the fee is Rs. 5.

⁸ See instructions in paragraph 89, Part II.

⁹ The words " the application and each of the copies of the design " were inserted by the late Department of Industries and Civil Supplies Notification No. 223-I. R. (7)/45, dated the 6th October, 1945.

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(2) The application shall state the class¹ in which the design is to be registered, and the article or articles to which the design is to be applied.

(3) If it is desired to register the same design in more than one class, a separate application² shall be made in each class, and the application shall contain the number or numbers of the registration or registrations already effected.

(4) If so required by the Controller, the applicant shall state the purpose for which the article is used and the material or predominating material of which the article is made.

36.—The applicant may, and shall, if required by the Controller in any case so to do, endorse on the application and each of the representation³ a brief statement of the novelty⁴ he claims for his design.

Statement of novelty.

37.—If the Controller in any case so requires, he shall be supplied with one or more representations or specimens of the design in addition to those supplied with the application.

Additional copies or representations or specimens.

38.—(1) The four copies³ of the design required by rule 35 shall be exactly similar drawings, photographs, tracings, or other representations³ of the design or shall be specimens of the design.

Representations.

(2) When a design is to be applied to a set, each of the representations accompanying the application shall show all the various arrangements in which it is proposed to apply the design to the articles included in the set.

(3) Each representation³ of the design whether to be applied to a single article or to a set, shall be on paper of a size 13 by 8 inches (and not on cardboard) and shall appear on one side only of the paper. The figure or figures shall be placed in an upright position on the sheet. When more figures than one are shown, these shall, where possible, be on one and the same sheet, and each shall be designated (e.g., perspective view, front view, side view).

(4) When a design is to be applied to a set,⁵ any doubt whether the given articles do or do not constitute a set shall be determined by the Controller.

(5) If the specimens are not, in the opinion of the Controller, suitable for record in the Office, they shall be replaced by representations.

(6) Where words, letters or numerals are not of the essence of the design, they shall be removed from the representations or specimens; where they are of the essence of the design, the Controller

¹ See Fourth Schedule, page 134.

² Form 15, 16 or 17 (pages 115—117) : Fee, Rs. 5 for classes 1—14. When the design is to be applied to a set in a class, the fee is Rs. 5.

³ See instructions in paragraph 89, Part II.

⁴ See instructions in paragraph 90, Part II.

⁵ For definition of "set", see Rule 2(f), page 56.

may require the insertion of a disclaimer¹ of any right to their exclusive use.

(7) Each representation of a design which consists of a repeating surface pattern shall show the complete pattern and a sufficient portion of the repeat in length and width, and shall not be of less size than 5 by 4 inches.

(8) If the names or representations of living persons appear on a design, the Controller shall, if he so requires, be furnished with consents from such persons before proceeding to register the design. In the case of persons recently dead, the Controller may call for consents from their legal representatives before proceeding with registration of a design on which their names or representations appear.

Reciprocity application for the registration of a design.

238A.—(1) Every reciprocity application³ for the registration of a design shall contain a declaration that a British application⁴ has been made for the protection of the design to which such reciprocity application relates and shall specify every part of⁵ Her Majesty's dominions⁶ in which any such⁴ British application has been made and the official date or dates thereof respectively. The application shall be made within six months from the date of the first British application by the person by whom such first British application was made, or by legal representative or assignee either alone or jointly with any other person.

(2) In addition to the four copies of the design left with every reciprocity application for the registration of a design, a copy of the design filed or deposited by the applicant or his predecessor in title, as the case may be, in respect of the first British application, duly certified by the official Chief or Head of the Patent Office in which it was filed, or deposited or otherwise verified to the satisfaction of the Controller, shall be left at the Office at the same time as the reciprocity application or within such further time not exceeding three months,⁷ as the Controller may allow.

(3) Save as aforesaid and as provided by Rule 52 all proceedings in connection with a reciprocity application shall be taken within the time and in the manner required by the Act or prescribed by these rules for ordinary applications.⁸

Acceptance.

39.—Upon receipt of an application for registration, the Controller shall consider it and may accept it if he considers that there is no objection to the design being registered.

¹ For suitable forms of disclaimers, see paragraph 91, Part II.

² This rule was inserted by the late Department of Industries and Civil Supplies Notification No. 223-I. R. (7)/45, dated the 6th October, 1945.

³ For definition of "reciprocity application", see Rule 2 (b), page 56.

⁴ For definition of "British application", see Rule 2 (b), page 56.

⁵ For list of the countries which have reciprocal arrangements with Pakistan, see pages 139—140 and also paragraph 84, Part II.

⁶ Vide Ministry of Industries Notification No. 19(6) S. & D. II/55, dated 26th December, 1956.

⁷ A request on Form 4 (page 104) accompanied by a fee of Rs. 15 for an extension of one month, Rs. 30 for two months, or Rs. 45 for three months, as the case may be, should be filed for obtaining such further time.

⁸ See Rule 35 and foot-note 7 on page 68.

40.—If on consideration of the application any objections appear to the Controller, a statement of these objections shall be sent to the applicant or his agent in writing and unless within one month the applicant or his agent removes the objection or applies for a hearing,¹ the applicant shall be deemed to have withdrawn his application. Objections.

41.—The decision of the Controller at such hearing as aforesaid shall be communicated in writing to the applicant or his agent who may within one month apply² to the Controller requiring him to state in writing the grounds of his decision and the materials used by him in arriving at the same. Decision of Controller.

42.—Upon receipt of such application,² the Controller shall send to the applicant or his agent such statement as aforesaid in writing, and the date when such statement is sent shall be deemed to be the date of the Controller's decision for the purpose of appeal³. Date of appeal.

43.—An Application which, owing to any neglect or default, of an applicant, has not been completed so as to enable registration to be effected within six months of the date of application, shall be deemed to be abandoned. Non-completion within six months.

Extension of Period⁴

44.—†[Deleted]

Marking of Articles

45.—Before delivery on sale of any articles to which a registered design has been applied, the proprietor of such design shall cause each such article to be marked with the word REGISTERED, or with the abbreviation REGD., or with the abbreviation RD., as he may choose, and also (except in the case of articles to which have been applied designs registered in classes 9, 13⁵ or 14^{6* *}) with the number appearing on the certificate of registration ; Marking of articles before delivery on sale.

⁷Provided that the requirements of this rule and of clause (b) of sub-section (1) of Section 48 of the Act shall be dispensed with as regards—

- (i) textile goods in which the design is printed or woven, other than handkerchiefs ; and
- (ii) articles made of charcoal dust, which are brittle and which are not sold in single pieces.

¹ No form or fee is prescribed.

² Form 18 (page 118), Fee, Rs. 10.

³ See Section 43 (4), page 37 and foot-note 8 on page 37.

⁴ Form 19 (page 119), Fee, Rs. 15.

† This rule was deleted by the late Department of Industries and Civil Supplies Notification No. 223-I. R. (7)/45, dated the 6th October 1945.

⁵ The word " or " was inserted by the late Department of Industries and Labour, Notification No. A-197, dated the 16th January 1935.

⁶ The word and figures " and 15 " were omitted, *ibid.*

⁷ This proviso was substituted for the original proviso (as amended by the late Department of Industries and Labour, Notification No. A-197, dated the 16th January 1935), by the late Department of Industries and Civil Supplies, Notification No. 223-I.R. (7)/45, dated the 6th October 1945.

Inspection and Searches

Inspection
of designs.

46.—Registered designs shall not, except as provided in Section 50 of the Act, be open to inspection until two years after the date of application for registration.

Search under
Section 51.

47.—(1) If any person desires to obtain the information which he is entitled to obtain under Section 51 of the Act, and can furnish the registration number of the design, he [shall lodge with the Controller Form 20,¹ and the Controller shall thereupon furnish him with the information aforesaid.

(2) If the applicant is unable to furnish the registration number of the design, he shall lodge with the Controller Form 21² together with such information as is in his possession, and the Controller shall thereupon cause such search to be made in the class indicated as may be possible on the information supplied, and shall furnish such information as may be obtainable. Where Form 21² is accompanied by a representation or specimen of the design, such representation or specimen shall be furnished in duplicate.

Cancellation³

Cancellation
of
registrations
of designs
under
Section 51A.

48.—(1) An application³ to the Controller for the cancellation of the registration of a design shall be made in duplicate, and shall be accompanied by a statement in duplicate setting out the nature of the applicant's interest and the facts upon which he bases his application.

(2) If the application for the cancellation of the registration of a design is made by a person who is not the registered proprietor, a copy of the application along with the statement shall be transmitted by the Controller to the registered proprietor.

(3) If the registered proprietor intends to oppose⁴ the application, he shall, ⁵within a time to be specified by the Controller, leave at the Office a counter-statement setting out the grounds on which he intends to oppose the application, and shall, within the same time, deliver to the applicant a copy of the counter-statement.

⁶(4) Sub-rules (3) to (6) of Rule 21 and Rule 22 shall apply *mutatis mutandis* to subsequent proceedings on the application.

¹ Fee, Rs. 5.

² Fee, Rs. 15.

³ Form 22 (page 122); Fee, Rs. 10. See instructions under the heading "Cancellation of the Registration" in paragraph 103, Part II.

⁴ No form is prescribed and no fee is necessary.

⁵ The words "within a time to be specified by the Controller" were substituted for the words "within 14 days of his receiving the application or within such further time as the Controller may allow" by the late Department of Industries and Civil Supplies Notification No. 223-I. R. (7)45 dated the 6th October 1945.

⁶ This sub-rule was substituted for original sub-rules (4) to (7) of this rule by, *ibid.*

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GENERAL

¹Register of Patents and Designs

49.—Upon the sealing² of a patent the Controller shall cause to be entered in the Register³ of Patents the name, address and nationality of the patentee as the grantee thereof, the title of the invention, the date of the patent, and the date of the grant thereof, together with the address for service. Entry of grant.

50.—The patent granted on any reciprocity application shall be entered in the register as dated of the official date of the first British application⁵ in respect of which the reciprocity application was made, and the payment of renewal fees⁶ and the expiration of the patent shall be reckoned as from that date. The date of the reciprocity application shall also be entered in the register. Entry in respect of reciprocity application.

51.—Upon payment of the fee⁶ prescribed for the continuance of a patent, the Controller shall cause to be entered in the Register of Patents a record of the date of payment of such fee. Entry of renewal fee.

752.—(1) When a design is accepted, there shall be entered in the Register of Designs, in addition to the particulars required by the Act, the number of the design, the class in which it is registered, the date of filing the application for registration in this country, the reciprocity date, if any, claimed for the registration, and such other matters as would affect the validity or proprietorship of the design Registering designs.

(2) Where the accepted design is one in respect of which a reciprocity date has been allowed, the registration, the extension or the expiration of the copyright in the said design shall be reckoned from such reciprocity date.

53.—If a patentee or a proprietor of a registered design sends to the Controller notice⁸ in respect of an alteration in his name, address or addresses for service, the Controller shall cause the register to be altered accordingly. Alteration of address.

54.—Where a person becomes entitled, by assignment, transmission⁷ or other operation of law, to a patent, or to a copyright in a registered design, or to any interest therein, as mortgagee or licensee, application⁹ shall be made to the Controller for the entry in the register, of his name as proprietor or part proprietor of the patent, or design, or of a notice of such interest, as the case may be. Application for entry of subsequent proprietorship.

¹See Section 20, page 24 and Section 46, page 38, respectively.

²See Section 10, pages 15—17.

³See Section 20, page 24.

⁴For definition see Rule 2 (e) of the Patents and Designs Rules, 1933, page 56.

⁵For definition see Rule 2(b) of the Patents and Designs Rules, 1933, page 56.

⁶See Section 14, pages 18-19 foot-note 3 on page 19, and also entry No. 9 in the First Schedule, page 80.

⁷The original Rule 52 was renumbered as sub-rule (1) of this rule and sub-rule (2) was inserted by the late Department of Industries and Civil Supplies Notification No. 223-I.R. (7)/45, dated the 6th October 1945.

⁸Form 23 (page 123); Fee, Rs. 2.50. No entry can be made in the Register of Patents before a patent is sealed, and in the Register of Designs before a design is accepted for registration.

⁹Form 25 or 26 (pages 125-126). For fee, see foot-note 7 on page 45.

Particulars
in applica-
tions.

55.—An application¹ under Rule 54 shall contain the name, address and nationality of the person claiming to be entitled, together with full particulars of the instrument, if any, under which he claims.

Production
of document
of title and
other proof.

56.—Every assignment, and every other document containing, giving effect to or being evidence of the transmission of a patent or of copyright in a registered design or affecting the proprietorship thereof as claimed by such application shall, unless the Controller otherwise directs, be presented to him together with the application, and he may call for such other proof of title or written consent as he may require for his satisfaction :

Provided that in the case of a document which is a public document, an official or certified copy thereof may be presented.

Form of
entry.

57.—The entry to be made in the registers on a request¹ under rule 54 shall be in the following form :—

“In pursuance of an application received on the_____.

	<u>proprietors</u> <u>licensees</u> <u>mortgagees</u> etc.	by virtue of	<u>assignment</u> <u>license</u> <u>mortgage deed</u> etc.
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dated_____and made between_____of
the one part and_____of the other part.”

Entry of
notification
of documents

58.—An Application² for entry in the registers of notification of any document (not already provided for), purporting to affect the proprietorship of a patent, or of a registered design, shall be accompanied by an attested copy of the document, the accuracy of such copy being certified as the Controller may direct, and the original document shall at the same time be produced and left at the Office if required for further verification.

Hours of
inspection of
registers.

59.—The Registers of Patents and Designs shall be open to the inspection³ of the public at all times on which the Office is open⁴ to the public, except at times when they are required for actual official use.

Rectification
of registers.

60.—If an application⁵ is made for the rectification of the Register of Patents or Designs under Section 64 of the Act, the Controller shall notify all persons whose names, at the time of the application, are entered on the register as claiming an interest in the patent or design, and shall advertise the application in the *Gazette of Pakistan*.

¹From 25 or 26 (pages 125-126). For fee, see foot-note 7 on page 45.

²Form 27 (page 127). For fee, see foot-note 7, on page 45.

³Fee for inspection of the Registers is Rs. 2 in respect of each patent or design. See Section 59 (page 44), and entry No. 33 in the First Schedule, page 52.

⁴See the paragraph headed “The Patent Office : Office Hours” in paragraph 9, Part II.

⁵Form 30 (page 131) : Fee, Rs. 15.

61.—Notice of opposition¹ to any rectification of the Register of Patents or the Register of Designs may be given within six weeks of the advertisement of the application for rectification and the procedure for the disposal of such opposition shall be regulated by the provisions of rules 20, 21 and 22.

Opposition to rectification.

Appeals²

62.—(1) An appeal² to the ³Central Government under any provision of the Act from a decision of the Controller shall be lodged with the Controller in duplicate and shall state fully the reasons for appealing.

Appeals to the ³Central Government

(2) The Controller shall forward one copy of the appeal to the ⁴Central Government * * * who shall notify the appellant of its receipt.

⁵(3) (a) In appeals under Sections 9, 10, (1A), 16 and 17 of the Act, the appellant shall, on lodging the appeal in the manner set forth in sub-rule (1), send a copy of the appeal to the respondent (or to each of the respondents where there are two or more respondents appearing separately), and shall also intimate to the Controller the date of sending of the copy.

(b) Each of the respondents shall acknowledge in writing the receipt of the copy of the appeal. Any respondent may, within one month from the date on which the copy of the appeal is sent to him by the appellant, or within such further time as may be allowed by the Central Government leave at the office a memorandum of objection and on so leaving send a copy thereof to the appellant.

(c) The memorandum of objection shall be strictly confined to matters raised in the appeal memorandum, and shall not deal with any cross objection attacking any portion of the Controller's decision passed against the respondent, such as could have been taken by filing a separate appeal by the respondent.

(d) The memorandum of objection shall be filed in duplicate and the Controller shall forward one copy to the Central Government, who shall notify the respondent of its receipt.

¹Form 6 (page 106) ; Fee, Rs. 10.

²Form 5 (page 105), Fee, Rs. 50.

³See foot-note 3 on page 67.

⁴The words "Central Government" were substituted for the words "Governor-General in Council" by the late Department of Industries and Civil Supplies Notification No. 223-I.R. (7)/45, dated the 6th October 1945; and the words "through the Secretary in the Department of Industries and Labour" which occurred after the words "Governor-General in Council" were omitted by the late Department of Industries and Labour Notification No. A-197, dated the 11th December 1935.

⁵Sub-rules (3) to (5) were substituted for original sub-rules (3) to (8) as amended by the late Department of Industries and Labour Notification No. A-197, dated the 11th December 1935, by the late Department of Industries and Civil Supplies Notification No. 223-I.R. (7)/45, dated the 6th October 1945.

¹(4) On completion of these proceedings, if any, or at such other time as the Central Government may see fit, it shall consider the appeal together with the memorandum of objection, if any, and pass an order determining the case finally, or reminding it for further inquiry and reconsideration by the Controller, or allowing the appeal in part, as it may deem fit. The decision of the Central Government shall be communicated to the Controller and to the parties.

¹(5) Nothing in these rules shall be deemed to affect the discretionary powers of the Central Government to call for explanatory or supplementary statements from the appellant or the respondent if at any time the Central Government is of opinion that such statements are necessary for a fair consideration of the case.

Certificates

Certified
copies of
documents.

63.—Certified copies² of any entry in the registers or certified copies of, or extracts from patents, specifications, disclaimers, affidavits, declarations and other public documents in the Office, or of or from registers and other books kept there, shall be furnished by the Controller on payment of the prescribed fee.²

³ *Information*

Request for
information

³63A. Any person on making a request to the Controller on Form 29A,⁴ shall be entitled to obtain information in respect of any one of the following matters :—

- ⁵(a) When a complete specification following a provisional specification has been left.
- ⁵(aa) When an application for a patent has been accepted or deemed to have been abandoned, or deemed to have been refused.
- (b) When a patent has been sealed, or when the time for sealing has expired.
- (c) When a renewal fee in respect of a patent has been paid.
- (d) When a patent has ceased.
- (e) When any application has been made, or action taken, involving an entry in the Register of Patents or notification in the *Gazette of Pakistan*.

¹Sub-rules (3) to (5) were substituted for original sub-rules (3) to (8) as amended by the late Department of Industries and Labour Notification No. A-197, dated the 11th December 1935, by the late Department of Industries and Civil Supplies Notification No. 223-I.R. (7)/45, dated the 6th October 1945.

²Application should be made on Form 29, page 129. (Fee, Rs. 10). An additional fee of 25 Paisas for every 100 words is also necessary, subject to a minimum of Re. 1. See also Section 59, page 44.

³The heading "Information" and Rule 63A were inserted by the late Department of Industries and Civil Supplies Notification No. 223-I.R. (7)/45, dated the 6th October 1945.

⁴Form 29A (page 130); Fee, Rs. 5 in respect of each of the matters specified in this rule.

⁵Clauses (a) and (aa) were substituted for original clause (a), by the Department of Industries and Supplies Notification No. 223-I. R. (34)/45, dated the 15th June 1946. The said clause (a) read as follows :—

"(a) When an application for a patent has been accepted, or has become void."

77

1 Affidavits

163B.—(1) The affidavits required by the Act and these Rules, or used in any proceedings thereunder, shall be headed in the matter or matters to which they relate, shall be drawn up in the first person and shall be divided into paragraphs consecutively numbered; and each paragraph shall, as far as possible, be confined to one subject. Every affidavit shall state the description and true place of abode of the person making the same, shall bear the name and address of the person leaving it and shall state on whose behalf it is left.

Form, etc. of affidavits.

(2) Affidavits shall be confined to such facts as the deponent is able of his own knowledge to prove, except on interlocutory applications, on which statements of his belief may be admitted, provided that the grounds thereof are stated.

(3) The Affidavits referred to in sub-rule (1) shall be made and subscribed, as follows :—

- (a) in Pakistan² before any court or person having by law authority to receive evidence, or before any officer empowered by such court or person as aforesaid to administer oaths, or before the commanding officer of any military, naval or air force station or ship occupied by troops in the service of Pakistan²;
- (b) in any other part of Her Majesty's dominions, before any court, judge, justice of the peace or any officer authorised by law to administer an oath there for the purpose of a legal proceeding; and
- (c) if made out of Her Majesty's dominions, before a British Minister, or person exercising the functions of a British Minister, or a Consul, Vice-Consul, or other person exercising the functions of a British Consul, or before a notary public, or before a judge or magistrate.

Miscellaneous Powers of the Controller

64.—The time within which a person entitled under Section 67 of the Act to an opportunity of being heard³ shall exercise his option of requiring to be heard shall be one month from the date of a notice which the Controller shall give to such person or his agent before determining the matter with reference to which such person is entitled to be heard. If within that month such person or his agent requires to be heard, the Controller shall appoint a date for the hearing and shall give ten days' notice thereof :

Exercise of discretionary power of Controller.

Provided that if the giving of ten days' notice would cause an application for a patent or for the registration of design⁴ to be deemed to have been refused,⁵ or, as the case may be

¹The heading " Affidavits " and Rule 63B were inserted by the late Department of Industries and Civil Supplies Notification No. 223-I.R. (7)/45, dated the 6th October, 1945.

²Vide Ministry of Industries Notification No.19 (6)/S&D II/55, dated 26-12-1956.

³See foot-note 8 on page 47.

⁴The words " to be deemed.....abandoned " were substituted for the words " to become void ", by the Department of Industries and Supplies Notification No. 223-I.R. (34)/45, dated the 15th June, 1946.

⁵See Section 5(4), page 13, and foot-note 9 on page 13.

abandoned¹ before the hearing, the Controller may curtail the period of notice.

Controller may require statement.

65.—Whether an applicant or agent desires to be heard or not, the Controller may at any time require him to submit a statement in writing within a time to be notified by the Controller, or to attend before him and make explanations with respect to such matters as the Controller may require.

General powers of amendment.

66.—Any document for the amending of which no special provision is made by the Act may be amended, and any irregularity in procedure which, in the opinion of the Controller, may be obviated without detriment to the interests of any person, may be corrected if the Controller thinks fit, and upon such terms as he may direct.

General power to enlarge time.

67.—The time prescribed by these rules for doing any act or taking any proceeding thereunder may be enlarged by the Controller, if he thinks fit, and upon such terms as he may direct.²

Designs excluded from protection under Copyright³ Act, 1914⁴

Designs excluded from protection under Copyright³ Act, 1914.⁴

67A.—A design shall be deemed to be used as a model or pattern to be multiplied by any industrial process within the meaning of the Copyright³ Act, 1914⁴ :—

- (a) When the design is reproduced or is intended to be reproduced in more than 50 single articles, unless all the articles in which the design is reproduced or is intended to be reproduced together form only a single set as defined by rule 2 of these rules.
- (b) Where the design is to be applied to (1) printed paper hangings, (2) carpets, floor-cloths or oil cloths, (3) textile goods or (4) lace not made by hand.

Repeal

Repeal.

68.—(1) The Indian Patents and Designs Rules, 1912, are hereby superseded, provided that any application or other matter pending under those rules on the date of the coming into force of these rules shall be disposed of under those rules.

(2) The notifications of the Government of India in the Department of Industries and Labour, No. 5A-197, dated the 17th July, 1930, and the 4th November, 1932, are hereby superseded.

¹See Section 43 (5), page 37.

²The power given by this rule does not extend to the enlargement of time prescribed by the Act, e.g., in Section 5(4), 9(1), 10(2), 14(2), 15(1), etc.

³Vide Ministry of Industries Notification No. 19(6) S & DII/55, dated 26th December, 1956.

⁴See foot-note 2 on page 51.

⁵The notification No. A-197, dated the 17th July, 1930 prescribed the renewal fees payable in respect of the fifteenth and the sixteenth years of the term of patents. The notification No. A-197, dated the 4th November, 1932 prescribed the renewal fee payable in respect of each year on patents extended or a new patent granted under Section 15 of the Act. (For fees payable at present in respect of the said years, see entries Nos. 9 and 13 respectively in the First Schedule to the Patents and Design Rules, 1933.)

ANNEX III

**THE SECRET PATENTS RULES,
1933**

2SECRET PATENT RULES, 1933.1*(As amended up to the 24th September 1956)*

Notification No. A-197, dated the 3rd February 1933.—In exercise of the powers conferred by clause (eee) of sub-section (1) and by sub-section 2A of Section 77 of the Patents and Designs Act, 1911 (II of 1911), the Governor General in Council is pleased to make the following rules :—

- 1.—These rules may be called the ²Secret Patent Rules, 1933. Short title.
- 2.—In these rules, unless there is anything repugnant in the subject or context,— Definitions.
- (a) “ Act ” means the ²Patents and Designs Act, 1911 ;
- (b) “ Controller ” means the Controller of Patents and Designs appointed under Section 56 of the Act, and includes any officer appointed to act for him ;
- (c) “ Office ” means the Patent Office provided under Section 55 of the Act.
- 3.—(1) ³When it has been decided by the Central Government that it is advisable to take out a secret patent for any invention assigned to it on behalf of Central Government² under Section 21A⁴ of the Act, and an application for such patent has been made on Form 1-D⁵ annexed hereto accompanied by a certificate of the Central Government under the said section, the Controller shall not communicate the application or any documents relating thereto to any member of his staff other than an examiner or examiners specially authorised by him in this behalf who shall make the investigations required to be made under Section 5 (1) of the Act in the case of other applications for patents. Secret patents.

¹ These rules were published in Part II of the *Gazette of India*, dated the 11th February 1933, under the late Department of Industries and Labour Notification No. A-197, dated the 3rd February 1933. For subsequent amendments, see the late Department of Industries and Labour Notification No. A-626(1), dated the 31st March 1937 published in the *Gazette of India Extraordinary*, dated the 1st April 1937, page 518 ; the late Department of Industries and Civil Supplies Notifications No. 205-I.R.(1)/B-44, dated the 15th April 1944 published in the *Gazette of India*, Part I, Section I, dated the 15th April 1944, page 424, and No. 223-I.R.(6)/45, dated the 26th May, 1945, published in the *Gazette of India*, Part I, Section I, dated the 26th May 1945, page 617, and the Department of Industries and Supplies Notification No. 223-I.R. (35)/45, dated the 13th July 1946 published in the *Gazette of India*, Part I, Section I, dated the 13th July 1946, page 1039, read with the same Department's Notification No. 223-I.R. (35)/45, dated the 25th July 1946, published in the *Gazette of India*, Part I, Section I, dated the 3rd August 1946, page 1200.

²Vide Ministry of Industries Notification No. 19(6)/S&D-II/55, dated 24-9-56.

³ The words “ When it has been decided accompanied by a certificate of the Central Government under the said section,” were substituted for the words “ When it has been decided by the Governor General in Council that it is advisable to take out a secret patent for any invention assigned under Section 21A of the Act to the Central Government on behalf of Her Majesty, and an application for such patent has been made on Form 1-D annexed hereto accompanied by a certificate of the Governor General in Council under the said section,” by the late Department of Industries and Civil Supplies Notification No. 223-I.R. (6)/45, dated the 26th May 1945.

⁴ See pages 26-27.

⁵ See page 137.

(2) Unless and until such invention is re-assigned to the inventor by the ¹Central Government :—

- (a) the application for the patent and the acceptance of the same shall not be advertised, nor shall the grant of the patent for such invention be open to opposition under Section 9² of the Act; but the Controller shall cause a patent to be sealed in respect of every such invention as soon as may be after the acceptance of the application relating thereto ;
- (b) every such secret patent shall be registered in a confidential register at the office and no details or particulars relating thereto shall at any time be published as required by the Act in the case of patents other than secret patents, nor shall any entry be made in the ordinary Register of Patents ³ in respect of any such secret patent or any assignment thereof.

Rer assign
ments.

4. In the event of any secret patent being re-assigned to the inventor by the ¹Central Government—

- (a) an entry to that effect shall be made in the ordinary Register of Patents as well as in the confidential Register of Patents,
- (b) all fees that would have been thereafter payable if the patent had not been a secret patent shall be paid in respect thereof ;
- (c) the patent shall remain in force only for the same term, and subject to the same conditions as to payments of fees and otherwise as if it had not been a secret patent.

¹ The words "Central Government" were substituted for "Secretary of State for India in Council", by the late Department of Industries and Labour Notification No. A-62(1), dated the 31st March 1937.

² See pages 14-15.

³ See Section 20 on page 24

ANNEX IV

**THE TRADE MARKS ACT,
1940**

THE TRADE MARKS ACT, 1940

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Trade Marks
(Chapter I.—Preliminary)

1

¹ACT No. V OF 1940

[11th March, 1940]

An Act to provide for the registration and more effective protection of Trade Marks.

WHEREAS it is expedient to provide for the registration and more effective protection of trade marks :

It is hereby enacted as follows :—

CHAPTER I

PRELIMINARY

1.—(1) This Act may be called the Trade Marks Act, 1940.

²(2) It extends to the whole of Pakistan.]

(3) This section and section 85 shall come into force at once ; the remaining provisions of the Act shall come into force on such date³ as the ⁴[Federal Government] may, by notification in the official Gazette, appoint in this behalf.

Short title,
extent and
commence-
ment.

2.—(1) In this Act, unless there is anything repugnant in the subject or context,—

Definitions.

(a) “associated trade marks” means trade marks deemed to be, or required to be registered as, associated trade marks under this Act ;

(b) “certification trade mark” means a mark adapted in relation to any goods to distinguish in the course of trade goods certified by any person in respect of origin, material, mode of manufacture, quality, accuracy or other characteristic, from goods not so certified and registerable as such under the provisions of Chapter VIII in respect of those goods in the name, as proprietor of the certification trade mark, of that person ;

For Statement of Objects and Reasons, see Gazette of India, 1939, Pt. V, p. 249; for Report of Select Committee, see *ibid.*, 1940, Pt. V, p. 51.

This Act has been applied to Baluchistan, see Notification No. 168-N, dated the 17th October, 1940, Gazette of India, 1940, Pt. I, p. 1478.

The Act, rules, notifications and orders made under it have been applied to the Tribal Areas or to the parts of those areas to which they have not been already applied, see the Tribal Areas (Application of Acts) Reg., 1965, Gaz. of P., 1965, Ext., pp 1016—18.

The Act has been and shall be deemed to have been brought into force in Gwadur with effect from the 8th September, 1958, by the Gwadur (Application of Central Laws) Ordinance, 1960 (37 of 1960), s. 2.

The Act has been extended to—

- (i) the Leased Areas of Baluchistan by the Leased Areas (Laws) Order, 1950 (G.G.O. 3 of 1950);
- (ii) the Baluchistan States Union by the Baluchistan States Union (Federal Laws) (Extension) Order, 1953 (G.G.O. 4 of 1953);
- (iii) the Khairpur State, see the Khairpur (Federal Laws) (Extension) Order, 1953 (G.G.O. 5 of 1953); and
- (iv) the Bahawalpur State, see the Bahawalpur (Extension of Federal Laws) Order, 1953 (G.G.O. 11 of 1953).

²Subs. by the Central Laws (Statute Reform) Ordinance, 1960 (21 of 1960), s. 3 and 2nd Sch. (with effect from the 14th October, 1955), for sub-section (2), which was amended by A.O., 1949.

³. Brought into force with effect from the 1st June, 1942, see Gazette of India, Extraordinary, 1942, p. 684.

⁴ Subs. by F.A.O., 1975, Art. 2 and Table, for “ Central Government”.

Trade Marks [1940 : Act V
(Chapter I.—Preliminary)]

¹[(c) " District court " means the Court of the District Judge and includes the court of an Additional District Judge or an Additional Judge or a Joint Judge ;]

2* * * * *

- (e) " 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 to be sold or otherwise traded in within ³[Pakistan], or as to use in relation to goods to be exported to any market outside ³[Pakistan] ;
- (f) " mark " includes a device, brand, heading, label, ticket, name, signature, word, letter or numeral or any combination thereof ;
- (g) " permitted use " means the use of a trade mark by a registered user thereof in relation to goods with which he is connected in the course of trade and in respect of which for the time being the trade mark remains registered and he is registered as a registered user, being use such as to comply with any conditions or restrictions to which his registration is subject ;
- (h) " prescribed " means prescribed by rules made, in relation to proceedings before a high Court, by such High Court, and in other cases, by the ⁴[Federal Government] ;
- (i) " registered " (with its grammatical variations) means registered under this Act ;
- (j) " registered trade mark " means a trade mark which is actually on the register ;
- (k) " registered user " means a person who is for the time being registered as such under section 41 ;
- (l) " trade mark " means a mark used or proposed to be used in relation to goods for the purpose of indicating or so as to indicate a connection in the course of trade between the goods and some person having the right, either as proprietor or as registered user, to use the mark whether with or without any indication of the identity of that person ;
- (m) " 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 ;

¹Subs. by the Trade Marks (Amdt.) Ordinance, 1959 (30 of 1959), s. 2, for the original cl. (c)

²The original (d) omitted by the Central Laws (Statute Reform) Ordinance 1960 (21 of 1960), s. 3 and 1 2nd Sch. (with effect from the 14th October, 1955).

³Subs. by ord 21 of 1960, s. 3 and 2nd (with effect from the 14th October, 1955), for "the Provinces and the Capital of the Federation" which had been subs. by A. O., 1949 for "British India".

⁴Subs. by F.A.O., 1955, Art. 2 and Table, for "Central Government".

1940 : Act V]

Trade Marks

3

(Chapter I.—Preliminary. Chapter II.—The Register and Conditions for Registration.)

(n) "tribunal" means the Registrar or, as the case may be, the Court before which the proceeding concerned is pending.

(2) References in this Act to the use of a mark shall be construed as references to the use of a printed or other visual representation of the mark, and references herein to the use of a mark in relation to goods shall be construed as references to the use thereof upon, or in any other relation whatsoever to such goods.

3. The provisions of this Act shall be in addition to, and not in derogation of the provisions of any other law for the time being in force.

Application of other laws not barred.

CHAPTER II

THE REGISTER AND CONDITIONS FOR REGISTRATION

4.—(1) For the purposes of this Act there shall be established ¹[at Karachi] a ²[Trade Marks Registry], and a record called the Register of Trade Marks (in this Act referred to as the register) shall be kept thereat wherein shall be entered all registered trade marks ³* * * with the names, addresses and descriptions of their proprietors, notifications of assignments and transmissions, the names, addresses and descriptions of registered users, 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.

The register of trade marks.

(2) Subject to the superintendence and direction of the ⁴[Federal Government] the register shall be kept under the control and management of ⁵[an officer appointed by the ⁶[Federal Government], who shall ⁶* * * be called the Registrar of Trade Marks and is in this Act referred to as the Registrar.

⁷[(2A) The ⁴[Federal Government] shall appoint ⁸[one] or more Deputy Registrars of Trade Marks to discharge under the superintendence and direction of the Registrar such functions of the Registrar under this Act as he may from time to time authorise

¹Subs. by A.O., 1949, for "at Bombay" which had been subs. by the Trade Marks (Amdt.) Act, 1943 (15 of 1943), s. 2, for "at the Patent Office".

²Subs. by the Trade Marks (Amdt.) Act, 1941 (27 of 1941), s. 2, for "Trade Mark Registry".

³The words "except those entered in the Bombay register under Chapter IX" which were ins. by Acts 27 of 1941, omitted by Act 15 of 1943, s. 2 (with effect from the 5th June, 1943).

⁴Subs. by F.A.O., 1975, Art. 2 and Table. for "Central Government".

⁵Subs. by Act 15 of 1943, s. 2, for "the Controller of Patents and Designs" (with effect from the 5th June, 1943).

⁶The words "for the purposes of this Act" omitted *ibid.* (with effect from the 5th June, 1943).

⁷Subs. by the Trade Marks (Amdt.) Act, 1946 (12 of 1946), s. 2, for the original sub-section (2A).

⁸Subs. by the Trade Marks (Amdt.) Ordinance, 1948 (25 of 1948), s. 2 for "two".

4

Trade Marks

[1940 : Act V

(Chapter II.—The Register and Conditions for Registration)

them to discharge ; and any reference in this Act to the Registrar shall include a reference to any Deputy Registrar when so discharging any such function.

(2B) The ¹[Federal Government] may by notification in the official Gazette authorise the Registrar to delegate any particular functions of the Registrar to officers other than the Deputy Registrars of Trade Marks.]

(3) 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.

²[(4) There shall be a seal for the Trade Marks Registry.]

³4A. [*Branch of Trade Marks Registry.*] Omitted by F.A.O., 1975, Art. 2 and Sch.

Registration to be in respect of particular goods.

5.—(1) A trade mark may be registered only in respect of particular goods or classes of goods.

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

Distinctiveness requisite for registration.

6.—(1) A trade mark shall not be registered unless it contains or consists of at least one of the following essential particulars, namely :—

- (a) the name of a company, individual, or firm, represented in a special or particular manner ;
- (b) the signature of the applicant for registration or some predecessor in his business ;
- (c) one or more invented words ;
- (d) one or more words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification, a geographical name or surname or the name of a sect, caste or tribe in ⁴[Pakistan] ;
- (e) any other distinctive mark, provided that a name, signature, or any word, other than such as fall within the descriptions in the above clauses, shall not be registrable except upon evidence of its distinctiveness.

¹Subs. by F.A.O., 1975, Art. 2 and Table, for "Central Government".

²Sub-section (4) added by the Trade Marks (Amdt.) Act, 1943 (15 of 1943), s. 2 (with effect from the 5th June, 1943).

³S4 A ins. *ibid.*, s. 2A (with effect from the 5th June, 1943).

⁴Subs. by A. O., 1949, for "India".

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(2) For the purposes of this section, the expression "distinctive" means adapted, in relation to the goods in respect of which a trade mark is proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is proposed to be registered subject to limitations, in relation to use within the extent of the registration.

(3) In determining whether a trade mark is adapted to distinguish as aforesaid, the tribunal may have regard to the extent to which—

- (a) the trade mark is inherently so adapted to distinguish, and
- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact so adapted to distinguish :

Provided that in the case of a trade mark which has been continuously used (either by the applicant for registration or by some predecessor in his business, and either in its original form or with additions or alterations not substantially affecting its identity) in relation to the same goods as those in relation to which registration is applied for, during a period from a date prior to the 25th day of February, 1937, to the date of application for registration, the Registrar shall not refuse registration by reason only of the fact that the trade mark is not adapted to distinguish as aforesaid, and may accept evidence of acquired distinctiveness as entitling the trade mark to registration.

7.—(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.

Limitation
as to colour.

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

8. No trade mark nor part of a trade mark shall be registered which consists of, or contains, any scandalous design, or any matter the use of which would—

Prohibition
of registra-
tion of cer-
tain matter.

- (a) by reason of its being likely to deceive or to cause confusion or otherwise, be disentitled to protection in a Court of justice ; or
- (b) be likely to hurt the religious susceptibilities of any class of [the citizens of Pakistan] ; or
- (c) be contrary to any law for the time being in force or to morality.

9. No word which is the commonly used and accepted name of any single chemical element or single chemical compound (as distinguished from a mixture) shall be registered as a trade mark

Use of
names of
chemical
elements
barred.

¹Subs. by A.O., 1961, Art. 2 and Sch., for "His Majesty's subjects" (with effect from the 23rd March, 1956).

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in respect of a chemical substance or preparation, and any such registration shall, notwithstanding anything in section 24, be deemed for the purposes of section 46 to be an entry made in the register without sufficient cause or an entry wrongly remaining on the register, as the circumstances may require :

Provided that 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 registered user 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.

Prohibition of registration of identical or similar trade mark.

10.—(1) Save as provided in sub-section (2), no trade mark shall be registered in respect of any goods or description of goods which is identical with a trade mark belonging to a different proprietor and ¹[either already on the register or already registered in any ²[Acceding State or a non-Acceding State] to which section 82A for the time being applies] in respect of the same goods or description of goods or which so nearly resembles such trade mark as to be likely to deceive or cause confusion.

(2) In case of honest concurrent use or of other special circumstances which, in the opinion of the Registrar, make it proper so to do he may permit the registration by more than one proprietor of trade marks which are identical or nearly resemble each other in respect of the same goods or description of goods, subject to such conditions and limitations, if any, as the Registrar may think fit to impose.

(3) 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 may refuse to register any of them until their rights have been determined by a competent Court.

Registration of parts of trade marks and of trade marks as a series.

11.—(1) Where the proprietor of a trade mark claims to be entitled to the 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 description of goods which, while resembling each other in the material particulars thereof, yet differ in respect of—

(a) statements of the goods in relation to which they are respectively used or proposed to be used ; or

¹Subs. by the Trade Marks (Amdt.) Act, 1946 (12 of 1946), s. 3, for "already on the register".

²Subs. by A. O., 1949, for "Indian State".

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- (b) statements of number, price, quality, or names of places;
or
- (c) other matter of a non-distinctive character which does not substantially affect the identity of the trade mark ; or
- (d) colour ;

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

12.—(1) Where a trade mark which is registered, or is the subject of an application for registration, in respect of any goods is identical with another trade mark which is registered, or is the subject of an application for registration, in the name of the same proprietor in respect of the same goods or description of goods, or so nearly resembles it as to be likely to deceive or cause confusion if used by a person other than the proprietor, the Registrar may at any time require that the trade marks shall be entered on the register as associated trade marks.

Associated
trade marks.

(2) Where a trade mark and any part thereof are, in accordance with the provisions of sub-section (1) of section 11, registered as separate trade marks in the name of the same proprietor, they shall be deemed to be, and shall be registered as, associated trade marks.

(3) All trade marks registered in accordance with the provisions of sub-section (3) of section 11 as a series in one registration shall be deemed to be, and shall be registered as, associated trade marks.

(4) On application made in the prescribed manner by the registered proprietor of two or more trade marks registered as associated trade marks, the Registrar may dissolve the association as respects any of them if he is satisfied that there would be no likelihood of deception or confusion being caused if that trade mark were used by any other person in relation to any of the goods in respect of which it is registered, and may amend the register accordingly.

13. If a trade mark contains—

- (a) any part not separately registered as a trade mark in the name of the proprietor, or for the separate registration of which no application has been made, or
- (b) any matter common to the trade, or otherwise of a non-distinctive character,

Registration
subject to
disclaimer.

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

Application
for registra-
tion.

14.—(1) Any person claiming to be the proprietor of a trade mark used or proposed to be used by him who is desirous of registering it shall apply in writing to the Registrar in the prescribed manner, and subject to the provisions of this Act, the Registrar may refuse the application or may accept it absolutely or subject to such amendments, modifications, conditions or limitations, if any, as he may think fit.

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

(3) The tribunal 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.

Opposition
to registra-
tion.

15.—(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 prescribed manner :

Provided that the Registrar may cause an application to be advertised before acceptance if it relates to a trade mark to which clause (e) of sub-section (1) of section 6 applies, or in any other case 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.

(2) Any person may, within the prescribed time from the date of the advertisement of an application, give notice in writing in the prescribed manner to the Registrar of opposition to the registration.

(3) The Registrar shall serve in the prescribed manner a copy of the notice on the applicant, and within the prescribed time 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.

(4) If the applicant sends such counter-statement, the Registrar shall serve in the prescribed manner a copy thereof on the persons giving notice of opposition, and shall, after hearing the parties, if so required, and considering the evidence, decide whether, and subject to what conditions or limitations, if any, registration is to be permitted.

(5) If a person giving notice of opposition or an applicant sending a counter-statement after receipt of a copy of such notice,

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of an appellant against an order of the Registrar under section 14 or this section, neither resides nor carries on business in ¹[Pakistan], the tribunal may require him to give security for costs of the proceedings before it, and in default of such security being duly given may treat the opposition or application or appeal, as the case may be, as abandoned.

16.—(1) When an application for registration of a trade mark has been accepted and either has not been opposed and the time for notice of opposition has expired, or having been opposed, has been decided in favour of the applicant, the Registrar shall, unless the application has been accepted in error, or unless the ²[Federal Government] otherwise directs, register the said trade mark, and the trade mark, when registered, shall be registered as of the date of the making of the said application, and that date shall, subject to any directions made under section 83 applicable to such trade mark, be deemed for the purposes of this Act to be the date of registration.

Registration.

(2) On the registration of a trade mark the Registrar shall issue to the applicant a certificate in the prescribed form of the registration thereof sealed with the seal of the ³[Trade Marks Registry].

(3) 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.

17.—(1) Save as provided in sub-section (2), nothing in this Act shall authorise the registration of two or more persons who use a trade mark independently, or propose so to use it, as joint proprietors thereof.

Jointly owned trade marks.

(2) Where the relations between two or more persons interested in a trade mark are such that no one of them is entitled as between himself and the other or others of them to use it except—

(a) on behalf of both or all of them, or

(b) in relation to an article with which both or all of them are connected in the course of trade,

those persons may be registered as joint proprietors of the trade mark, and this Act shall have effect in relation to any rights to the use of the trade mark vested in those persons as if those rights had been vested in a single person.

18.—(1) The registration of a trade mark shall be for a period of seven years, but may be renewed from time to time in accordance with the provisions of this section.

Duration and renewal of registration.

(2) The Registrar shall, on application made by the registered proprietor of a trade mark in the prescribed manner and within

¹ See foot-note 3, on page 6, *supra*.

² Subs. by F.A.O., 1973, Art. 2 and Table, for "Central Government".

³ Subs. by the Trade Marks (Amdt.) Act, 1943 (15 of 1943), s. 3, for "Patent Office" (with effect from the 5th June, 1943).

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 (Chapter III.—Procedure for, and duration of, Registration.
 Chapter IV.—Effect of Registration.)

the prescribed period, renew the registration of the trade mark for a period of fifteen years from the date of expiration of the original registration or of the last renewal of registration, as the case may be (which date is in this section referred to as "the expiration of the last registration").

(3) At the prescribed time before the expiration of the last registration of a trade mark, the Registrar shall send notice in the prescribed manner to the registered proprietor of the date of expiration and the conditions as to payment of fees and otherwise upon which a renewal of registration may be obtained, and if at the expiration of the time prescribed in that behalf those conditions have not been duly complied with the Registrar may remove the trade mark from the register, subject to such conditions (if any) as to its restoration to the register as may be prescribed.

Effect of removal from register for failure to pay fee for renewal.

19. Where a trade mark has been removed from the register ¹[under this Act, or from the register of trade marks in any ²[Acceding State or a non-Acceding State] to which section 82A for the time being applies] for failure to pay the fee for renewal, it shall nevertheless, for the purpose 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* trade 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.

CHAPTER IV

EFFECT OF REGISTRATION

No action for infringement of unregistered trade mark.

20.—(1) No person shall be entitled to institute any proceeding to prevent, or to recover damages for, the infringement of an unregistered trade mark unless such trade mark has been continuously in use since before the 25th day of February, 1937, by such person or by a predecessor in title of his and unless an application for its registration, made within five years from the commencement of this Act, has been refused ; and the Registrar shall, on application in the prescribed manner, grant a certificate that such application has been refused.

(2) Nothing in this Act shall be deemed to affect rights of action against any person for passing off goods as the goods of another person or the remedies in respect thereof.

¹ Ins. by the Trade Marks (Amdt.) Act, 1946 (12 of 1946), s. 4.

² Subs. by A. O., 1949, for "Indian State".

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¹[21.—(1)] Subject to the provisions of sections 22, 25 and 26, the registration of a person in the register as proprietor of a trade mark in respect of any goods shall ²* * give to that person the exclusive right to the use of the trade mark in relation to those goods and, without prejudice to the generality of the foregoing provision, that right shall be deemed to be infringed by any person who, not being the proprietor of the trade mark or a registered user thereof using by way of the permitted use, uses a mark identical with it or so nearly resembling it as to be likely to deceive or cause confusion, in the course of trade, in relation to any goods in respect of which it is registered, and in such manner as to render the use of the mark likely to be taken either—

Right conferred by registration.

- (a) as being used as a trade mark ; or
- (b) to import a reference to some person having the right either as a proprietor or as registered user to use the trade mark or to goods with which such a person as aforesaid is connected in the course of trade.

³[(2) A person registered in any ⁴[Acceding State or a non-Acceding State] to which section 82A for the time being applies, as proprietor of a trade mark shall have the same rights in respect thereof as are conferred by this section on a person registered under this Act as proprietor of a trade mark.]

22.—(1) The right to the use of a trade mark given under section 21 by registration shall be subject to any conditions or limitations entered on the register, and shall not be deemed to be infringed by the use of any such mark as aforesaid in any mode, in relation to goods to be sold or otherwise traded in, in any place, or in relation to goods to be exported to any market, or in any other circumstances, to which, having regard to any such limitations the registration does not extend.

No infringement in certain circumstances.

(2) The said right to the use of a trade mark shall not be deemed to be infringed by the use of any such mark as aforesaid by any person—

- (a) in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark if, as to those goods or a bulk of which they form part, the proprietor or the registered user conforming to the permitted use has applied the trade mark and has not subsequently removed or obliterated it, or has at any time expressly or impliedly consented to the use of the trade mark ; or
- (b) in relation to goods adapted to form part of, or to be accessory to, other goods in relation to which the trade mark has been used without infringement of the right given as aforesaid or might for the time being be so used, if the use of the mark is reasonably necessary

¹ Re-numbered by the Trade Marks (Amdt.) Act, 1946 (12 of 1946), s. 5.

² The words "if valid" omitted, *ibid.*

³ Sub-section (2) added, *ibid.*

⁴ Subs. by A. O., 1949, for "Indian State".

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in order to indicate that the goods are so adapted and neither the purpose nor the effect of the use of the mark is to indicate otherwise than in accordance with the fact a connection in the course of trade between any person and the goods.

(3) The use of a registered trade mark, being one of ¹[two or more trade marks registered under this Act or in any ²[Acceding State or a non-Acceding State] to which section 82A for the time being applies] which are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration as aforesaid, shall not be deemed to be an infringement of the right so given to the use of any other of those trade marks.

Registration to be *prima facie* evidence of validity.

23. In all legal proceedings relating to a ³[trade mark registered under this Act or in any ²[Acceding State or a non-Acceding State] to which section 82A for the time being applies] 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.

Registration to be conclusive as to validity after seven years.

24. In all legal proceedings relating to a registered trade mark, the original registration of the trade mark shall after the expiration of seven years from the date of such 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 section 8.

Saving for vested rights.

25. Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it in relation to goods in relation to which that person or a predecessor in title of his has continuously used that trade mark from a date prior—

- (a) to the use of the first-mentioned trade mark in relation to those goods by the proprietor or a predecessor in title of his, or
- (b) to the registration of the first-mentioned trade mark in respect of those goods in the name of the proprietor or a predecessor in title of his,

whichever is the earlier, or to object (on such use being proved) to registration of that identical or nearly resembling trade mark in respect of those goods under sub-section (2) of section 10.

Saving for use of name, address, or description of goods.

26. No registration of a trade mark shall interfere with any *bona fide* use by a person of his own name or that of his place of business, or of the name, or of the name of the place of business, of any of his predecessors in business, or the use by any person of any *bona fide* description of the character or quality of his goods,

¹ Subs. by the Trade Marks (Amtd.) Act, 1946 (12 of 1946), s. 6, for "two or more registered trade marks".

² Subs. by A. O., 1949, for "Indian State".

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not being a description that would be likely to be taken as importing any such reference as is mentioned in clause (b) of section 21 or in clause (b) of section 57.

27.—(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 words which the trade mark contains or of which it consists as the name or description of an article or substance :

Words used
as name or
description
of an article
or substance.

Provided that, if it is proved either—

- (a) that there is a well-known and established use of the said words as the name or description of the article or substance by a person or persons carrying on a trade therein, not being use in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark or (in the case of a certification trade mark) goods 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 section, that a period of two years or more after the cesser of the patent has elapsed, and that the said words are 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 clause (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 46—
 - (i) 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, shall be deemed to be an entry wrongly remaining on the register ;
 - (ii) if the trade mark contains such words and other matter, the tribunal, in deciding whether the trade mark shall remain on the register, so far as regards registration in respect of the article or substance in question and of any goods of the same description, may, in case of a decision in favour of its remaining on the register, require as a condition thereof that the proprietor shall disclaim any right to the exclusive use in relation to that article or substance and any goods of the same description, of such words, 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 ;
- (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 Act or any

(Chapter IV.—Effect of Registration. Chapter V.—
Assignment and Transmission.)

other law to the exclusive use of the trade mark in relation to the article or substance in question or to any goods of the same description, or

- (ii) if the trade mark contains such words and other matter, all such rights of the proprietor to the exclusive use of such words, in such relation as aforesaid,

shall be deemed to have ceased on the date at which the use mentioned in clause (a) of the proviso to sub-section (1) first became well-known and established, or at the expiration of the period of two years mentioned in clause (b) of the said proviso.

CHAPTER V

ASSIGNMENT AND TRANSMISSION

Power of registered proprietor to assign and give receipts.

28. The person for the time being entered in the register as proprietor of a trade mark shall, subject to the provisions of this Act and to any rights appearing from the register to be vested in any other person, have power to assign the trade mark, and to give effectual receipts for any consideration for such assignment.

Assignability of registered trade marks.

29. Notwithstanding anything in any other law to the contrary, a registered trade mark shall, subject to the provisions of this Chapter, be assignable and transmissible whether in connection with the goodwill of a business or not, and in respect either of all of the goods in respect of which it is registered or of some only of those goods.

Assignability of unregistered trade marks.

30. An unregistered trade mark shall be assignable and transmissible whether in connection with the goodwill of a business or not :

Provided that, except in connection with the goodwill of a business, assignment or transmission shall be permissible only if—

- (a) at the time of assignment or transmission of the unregistered trade mark it is used in the same business as a registered trade mark, and
- (b) the registered trade mark is assigned or transmitted at the same time and to the same person as the unregistered trade mark, and
- (c) the unregistered trade mark relates to goods in respect of which the registered trade mark is assigned or transmitted.

Restrictions on assignment or transmission where multiple exclusive rights would be created.

31.—(1) Notwithstanding anything in sections 29 and 30, a trade mark shall not be assignable or transmissible in a case in which as a result of the assignment or transmission there would in the circumstances subsist, whether under this Act or any other law, exclusive rights in more than one of the persons concerned to the use, in relation to the same goods or description of goods, of trade marks nearly resembling each other or of identical trade

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marks, if, having regard to the similarity of the goods and of the trade marks, the use of the trade marks in exercise of those rights would be likely to deceive or cause confusion :

Provided that an assignment or transmission shall not be deemed to be invalid under this sub-section if the exclusive rights subsisting as a result thereof in the persons concerned respectively are, having regard to limitations imposed thereon, such as not to be exercisable by two or more of those persons in relation to goods to be sold, or otherwise traded in, within ¹[Pakistan] (otherwise than for export therefrom), or in relation to goods to be exported to the same market outside ¹[Pakistan].

(2) The proprietor of a registered trade mark who proposes to assign it may submit to the Registrar in the prescribed manner a statement of case setting out the circumstances and the Registrar may issue to him a certificate stating whether, having regard to the similarity of the goods and of the trade marks referred to in the case, the proposed assignment would or would not be invalid under sub-section (1), and a certificate so issued shall, subject to appeal and unless it is shown that the certificate was obtained by fraud or misrepresentation, be conclusive as to the validity or invalidity under sub-section (1) of the assignment in so far as such validity or invalidity depends upon the facts set out in the case, but, as regards a certificate in favour of validity, only if application for the registration under section 35 of the title of the person becoming entitled is made within six months from the date on which the certificate is issued.

32. Notwithstanding anything in sections 29 and 30, a trade mark shall not be assignable or transmissible in a case in which as a result of the assignment or transmission there would in the circumstances subsist whether under this Act or any other law, an exclusive right in one of the persons concerned to the use of the trade mark limited to use in relation to goods to be sold, or otherwise traded in, in any place in ¹[Pakistan] and an exclusive right in another of these persons to the use of a trade mark nearly resembling the first-mentioned trade mark or of an identical trade mark in relation to the same goods or description of goods limited to use in relation to goods to be sold, or otherwise traded in, in any other place in ¹[Pakistan] :

Restrictions on assignment or transmission when exclusive rights would be created in different parts of Pakistan.

Provided that in any such case, on application in the prescribed manner by the proprietor of a trade mark who proposes to assign it, or by a person who claims that a registered trade mark has been transmitted to him or to a predecessor in title of his since the commencement of this Act, the Registrar, if he is satisfied that in all the circumstances the use of the trade mark in exercise of the said rights would not be contrary to the public interest, may approve the assignment or transmission, and an assignment or transmission so approved shall not, unless it is shown that the approval was obtained by fraud or misrepresentation, be deemed to be invalid under this section or section 31 if application

¹ See foot-note 3 on page 6, *supra*.

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for the registration under section 35 of the title of the person becoming entitled is made within six months from the date on which the approval is given or, in the case of a transmission, was made before that date.

Conditions for assignment otherwise than in connection with the goodwill of a business.

33. Where an assignment in respect of any goods of a trade mark which is at the time of the assignment used in a business in those goods, is made after the commencement of this Act otherwise than in connection with the goodwill of that business, the assignment shall not take effect unless the assignee, not later than the expiration of six months from the date on which the assignment is made or within such extended period, if any, as the Registrar may allow, applies to the Registrar for directions with respect to the advertisement of the assignment, and advertises it in such form and manner and within such period as the Registrar may direct.

Conditions for assignment and transmission of certification trade marks and associated trade marks.

34.—(1) A certification trade mark shall not be assignable or transmissible otherwise than with the consent of the ¹[Federal Government], for which application shall be made in writing in the prescribed manner through the Registrar.

(2) Associated trade marks shall be assignable and transmissible only as a whole and not separately.

Registration of assignments and transmissions.

35.—(1) Where a person becomes entitled by assignment or transmission to a registered trade mark, he shall apply in the prescribed manner to the Registrar to register his title, and the Registrar shall on receipt of the application and on proof of title to his satisfaction, register him as the proprietor of the trade mark in respect of the goods in respect of which the assignment or transmission has effect, and shall cause particulars of the assignment or transmission to be entered on the register.

(2) Except for the purposes of an appeal against a decision of the Registrar under sub-section (1) or of an application under section 46, a document or instrument in respect of which no entry has been made in the register in accordance with sub-section (1) shall not be admitted in evidence before any tribunal in proof of the title to a trade mark unless the tribunal otherwise directs.

CHAPTER VI

USE OF TRADE MARKS AND REGISTERED USERS

Proposed use of trade mark by company to be formed.

36.—(1) No application for the registration of a trade mark in respect of any goods 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 company is about to be formed and registered under the Companies Act, 1913 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 by the company.

VII of 1913.

¹ Subs. by F.A.O., 1975, Art. 2 and Table, for "Central Government".

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

(3) Where in a case to which sub-section (1) applies, a trade mark in respect of any goods is registered in the name of an applicant who relies on intention to assign 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, the registration shall cease to have effect in respect thereof at the expiration of that period, and the Registrar shall amend the register accordingly.

37.—(1) Subject to the provisions of section 38, a registered trade mark may be taken off the register in respect of any of the goods in respect of which it is registered on application in the prescribed manner by any person aggrieved to a High Court or to the Registrar, on the ground either—

Removal
from regis-
ter and im-
position of
limitations
on ground
of non-use.

- (a) that the trade mark was registered without any *bona fide* intention on the part of the applicant for registration that it should be used in relation to those goods by him or, in a case to which the provisions of section 36 apply, by the company concerned, and that there has in fact been no *bona fide* use of the trade mark in relation to those goods by any proprietor thereof for the time being up to a date one month before the date of the application; or
- (b) that up to a date one month before the date of the application, a continuous period of five years or longer elapsed during which the trade mark was registered and during which there was no *bona fide* use thereof in relation to those goods by any proprietor thereof for the time being :

Provided that, except where the applicant has been permitted under sub-section (2) of section 10 to register an identical or nearly resembling trade mark in respect of the goods in question or where the tribunal is of opinion that he might properly be permitted so to register such a trade mark, the tribunal may refuse an application made under clause (a) or clause (b) in relation to any goods, if it is shown that there has been, before the relevant date or during the relevant period, as the case may be, *bona fide* use of the trade mark by any proprietor thereof for the time being in relation to goods of the same description, being goods in respect of which the trade mark is registered.

(2) Where in relation to any goods in respect of which a trade mark is registered—

- (a) the circumstances referred to in clause (b) of sub-section (1) are shown to exist so far as regards non-use of the trade mark in relation to goods to be sold, or

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otherwise traded in, in a particular place in ¹[Pakistan] (otherwise than for export from ¹[Pakistan]), or in relation to goods to be exported to a particular market outside ¹[Pakistan] ; and

- (b) a person has been permitted under sub-section (2) of section 10 to register an identical or nearly resembling trade mark in respect of these goods under a registration extending to use in relation to goods to be so sold, or otherwise traded in, or in relation to goods to be so exported, or the tribunal is of opinion that he might properly be permitted so to register such a trade mark,

on application by that person in the prescribed manner to a High Court or to the Registrar, the tribunal may impose on the registration of the first-mentioned trade mark such limitations as it thinks proper for securing that that registration shall cease to extend to such use.

(3) An applicant shall not be entitled to rely for the purpose of clause (b) of sub-section (1) or of sub-section (2) on any non-use of a trade mark which is shown to have been due to special circumstances in the trade and not to any intention to abandon or not to use the trade mark in relation to the goods to which the application relates.

Defensive
registration
of well-
known trade
marks.

38.--(1) Where a trade mark consisting of any invented word has become so well-known as respects any goods in relation to which it is registered and has been used, that the use thereof in relation to other goods would be likely to be taken as indicating a connection in the course of trade between those goods and a person entitled to use the trade mark in relation to the first-mentioned goods, then, notwithstanding that the proprietor registered in respect of the first-mentioned goods does not use or propose to use the trade mark in relation to those other goods and notwithstanding anything in section 37, the trade mark may on application in the prescribed manner by such proprietor be registered in his name in respect of those other goods as a defensive trade mark and, while so registered, shall not be liable to be taken off the register in respect of those goods under the said section.

(2) The registered proprietor of a trade mark may apply for the registration thereof in respect of any goods as a defensive trade mark notwithstanding that it is already registered in his name in respect of those goods otherwise than as a defensive trade mark, or may apply for the registration thereof in respect of any goods otherwise than as a defensive trade mark notwithstanding that it is already registered in his name in respect of those goods as a defensive trade mark, in lieu in each case of the existing registration.

(3) A trade mark registered as a defensive trade mark and that trade mark as otherwise registered in the name of the same proprietor shall, notwithstanding that the respective registrations are in respect of different goods, be deemed to be, and shall be registered as, associated trade marks.

¹ See foot-note 3 on page 6, *supra*.

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(4) On application in the prescribed manner by any person aggrieved to a High Court or to the Registrar, the registration of a trade mark as a defensive trade mark may be cancelled on the ground that the requirements of sub-section (1) are no longer satisfied in respect of any goods in relation to which the trade mark is registered in the name of the same proprietor otherwise than as a defensive trade mark, or may be cancelled as respects any goods in relation to which it is registered as a defensive trade mark on the ground that there is no longer any likelihood that the use of the trade mark in relation to those goods would be taken as giving the indication mentioned in sub-section (1).

(5) The Registrar may at any time cancel the registration as a defensive trade mark of a trade mark of which there is no longer any registration in the name of the same proprietor otherwise than as a defensive trade mark.

(6) Except as otherwise expressly provided in this section, the provisions of this Act shall apply in respect of the registration of trade marks as defensive trade marks and of trade marks so registered as they apply in other cases.

39.—(1) A person other than the proprietor of a trade mark may be registered as a registered user thereof in respect of all or any of the goods in respect of which it is registered (otherwise than as a defensive trade mark) and either with or without conditions or restrictions.

Registered users.

(2) The permitted use of a trade mark shall be deemed to be used by the proprietor thereof, and shall be deemed not to be used by a person other than the proprietor, for any purpose for which such use is material under this Act or any other law.

40.—(1) Subject to any agreement subsisting between the parties, registered user of a trade mark shall be entitled to call upon the proprietor thereof to take proceedings to prevent infringement thereof, and if the proprietor refuses or neglects to do so within three months after being so-called upon, the registered user may institute proceedings for infringement in his own name as if he were the proprietor, making the proprietor a defendant.

Power of registered user to take proceedings against infringement.

(2) Notwithstanding anything contained in any other law, a proprietor so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

41.—(1) Where it is proposed that a person should be registered as a registered user of a trade mark, the proprietor and the proposed registered user shall make application in writing to the Registrar in the prescribed manner accompanied by an affidavit made by the proprietor, or by some person authorised to the satisfaction of the Registrar to act on his behalf,—

Application for registration as registered user.

(a) giving particulars of the relationship, existing or proposed, between the proprietor and the proposed registered user, including particulars showing the degree of control by the proprietor over the permitted use which their relationship will confer and whether it is a term of their relationship that the proposed registered

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user shall be the sole registered user or that there shall be any other restriction as to persons for whose registration as registered users application may be made ;

- (b) stating the goods in respect of which registration is proposed ;
- (c) stating any conditions or restrictions proposed with respect to the characteristics of the goods, to the mode or place of permitted use, or to any other matter ;
- (d) stating whether the permitted use is to be for a period or without limit of period, and, if for a period, the duration thereof ;

and by such further documents, information or evidence as may be required by the Registrar or as may be prescribed.

(2) When the requirements of sub-section (1) have been complied with, if the Registrar is satisfied that in all the circumstances the use of the trade mark in respect of the proposed goods or any of them by the proposed registered user subject to any conditions or restrictions which the Registrar may think proper, would not be contrary to the public interest, the Registrar may register, subject as aforesaid, the proposed registered user as a registered user in respect of the goods as to which he is so satisfied.

(3) The Registrar shall refuse an application under this section if it appears to him that the grant thereof would tend to facilitate trafficking in a trade mark.

(4) The Registrar shall, if so requested by an applicant, take steps for securing that information given for the purposes of an application under this section (other than matter entered in the register) is not disclosed to rivals in trade.

(5) The Registrar shall issue notice in the prescribed manner—

- (a) of the registration of a person as a registered user, to any other registered user of the trade mark ;
- (b) of an application under section 42, to the registered proprietor, and each registered user (not being the applicant) of the trade mark.

Power to Registrar to vary or cancel registration as registered user.

42. Without prejudice to the provisions of section 46, the registration of a person as a registered user—

- (a) may be varied by the Registrar as regards the goods in respect of which, or any conditions or restrictions subject to which, it has effect, on the application in writing in the prescribed manner of the registered proprietor of the trade mark ;
- (b) may be cancelled by the Registrar on the application in writing in the prescribed manner of the registered proprietor or of the registered user or of any other registered user of the trade mark ;
- (c) may be cancelled by the Registrar on the application in writing in the prescribed manner of any person on any of the following grounds, namely :—
 - (f) that the registered user has used the trade mark otherwise than by way of the permitted use, or

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in such a way as to cause or to be likely to cause, deception or confusion;

(ii) that the proprietor or the registered user misrepresented, or failed to disclose, some fact material to the application for the registration, or that the circumstances have materially changed since the date of the registration ;

(iii) that the registration ought not to have been effected having regard to rights vested in the applicant by virtue of a contract in the performance of which he is interested ;

(d) may be cancelled by the Registrar in respect of any goods in relation to which the trade mark is no longer registered.

43. Nothing in this Act shall confer on a registered user of a trade mark any assignable or transmissible right to the use thereof.

Registered user not to have right of assignment or transmission.

44.—(1) Where under the provisions of this Act use of a registered trade mark is required to be proved for any purpose, the tribunal may, if and so far as it shall think right, accept use of a registered associated trade mark, or of the trade mark with additions or alterations not substantially affecting its identity, as an equivalent for the use required to be proved.

Use of one of associated or substantially identical trade marks equivalent to use of another.

(2) The use of the whole of a registered trade mark shall for the purposes of this Act be deemed to be also a use of any trade mark being a part thereof and registered in accordance with sub-section (1) of section 11 in the name of the same proprietor.

45.—(1) The application in ¹[Pakistan] of a trade mark to goods to be exported from ¹[Pakistan] and any other act done in ¹[Pakistan] in relation to goods to be so exported which, if done in relation to goods to be sold or otherwise traded in within ¹[Pakistan] would constitute use of a trade mark therein, shall be deemed to constitute use of the trade mark in relation to those goods for any purpose for which such use is material under this Act or any other law.

Use of trade mark for export trade, and use when form of trade connection changes.

(2) The use of a registered trade mark in relation to goods 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 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.

CHAPTER VII

RECTIFICATION AND CORRECTION OF THE REGISTER

46.—(1) On application in the prescribed manner by any person aggrieved to a High Court or to the Registrar, the tribunal

Power cancelled

¹ See footnote 3 on page 6, *supra*.

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vary registration and rectify the register.

may make such order as it may think fit for cancelling or varying the registration of a trade mark on the ground of any contravention of, or failure to observe a condition entered on the register in relation thereto.

(2) Any person aggrieved by the absence or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply in the prescribed manner to a High Court or to the Registrar, and the tribunal may make such order for making, expunging or varying the entry as it may think fit.

¹[*Explanation.*—For the purposes of sub-section (1) and this sub-section, a person who has registered a trade mark in any ²[Acceding State or a non-Acceding State] to which section 82A for the time being applies, may be a "person aggrieved".]

(3) The tribunal may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connection with the rectification of the register.

(4) A High Court or the Registrar, of its or his own motion, may, after giving notice in the prescribed manner to the parties concerned and after giving them an opportunity of being heard, make any order referred to in sub-section (1) or sub-section (2).

(5) Any order of the Court rectifying the register shall direct that notice of the rectification shall be served upon the Registrar in the prescribed manner who shall upon receipt of such notice rectify the register accordingly.

Correction of register.

47.—(1) The Registrar may, on application made in the prescribed manner by the registered proprietor,—

- (a) correct any error in the name, address or description of the registered proprietor of a trade mark ;
- (b) enter any change in the name, address or description of the person who is registered as proprietor of a trade mark ;
- (c) cancel the entry of a trade mark on the register ;
- (d) strike out any goods or classes of goods from those in respect of which a trade mark is registered ;
- (e) enter a disclaimer or memorandum relating to a trade mark which does not in any way extend the rights given by the existing registration of the trade mark.

(2) The Registrar may, on application made in the prescribed manner by a registered user of a trade mark, correct any error, or enter any change, in the name, address or description of the registered user.

Alteration of registered trade mark.

48.—(1) The registered proprietor of a trade mark may apply in the prescribed manner to the Registrar for leave to add to or alter the trade mark in any manner not substantially affecting the

¹ *Explanation* added by the Trade Marks (Amdt.) Act, 1946 (12 of 1946), section 8.

² Subs. by A. O., 1949, for "Indian State".

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identity thereof, and the Registrar may refuse leave or may grant it on such terms and subject to such limitations as he may think fit.

(2) The Registrar may cause an application under this section to be advertised in the prescribed manner in any case where it appears to him that it is expedient so to do, and where he does so, if within the prescribed time from the date of the advertisement any person gives notice to the Registrar in the prescribed manner of opposition to the application, the Registrar shall, after hearing the parties if so required, decide the matter.

(3) Where leave is granted under this section, the trade mark as altered shall be advertised in the prescribed manner, unless the application has already been advertised under sub-section

(2). 49.—(1) The Registrar shall not, in exercise of any power conferred on him under clause (a) of sub-section (2) of section 84, make any amendment of the register which would have the effect of adding any goods or classes of goods to those in respect of which a trade mark is registered (whether in one or more classes) immediately before the amendment is to be made or of antedating the registration of a trade mark in respect of any goods :

Adaptation of entries in register to amended or substituted classification of goods.

Provided that this sub-section shall not apply when the Registrar is satisfied that compliance therewith would involve undue complexity and that the addition or antedating, as the case may be, would not affect any substantial quantity of goods and would not substantially prejudice the rights of any person.

(2) A proposal so to amend the register shall be notified to the registered proprietor of the trade mark affected and advertised in the prescribed manner, and may be opposed before the Registrar by any person aggrieved on the ground that the proposed amendment contravenes the provisions of sub-section (1).

CHAPTER VIII

CERTIFICATION TRADE MARKS

50.—Subject to the provisions of this Chapter, the other provisions of this Act except sections 6, 21, 22, 31, 32, 33, 36, 37, 38, 39, 40, 41, 42 and 43 and sub-section (2) of section 45 shall apply to certification trade marks as they apply to trade marks.

Provisions of this Act applicable to certification trade marks.

51. A mark shall not be registerable as a certification trade mark in the name of a person who carries on a trade in goods of the kind certified.

Certification trade mark not to be registered in name of person trading in goods certified thereby.

Determina-
tion whether
a mark is a
certification
trade mark.

52. In determining whether a mark is adapted to distinguish in accordance with the provisions of clause (b) of sub-section (1) of section 2, the tribunal may have regard to the extent to which—

- (a) the mark is inherently so adapted to distinguish in relation to the goods in question ; and
- (b) by reason of the use of the mark or of any other circumstances, the mark is in fact so adapted to distinguish in relation to the goods in question.

Application
for registra-
tion.

53.— (1) An application for the registration of a mark as a certification trade mark shall be made to the Registrar¹* * * in writing in the prescribed manner by the person proposed to be registered as the proprietor thereof, and accompanied by a draft of the regulations to be deposited under section 56.

(2) The provisions of section 14 shall have effect in relation to an application under this section as they have effect in relation to an application under the said section, except that for references therein to acceptance of an application there shall be substituted references to authorisation to proceed with the application.

(3) In dealing under the said provisions with an application under this section, the tribunal shall have regard to the like considerations, so far as relevant, as if the application were an application under section 14 and to any other considerations (not being matters within the competence of the ²[Federal Government] under section 54) relevant to applications under this section, including the desirability of securing that a certification trade mark shall comprise some indication that it is a certification trade mark.

Considera-
tion of
application
for registra-
tion by
Federal
Government.

54. When authorisation to proceed with an application under section 53 has been given, the Registrar shall forward the application to the ²[Federal Government] who shall consider the application with regard to the following matters, namely :—

- (a) whether the applicant is competent to certify the goods in respect of which the mark is to be registered ;
- (b) whether the draft of the regulations to be deposited under section 56 is satisfactory ;
- (c) whether in all the circumstances the registration applied for would be to the public advantage ;

and may either—

- (i) direct that the application shall not be accepted ; or
- (ii) direct the Registrar to accept the application and approve the said draft of the regulations either without modification and unconditionally or subject to any conditions or limitations, or to any amendments or modification of the application or of the regulations, which it thinks requisite having regard to any of the said matters ;

The words "or the Bombay Registrar, as the case may be" which were ins. by the Trade Marks (Amdt.) Act, 1941 (27 of 1941), s. 3, omitted by the Trade Marks (Amdt.) Act, 1943 (15 of 1943), s. 4 (with effect from the 5th June, 1943).

² Subs. by F. A. O., 1975, Art. 2 and Table, for "Central Government".

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but, except in the case of a direction for acceptance and approval without modification and unconditionally, the ¹[Federal Government] shall not decide the matter without giving to the applicant an opportunity of being heard :

Provided that the ¹[Federal Government] may, at the request of the applicant made with the concurrence of the Registrar, consider the application with regard to any of the said matters before authorisation to proceed with the application has been given, so however that the ¹[Federal Government] shall be at liberty to reconsider any matter on which it has given a decision under this proviso if any amendment or modification is thereafter made in the application or in the draft of the regulations.

55.—(1) When an application has been accepted, the Registrar shall, as soon as may be thereafter, cause the application as accepted to be advertised in the prescribed manner, and the provisions of section 15 shall have effect in relation to the registration of the mark as if the application had been an application under section 14 :

Opposition
to registra-
tion.

Provided that, in deciding under the said provisions the tribunal shall have regard only to the considerations referred to in sub-section (3) of section 53, and a decision under the said provisions in favour of the applicant shall be conditional on the determination in his favour by the ¹[Federal Government] under sub-section (2) of this section of any opposition relating to any of the matters referred to in section 54.

(2) When notice of opposition is given relating to any of the matters referred to in section 54, the ¹[Federal Government] shall, after hearing the parties, if so required, and considering any evidence, decide whether, and subject to what conditions or limitations, or amendments or modifications, if any, of the application or of the regulations to be deposited under section 56, registration is, having regard to those matters, to be permitted.

56.—(1) There shall be deposited at the ²[Trade Marks Registry] in respect of every mark registered as a certification trade mark regulations approved by the ¹[Federal Government] for governing the use thereof, which shall include provisions as to the cases in which the proprietor is to certify goods and to authorise the use of the certification trade mark, and may contain any other provisions which the ¹[Federal Government] may by general or special order require or permit to be inserted therein (including provisions conferring a right of appeal to the Registrar against any refusal of the proprietor to certify goods or to authorise the use of the certification trade mark in accordance with the regulations) ; and regulations so deposited shall be open to inspection in like manner as the register.

Deposit of
regulations
governing
the use of a
certification
trade mark.

(2) The regulations so deposited may on the application of the registered proprietor be altered by the Registrar with the consent of the ¹[Federal Government].

¹ Subs. by F.A. O, 1975, Art. 2 and Table, for "Central Government".

² Subs. by the Trade Marks (Amdt.) Act, 1943 (15 of 1943), s. 5, for "Patent Office" (with effect from the 5th June, 1943).

(3) The ¹[Federal Government] may cause such application to be advertised in any case where it appears to it expedient so to do, and where it does so, if within the time specified in the advertisement any person gives notice of opposition to the application, the ¹[Federal Government] shall not decide the matter without giving the parties an opportunity of being heard.

Right conferred by registration.

²[57.— (1)] Subject to the provisions of sections 25, 26 and 58, the registration of a person as proprietor of a certification trade mark in respect of any goods shall, ³* *, give to that person the exclusive right to the use of the certification trade mark in relation to those goods, and, without prejudice to the generality of the foregoing provision, that right shall be deemed to be infringed by any person who, not being the proprietor of the mark or a person authorised by him in that behalf under the regulations deposited under section 56, using it in accordance therewith, uses a mark identical with it or so nearly resembling it as to be likely to deceive or cause confusion, in the course of trade, in relation to any goods in respect of which it is registered, and in such manner as to render the use of the mark likely to be taken either—

- (a) as being used as a certification trade mark ; or
- (b) to import a reference to some person having the right either as proprietor, or by his authorisation under the said regulations, to use the mark, or to goods certified by the proprietor.

⁴[(2) A person registered in any ⁵[Acceding State or a non-Acceding State] to which section 82A for the time being applies, as proprietor of a certification trade mark shall have the same rights in respect thereof as are conferred by this section on a person registered under this Act as proprietor of a certification trade mark.]

No infringement in certain circumstances.

58.— (1) The right to the use of a certification trade mark given under section 57 by registration shall be subject to any conditions or limitations entered on the register, and shall not be deemed to be infringed by the use of any such mark as aforesaid in any mode, in relation to goods to be sold or otherwise traded in in any place, in relation to goods to be exported to any market, or in any other circumstances, to which having regard to any such limitations, the registration does not extend.

(2) The said right to the use of a certification trade mark shall not be deemed to be infringed by the use of any such mark as aforesaid by any person —

- (a) in relation to goods certified by the proprietor of the mark if, as to those goods or a bulk of which they form part, the proprietor or another in accordance with his authorisation under the relevant regulations

¹ Subs. by F.A.O., 1975, Art. 2 and Table, for "Central Government".

² S. 57 re-numbered by the Trade Marks (Amdt.) Act, 1946 (12 of 1946), s. 9.

³ The words "if valid" omitted, *ibid.*

⁴ Sub-section (2) added *ibid.*

⁵ Subs. by A. O., 1949, for "Indian State".

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has applied the mark and has not subsequently removed or obliterated it, or the proprietor has at any time expressly or impliedly consented to the use of the mark, or

- (b) in relation to goods adapted to form part of, or to be accessory to, other goods in relation to which the mark has been used without infringement of the right given as aforesaid or might for the time being be so used, if the use of the mark is reasonably necessary in order to indicate that the goods are so adapted and neither the purpose nor the effect of the use of the mark is to indicate otherwise than in accordance with the fact that the goods are certified by the proprietor :

Provided that clause (a) shall not apply to the case of use consisting of the application of any such mark as aforesaid to any goods, notwithstanding that they are such goods as are mentioned in that clause if such application is contrary to the said regulations.

(3) Where a certification trade mark is one of two or more ¹[certification trade marks registered under this Act or in any ²[Acceding State or non-Acceding State] to which section 82A for the time being applies,] which are identical or nearly resemble each other, the use of any of those marks in exercise of the right to the use of that mark given by registration, shall not be deemed to be an infringement of the right so given to the use of any other of those marks.

59.—(1) The ³[Federal Government] may, on the application in the prescribed manner of any person aggrieved or on the recommendation of the Registrar, and after giving the proprietor an opportunity of opposing the application or recommendation, make such order as it thinks fit for expunging or varying any entry in the register relating to a certification trade mark, or for varying the deposited regulations, on any of the following grounds, namely :—

Cancellation
or varying
of registra-
tion:

- (a) that the proprietor is no longer competent, in the case of any of the goods in respect of which the mark is registered, to certify those goods ;
- (b) that the proprietor has failed to observe any provision of the deposited regulations to be observed on his part ;
- (c) that it is no longer to the public advantage that the mark should be registered ;
- (d) that it is requisite for the public advantage that, if the mark remains registered, the regulations should be varied ;

and neither a High Court nor the Registrar shall have any jurisdiction to make an order under section 46 on any of those grounds.

(2) The Registrar shall rectify the register and the deposited regulations in such manner as may be requisite for giving effect to an order made under sub-section (1).

¹ Subs. by the Trade Marks (Amend.) Act, 1946 (12 of 1946), s. 10, for "registered certification trade marks".

² Subs. by the Federal Laws (Revision and Declaration) Act, 1951 (26 of 1951), s. 4 and Third Sch., for "Indian State".

³ Subs. by F.A.O., 1975, Art. 2 and Table, for "Central Government".

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Costs not to be awarded in certain cases.

60. The Registrar shall have no power to award costs to or against any party on an appeal to him against a refusal of the proprietor of a certification trade mark to certify goods or to authorise the use of the mark.

Decisions of Federal Government to be final.

61. Save as otherwise expressly provided in this Chapter, every decision of the ¹[Federal Government] under this Chapter shall be final.

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CHAPTER IX

SPECIAL PROVISIONS FOR TEXTILE GOODS

Textile goods.

62. The ¹[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 Act shall apply to such trade marks as they apply to trade marks used in relation to other classes of goods.

63. [Separate Trade Marks Registry at Bombay.] Omitted by the Trade Marks (Amdt.) Act, 1945 (XV of 1945), s. 6.

63A. [Jurisdiction of Bombay Registrar and Registrar in respect of trade marks used in relation to textile goods.] Omitted by the Trade Marks (Amdt.) Act, 1943 (XV of 1943), s. 6.

Restrictions on registration of textile goods.

²[64.—(1) In respect of textile goods being piece goods—

- (a) no mark consisting of a line heading alone shall be registrable as a trade mark;
- (b) a line heading shall not be deemed to be adapted to distinguish;
- (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.]

Refused Textile Marks List.

³[65. Trade marks in respect of textile goods of which registration has been refused shall be entered by the Registrar in a list called the Refused Textile Marks List, and the said list shall at all convenient times be open to the inspection of the public subject to such conditions and restrictions as may be prescribed.]

Advisory Committees.

66.—(1) The ¹[Federal Government] may in the prescribed manner constitute one or more Advisory Committees of persons versed in the usages of the textile trade for the purpose of this section.

¹ Subs. by F. A. C., 1975, Art. 2 and Table, for "Central Government".

² Subs. by the Trade Marks (Amdt.) Act, 1943 (15 of 1943), s. 7, for the original section 64 (with effect from the 5th June, 1943).

³ Subs. *ibid.*, s. 8, for the original s. 65 (with effect from the 5th June, 1943).

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and State Emblems.)

(2) The Registrar ¹ * * * shall consult any such 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 such Committees shall be determined by rules made under this Act.

CHAPTER X

OFFENCES AND RESTRAINT OF USE OF ROYAL ARMS AND STATE EMBLEMS.

67. If any person 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 may extend to two years, or with fine, or with both.

Penalty for falsification of entries in register

68.—(1) ²[On and after the 1st day of January 1947,] 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 ; or
- (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 ; or
- (c) to the effect that a registered trade mark is registered in respect of any goods 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.

Penalty for falsely representing a trade mark as registered.

(2) If any person contravenes any of the provisions of subsection (1), he shall be punishable with imprisonment for a term which may extend to six months, or with fine which may extend to five hundred rupees, or with both.

(3) For the purposes of this section, the use in ³[Pakistan] in relation to a trade mark of the word “registered”, or of any

¹ The original words “or the Deputy Registrar” which were amended by the Trade Marks (Amdt.) Act, 1941 (27 of 1941), s. 6, omitted by the Trade Marks (Amdt.) Act, 1943 (15 of 1943), s. 9 (with effect from the 5th June, 1943).

² Subs. by the Trade Marks (Amdt.) Act, 1946 (12 of 1946), s. 11, for “From such date, not being earlier than one year from the commencement of this Act, as the Central Government may, by notification in the official Gazette, appoint in this behalf”.

³ See foot-note 3 on page 6, *supra*.

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(Chapter X.—Offences and Restraint of Use of Royal Arms and State Emblems.)

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 law of a country outside ¹[Pakistan], being a country under the law of which the registration referred to is in fact in force ; or
- (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 law of ²[an Acceding State or a Country outside Pakistan] and in relation solely to goods to be exported to that country.

³(4) Nothing in this section shall—

- (a) apply to a trade mark, application for the registration of which has been made before the 1st day of January 1947, until such application has been disposed of ;
- (b) affect the use of the word “registered” in respect of a trade mark registered in any ⁴[Acceding State or a non-Acceding State] to which section 82A for the time being applies, or until the application has been disposed of, in respect of a trade mark, application for the registration of which has been made in any such ⁴[Acceding State or a non-Acceding State] before the aforesaid date.]

69. If a person, without due authority, uses in connection with any trade, business, calling or profession—

- (a) the Royal Arms ⁵[or 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 Royal Arms ⁵[or Government Arms], or
- (b) ⁶[name, title and semblance of Quaid-i-Azam Mohammad Ali Jinnah and 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, His Majesty's Government or the ⁷[Federal Government]

¹ See foot-note 3 on page 6, *supra*.

² Subs. by A.O., 1949, for “a Country outside British India”.

³ Sub-section (4) added by the Trade Marks (Amdt.) Act, 1946 (12 of 1946), s. 11.

⁴ Subs. by A. O., 1949, for “Indian State”.

⁵ Ins. by A. O. 1961, Art. 2 and Sch. (with effect from the 23rd March, 1956).

⁶ Ins. by the Trade Marks (Amdt.) Act, 1949 (3 of 1950), s. 2.

⁷ Subs. by F.A.O., 1975, Art. 2 and Table, for “Central Government”.

Restraint
of use of
Royal Arms
and State
emblems.

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(Chapter X.—*Offences and Restraint of Use of Royal Arms and State Emblems.* Chapter XI.—*Miscellaneous.*)

or any Provincial Government or any department of any such Government, ¹[or]

²[(c) 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 in such manner as is to be calculated to lead to the belief that he is duly authorized by the Secretary-General in the case of the United Nations or by the Director-General of the World Health Organization in the case of that Organization to use that emblem, seal or name,]

he may, at the suit of any person who is authorised to use such Arms or such device, emblem or title or of the Registrar, ³* * * be restrained by injunction from continuing so to use the same :

⁴[Provided that nothing in this section shall be construed as affecting the right, if any, of the proprietor of a trade mark containing any such Arms, device, emblem or title to continue to use such trade mark.]

CHAPTER XI

MISCELLANEOUS

70. In all proceedings under this Act 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 and issuing commissions for the examination of witnesses;
- (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 ;
- (c) the Registrar shall not exercise any power vested in him by this Act or the rules made thereunder adversely to any party duly appearing before him without (if required in writing within the prescribed time so to do) giving such party an opportunity of being heard ;
- (d) the Registrar may, save as otherwise expressly provided in this Act, and subject to any rules made in this behalf under section 84, make such orders as to costs as he considers reasonable, and any such order shall be executable as a decree of a Civil Court.

Procedure
before the
Registrar.

¹ Added by the Trade Marks (Amdt.) Ordinance, 1948 (25 of 1948), s. 3.

² Subs. by the Trade Marks (Amdt.) Act, 1949 (3 of 1950), s. 2, for cl. (c) which was added by Ordi. of 1948, s. 3.

³ The words "or the Bombay Registrar" omitted by the Trade Marks (Amdt.) Act, 1943 (15 of 1943), s. 10 (with effect from the 5th June, 1943)

⁴ Proviso added, *ibid.* (with effect from the 5th June, 1943).

(Chapter XI.—Miscellaneous)

Procedure
before
Federal
Government.

71. In all proceedings under this Act before the ¹[Federal Government], evidence shall be given by affidavit, provided that the ¹[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 70.

Procedure
in certain
cases of
option to
apply to a
High Court
or the
Registrar.

72. Where under this Act an applicant has the option of making an application either to a High Court or to the Registrar,—

(a) if any suit or other proceedings concerning the trade mark in question is pending before a High Court or a District Court, the application shall be made to that High Court or, as the case may be, to the High Court within whose jurisdiction that District Court is situated ;

(b) if in any other case the application is made to the Registrar, the Registrar may, if he thinks fit, refer the application at any stage of the proceedings to a High Court.

Suits for in-
fringement
to be insti-
tuted before
District
Court.

73. 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.

Appearance
of Registrar
in proceed-
ings involv-
ing recti-
fication of
register.

74.—(1) In any suit or other legal proceedings in which the relief sought, includes alteration or rectification of the register, the Registrar shall have the right to appear and be heard, and shall appear if so directed by the tribunal.

(2) Unless the tribunal otherwise directs, the Registrar may, in lieu of appearing, submit a statement in writing signed by him, giving such particulars as he thinks proper of the proceedings before him relating to the matter in issue, or of the grounds of any decision given by him affecting it, or of the practice of the ²[Trade Marks Registry] in like cases, or of other matters relevant to the issues and within his knowledge as Registrar, and such statement shall be evidence in the suit or other proceeding.

3* * * * *

Costs of
Registrar in
proceedings
before High
Court.

⁴[74-A. In all proceedings under this Act before a High Court the costs of the Registrar shall be in the discretion of the High Court, but the Registrar shall not be ordered to pay the costs of any of the parties.]

Evidence of
entries in
register and

75.—(1) A printed or written copy of any entry in the register, purporting to be certified by the Registrar and sealed with the seal of the ²[Trade Marks Registry], shall be admitted in evidence

¹ Subs. by F.A.O., 1975, Art 2, and Table, for " Central Government ".

² Subs. by the Trade Marks (Amdt.) Act, 1943 (15 of 1943), s. 11, for " Patent Office " (with effect from the 5th June, 1943).

³ Sub-section (3) omitted *ibid.* (with effect from the 5th June, 1943).

⁴ S. 74A ins. *ibid.*, s. 12 (with effect from the 5th June, 1943).

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in all Courts in ¹[Pakistan] and in all proceedings without further ²[proof or production] of the original.

things
done by
Registrar.

(2) A certificate purporting to be under the hand of the Registrar as to any entry, matter or thing that he is authorised by this Act 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.

76.—(1) Save as otherwise expressly provided in this Act, an appeal shall lie, within the period prescribed by the ³[Federal Government] from any decision of the Registrar ⁴* * * under this Act or the rules made thereunder to the High Court having jurisdiction :

Appeals.

Provided that if any suit or other proceeding concerning the trade mark in question is pending before a High Court or a District Court, the appeal shall be made 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 13 or section 14 or section 15, it shall not be open, save with the express permission of the 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.

Act V
of
1908.

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

77. A High Court may make rules consistent with this Act as to the conduct and procedure of all proceedings under this Act before it.

Power to
High Courts
to make
rules.

78. If in any legal proceeding in which the validity of the registration of a trade mark comes into question, 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 proceeding 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.

Certificate
of validity.

¹ See foot-note 3 on page 6, *supra*.

² Subs. by the Trade Marks (Amdt.) Act, 1941 (27 of 1941), s. 8, for "proof of production".

³ Subs. by F.A.O., 1975, Art 2. and Table, for "Central Government".

⁴ The words "or the Bombay Registrar" omitted by the Trade Marks (Amdt.) Act, 1943 (15 of 1943) s. 14 (with effect from the 5th June, 1943).

Trade usage,
etc., to be
taken into
considera-
tion.

79. In any suit or other proceeding relating to a trade mark, the tribunal shall admit evidence of the usages of the trade concerned and of any relevant trade mark or got up legitimately used by other persons.

Agents.

80. Where by or under this Act any act, other than the making of an affidavit, is required to be done by any person, the act may, subject to prescribed conditions or in special cases with the consent of the ¹[Federal Government], be done, in lieu of by that person himself, by duly authorised agent, being either a legal practitioner or a person registered in the prescribed manner as a trade marks agent.

Fees.

81. There shall be paid in respect of applications and registration and other matters under this Act such fees as may be prescribed by the [Federal Government].

Government
to be bound.

82. The provisions of this Act shall be binding on the ²[Government].

Power to
make recip-
rocal arrange-
ments with
Acceding
or a non-
Acceding
State.

³[82A.—(1) The ¹[Federal Government] may enter into reciprocal arrangements with any ⁴[Acceding State or a non-Acceding State] whereby trade marks and certification trade marks registered under this Act shall have in that State protection as if registered in that State and where such arrangements have been entered into with any ⁴[Acceding State or a non-Acceding State], the ¹[Federal Government] shall by notification in the official Gazette declare that this section shall apply to that State.

(2) Where any such arrangements as aforesaid with any ⁴[Acceding State or a non-Acceding State] are terminated, the ¹[Federal Government] shall by a further like notification cancel the notification under sub-section (1) relating to that State.]

Power to
make
reciprocal
arrange-
ments with
other Go-
vernments.

83. If at any time after the expiry of six months from the commencement of this section it is made to appear to the ¹[Federal Government] that any Government ⁵[outside Pakistan] has made satisfactory provision for the protection within its territories of trade marks in respect of which an application for registration has been made in ⁶[Pakistan], the ¹[Federal Government] may, by notification in the official Gazette, make provision with regard to trade marks in respect of which an application for registration has been made within the territories of that Government to enable any person who has applied with in such territories for registration of a trade mark or his legal representative or assignee to obtain registration of the trade mark in ⁶[Pakistan] under this Act on his making an application for registration in ⁶[Pakistan] within such

¹ Subs. by F.A.O., 1975, Art. 2 and Table, for "Central Government".

² Subs. by A. O., 1961, Art. 2 for "Crown". (with effect from the 23rd March, 1956.

³ S. 82A ins. by the Trade Marks (Amdt.) Act, 1946 (12 of 1946), s. 12.

⁴ Subs. by A. O., 1949, for "Indian State".

⁵ The original words "outside British India" have successively been amended by Act, 12 of 1946, s. 13, and A. O., 1949, to read as above.

⁶ See foot-note 3 on page 6, *supra*.

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period as may be fixed in this behalf by the notification as if an application for registration under this Act had been made in respect of that trade mark at the date at which the application for registration was made within the territories of that Government.

84.—(1) The ¹[Federal Government] may, subject to the condition of previous publication by notification in the official Gazette, make rules² to carry out the purposes of this Act.

Power of
Federal
Government
to make
rules.

(2) In particular and without prejudice to the generality of the foregoing power, such rules may—

- (a) prescribe the classification of goods for the purpose of the registration of trade marks, and empower the Registrar to amend the register so far as may be necessary for the purpose of adapting the entries therein to any amended or substituted classification which may be prescribed;
- (b) require the making of duplicates of trade marks and other documents connected therewith;
- (c) provide for securing and regulating the publication, sale or distribution of copies of trade marks and other documents connected therewith;
- (d) prescribe additional matters to be entered in the register;
- (e) prescribe the conditions and restrictions subject to which the register, ³* * * and the Refused Textile Marks ⁴[List] may be inspected;
- (f) prescribe the form of certificates of registration;
- (g) prescribe the conditions under which a trade mark removed from the register may be restored under sub-section (3) of section 18;
- (h) prescribe the further documents, information or evidence to accompany an application under sub-section (1) of section 41;
- (i) prescribe classes of goods as textile goods for the purposes of Chapter IX;
- (j) provide for the constitution of Advisory Committees referred to in section 66, and prescribe the places of meeting, and conduct of business at meetings, of such Committees;
- (k) regulate the awarding of costs by the Registrar under section 70;
- (l) prescribe the conditions subject to which an agent referred to in section 80 may act;

¹ Subs. by F.A.O., 1975, Art. 2 and Table, for "Central Government".

² For the Revised Trade Marks Rules, 1963, see Gaz. of P., 1963, Pt. I, pp. 370—426.

³ The words "the Textile Marks Records" omitted by the Trade Marks (Amdt.) Act, 1943 (15 of 1943), s. 15 (with effect from the 5th June, 1943).

⁴ Subs. *ibid.*, for "Lists" (with effect from the 5th June, 1943).

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- ¹[(*ll*)] make such supplementary provision as may be necessary or expedient to give effect to reciprocal arrangements entered into with ²[Acceding States or non-Acceding States under section 82A ;]
- (*m*) prescribe the fees to be paid under this Act ;
- (*n*) provide for the establishment of branches of the Trade Marks Registry when expedient for facilitating the working of this Act, and authorise the preparation of copies of the register to be kept at such branch offices ;
- (*o*) prescribe the manner in which, in proceedings under this Act before the ³[Federal Government] or the Registrar, application shall be made, notices given and matters advertised ;
- (*p*) prescribe times or periods required by this Act to be prescribed ;
- (*q*) provide, generally, for regulating the business of the Trade Marks Registry and of branches established under clause (*n*) ⁴* * * and for regulating all things by this Act placed under the direction or control of the ³[Federal Government] or the Registrar.

5* * * * *

Power to Federal Government to make provision for applications for registration before the coming into force of the remaining provisions of Act.

85. The ³[Federal Government] may, by notification in the official Gazette, provide such procedure as it considers expedient to enable intending applicants to deposit trade marks at the Patent Office before the coming into force of the remaining provisions of this Act :

Provided that the deposit of a trade mark under this section shall not affect any right, existing or accruing, in the trade mark.

⁶86. [*Proceedings at Patent Office and the Bombay Registry to be deemed to have been taken at Trade Marks Registry.*] Omitted by A. O., 1949.

¹ Cl. (*ll*) ins. by the Trade Marks (Amdt.) Act, 1946 (12 of 1946), s. 14.

² Subs. by A. O., 1949, for "Indian States".

³ Subs. by F. A. O., 1975, Art. 2 and Table, for "Central Government".

⁴ The words and figures "or under section 63" omitted by the Trade Marks (Amdt.) Act, 1941 (27 of 1941), s. 10.

⁵ Cl. (*r*) omitted by the Trade Marks (Amdt.) Act, 1943 (15 of 1943), s. 15 (with effect from the 5th June, 1943).

⁶ This section was added *ibid.*, s. 16 (with effect from the 5th June, 1943).

ANNEX V

**THE REVISED TRADE MARKS RULES,
1963**



(Under section 84.—Revised Trade Marks Rules)

THE REVISED TRADE MARKS RULES, 1963

S.R.O. 699(K) 63, dated the 16th September, 1963.—In exercise of the powers conferred by section 84 of the Trade Marks Act, 1940 (*V of 1940*), the Government of Pakistan is pleased to publish the following Trade Marks Rules. They will come into effect immediately :—

THE REVISED TRADE MARKS RULES, 1963

PART I

CHAPTER I

PRELIMINARY

1. Short title and commencement.—(1) These rules may be called the Revised Trade Marks Rules, 1963.

(2) They shall come into force at once.

2. Definitions.—In these rules, unless there is anything repugnant in the subject or context,—

- (a) “ Act ” means the Trade Marks Act, 1940 ;
- (b) “ Branch Registry ” means a Branch of the Trade Marks Registry established under rule 139 ;
- (c) “ form ” means a form set forth in either the Second or the Third Schedule to these rules ;
- (d) “ Journal ” means the Trade Marks Journal ;
- (e) “ section ” means a section of the Act ;
- (f) “ specification ” means the designation of goods in respect of which a trade mark, or a registered user of a trade mark, is registered or proposed to be registered.

3. Fees.—(1) The fees to be paid in respect of applications and registration and other matters under the Act shall be those specified in the First Schedule to these rules, hereinafter referred to as the prescribed fees.

(2) (a) Fees may be paid in cash at the Trade Marks Registry, or may be sent by money order or postal order or cheque, payable to the Registrar.

(b) Cheques not carrying the correct addition for commission, and other cheques on which the full value cannot be collected in cash within the time allowed for payment of the fee shall be accepted only at the discretion of the Registrar.

(c) Stamps shall not be received in payment of fees.

4. Forms.—The forms set forth in the Second and the Third Schedules to these rules shall be used in all cases to which they are applicable and may be modified as directed by the Registrar to meet other cases.

(Under section 4.—Revised Trade Marks Rules)

5. Size, etc. of documents.—(1) Subject to any other directions that may be given by the Registrar, all applications, notices, statements or other documents, except trade marks authorized or required by the Act or these rules to be made, left with or sent to the Trade Marks Registry or left with or sent to the Registrar or the ¹[Federal Government] shall be written, typewritten, lithographed or printed in the English language in large and legible characters with deep permanent ink upon strong paper, and, except in the case of affidavits, on one side only, of a size of approximately 13 inches by 8 inches, and shall have on the left hand part thereof a margin of not less than one inch and a half.

(2) Duplicate documents including trade marks shall be filed at the Trade Marks Registry, if at any time required by the Registrar.

6. Signature of documents.—(1) A document purporting to be signed by a partnership shall be signed by at least one of the partners and a document purporting to be signed by a body corporate shall be signed by a director or by the secretary or other principal officer of the body corporate. A document purporting to be signed by any other association of persons shall be signed by the President, Chairman or Principal Secretary of the Association or by any other person who appears to the Registrar to be duly qualified. The capacity in which an individual signs a document on behalf of a partnership or a body corporate or other association of persons shall be stated below his signature.

(2) Signatures to any documents if written in characters other than Roman, or if not clearly legible shall be accompanied by a transliteration in English and in block capitals.

7. Service of documents.—All applications, notices, statements, papers having representations affixed thereto, or other documents authorized or required by the Act or these rules to be made, left or sent, at or to the Trade Marks Registry or with or to the Registrar or the ¹[Federal Government] or any other person may be sent through the post by a prepaid letter; any application or any document so sent shall be deemed to have been made, left or sent at the time when the letter containing the same would be delivered in the ordinary course of post. In proving such sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

8. Particulars of applicants and other persons.—(1) Names and addresses of applicants and other persons shall be given in full, together with their nationality and such particulars, if any, of caste or calling as are necessary for identification. In the case of a firm, the full name and nationality of every partner thereof shall be stated.

(2) The address given shall in all cases be as full as possible, for the purpose of enabling any person easily to find the place of trade or business of the person whose address is given.

(3) In the case of a body corporate or firm or an association the country of incorporation and the nature of registration, if any, as the case may be, shall be given.

¹Subs. by S.R. O. 1620(I) 73, dated 22-11-73, item (1), for "Central Government". *see Gaz. of P., 1973, Ext., Pt. II, p. 2355.*

(Under section 84.—Revised Trade Marks Rules)

9. **Address for service.**—(1) Every applicant or opponent in any proceeding under the Act or these rules, 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 proceeding in question.

(2) Every person who is registered as a proprietor or registered user of a trade mark or who is about to be registered as such may, if he so desires, give upon Form TM-50 an address for service in Pakistan for entry in the register, and such address entered in the register may be treated as the actual address of that person for all purposes connected with the trade marks. All applications on Form TM-50 under this rule shall be signed by the person about to be registered or the registered proprietor or registered user, as the case may be, or by an agent expressly authorized by him for the purpose of such application.

(3) In any case in which no address for service is entered in the register, the Registrar may treat the trade or business address of the registered proprietor or registered user of a trade mark as therein entered as his address for service for all purposes connected with the trade mark.

(4) Any written communication addressed to a person as aforesaid at an address for service given by him or at an address treated by the Registrar as his address for service, shall be deemed to be properly addressed.

(5) Unless an address for service as required in sub-rule (1) is given, the Registrar shall be under no obligation to send any notice that may be required by the Act or these rules, and no subsequent order or decision in the proceedings shall be called in question on the ground of any such non-service of notice.

10. **Agency.**—The authorization of an agent for the purpose of section 80 shall be executed on Form TM-48.

CHAPTER II

CLASSIFICATION

11. **Classification of goods.**—For the purposes of the registration of trade marks and of these rules, goods shall be classified in the manner specified in the Fourth Schedule to these rules.

APPLICATION FOR REGISTRATION

12. **Form of application.**—An application to the Registrar for the registration of a trade mark shall be signed by the applicant. For a trade mark other than a defensive trade mark, the application shall be made on Form TM-1, if in respect of non-textile goods.

13. **Application to be confined to one class.**—(1) Every application for the registration of a trade mark shall be in respect of goods in one class only of the Fourth Schedule to these rules.

(2) **Separate applications.**—Applications for the registration of the same trade mark in different classes shall be treated as separate and distinct applications,

(Under section 84.—Revised Trade Marks Rules)

and in all cases where a trade mark is registered under the same official number for goods in more than one class, whether on conversion of the specification under rule 75 or otherwise, the registration in respect of the goods included in each separate class shall be deemed to be a separate registration for all the purposes of the Act.

14. Statement of user in applications.—An application to register a trade mark shall contain a statement of the period during which, and the person by whom, it has been used in respect of the goods mentioned in the application. The Registrar may require the applicant to file an affidavit testifying to such user with exhibits showing the mark as used.

15. Representation of marks.—Every application for the registration of a trade mark, and where additional copies of the application are required, every such copy shall contain a representation of the mark in the space provided on the application form for that purpose. Where the representation exceeds such space in size, the representation shall be mounted upon linen, tracing cloth or such other material as the Registrar may consider suitable. Part of the mounting shall be affixed in the space aforesaid and the rest may be folded.

16. Additional representations.—Every application for the registration of a trade mark shall, except as hereinafter provided, be made in duplicate and shall be accompanied by six additional representations of the mark. The representations of the mark on the application and its duplicate and the additional representations shall correspond exactly with one another. The additional representations shall in all cases be noted with all such particulars as may from time to time be required by the Registrar. Such particulars shall, if required, be signed by the applicant.

17. Representations to be durable.—All representations of trade marks must be of a durable nature and each additional representation required to be filed with an application for registration shall be mounted on a sheet of strong paper of the size of approximately 13 inches by 8 inches, leaving a margin of not less than one inch and a half on the left hand part of the sheet.

18. Specimens of the mark in exceptional cases.—Where a representation of a trade mark cannot be given in the manner set forth in rule 17, a specimen or copy of the trade mark may be sent either of full size or on a reduced scale, and in such form as the Registrar may think most convenient.

19. Series of trade marks.—Where application is made for the registration of a series of trade marks under sub-section (3) of section 11 copies of representations of each trade mark of the series shall accompany the application in the manner set forth in rules 15 and 16.

20. Transliteration.—Where a trade mark contains a word or words in characters other than Roman, there shall, unless the Registrar otherwise directs, be endorsed on the application form, and on each of the accompanying representations, a sufficient transliteration to the satisfaction of the Registrar of each of such words, and every such endorsement shall state the language to which the word belongs and shall be signed by the applicant.

(Under section 81.—Revised Trade Marks Rules)

21. Translation.—Where a trade mark contains a word or words in a language other than English, the Registrar may ask for an exact translation thereof together with the name of the language, and such translation and name, if he so requires, shall be endorsed and signed as aforesaid.

PROCEDURE ON RECEIPT OF APPLICATION FOR REGISTRATION OF A TRADE MARK.

22. Acknowledgement of receipt of application.—Every application for the registration of a trade mark in respect of any goods shall, on receipt, be acknowledged by the Registrar.

23. Search.—Upon receipt of an application for the registration of a trade mark in respect of any goods the Registrar shall cause a search to be made amongst the registered marks and amongst the pending applications for the purpose of ascertaining whether there are on record in respect of the same goods or description of goods any marks identical with the mark sought to be registered or so nearly resembling it as to render it likely to deceive or cause confusion and the Registrar may cause the search to be renewed at any time before the acceptance of the application, but shall not be bound to do so.

24. Objection to acceptance—Hearing.—(1) If, on consideration of the application, and of any evidence of use or of distinctiveness or of any other matter which the applicant may or may be required to furnish the Registrar has any objection to the acceptance of the application or proposes to accept it subject to such conditions, amendments, disclaimers, modifications or limitations as he may think right to impose, the Registrar shall communicate such objection or proposal in writing to the applicant.

(2) Unless within ¹[two months] from the date of the communication mentioned in sub-rule (1), the applicant alters his application according to the proposal aforesaid, or sends his observations to the Trade Marks Registry or applies for a hearing, the application shall be deemed to have been abandoned and no further reference to the applicant shall be necessary.

(3) An application which is treated as abandoned under sub-rule (2) or subsection (3) of section 16 may be restored ²[within two months] to the file on sufficient cause being shown to the satisfaction of the Registrar and on an application to that effect being made in Form TM-56 accompanied by a statement of the case.

25. Decision of Registrar.—(1) The decision of the Registrar at a hearing under rule 24, or without a hearing if the applicant has duly communicated his observations in writing, and has stated that he does not desire to be heard, shall be communicated to the applicant in writing, and if the applicant intends to appeal from such decision he may within one month from the date of such communication apply on Form TM-15 to the Registrar requiring him to state in writing the grounds of, and the materials used by him in arriving at, his decision.

¹ Subs. by S.R.O. 507(1)/77, dated 11-6-77, item (1), for "three months" (*w.e.f.* 1-7-1977), see *Gaz. of P.*, 1977, Ext., Pt. II, pp. 1009—14.

² *Ins. ibid.* (*w.e.f.* 1-7-1977).

(Under section 84.—Revised Trade Marks Rules)

(2) In a case where the Registrar makes any requirements to which the applicant does not object, the applicant shall comply therewith before the Registrar issues a statement in writing under sub-rule (1).

(3) The date when such statement is sent shall be deemed to be the date of the Registrar's decision for the purpose of appeal.

DEFENSIVE TRADE MARKS

26. Application for registration and proceedings relating thereto.—An application for the registration of a defensive trade mark under section 38 shall be made on Form TM-3 and shall be accompanied by a statement of case setting forth full particulars of the facts on which the applicant relies in support of his application, verified by an affidavit made by the applicant. The applicant may send with this affidavit or subsequently such other evidence as he may desire to furnish, and the Registrar shall consider the whole of the evidence before deciding the application. In all other respects and where they are appropriate and it is not otherwise stated, these rules shall apply to such application as they apply to applications for the registration of ordinary trade marks.

ADVERTISEMENT OF APPLICATION

27. Manner of advertisement.—An application for the registration of a trade mark required or permitted to be advertised by sub-section (1) of section 15 shall be advertised in the Journal during such time and in such manner as the Registrar may direct. In the case of an application with which the Registrar proceeds only after the applicant has lodged the written consent to the proposed registration of the registered proprietor of another trade mark or of another applicant the words "By Consent" shall appear in the advertisement. If no representation of the trade mark be included in the advertisement of the application, the Registrar shall mention in such advertisement the place or places where a specimen or representation of the trade mark may be inspected.

28. Wood block or Electro-type.—For the purposes of advertisement in the Journal, the applicant may, ¹[within two months] supply or be required to supply a printing block (or more than one, if necessary) of the trade mark satisfactory to the Registrar, of such dimensions as may from time to time be approved or directed by the Registrar, or shall supply such information or other means of advertising the trade mark as may be required by the Registrar, and the Registrar, if dissatisfied with the printing block supplied by the applicant or his agent, may require a fresh block before proceeding with the advertisement. Any printing block so sent to the Registrar shall be retained by the Trade Marks Registry.

29. Advertisement of series.—Where an application relates to a series of trade marks differing from one another in respect of the particulars mentioned in sub-section (3) of section 11, the applicant may be required to supply a printing block (or more than one, if necessary) satisfactory to the Registrar of any or of each of the trade marks constituting the series; or the Registrar may, if he thinks fit, insert with the advertisement of the application a statement of the manner in which the several trade marks differ from one another:

¹ Subs. by S.R.O. 507(1)/77, dated 11-6-77, item (2), for "at the appropriate item" (w.e.f. 1-7-1977), see Gaz of P., 1977, Ext. Pt. II, PP 1009—14.

(Under section 15.—Revised Trade Marks Rules)

OPPOSITION TO REGISTRATION

30. **Notice of opposition.**—The time within which a notice of opposition to the registration of a trade mark may be given, shall be ¹[two] months from the date of advertisement of the application for registration, in the Journal. Such notice shall be on Form TM-5.

31. **Particulars to be given in the notice.**—The notice shall be given in duplicate, and shall include a statement of the grounds ²[fully supported by documents] upon which the opponent objects to the registration. If registration is opposed on the ground that the trade mark in question resembles any marks already on the register, the registration numbers of such trade marks and the dates of the Journals in which they have been advertised shall be set out.

32. **Counter-statement.**—The counter-statement required by sub-section (3) of section 15 shall be sent in duplicate on Form TM-6. ³[fully supported by documents within one month] from the receipt by the applicant of the duplicate notice of opposition. The applicant shall also set out in the counter-statement what facts, if any, alleged in the notice of opposition, are admitted by him.

* * * * *

36. **Further evidence.**—No further evidence shall be left on either side, but, in any proceedings before the Registrar, he may at any time, if he thinks fit, give leave to either the applicant or the opponent to leave any evidence upon such terms as to costs or otherwise as he may think fit.

37. **Exhibits.**—Where there are exhibits to affidavits filed in an opposition, copies or impressions of such exhibits shall be sent to the other party on his request and at his expense, or, if such copies or impressions cannot conveniently be furnished, the originals shall be left with the Registrar in order that they may be open to inspection. The original exhibits shall be produced at the hearing unless the Registrar otherwise directs.

38. **Hearing.**—Upon completion of the evidence the Registrar shall give notice to the parties of a date when he will hear the arguments in the case. Such appointment shall be for a date at least one month after the date of the notice, unless the parties consent to a shorter notice. Within fourteen days from the receipt of the notice any party who intends to appear shall so notify the Registrar on Form TM-7. Any party who does not so notify the Registrar within the time last aforesaid, may be treated as not desiring to be heard and the Registrar may act accordingly.

39. **Security for costs.**—The security for cost which the Registrar may require under sub-section (5) of section 15, may be fixed at any amount which he may consider proper, and such amount may be further enhanced by him at any stage in the opposition proceedings.

1. Subs. by S.R.O. 507(1)/77, dated 11-6-77, item (3), for "four" (w.e.f. 1-7-1977), see Gaz. of P., 1977, Ext., Pt. II, pp. 1009—14.

2. Ins: *ibid.*, item (4) (w.e.f. 1-7-1977).

3. Subs: *ibid.*, item (5), for "within two months" (w.e.f. 1-7-1977).

4. Rules 33 to 35 omitted *ibid.*, item (6), (w.e.f. 1-7-1977).

(Under section 84.—Revised Trade Marks Rules)

NOTICE OF NON-COMPLETION OF REGISTRATION

40. Procedure for giving notice.—The notice which the Registrar is required by sub-section (3) of section 16, to give to an applicant, shall be sent to the applicant at his trade or business address or address for service on Form O-1, but if the applicant has authorised an agent for the purpose of the application, the notice shall be sent to the agent and a duplicate thereof to the applicant. The notice shall specify twenty-one days time from the date thereof or such further time as the Registrar may allow, for completion of the registration.

REGISTRATION

41. Entry in Register.—(1) As soon as may be after the expiration of four months from the date of the advertisement in the Journal of any application for the registration of a trade mark, the Registrar shall, subject to any opposition and the determination thereof, and to the provisions of sub-section (1) of section 16 and upon payment of the prescribed fee on Form TM-11, enter the trade mark in the register.

(2) The entry of a trade mark in the register shall specify the date of the registration, the goods in respect of which it is registered, and all particulars required by sub-section (1) of section 4, including both the trade or business address and the address for service of the applicant (if an application on Form TM-50 for the entry thereof has been accepted), particulars of the trade, business profession, occupation, or other description of the proprietor, particulars of any undertaking by the proprietor entered on the form of application, particulars affecting the scope of the registration or the rights conferred by the registration, and such other particulars as are prescribed.

(3) In the case of an application as aforesaid which the Registrar accepts only after the applicant has lodged the written consent to the proposed registration, of the registered proprietor of another trade mark or another applicant for registration, the entry made under this rule in the register shall state that it is "By Consent" and shall give the number of the previous registration or application for registration.

42. Associated marks.—Where a trade mark is registered as associated with any other marks, the Registrar shall note in the register in connection with the first-mentioned mark the registration numbers of the marks with which it is associated and shall also note in the register in connection with each of the associated marks the registration number of the first-mentioned mark as being a mark associated therewith.

43. Death of applicant before registration.—In case of death of any applicant for the registration of a trade mark after the date of his application and before the trade mark has been entered in the register, the Registrar may, on proof of the applicant's death and of the title of another person to the ownership of the trade mark, ¹[being furnished to him within ninety days] enter in the register the name, address and description of that person as the proprietor of the trade mark.

¹. Ins. by S.R.O. 507(I)/77, dated 11-6-77, item (7) (w.e.f. 1-7-1977). See Gaz of P., 1977, Ext., Pt. II, pp. 1009-14.

(Under section 84.—Revised Trade Marks Rules)

44. Certificate of registration.—The certificate of registration of a trade mark to be issued by the Registrar under sub-section (2) of section 16 shall be in Form O-2 with such modifications as the circumstances of any case may require, and the Registrar shall annex a copy of the trade mark to the certificate.

CHAPTER III

DISSOLUTION OF ASSOCIATED MARKS

45. Application for dissolution.—An application under sub-section (4) of section 12 shall be made on Form TM-14 and shall include a statement of the grounds of the application.

RENEWAL OF REGISTRATION AND RESTORATION

46. Renewal of registration.—An application for the renewal of the registration of a trade mark shall be made on Form TM-12 and may be made at any time not more than six months before the expiration of the last registration of the trade mark.

47. Notice before removal of trade mark from register.—At a date not less than one month and not more than two months before the expiration of the last registration of a trade mark, if no application on Form TM-12 for renewal of the registration together with the prescribed fee has been received, the Registrar shall notify the registered proprietor in writing on Form O-3 of the approaching expiration at his trade or business address as well as address for service entered in the register.

48. Advertisement of non-payment.—If at the expiration of the last registration of a trade mark the renewal fee has not been paid, the Registrar shall advertise the fact forthwith in the Journal and if within four months of that advertisement the renewal fee on Form TM-12 together with the prescribed additional fee is received, he shall renew the registration without removing the mark from the register.

49. Removal of trade mark from register and restoration.—(1) Where, at the expiration of four months from the advertisement mentioned in the last foregoing rule, the fees therein referred to have not been paid, the Registrar may remove the mark from the register, and the removal shall take effect from the expiration of the last registration.

(2) After the mark has been removed from the register, the Registrar may, on receipt of a request made in that behalf on Form TM-13 ¹[within one year of the expiration of the last registration,] restore the mark to the register on being satisfied that it is just so to do, and upon such conditions as he may think fit to impose.

¹ Ins. by S.R.O. 507 (1)/77, dated 11-6-77, item (8) (*w.e.f.* 1-7-1977), see *Gaz. of P.*, 1977, Ext., Pt. II, pp. 1009—14.

(Under section 84.—Revised Trade Marks Rules)

50. Notice and advertisement of renewal and restoration.—Upon the renewal or restoration and renewal of a registration, a notice to that effect shall be sent to the registered proprietor and the renewal or restoration and renewal shall be advertised in the Journal.

ASSIGNMENT AND TRANSMISSION

51. Application for entry of assignment or transmission.—An application to register the title of a person who becomes entitled by assignment or transmission to a registered trade mark shall be made on Form TM-24 or TM-23 according as it is made by such person alone or conjointly with the registered Proprietor.

52. Particulars to be stated in application.—An application under rule 51 shall contain full particulars of the instrument, if any, under which the applicant or in the case of a joint application, the person other than the registered proprietor claims to be entitled to the trade mark ; and such instrument or a duly certified copy thereof shall be produced at the Trade Marks Registry, for inspection at the time of application. The Registrar may require and retain an attested copy of any instrument produced for inspection in proof of title, but such copy shall not be open to public inspection.

53. Case accompanying application.—Where a person applying under rule 51 for registration of his title does not establish his claim under any document or instrument which is capable in itself of furnishing proof of his title, he shall, unless the Registrar otherwise directs, either upon or with the application, state a case setting forth the full particulars of the facts upon which his claim to be proprietor of the trade mark is based, and showing that the trade mark has been assigned or transmitted to him. If the Registrar so requires, the case shall be verified by an affidavit on Form TM-18.

54. Proof of title.—The Registrar may call upon any person who applies to be registered as proprietor of a registered trade mark to furnish such proof or additional proof of title as he may require for his satisfaction.

55. Advertisement of assignment without goodwill of trade mark in use.—
(1) An application for directions under section 33 shall be made on Form TM-20 and shall state the date on which the assignment was made. The application shall give particulars of the registration in the case of a registered trade mark, and in the case of an unregistered mark, shall show the mark and give particulars of the registered trade mark that has been assigned therewith in accordance with section 30. The Registrar may call for any evidence or further information and if he is satisfied with regard to the various matters he shall issue directions in writing with respect to the advertisement of the assignment.

(2) The Registrar may refuse to consider such an application in a case to which section 32 applies, unless his approval has been obtained under the said section and a reference identifying the Registrar's notification of approval is included in the application.

(3) A request for an extension of the period within which the application may be made shall be on Form TM-21 and may be made at any time before or during the period for which extension can be allowed. The extension of the period which the Registrar may allow shall not exceed three months.

(Under section 84.—Revised Trade Marks Rules)

56. Application for entry of assignment without Goodwill.—An application under rule 51 relating to an assignment of a trade mark in respect of any goods shall state—

- (a) whether the trade mark was, at the time of the assignment, used in a business in any of those goods ; and
- (b) whether the assignment was made otherwise than in connection with the goodwill of that business,

and if both those circumstances subsisted, then the applicant shall leave at the Trade Marks Registry a copy of the directions to advertise the assignment, obtained upon application under rule 55, and such proof, including copies of advertisements or otherwise, as the Registrar may require, to show that his directions have been fulfilled and if the Registrar is not satisfied that the directions have been fulfilled, he shall not proceed with the application.

57. Separate registrations.—Where pursuant to an application under rule 51 and as the result of a division and separation of the goods of a registration or a division and separation of places or markets, different persons become registered separately under the same registration number as subsequent proprietors of a trade mark, each of the resulting separate registrations in the names of those different persons shall be deemed to be a separate registration for all the purposes of the Act.

58. Registrar's certificate or approval as to certain assignments and transmissions.—Any person who desires to obtain the Registrar's certificate under sub-section (2) of section 31 or his notification of approval under section 32 shall send to the Registrar with his application on Form TM-17 or Form TM-19, as the case may be, a statement of case in duplicate setting out the circumstances and a copy of any instrument or proposed instrument effecting the assignment or transmission. The Registrar may call for any evidence or further information that he may consider necessary and the statement of case shall be amended if required to include all the relevant circumstances and shall, if required, be verified by an affidavit. The Registrar, after hearing (if so required) the applicant and any other person whom the Registrar may consider to be interested in the transfer, shall consider the matter and issue a certificate thereon or a notification in writing of approval or disapproval thereof, as the case may be. Where a statement of case is amended, two copies thereof in its final form shall be left at the Trade Marks Registry. The Registrar shall seal a copy of the statement of case in its final form to the certificate or notification.

59. Registration of Assignment to a company under section 36.—For the purposes of sub-section (3) of section 36, the period within which a company may be registered as the subsequent proprietor of a registered trade mark, upon application made under rule 51 shall be six months from the date of advertisement in the Journal of the Registration of the trade mark or such further period not exceeding six months as the Registrar may allow, on application being made on Form TM-25 by the applicant for registration of title or the registered proprietor, as the case may be, at any time before or during the period for which the extension can be allowed.

(Under section 84.—Revised Trade Marks Rules)

REGISTERED USERS

60. Entry and notification.—(1) An application to the Registrar for the registration under section 41 of a person as a registered user of a registered trade mark shall be made by that person and the registered proprietor on Form TM-28.

(2) The entry of a registered user in the register shall set forth, in addition to the particulars mentioned in sub-section (1) of section 41, his address for service, if an application by him on Form TM-50 therefor has been accepted, and the date on which the entry is made. A notification in writing of the registration of a registered user shall be sent to the registered proprietor of the trade mark, to the registered user and to every other registered user whose name is entered in relation to the same registration of a trade mark and shall be inserted in the Journal.

61. Registered proprietor's application to vary entry.—An application by the registered proprietor of a trade mark for the variation of the registration of a registered user of that trade mark under clause (a) of section 42 shall be made on Form TM-29 and shall be accompanied by a statement of the grounds on which it is made and, where the registered user in question consents, by the written consent of that registered user.

62. Cancellation of the registration of registered user.—(1) An application for the cancellation of the registration of a registered user under clause (b) or clause (c) of section 42 shall be made on Form TM-30 or Form TM-31, as the case may be, and shall be accompanied by a statement of the grounds on which it is made.

(2) In case of the registration of a registered user for a period, in accordance with clause (d) of sub-section (1) of section 41, the Registrar shall cancel the entry of the registered user at the end of that period. Where some or all of the goods are omitted from those in respect of which a trade mark is registered, the Registrar shall at the same time omit them from those specifications of registered users of the trade mark in which they are comprised. The Registrar shall notify every cancellation or omission under this sub-rule to the registered users whose permitted use is affected thereby and to the registered proprietor of the trade mark.

63. Notification and hearing.—The Registrar shall notify in writing applications under section 42 to the registered proprietor and each registered user (not being the applicant) under the registration of the trade mark. Any person so notified who intends to intervene in the proceedings, shall within one month of the receipt of such notification give notice to the Registrar on Form TM-32 to that effect and shall send therewith a statement of the grounds of his intervention. The Registrar shall thereupon serve or cause to be served copies of such notice and statement on the other parties *viz.*, the applicant, the registered proprietor, the registered user whose registration is in suit, and any other registered user who intervenes. Any such party may, within such time or times as the Registrar may appoint, leave evidence in support of his case, and the Registrar after giving the party an opportunity of being heard may accept or refuse the application or accept it subject to any conditions, amendments, modifications or limitations he may think right to impose.

(Under section 84.—Revised Trade Marks Rules)

64. Registered user's application under section 47 (2).—Applications under sub-section (2) of section 47 shall be made on Form TM-16 or Form TM-33 or Form TM-34 as may be appropriate by a registered user of a trade mark or by such person as may notify the Registrar that he is entitled to act in the name of a registered user and the Registrar may require such evidence by affidavit or otherwise as he may think fit as to the circumstances in which the application is made.

APPLICATION FOR ALTERATION OR RECTIFICATION OF REGISTER

65. Application to rectify, or remove a trade mark from the register.—An application to the Registrar under section 37, 38 or 48 for the making, expunging or varying of any entry in the register shall be made on Form TM-26 and shall be accompanied by a statement meeting out fully the nature of the applicant's interest, the facts upon which he bases his case and the relief which he seeks. Where the application is made by a person who is not the registered proprietor of the trade mark in question, the application and the statement aforesaid shall be left at the Trade Marks Registry in duplicate. The duplicate copies shall be transmitted forthwith by the Registrar to the Registered proprietor.

66. Further procedure.—Upon an application mentioned in rule 65 being made and copies thereof being transmitted to the registered proprietor, if necessary, the provisions of rules 32 to 39 shall apply *mutatis mutandis* to the further proceedings on the application but the Registrar shall not rectify the register or remove the mark from the register merely because the registered proprietor has not filed a counter-statement. In any case of doubt any party may apply to the Registrar for directions.

67. Intervention by third parties.—Any person, other than the registered proprietor, alleging interest in a registered trade mark in respect of which an application is made under rule 65 may apply on Form TM-27 for leave to intervene, stating the nature of his interest, and the Registrar may refuse or grant such leave after hearing (if so required) the parties concerned, upon such conditions and terms as he may deem fit.

1[67A. Rectification of the register by the Registrar.—(1) A notice under sub-section (4) of section 46 shall be sent by registered post to the parties concerned and shall state the grounds on which the Registrar proposes to make an order under sub-section (1) or sub-section (2) of that section, and specify the place, time and date, not being less than one month from the date of issue of such notice, on which the parties concerned may appear before him or submit their claim in writing :

Provided that the Registrar may adjourn the hearing to such future date as he may deem fit.

(2) Where any person to whom a notice has been issued under sub-rule (1) fails to appear before the Registrar, he may make such order as he may deem fit.

(3) An order made under sub-rule (2) shall be in writing and shall be sent by registered post to the parties concerned.] ;

¹ Ins by S.R.O. No. 783(T)/80, dated the 26th July, 1980, see Gaz. of P., 1980, Ext. Pt. II, pp. 1462—1464 (w.e.f. 1-8-80).

(Under section 84.—Revised Trade Marks Rules)

ALTERATION OF ADDRESS

68. Alteration of address in register.—(1) A registered proprietor or a registered user of a trade mark whose trade or business address is changed, so that the entry in the register is rendered incorrect shall forthwith request the Registrar on Form TM-34 to make the appropriate alteration of the address in the register, and the Registrar shall alter the register accordingly if he is satisfied in the matter.

(2) A registered proprietor or a registered user of a trade mark whose address for service in Pakistan entered in the Register is changed, whether by discontinuance of the entered address or otherwise, so that the entry in the register is rendered incorrect, shall forthwith request the Registrar on Form TM-50 to make the appropriate alteration of the address in the Register, and the Registrar shall alter the register accordingly if he is satisfied in the matter.

(3) A registered proprietor or a registered user of a trade mark whose registered trade or business address or address for service is altered by a public authority, so that the changed address designates the same premises as before, may make the aforesaid request to the Registrar on Form TM-34 or TM-50, as the case may be, and if he does so he shall leave therewith a certificate of the alteration given by the said authority. If the Registrar is satisfied as to the facts of the case, he shall alter the register accordingly, but shall not require any fees to be paid on the forms.

(4) In case of the alteration of the address of a person entered in the register as the address for service of more than one registered proprietor or registered user of trade marks, the Registrar may, on proof that the said address is the address of the applicant and if satisfied that it is just to do so, accept an application from that person on a Form TM-50, amended so as to suit the case, for the appropriate alteration of the entries of his address as the address for service in the several registrations, particulars of which shall be given in the form, and may alter the entries accordingly.

(5) All applications under this rule on Form TM-50 shall be signed by the registered proprietor or the registered user, as the case may be, or by an agent expressly authorized by him for the purpose of such an application, unless in exceptional circumstances the Registrar otherwise allows.

CORRECTION OF REGISTER

69. Application under section 47(1).—Where an application has been made under sub-section (1) of section 47 for the alteration of the register by correction change, cancellation or striking out goods, or for the entry of a disclaimer or memorandum, the Registrar may require the applicant to furnish such evidence by affidavit or otherwise as the Registrar may think fit, as to the circumstances in which the application is made. Such application shall be made on Form TM-16, TM-33, TM-34, TM-35, TM-36, TM-37 or TM-50 as may be appropriate.

(Under section 84.—Revised Trade Marks Rules)

70. Advertisement of certain applications.—(1) Where an application has been made under clause (c), (d) or (e) of sub-section (1) or section 47, on Form TM-35, TM-36 or TM-37, respectively, the Registrar shall serve or cause to be served a copy of the application on any person who appears from the register to have any interest in the trade mark.

(2) Where application is made under clause (e) of the said sub-section on Form TM-37 to enter a disclaimer or memorandum relating to a trade mark, the Registrar shall before deciding upon such application, advertise the application in the Journal in order to enable any person to lodge at the Trade Marks Registry a statement in writing, showing the reasons for his objections to the proposed entry, within four months from the date of the advertisement.

ALTERATION OF REGISTERED TRADE MARKS

71. Alteration of registered trade marks.—Where a person applies under section 48 for leave to add to or alter his registered trade mark, he shall make his application in writing on Form TM-38 and shall furnish six copies of the mark as it will appear when so added to or altered.

72. Advertisement before decision and opposition.—(1) The Registrar shall consider the application and shall, if it appears to him expedient, advertise the application in the journal before deciding it.

(2) Within ¹[two] months from the date of advertisement under sub-rule (1), any person may give notice of opposition to the application on Form TM-39 and may also send therewith a further statement of his objections. The notice and the statement, if any, shall be sent in duplicate. The provisions of rules 32 to 39 shall apply *mutatis mutandis* to the further proceedings on such notice.

73. Advertisement, Illustration.—If in the opinion of the Registrar an advertisement describing in words the proposed addition or alteration, would not be likely to convey to the mind an exact representation of the mark so altered or added to, he may require the applicant to supply a printing block suitable for advertising the mark with the addition or alteration as aforesaid. The advertisements under sub-section (2) of section 48 shall *mutatis mutandis* be made in the same manner as advertisements relating to an application for registration of a trade mark.

74. Decision, Advertisement, Notification.—If the Registrar decides to allow the application he shall alter the mark in the register in the manner applied for and insert in the Journal a notification that the mark has been altered. If the application has not been advertised under rule 72 he shall also advertise in the Journal the trade mark as altered.

RE-CLASSIFICATION OF GOODS IN RESPECT OF EXISTING REGISTRATION.

75. Re-classification in respect of existing registration.—(1) On the classification set forth in the Fourth Schedule to these Rules being amended, the registered proprietor of a trade mark may apply to the Registrar on Form TM-40 for

¹ Subs. by S.R.O. No. 783(I)/80, dated the 26th July, 1980, for "four", see Gaz. of P., 1980, Ext. Pt. II, pp. 1462—1464 (w.e.f. 1-8-80).

(Under section 84.—Revised Trade Marks Rules)

the conversion of the specification relating to his trade mark, so as to bring that specification into conformity with the amended classification. The application shall include a request for the like conversion of the specification in respect of any registered users under that registration.

(2) The Registrar shall, thereon, notify in writing to the registered proprietor a proposal showing the form which, in the Registrar's view, the amendment of the register should take in consequence of the proposed conversion. Two or more registrations of a trade mark having the same date and in respect of goods which fall within the same class under the amended or substituted classification, may be amalgamated upon conversion in accordance with this rule.

(3) The proposal referred to in sub-rule (2) shall be advertised in the Journal.

(4) Notice of opposition to such proposal shall be given on Form TM-41 in duplicate within one month from the date of the advertisement and shall be accompanied by a statement in duplicate showing how the proposed amendment would contravene the provisions of sub-section (1) of section 49.

(5) The procedure for the disposal of an opposition under this rule shall be regulated by the provisions of rules 32 to 39 *mutatis mutandis*.

(6) If there is no opposition within the time specified in sub-rule (4), or in case of opposition, if the conversion of the specification is allowed, the proposal as allowed shall be advertised in the Journal, and all necessary entries shall be made in the register. The date when such entries are made in the register shall be recorded therein. Any entry made in the register in pursuance of this sub-rule shall not affect the date of renewal of registration under section 18, which shall be determined in the same manner as before the allowance of the conversion.

MISCELLANEOUS POWERS OF THE REGISTRAR

1[76. **Extension of Time.**—If in any particular case the Registrar is satisfied that the circumstances are such as to justify an extension of time for doing any act or taking any proceedings under these rules, not being a time expressly provided in the Act or prescribed by rule 55 or 59, he may extend the time upon such notice to other party, if necessary, and upon such terms as he may direct, and extension may be granted though the time for doing the act or taking the proceeding has already expired. An extension granted under this rule shall not exceed a period of more than one month at a time, provided that the total period of such extensions shall not exceed *six months* against each statutory period prescribed. An application for extension of time shall be made in Form TM-55, on payment of the prescribed fee].

77. **Exercise of discretionary power of Registrar.**—The time within which a person entitled under clause (c) of section 70 to an opportunity of being heard shall exercise his option of requiring to be heard shall, save as otherwise expressly provided in the Act or these rules, be one month from the date of a notice which the Registrar shall give to such person before determining the matter with reference to which such person is entitled to be heard. If within that month such

¹ Subs. by S.R.O. 507(I)/77, dated 11-6-77, item (9), for rule 76, (*w.e.f.* 1-7-1977), see Gaz. of P., 1977, Ext., Pt. II, pp. 1009—14.

(Under section 84.—Revised Trade Marks Rules)

person requires to be heard, the Registrar shall appoint a date for the hearing and shall give 10 day's notice thereof.

78. Notification of decision.—The decision of the Registrar in the exercise of any discretionary power given to him by the Act or these rules shall be notified to the person affected.

79. Correction of irregularity in procedure.—Any irregularity in procedure which, in the opinion of the Registrar, may be obviated without detriment to the interests of any person, may be corrected, if the Registrar thinks fit and on such terms as he may direct.

AWARD OF COSTS BY REGISTRAR

80. Costs in uncontested cases.—(1) Where any opposition duly instituted under these rules, is not contested by the applicant, the Registrar in deciding whether costs should be awarded to the opponent shall consider whether the proceedings might have been avoided if reasonable notice had been given by the opponent to the applicant before the notice of opposition was lodged.

(2) Sub-rule (1) shall not apply to costs in respect of fees specified under entries 11, 12 and 13 of the First Schedule to these rules which shall follow the event.

81. Scale of costs.—In all proceedings before the Registrar the Registrar may, save as otherwise expressly provided by the Act, award such costs as he considers reasonable, having regard to all the circumstances of the case, provided that the amount of costs awarded in respect of any of the matters set forth in the Sixth Schedule to these rules shall not exceed the amount therein specified.

CERTIFICATES

82. Certificates other than under section 16 (2).—The Registrar may give a certificate [other than a certificate under sub-section (2) of section (16)] as to any entry, matter or thing which he is authorised or required by the Act or these rules to make or do, upon receipt of a request therefor on Form TM-46 from any person who can show, if so required by the Registrar, an interest in the entry, matter or thing to the satisfaction of the Registrar. Where a copy of any trade mark has to be included in a certificate, the Registrar may require the applicant to supply a copy thereof suitable for the purpose, and if the applicant fails to do so, the Registrar shall not be obliged to include a copy of the mark in the certificate.

83. Certificate for use in obtaining registration abroad.—(1) Where a certificate relating to the registration of a trade mark is desired for use in obtaining registration in any territory outside Pakistan, the Registrar shall include in the certificate a copy of the mark and may require the applicant for the certificate to furnish him with a copy of the mark suitable for the purpose, and if the applicant fails to do so, the Registrar may refuse to issue the certificate.

(2) Where a trade mark is registered without limitation of colour, the copy of the mark to be included in the certificate, may be either in the colour in which it appears upon the register or in any other colour or colours.

(Under section 84.—Revised Trade Marks Rules)

(3) The Registrar may state in the certificate such particulars concerning the registration of the mark as to him may seem fit, and may omit therefrom references to any disclaimers appearing in the register. The purpose for which the certificate is issued shall be stated therein.

APPEALS TO HIGH COURT

¹[84. Time for appeal.—An appeal to a High Court from any decision of the Registrar under the Act or these rules, shall be made within two months from the date of such decision].

CERTIFICATE OF VALIDITY

85. Certificates of validity to be noted.—Where the court has certified as provided in section 78 with regard to the validity of a registered trade mark, the registered proprietor thereof may request the Registrar on Form TM-47 to add to the entry in the register a note that the certificate of validity has been granted in the course of the proceedings, particulars of which shall be given in the request. An officially certified copy of the certificate shall be sent with the request, and the Registrar shall record a note to that effect in the register and publish the note in the Journal.

INSPECTION OF DOCUMENTS BY THE PUBLIC

86. Inspection of register, etc.—The register and the Refused Textile Marks List, shall be open to inspection, on payment of the prescribed fee, at such time on all the days on which the Trade Marks Registry is not closed to the public, as may be fixed by the Registrar.

87. Request to Registrar for search.—Any person may in Form TM-54 request the Registrar to cause a search to be made in respect of specified goods classified in any one class of the Fourth Schedule to these rules to ascertain whether any mark in the register or among pending applications for registration or in the Refused Textile Marks List resembles a trade mark of which duplicate representations accompany the form. The Registrar shall cause such search to be made and the person making the request to be informed of the result thereof.

88. Distribution of copies of Journal and other documents.—The ²[Federal Government] may direct the Registrar to distribute the Journal and any other document which it may consider necessary, to such places as may be fixed by the ²[Federal Government] in consultation with the Provincial Governments and notified from time to time in the *official Gazette*.

APPLICATIONS TO HIGH COURT

89. Applications made to the Court to be served on the Registrar.—Every application to a High Court under the Act shall be served on the Registrar.

¹ Subs. by S.R.O. 507(I)/77, dated 11-6-77, item (10), for rule 84 (*w.e.f.* 1-7-1977), see *Gaz. of P.*, 1977 Ext., Pt. II, pp. 1009—14.

² See foot-note 1 on page 2, *supra*.

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STATUTORY RULES AND ORDERS

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(Under section 84.—Revised Trade Marks Rules) -----

PART II

Special Provisions for Certification Trade Marks

90. Rules to apply to Certification Trade Marks.—Subject to the provisions of this Part, the provisions of Part I and Part V of these rules shall apply to certification trade marks as they apply to trade marks.

91. Application for registration and proceedings relating thereto.—(1) An application for the registration of a certification trade mark under sub-section (1) of section 53 shall be made to the Registrar on Form TM-4 and shall be accompanied by three duplications of the application and by six additional representations of the mark. The draft regulations to be forwarded with the application under the said sub-section (1) of section 53 shall be in triplicate and shall be accompanied by Form TM-49.

(2) References in Part I of these rules to the acceptance of an application for the registration of a trade mark, shall, in their application to a certification trade mark, be substituted by references to authorisation to proceed with the application.

(3) An applicant for the registration of a certification trade mark shall not be deemed to have abandoned his application, if, in the circumstances of rule 24, he does not apply for a hearing or reply in writing.

(4) The address of an applicant to register a certification trade mark shall be deemed to be a trade or business address for all the purposes for which such an address is required by these rules.

92. Case accompanying application.—The applicant shall send to the Registrar with his application a case setting out the grounds on which he relies in support of his application. Such case shall be furnished in duplicate.

93. Opposition to registration of certification trade marks.—(1) The references to Forms TM-5, TM-6, and TM-7 in rules 30 to 39 shall in their application to proceedings on the opposition to the registration of certification trade marks under sub-section (2) of section 55, be substituted by reference to Form TM-8, TM-9 and TM-10, respectively.

(2) In any case of doubt with regard to the application of the provisions of rules 30 to 39 to proceedings on the opposition to the registration of a certification trade mark any party may apply to the Registrar or the ¹[Federal Government], as the case may be, for directions.

94. Rectification of certification trade mark entries.—An application on any of the grounds mentioned in sub-section (1) of section 59 shall be made on Form TM-43 and shall set forth full particulars of the grounds on which the application is made.

95. Alteration of regulations relating to certification trade marks.—An application by the registered proprietor of a certification trade mark under sub-section (2) of section 56 shall be made on Form TM-42 and where the ¹[Federal

¹ See foot-note 1 on page 2, *supra*.

(Under section 84.—Revised Trade Marks Rules)

Government] decides to advertise such application under sub-section (3) of section 56, the advertisement shall be made in the Journal.

96. Consent of ¹[Federal Government] to assignment or transmission of certification trade mark.—An application for the consent of the ¹[Federal Government] under sub-section (1) of section 34 shall be made on Form TM-22.

PART III

Special Provisions for Textile Marks

CHAPTER I.—MISCELLANEOUS

97. Rules to apply to textile marks.—Subject to the provisions of this Part, the provisions of Part-I, Part-II and Part-V of these Rules shall apply to textile marks and certification trade marks in respect of textile goods as they apply to trade marks and certification trade marks in respect of non-textile goods.

98. Textile Marks.—The expression “textile mark” means a trade mark or a certification trade mark used or proposed to be used in relation to goods specified in rule 99 as “textile goods” for the purpose of Chapter IX of the Act.

99. Textile goods.—The classes of goods to which Chapter IX of the Act shall apply and which are in the Act and these rules referred to as textile goods shall be classes 22 to 27 (inclusive) of the Fourth Schedule to these rules.

100. Application to register word mark.—An application for the registration of trade mark consisting exclusively of a word or words (not being an invented word or invented words) relating to textile goods shall be made on Form TM-51.

101. Application to register letters or numerals.—Subject to the provisions of rule 102, an application for the registration of a trade mark consisting of letters or numerals or any combination thereof relating to textile goods shall be made on Form TM-52.

102. Items of textile goods.—A separate application for the registration of a trade mark shall be made in respect of each of the items of textile goods mentioned in the Fifth Schedule to these rules where the mark consists exclusively of letters or numerals or any combination thereof. Such application shall be made on Form TM-53.

103. Grouping of items of the Fifth Schedule.—For the purposes of applications for the registration of trade marks consisting exclusively of letters, numerals or any combination thereof made on Form TM-53, the items of the Fifth Schedule to these rules shall be grouped as follows; and goods falling in each

¹See foot-note 1 on page 2, *supra*.

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group shall be deemed to be goods of the same description, and goods falling in different groups shall not be deemed to be goods of the same description.

Group 1—Items 1, 4, 5, 8, 9, 10, 11, 12, 16, 19, 20, 22, 23, 24, 25, 26, 27, 30, 33, 36, 37, 39, 41, 42, 44, 45, 48, 49, 54, 55, 59, 61, 62, 65 and 91.

Group 2—Items 2, 3, 14, 17, 18, 34, 35 and 47.

Group 3—Items 6, 7, 21, 38 and 52.

Group 4—Items 13, 29, 75, 77 and 78.

Group 5—Items 15, 28, 31, 40, 60, 66, 79, 88, 90 and 93.

Group 6—Items 32, 43, 64 and 94.

Group 7—Items 46, 83 and 85.

Group 8—Items 50, 51, 56, 57, 63, 76, 80, 84, 86, 87 and 89.

Group 9—Item 53.

Group 10—Items 58, 82 and 92.

Group 11—Items 67, 68, 69, 70 and 71.

Group 12—Item 72.

Group 13—Item 73.

Group 14—Item 74.

Group 15—Item 81.

104. Entry in the Refused Textile Marks List.—Where the registration of a trade mark in respect of textile goods has been refused, the applicant may file a request on Form TM-44 accompanied by the prescribed fee to enter the trade mark in the Refused Textile Marks List and thereupon particulars in reference to that refused mark shall be entered in the list.

105. Continuance of a mark in the Refused Textile Marks List.—A mark entered upon the Refused Textile Marks List in the manner aforesaid shall remain in that list for a period of seven years from the date of application to register, but it may be continued in the list beyond that period if the applicant for registration, or his successor in business pays the prescribed continuance fee at the Trade Marks Registry on Form TM-45.

106. Notice to applicant.—(1) Before removing a mark from the Refused Textile Marks List for non-payment of the prescribed continuance fee the Registrar shall, at a date not more than six months but not less than three months prior to the date on which the removal of the mark would be due, give notice in writing that the mark will not be continued in the said list after a date to be specified in the notice unless the prescribed continuance fee is paid on or before the said date.

(Under section 84.—Revised Trade Marks Rules)

(2) The notice mentioned in the foregoing sub-rule shall be addressed to the applicant at the address appearing in the Refused Textile Marks List. In case such notice is returned by the postal authorities the Registrar may, but without being under any obligation to do so, discover the changed address of the applicant if he be still in business, or of his successor in business, with a view to bring the notice to his attention.

107. **Amendment of the Refused Textile Marks List.**—An application for amendment of an entry relating to the name, address or description of the proprietor of refused mark entered in the Refused Textile Marks List, shall be made on Form TM-16. If the Registrar is satisfied that it would be just and proper to allow the amendment he may accept the application in which case entry shall be amended accordingly.

108. **Search.**—Upon receipt of an application for the registration of a trade mark or a certification trade mark relating to textile goods, the Registrar shall cause a search to be made among the registered trade marks and certification trade marks, the Refused Textile Marks List, and pending applications for registration, for the purpose of ascertaining whether there are on record in respect of the same goods or description of goods any marks identical with the mark sought to be registered or so nearly resembling it as to render it likely to deceive or cause confusion and the Registrar may cause the search to be renewed at any time before the acceptance of the application.

109. **Application for registration, additional representation.**—Every application for the registration of a trade mark (other than a trade mark to which rule 100, 101 or 102 applies) relating to textile goods shall be made on Form TM-2 and shall be accompanied by six additional representations of the mark. The representations of the mark on the application and its duplicate and the additional representations shall correspond exactly with one another. The additional representations shall in all cases be noted with all such particulars as may from time to time be required by the Registrar. Such particulars shall, if required, be signed by the applicant.

CHAPTER II.—RULES UNDER SUB-SECTION (2) OF SECTION 64

110. **Definition.**—For the purposes of this Chapter, unless there is anything repugnant in the subject or context,—

- (a) “balanced numeral” means a trade mark consisting of either identical numerals or identical letters of not less than three nor more than seven digits ;
- (b) “digit” includes a single letter;
- (c) “letter fraction” means a fraction containing one or more letters.

111. **Non-registrability of certain marks.**—In respect of textile goods the following marks shall not be capable of registration, namely :—

- (a) any numeral of one digit or of more than six digits not being a balanced numeral ;

(Under section 84.—Revised Trade Marks Rules)

- (b) a single letter or any combination of letters or more than six letters not being a balanced numeral ;
- (c) any combination of numerals and letters of more than eight digits ;
- (d) any fraction or letter fraction consisting of more than eight digits together ;
- (e) any fraction or letter fraction having less than three digits together ;
- (f) any combination of numerals and fractions of more than six digits ;
- (g) any combination of numerals, letters, fractions and letter fractions either having more than eight digits or ending with a fraction of more than one digit in the numerator or in the denominator ;
- (h) numerals or letters representing cloth dimensions ;
- (i) a balanced numeral which does not consist of at least two more or two less digits than a balanced numeral of the same series already registered in the name of a different person in respect of the same goods or description of goods.

112. Marks likely to deceive or to cause confusion.—(1) A trade mark consisting of numerals, letters, fractions, letter fractions, or any combination thereof, and not being a balanced numeral, shall not be capable of being registered as a textile mark if it does not differ from a trade mark registered in the name of a different person in respect of the same goods or description of goods :—

- (a) in the case of numeral not exceeding four digits, in at least one corresponding digit ;
- (b) in the case of numeral of five digits, in at least two corresponding digits ;
- (c) in the case of numeral of six digits, in at least three corresponding digits ;
- (d) in the case of a combination of two letters, in at least one corresponding letter ;
- (e) in the case of combination of three or four letters, in at least two corresponding letters ;
- (f) in the case of a combination of five or six letters, in at least three corresponding letters ;
- (g) in the case of a mark consisting of one letter and one numeral digit, in at least one of them ;
- (h) in the case of mark consisting of one letter and two or three numeral digits, in at least one corresponding numeral digit ;
- (i) in the case of mark consisting of one letter and four or more numeral digits, in at least two corresponding digits ;

(Under section 84.—Revised Trade Marks Rules)

- (j) in the case of a mark consisting of two or more letters and one or more numeral digits, in at least one corresponding letter and one corresponding numeral digit ;
- (k) in the case of a fraction or letter fraction or any combination thereof in which the total number of digits in the numerator and denominator is three or four, in at least one corresponding digit from either the numerator or the denominator ;
- (l) in the case of a fraction or letter fraction or any combination thereof in which the total number of digits in the numerator and denominator is five or more, in at least one corresponding digit in the numerator and one corresponding digit in the denominator or two corresponding digits in either the numerator or the denominator ;
- (m) in the case of a combination consisting of a numeral and a fraction in at least one corresponding numeral digit ;
- (n) in the case of a combination of letters, numerals, and fractions (including letter fractions) :—
- (i) where the total number of digits excluding the fraction is not more than three, in at least one corresponding digit ;
- (ii) where the total number of digits, excluding the fraction, is four or more, in at least two corresponding digits.

(2) Nothing in sub-rule (1) shall be construed to signify that where a trade mark does not come within the scope of any case specified in the said sub-rule, the mark shall necessarily be regarded as not being likely to deceive or to cause confusion.

113. Exception in the case of 'old' marks.—In the case of a trade mark consisting of letters, numerals or any combination thereof which in respect of the same goods as those in relation to which registration is applied for, has been continuously used (either by the applicant for registration or by some predecessor in his business, and either in its original form or with additions or alterations not substantially affecting its identity) during the period from a date prior to the 25th day of February, 1937, to the date of application for registration, the Registrar shall not refuse registration by reason only of the fact that the trade mark does not satisfy the conditions and restrictions laid down in clause (i) of rule 111 or in rule 112 and may register such mark on evidence of user.

CHAPTER III.—ADVISORY COMMITTEE

114. Constitution.—(1) For the purpose of section 66, an Advisory Committee shall be constituted consisting of members appointed by the ¹[Federal Government] on the recommendation of the Associations specified in the Seventh Schedule to these rules.

(2) The number of recommendations which the Associations will be entitled to make shall be those specified in the said Schedule :

¹ See foot-note 1 on page 2, *supra*.

(Under section 84.—Revised Trade Marks Rules)

Provided that if within the period allowed by the ¹[Federal Government] for this purpose any of the said Associations fails to make any recommendation or to make the full number of recommendations which it is entitled to make, the ¹[Federal Government] may appoint the required number of members of the Advisory Committee of its own motion without any such recommendation.

(3) The ¹[Federal Government] may appoint other persons versed in the usage of the textile trade as members of the Committee.

115. Tenure of office of members.—The tenure of office of each member shall be two years, but a retiring member shall be eligible for re-appointment at the end of his tenure :

Provided that a member may continue to hold office after the expiry of two years from his appointment until such time as he is re-appointed or another member is appointed in his place.

116. Substitution of members.—Whenever any member of the Advisory Committee ceases to reside in Pakistan, or becomes incapable of acting as a member of the Advisory Committee, the ¹[Federal Government] may appoint another person to be a member in his stead, in accordance with the provision of rule 114.

117. Co-option of members.—Whenever it is considered expedient so to do, the Committee may co-opt one or more persons as its members for the purpose of any of its meetings :

Provided that any person co-opted as a member for the purpose of any meeting shall automatically cease to be a member after the termination of the said meeting.

118. Meetings.—(1) The Advisory Committee shall elect two of its members as Chairman and Vice-Chairman respectively. When the Chairman or Vice-Chairman ceases to hold office, the vacancy shall be filled by re-election at the next meeting of the Advisory Committee.

(2) The Advisory Committee shall also appoint a Secretary and deposit the name and address of the Secretary at the Trade Marks Registry.

(3) The meetings of the Advisory Committee shall be convened by the Chairman at such time and place as he thinks fit.

119. Manner of consultation.—Any question which the Advisory Committee is required to consider and advise upon may be referred for decision to the members of the Advisory Committee either at its meetings or by circulation of the papers :

Provided that any question referred by circulation of papers, shall on request of at least ten members of the Advisory Committee, be placed on the agenda of the next meeting of the Committee.

120. Facts of a case for advice.—The Registrar shall send in writing to the Advisory Committee the facts relating to the case in which their advice is sought.

¹ See foot-note 1 on page 2, *supra*.

(Under section 84.—Revised Trade Marks Rules)

121. Time-limit for giving advice.—The advice sought by Registrar from the Advisory Committee shall be given by the Committee in writing within 21 days from the date of the receipt of the letter seeking advice, but the Registrar may extend the time at the request of the Advisory Committee.

122. Further information.—Where for the purpose of giving advice sought by the Registrar, the Committee requires further information, the Secretary may write to the Registrar and the required information shall be given by the Registrar in writing.

123. Presiding at meetings.—The Chairman shall preside at every meeting at which he is present, and if he is absent, the Vice-Chairman shall preside over the meeting. In the absence of the Chairman and the Vice-Chairman, the members present shall elect one of their members to preside over the meeting.

124. Decision by voting.—Whenever the members of the Committee are divided in their opinion on any point at issue, the question shall be decided by a majority of the votes, and the voting shall be by show of hands. The Chairman may vote, and in the case of an equality of votes, shall have a casting vote.

125. Record of meetings.—The secretary shall maintain a record of all business transacted by the Advisory Committee. The Registrar shall be entitled to call for copies certified to be true by the Secretary of the record of the business transacted at any meeting.

PART IV

Registration of Trade Marks Agents

126. Definitions.—In this Part, unless there is anything repugnant in the subject or context :—

- (a) "Agents' Register" means the Register of Trade Marks Agents kept under rule 127 of these rules ;
- (b) "Graduate" means a graduate of University established by law in Pakistan, any foreign University recognised by the ¹[Federal Government].
- (c) "Registered Agent" means a Trade Marks Agent whose name is actually on the Agents' Register.

127. Register of Trade Marks Agents.—The ¹[Federal Government] shall maintain a Register of Trade Marks Agents wherein shall be entered the name, the address, the business address, the qualifications and the date of registration of every registered agent.

128. Eligibility for registration.—(1) No person shall be eligible for registration as a Trade Marks Agent unless he is resident in Pakistan and has been considered by the ¹[Federal Government] to be a fit person to become a registered agent.

¹See foot-note 1 on page 2, *supra*.

(Under section 84.—Revised Trade Marks Rules)

¹[(2) A person shall not be qualified for registration as a Trade Marks Agent unless he is a citizen of Pakistan and—

- (a) ²[is at least a graduate from a recognised University with at least one year's] experience of working with a Registered Trade Marks Agent or an advocate practising before the Trade Marks Registry ; or
- (b) has been an officer of Grade 16 or above in the Trade Marks Registry for a period of not less than 10 years :

Provided that no such person shall be entitled to registration for a period of ³[three] years from the date of retirement or termination of service :

Provided further that no such person shall be entitled to registration if he has been dismissed or removed from service.] ;

129. Persons debarred from registration.—A person shall not be eligible for registration as a Trade Marks Agent if he—

- (i) has been adjudged by a competent court to be of unsound mind ;
- (ii) is an undischarged insolvent ;
- (iii) being a discharged insolvent has not obtained from the court a certificate to the effect that his insolvency was caused by misfortune without any misconduct on his part ;
- (iv) has been convicted by a competent court, whether within or without Pakistan of an offence punishable with transportation or imprisonment, unless the offence of which he has been convicted has been pardoned or unless on an application made by him, the ⁴[Federal Government] has, by order in this behalf, removed the disability ; or
- (v) is considered by the ⁴[Federal Government] not to be a fit and proper person to become a registered agent by reason of any act of negligence, misconduct or dishonesty committed in his professional capacity.

130. Manner of making application.—All applications under the provisions of this Part, shall be sent to, or left at, the Trade Marks Registry, and shall be made in duplicate.

131. Applications for registration as a Trade Marks Agent.—(1) Every person desiring to be registered as a Trade Marks Agent shall make an application on Form TMA-1.

(2) The applicant shall furnish such further information bearing on his application as may be required of him at any time by the ⁴[Federal Government] or the Registrar.

¹ Subs. by S.R.O. 1137(I)/74, dated 27-8-74, item (1), for sub-rule (2), *see* Gaz. of P., 1974, Ext., Pt. II, pp. 595-96.

² Subs. by S.R.O. 507(I)/77, dated 11-6-77, item (11), for certain words (*w.e.f.* 1-7-1977), *see* Gaz. of P., 1977, Ext., Pt. II, pp. 1009—14.

³ Subs. *ibid.*, for "five" (*w.e.f.* 1-7-1977).

⁴ *See* foot-note 1 on page 2, *supra*.

(Under section 84.—Revised Trade Marks Rules)

1[132. Procedure on application.—On receipt of an application for the registration of a person as a Trade Marks Agent, the Registrar shall examine the application and obtain such other information or evidence as he may consider necessary for determining the eligibility of the applicant for registration as a Trade Marks Agent and, thereafter, shall forward to the Federal Government the application and other relevant papers alongwith his recommendation thereon.] ;

133. Certificate of registration.—If the 2[Federal Government] considers an applicant eligible for registration as a Trade Marks Agent, it shall send an intimation to that effect to the applicant, and any person so intimated may pay the prescribed fees for his registration as a Trade Marks Agent. On receipt of the prescribed fees, the Registrar shall send an intimation thereof to the 2[Federal Government]; and the 2[Federal Government] shall thereupon cause the applicant's name to be entered in the Agents' Register, and shall issue to him a certificate on form O-4 of registration as a Trade Marks Agent.

134. Continuance of a name in the Agents' Register.—The continuance of a person's name in the Agents' Register shall be subject to his payment of the fees prescribed in that behalf.

135. Removal of agent's name from Agents' Register.—(1) The 2[Federal Government] may remove permanently or temporarily from the Agents' Register the name of any registered agent—

- (a) from whom a request has been received to that effect ; or
- (b) from whom the annual fee has not been received on the expiry of three months from the date on which it became due ; or
- (c) who is found to have been subject at the time of his registration or thereafter has become subject, to any of the disabilities stated in clauses (i), (ii), (iii) and (iv) of rule 129 ; or
- (d) whom the 2[Federal Government] has declared not to be a fit and proper person to remain on the register by reason of any act of negligence, misconduct or dishonesty committed in his professional capacity :

Provided that before making such declaration, the 2[Federal Government] shall call upon the person concerned to show cause why his registration should not be cancelled and shall make such further enquiry, if any, as it may consider necessary.

(2) The 2[Federal Government] shall remove from the Agents' Register the name of any registered agent who is dead.

(3) The removal of the name of any person from the Agents' Register shall be notified, in the official Gazette and in the Journal and shall, wherever possible, be communicated to the person concerned.

136. Restoration of removed names.—(1) The 2[Federal Government] may, on an application on Form TMA-2 from a person whose name has been temporarily removed under sub-rule (1) of rule 135, restore his name to the Agents' Register.

(2) The restoration of a name to the Agents' Register shall be notified in the official Gazette and in the Journal, and shall whenever possible be communicated to the person concerned.

¹ Subs. by S.R.O. 1137(I)/74, dated 27-8-74, item (2), for rule 132, see Gaz. of P., 1974. Ext., Pt. II, pp. 1595-96.

² See foot-note 1 on page 2, *supra*.

(Under section 84.—Revised Trade Marks Rules)

137. Alteration in the Agents' Register.—(1) A registered agent may apply on Form TMA-3 for alteration of his name, address, business address or qualifications entered in the Agents' Register. On receipt of such application and the fee prescribed in that behalf, the ¹[Federal Government] shall cause the necessary alteration to be made in the Agents' Register.

(2) Every alteration made in the Agents' Register shall be notified in the Official Gazette and in the Journal.

138. Publication of the Agent's Register.—The Agents' Register shall be published from time to time, as the ¹[Federal Government] may deem fit, the entries being arranged in the alphabetical order of the surnames of the registered agents and copies thereof shall be placed on sale.

PART V

Rules Relating to Branch Registry

²[139. Establishment and administration of the Branch.—(1) The Federal Government may establish a Branch Registry at any place in the territory to which the Act extends.

(2) Each Branch Registry shall be in charge of a Deputy Registrar of Trade Marks or any other officer to whom any particular functions of the Registrar have been delegated by the Registrar, and shall act under the control and superintendence of the Registrar.]

140. Applications etc.—All applications, notices, statements or other documents, or any fees therefor, authorised or required by the Act or these rules to be made, left or sent or paid to the Trade Marks Registry may be made, left or sent or paid to the Branch Registry and shall, thereupon, have effect as if they were duly made, left or sent or paid to the Trade Marks Registry.

141. Inspection of copy of Register, etc.—A copy of the Register and of the Refused Textile Marks List shall be available for inspection on payment of the prescribed fee, at such times on all days on which the Branch Registry is not closed to the public, as may be fixed by the Registrar.

142. Hearing at the Branch Registry.—(1) Where an application for the registration of a trade mark has been made at the Branch Registry the application shall in the event of a hearing becoming necessary, and if the applicant so desires, be heard at the Branch Registry :

Provided that in the event of the Registrar having to deal with more than one application at one hearing it shall be in the discretion of the Registrar to direct the hearing of the application at Karachi or at the Branch Registry.

(2) Where the hearing has taken place at the Branch Registry, the decision in respect thereof shall be pronounced at the Branch Registry.

143. Repeal and savings.—(1) The Trade Marks Rules, 1942 are hereby repealed.

(2) Anything done, any action taken, any proceeding commenced or any order made under or in pursuance of the Trade Marks Rules, 1942, shall be deemed to have been done, taken, commenced or made under or in pursuance of these rules.

¹See foot-note 1 on page 2, *supra*.

²Subs. by S.R.O. 1620(I)/73, dated 22-11-73, item (2), for rule 139, see Gaz. of P., 1973, Ext., Pt. II, p. 2355.

ANNEX VI

**THE COPYRIGHT ORDINANCE,
1962**

The Copyright Ordinance, 1962

[as amended up to December 1, 1972]

[omissions]

CHAPTER I

PRELIMINARY

1. SHORT TITLE, EXTENT AND COMMENCEMENT.—(1) This Ordinance may be called the Copyright Ordinance, 1962.

(2) It extends to the whole of Pakistan.

(3) It shall come into force on such date as the Federal Government may, by notification in the official Gazette, appoint.

2. DEFINITIONS.—In this Ordinance, unless there is anything repugnant in the subject or context,—

(a) “adaptation” means,—

- (i) in relation to a dramatic work, the conversion of the work into a non-dramatic work;
- (ii) in relation to a literary work or an artistic work, the conversion of the work into a dramatic work by way of performance in public or otherwise;
- (iii) in relation to a literary or dramatic work, any abridgment of the work or any version of the work in which the story or action is conveyed wholly or mainly by means of pictures in a form suitable for reproduction in a book, or in a newspaper, magazine or similar periodical; and
- (iv) in relation to a musical work, any arrangement or transcription of the work;

(b) “architectural work of art” means any building or structure having an artistic character or design, or any model for such building or structure;

(c) “artistic work” means,—

(i) a painting, a sculpture, a drawing (including a diagram, map, chart or plan), an engraving or a photograph, whether or not any such work possesses artistic quality;

(ii) an architectural work of art; and

(iii) any other work of artistic craftsmanship;

(d) “author” means,—

(i) in relation to a literary or dramatic work, the author of the work;

(ii) in relation to a musical work, the composer;

(iii) in relation to an artistic work other than a photograph, the artist;

(iv) in relation to a photograph, the person taking the photograph;

(v) in relation to a cinematographic work, the owner of the work at the time of its completion; and

(vi) in relation to a record, the owner of the original plate from which the record is made, at the time of the making of the plate;

(e) “Board” means the Copyright Board constituted under section 45;

Date of the Ordinance (No. XXXIV): May 31, 1962; of amendatory Ordinance (No. LVI): December 1, 1972.

Official English text of basic Ordinance published in The Gazette of Pakistan, Extraordinary, of June 2, 1962, pp. 827-861; of amendatory Ordinance in The Gazette of Pakistan, Extraordinary, of December 4, 1972, p. 312.

Observation: The Copyright Ordinance, 1962, came into force on February 27, 1967, pursuant to a notification published by the Central Government in *The Gazette of Pakistan, Extraordinary*, of February 21, 1967, according to section I, sub-section (3). The Copyright (Amendment) Ordinance, 1972, entered into force on December 1, 1972.

- (f) "book" includes every volume, part or division of a volume, and pamphlet, in any language, and every sheet of music, map, chart or plan, separately printed or lithographed, but does not include a newspaper;
- (g) "calendar year" means the year commencing on the first day of January;
- (h) "cinematographic work" means any sequence of visual images recorded on material of any description (whether translucent or not), whether silent or accompanied by sound, which, if shown (played back, exhibited) conveys the sensation of motion;
- (i) "delivery" in relation to a lecture, includes delivery by means of any mechanical instrument or by radio-diffusion;
- (j) "dramatic work" includes any piece for recitation, choreographic work or entertainment in dumb show, the scenic arrangement or acting form of which is fixed in writing or otherwise but does not include a cinematographic work;
- (k) "engravings" include etchings, lithographs, wood-cuts, prints and other similar works, not being photographs;
- (l) "exclusive licence" means a licence which confers on the licensee or on the licensee and persons authorized by him, to the exclusion of all other persons (including the owner of the copyright), any right comprised in the copyright in a work, and "exclusive licensee" shall be construed accordingly;
- (m) "Government work" means a work which is made or published by or under the direction or control of—
- (i) the Government or any department of the Government; or
 - (ii) any court, tribunal or other judicial or legislative authority in Pakistan;
- (n) "infringing copy" means,—
- (i) in relation to a literary, dramatic, musical or artistic work, a reproduction thereof otherwise than in the form of a cinematographic work;
 - (ii) in relation to a cinematographic work, a copy of the work or a record embodying the recording in any part of the sound track associated with the film;
 - (iii) in relation to a record, any record embodying the same recording; and
 - (iv) in relation to a programme in which a broadcast reproduction right subsists under section 24, a record recording the programme, if such reproduction, copy or record is made or imported in contravention of any of the provisions of this Ordinance;
- (o) "lecture" includes address, speech and sermon;
- (p) "literary work" includes works on humanity, religion, social and physical sciences, tables and compilations;
- (q) "manuscript" means the original document embodying the work, whether written by hand or not;
- (r) "musical work" means any combination of melody and harmony or either of them, printed, reduced to writing or otherwise graphically produced or reproduced;
- (s) "newspaper" means any printed periodical work containing public news or comments on public news published in conformity with the provisions of sections 5, 6, 7 and 8 of the Press and Publications Ordinance, 1960 (XV of 1960);
- (t) "Pakistani work" means a literary, dramatic, musical or artistic work, the author of which is a citizen of Pakistan and includes a cinematographic work or a record made or manufactured in Pakistan;
- (u) "performance" includes any mode

- of visual or acoustic presentation, including any such presentation by the exhibition of a cinematographic work, or by means of radio-diffusion, or by the use of a record, or by any other means and, in relation to a lecture, includes the delivery of such lecture;
- (v) "performing rights society" means a society, association or other body, whether incorporated or not, which carries on in Pakistan the business of issuing or granting licences for the performance in Pakistan of any works in which copyright subsists;
- (w) "photograph" includes photo-lithograph and any work produced by any process analogous to photography but does not include any part of a cinematographic work;
- (x) "plate" includes any stereotype or other plate, stone, block, mould, matrix, transfer, negative, tape, wire, optical film, or other device used or intended to be used for printing or reproducing copies of any work, and any matrix or other appliances by which records for the acoustic presentation of the work are or are intended to be made;
- (y) "prescribed" means prescribed by rules made under this Ordinance;
- (z) "public libraries" means the National Library of Pakistan designated as such by the Federal Government and any two other libraries, one in each Province, specified by the Federal Government in this behalf, by notification in the official Gazette;
- (za) "radio-diffusion" includes communication to the public by any means of wireless diffusion whether in the form of sounds or visual images or both;
- (zb) "record" means any disc, tape, wire, perforated roll or other device in which sounds are embodied so as to be capable of being reproduced therefrom, other than a sound track associated with a cinematographic work;
- (zc) "recording" means the aggregate of the sounds embodied in and capable of being reproduced by means of a record;
- (zd) "reproduction" in the case of a literary, dramatic or musical work, includes a reproduction in the form of a record or of a cinematographic work and, in the case of an artistic work, includes a version produced by converting the work into a three-dimensional form, or if it is in three dimensions, by converting it into a two dimensional form and references to reproducing a work shall be construed accordingly;
- (ze) "Registrar" means the Registrar of Copyrights appointed under section 44 and includes a Deputy Registrar of Copyrights when discharging any function of the Registrar;
- (zf) "work" means any of the following works, namely:—
- (i) a literary, dramatic, musical or artistic work;
 - (ii) a cinematographic work;
 - (iii) a record;
- (zg) "work of joint authorship" means a work produced by the collaboration of two or more authors in which the contribution of one author is not distinct from the contribution of the other author or authors; and
- (zh) "work of sculpture" includes casts and models.

3. MEANING OF COPYRIGHT.—(1) For the purposes of this Ordinance, "copyright" means the exclusive right, by virtue of, and subject to the provisions of, this Ordinance,—

- (a) in the case of a literary, dramatic or musical work, to do and authorize the doing of any of the following acts, namely:—
- (i) to reproduce the work in any material form;
 - (ii) to publish the work;
 - (iii) to perform the work in public;
 - (iv) to produce, reproduce, perform or publish any translation of the work;

- (v) to use the work in a cinematographic work or make a record in respect of the work;
 - (vi) to communicate the work by radio-diffusion or to communicate to the public by a loud-speaker or any other similar instrument the radio-diffusion of the work;
 - (vii) to make any adaptation of the work;
 - (viii) to do in relation to a translation or an adaptation of the work any of the acts specified in relation to the work in sub-clauses (i) to (vi);
- (b) in the case of an artistic work, to do or authorize the doing of any of the following acts, namely:—
- (i) to reproduce the work in any material form;
 - (ii) to publish the work;
 - (iii) to use the work in a cinematographic work;
 - (iv) to show the work on television;
 - (v) to make any adaptation of the work;
 - (vi) to do in relation to an adaptation of the work any of the acts specified in relation to the work in sub-clauses (i) to (iv);
- (c) in the case of a cinematographic work, to do or authorize the doing of any of the following acts, namely:—
- (i) to make a copy of the work;
 - (ii) to cause the work in so far as it consists of visual images, to be seen in public and, in so far as it consists of sounds, to be heard in public;
 - (iii) to make any record embodying the recording in any part of the sound track associated with the work by utilising such sound track;
 - (iv) to communicate the work by radio-diffusion;
- (d) in the case of a record, to do or authorize the doing of any of the following acts by utilising the record

namely:—

- (i) to make any other record, embodying the same recording;
- (ii) to use the record in the sound track of a cinematographic work;
- (iii) to cause the recording embodied in the record to be heard in public;
- (iv) to communicate the recording embodied in the record by radio-diffusion.

(2) Any reference in sub-section (1) to the doing of any act in relation to a work or a translation or an adaptation thereof shall include a reference to the doing of that act in relation to a part thereof.

4. MEANING OF PUBLICATION.— (1) For the purposes of this Ordinance, "publication" means,—

- (a) in the case of a literary, dramatic, musical or artistic work, the issue of copies of the work to the public in sufficient quantities;
- (b) in the case of a cinematographic work, the sale or hire or offer for sale or hire of the work or copies thereof to the public;
- (c) in the case of a record, the issue of records to the public in sufficient quantities;

but does not, except as otherwise expressly provided in this Ordinance, include,—

- (i) in the case of a literary, dramatic or musical work, the issue of any records recording such work;
- (ii) in the case of a work of sculpture or an architectural work of art, the issue of photographs and engravings of such work.

(2) If any question arises under sub-section (1) whether copies of any literary, dramatic, musical or artistic work, or records issued to the public are sufficient in quantities, it shall be referred to the Board whose decision thereon shall be final.

5. WHEN WORK NOT DEEMED TO BE PUBLISHED OR PERFORMED IN PUBLIC.—

Except for the purposes of infringement of copyright, a work shall not be deemed to be published or performed in public, and a lecture shall not be deemed to be delivered in public, if published, performed in public or delivered in public, without the licence or consent of the owner of the copyright.

6. **WHEN WORK DEEMED TO BE FIRST PUBLISHED IN PAKISTAN.**—(1) For the purposes of this Ordinance, a work published in Pakistan shall be deemed to be first published in Pakistan, notwithstanding that it has been published simultaneously in some other country, unless such other country provides a shorter term of copyright for such work; and a work shall be deemed to be published simultaneously in Pakistan and in another country if the time between the publication in Pakistan and the publication in such other country does not exceed thirty days.

(2) If any question arises under subsection (1) whether the term of copyright for any work is shorter in any other country than that provided in respect of that work under this Ordinance, it shall be referred to the Board whose decision thereon shall be final.

7. **NATIONALITY OF AUTHOR WHERE THE MAKING OF UNPUBLISHED WORK IS EXTENDED OVER CONSIDERABLE PERIOD.**— Where, in the case of an unpublished work, the making of the work is extended over a considerable period, the author of the work shall, for the purposes of this Ordinance, be deemed to be a citizen of, or domiciled in, the country of which he was a citizen or wherein he was domiciled during the major part of that period.

8. **DOMICILE OF CORPORATIONS.**—For the purposes of this Ordinance, a body corporate shall be deemed to be domiciled in Pakistan if it is incorporated under any law in force in Pakistan or if it has an established place of business in Pakistan.

CHAPTER II

COPYRIGHT, OWNERSHIP OF COPYRIGHT AND THE RIGHTS OF THE OWNER

9. **NO COPYRIGHT EXCEPT AS PROVIDED IN THIS ORDINANCE.**—No person shall be entitled to copyright or any similar right in any work, whether published or unpublished, otherwise than under and in accordance with the provisions of this Ordinance, or of any other law for the time being in force, but nothing in this section shall be construed as abrogating any right or jurisdiction to restrain a breach of trust or confidence.

10. **WORKS IN WHICH COPYRIGHT SUBSISTS.**—(1) Subject to the provisions of this section and to the other provisions of this Ordinance, copyright shall subsist throughout Pakistan in the following classes of works, that is to say,—

- (a) original literary, dramatic, musical and artistic works;
- (b) cinematographic works; and
- (c) records.

(2) Copyright shall not subsist in any work specified in subsection (1), other than a work to which the provisions of section 53 or section 54 apply, unless,—

- (i) in the case of a published work, the work is first published in Pakistan, or where the work is first published outside Pakistan, the author is at the date of such publication, or in a case where the author was dead at that date, was at the time of his death, a citizen of Pakistan or domiciled in Pakistan;
- (ii) in the case of an unpublished work other than an architectural work of art, the author is at the date of the making of the work a citizen of Pakistan or domiciled in Pakistan; and
- (iii) in the case of an architectural work of art, the work is located in Pakistan.

(2A) Copyright shall not subsist in any

work referred to in subsection (2) as respects its reprint, translation, adaptation or publication, by or under the authority of the Federal Government, as text-book for the purpose of teaching, study or research in educational institutions.

(3) Copyright shall not subsist,—

(a) in any cinematographic work, if a substantial part of the work is an infringement of the copyright in any other work;

(b) in any record made in respect of a literary, dramatic or musical work, if, in making the record, copyright in such work has been infringed.

(4) The copyright or the lack of copyright in a cinematographic work or a record shall not affect the separate copyright in any work in respect of which or a substantial part of which, the work, or, as the case may be, the record is made.

(5) In the case of an architectural work of art, copyright shall subsist only in the artistic character and design and shall not extend to the processes or methods of construction.

11. WORK OF JOINT AUTHORS.—Where, in the case of a work of joint authorship, some one or more of the joint authors do not satisfy the conditions conferring copyright laid down by this Ordinance, the work shall be treated for the purposes of this Ordinance as if the other author or authors had been the sole author or authors thereof:

Provided that the term of the copyright shall be the same as it would have been if all the authors had satisfied such conditions.

12. PROVISION AS TO DESIGNS REGISTRABLE UNDER ACT II OF 1911.—(1) Copyright shall not subsist under this Ordinance in any design which is registered under the Patents and Designs Act, 1911 (II of 1911).

(2) Copyright in any design which is capable of being registered under the Patents and Designs Act, 1911 (II of 1911), but which has not been so registered, shall cease as soon as any article to which the design has been applied has been repro-

duced more than fifty times by an industrial process by the owner of the copyright or, with his licence, by any other person.

13. FIRST OWNER OF COPYRIGHT.—Subject to the provisions of this Ordinance, the author of a work shall be the first owner of the copyright therein:

Provided that,—

(a) in the case of a literary, dramatic or artistic work made by the author in the course of his employment by the proprietor of a newspaper, magazine or similar periodical under a contract of service or apprenticeship, for the purpose of publication in a newspaper, magazine or similar periodical, the said proprietor shall, in the absence of any agreement to the contrary, be the first owner of the copyright in the work in so far as the copyright relates to the publication of the work in any newspaper, magazine or similar periodical, or to the reproduction of the work for the purpose of its being so published, but in all other respects the author shall be the first owner of the copyright in the work;

(b) subject to the provisions of clause (a), in the case of a photograph taken, or a painting or portrait drawn, or an engraving or a cinematographic work made, for valuable consideration at the instance of any person, such person shall, in the absence of any agreement to the contrary, be the first owner of the copyright therein;

(c) in the case of a work made in the course of the author's employment under a contract of service or apprenticeship, to which clause (a) or clause (b) does not apply, the employer shall, in the absence of any agreement to the contrary, be the first owner of the copyright therein;

(d) in the case of a Government work, Government shall, in the absence of any agreement to the contrary, be

the first owner of the copyright therein;

- (e) in the case of a work to which the provisions of section 53 apply, the international organisation concerned shall be the first owner of the copyright therein.

14. ASSIGNMENT OF COPYRIGHT.—(1) The owner of the copyright in an existing work or the prospective owner of the copyright in a future work may assign to any person the copyright either wholly or partially and either generally or subject to limitations and either for the whole term of the copyright or any part thereof:

Provided that, in the case of the assignment of copyright in any future work, the assignment shall take effect only when the work comes into existence:

Provided further that, where the owner of the copyright in a work is the author of the work, no assignment of the copyright in the work or of any interest in such copyright shall be made, or if made shall be effective (except where the assignment is made in favour of Government or an educational, charitable, religious or non-profit making institution) for a period of more than ten years beginning from the calendar year next following the year in which the assignment is made; if an assignment of the copyright in a work is made in contravention of this proviso, the copyright in the work shall, on the expiry of the period specified in this proviso, revert to the author (who may re-assign the copyright in the work subject to the provisions herein contained), or if the author be dead to his representatives in interest.

(2) Where the assignee of a copyright becomes entitled to any right comprised in the copyright, the assignee as respects the rights so assigned, and the assignor as respects the rights not assigned, shall be treated for the purposes of this Ordinance as the owner of copyright and the provisions of this Ordinance shall have effect accordingly.

(3) In this section, the expression "assignee" as respects the assignment of the copyright in any future work includes the

legal representatives of the assignee, if the assignee dies before the work comes into existence.

15. MODE OF ASSIGNMENT.—No assignment of the copyright in any work shall be valid unless it is in writing signed by the assignor or by his duly authorized agent.

16. TRANSMISSION OF COPYRIGHT IN MANUSCRIPT BY TESTAMENTARY DISPOSITION.

—Where under a bequest a person is entitled to the manuscript of a literary, dramatic or musical work, or to an artistic work, and the work was not published before the death of the testator, the bequest shall, unless the contrary intention is indicated in the testator's will or any codicil thereto, be construed as including the copyright in the work in so far as the testator was the owner of the copyright immediately before his death.

17. RIGHT OF OWNER TO RELINQUISH COPYRIGHT.—(1) The owner of the copyright in a work may relinquish all or any of the rights comprised in the copyright by giving notice in the prescribed form to the Registrar and thereupon such rights shall, subject to the provisions of subsection (3), cease to exist from the date of the notice.

(2) On receipt of a notice under subsection (1), the Registrar shall cause it to be published in the official Gazette and in such other manner as he may deem fit.

(3) The relinquishment of all or any of the rights comprised in the copyright in a work shall not affect any rights subsisting in favour of any person on the date of the notice referred to in sub-section (1).

CHAPTER III

TERM OF COPYRIGHT

18. TERM OF COPYRIGHT IN PUBLISHED LITERARY, DRAMATIC, MUSICAL AND ARTISTIC WORKS.—Except as otherwise hereinafter provided, copyright shall subsist in any literary, dramatic, musical or artistic work (other than a photograph) published within the life-time of the author until fifty

years from the beginning of the calendar year next following the year in which the author dies.

Explanation.—In this section, the reference to the author shall, in the case of a work of joint authorship, be construed as a reference to the author who dies last.

19. TERM OF COPYRIGHT IN POSTHUMOUS WORK.—(1) In the case of a literary, dramatic or musical work or an engraving, in which copyright subsists at the date of the death of the author or, in the case of any such work of joint authorship, at or immediately before the date of the death of the author who dies last, but which or any adaptation of which, has not been published before that date, copyright shall subsist until fifty years from the beginning of the calendar year next following the year in which the work is first published or, where an adaptation of the work is published in any earlier year, from the beginning of the calendar year next following that year.

(2) For the purposes of this section, a literary, dramatic or musical work or an adaptation of any such work shall be deemed to have been published, if it has been performed in public or if any records made in respect of the work have been sold, or offered for sale, to the public.

20. TERM OF COPYRIGHT IN CINEMATOGRAPHIC WORKS, RECORDS AND PHOTOGRAPHS.—(1) In the case of a cinematographic work, copyright shall subsist until fifty years from the beginning of the calendar year next following the year in which the work is published.

(2) In the case of a record, copyright shall subsist until fifty years from the beginning of the calendar year next following the year in which the record is published.

(3) In the case of a photograph, copyright shall subsist until fifty years from the beginning of the calendar year next following the year in which the photograph is published.

21. TERM OF COPYRIGHT IN ANONYMOUS AND PSEUDONYMOUS WORK.—(1) In the case of a literary, dramatic, musical or artistic work (other than a photograph), which is

published anonymously or pseudonymously, copyright shall subsist until fifty years from the beginning of the calendar year next following the year in which the work is first published:

Provided that where the identity of the author is disclosed before the expiry of the said period, copyright shall subsist until fifty years from the beginning of the calendar year next following the year in which the author dies.

(2) In sub-section (1), references to the author shall, in the case of an anonymous work of joint authorship be construed,—

- (a) where the identity of one of the authors is disclosed, as references to that author;
- (b) where the identity of more authors than one is disclosed, as references to the author who dies last from amongst such authors.

(3) In sub-section (1), references to the author shall, in the case of a pseudonymous work of joint authorship, be construed,—

- (a) where the names of one or more (but not all) of the authors are pseudonyms and his or their identity is not disclosed, as references to the author whose name is not a pseudonym, or, if the names of two or more of the authors are not pseudonyms, as references to such one of those authors who dies last;

- (b) where the names of one or more (but not all) of the authors are pseudonyms and the identity of one or more of them is disclosed, as references to the author who dies last from amongst the authors whose names are not pseudonyms and the authors whose names are pseudonyms and are disclosed; and

- (c) where the names of all the authors are pseudonyms and the identity of one of them is disclosed, as references to the author whose identity is disclosed or, if the identity of two or more of such authors is disclosed, as references to such one of those authors who dies last.

Explanation.—For the purposes of this section, the identity of an author shall be deemed to have been disclosed, if either the identity of the author is disclosed publicly by both the author and the publisher or is otherwise established to the satisfaction of the Board by that author.

22. **TERM OF COPYRIGHT IN GOVERNMENT WORKS AND IN WORKS OF INTERNATIONAL ORGANISATIONS.**—(1) Copyright in a Government work shall, where Government is the first owner of the copyright therein, subsist until fifty years from the beginning of the calendar year next following the year in which the work is first published.

(2) In the case of a work of an international organisation to which the provisions of section 53 apply, copyright shall subsist until fifty years from the beginning of the calendar year next following the year in which the work is first published.

23. **TERM OF COPYRIGHT IN UNPUBLISHED WORK.**—(1) If a work, whose author's identity is known, is not published posthumously within fifty years after the death of the author, such work shall fall into the public domain after fifty years from the beginning of the calendar year next following the year in which the author dies.

(2) If a work, whose author's identity is not known, is not published within fifty years of its creation, such work shall fall into the public domain after fifty years from the beginning of the calendar year next following the year in which the work is created.

CHAPTER IV

RIGHTS OF BROADCASTING ORGANIZATIONS

24. **RIGHTS OF BROADCASTING ORGANIZATIONS.**—(1) Broadcasting organizations shall enjoy the right to authorize—

- (a) the rebroadcasting of their broadcasts;
- (b) the fixation of their broadcasts; and
- (c) the copying of fixations made of their broadcasts.

(2) This right shall subsist until twenty-five years from the beginning of the calendar year next following the year in which the broadcast took place.

25. **APPLICATION OF OTHER PROVISIONS OF THIS ORDINANCE TO BROADCASTS.**—Any person who, without the authorization of the broadcasting organization, does or causes the doing of any of the acts referred to in section 24 shall be deemed to infringe the rights of the broadcasting organization, and the provisions contained in Chapters XII to XVI shall, within the limits permitted by the nature of the matter, apply to broadcasting organizations and broadcasts as if they were authors and works, respectively.

26. **DEFINITIONS.**—(a) "Broadcasting" or "broadcast" means the transmission by wireless means for public reception of sounds, images or both.

(b) "Rebroadcasting" means the simultaneous broadcasting by one broadcasting organization of the broadcast of another broadcasting organization.

(c) "Fixation" means the incorporation of sounds or images or both in a device by means of which they can later be made aurally or visually perceivable.

27. **OTHER RIGHTS NOT AFFECTED.**—For the removal of doubts, it is hereby declared that the rights conferred upon broadcasting organizations shall not affect the copyright in any literary, dramatic, musical, artistic or cinematographic work, or in any record used in the broadcast.

CHAPTER V

RIGHTS IN PUBLISHED EDITIONS OF WORKS

28. **PROTECTION OF TYPOGRAPHY AND TERM OF PROTECTION.**—The publisher of an edition of a work shall enjoy the right to authorize the making, by any photographic or similar process, of copies, intended for sale in commerce, of the typographical arrangement of the edition, and such right shall subsist until twenty-

five years from the beginning of the calendar year next following the year in which the edition was first published.

29. **INFRINGEMENTS, ETC.**—Any person who, without the authorization of the publisher, makes or causes the making of, by any photographic or similar process, copies, intended for sale in commerce, of the typographical arrangement of the edition or any substantial part thereof, shall be deemed to infringe the rights of the publisher, and the provisions contained in Chapters XII to XVI shall, within the limits permitted by the nature of the matter, apply to the publisher and the typographical arrangements of editions as if they were authors and works respectively.

Explanation.—“Typographical arrangement” shall include calligraphy.

30. **RELATIONS TO COPYRIGHT.**—For the removal of doubts, it is hereby declared that, subject to the provisions of sub-section (2A) of section 10, the right conferred upon publishers by this Chapter shall

- (a) subsist irrespective of the question whether the edition is that of a work protected or unprotected by copyright;
- (b) not affect the copyright, if any, in the literary, dramatic, musical or artistic work itself.

CHAPTER VI

PERFORMING RIGHTS SOCIETIES

31. **PERFORMING RIGHTS SOCIETY TO FILE STATEMENTS OF FEES, CHARGES AND ROYALTIES.**—(1) Every performing rights society shall, within the prescribed time and in the prescribed manner, prepare, publish and file with the Registrar, statements of all fees, charges or royalties which it proposes to collect for the grant of licences for the performance in public of works in respect of which it has authority to grant such licences.

(2) If any such society fails, in relation to any work, to prepare, publish or file with the Registrar the statements referred to in

subsection (1) in accordance with the provisions of that sub-section, no action or other proceeding to enforce any remedy, civil or criminal, for infringement of the performing rights in that work shall be commenced except with the consent of the Registrar.

32. **OBJECTIONS RELATING TO PUBLISHED STATEMENTS.**—Any person having any objections to any fees, charges or royalties or other particulars included in any statement referred to in section 31 may at any time lodge such objections in writing at the Copyright Office.

33. **DETERMINATION OF OBJECTIONS.**—(1) Every objection lodged at the Copyright Office under section 32 shall, as soon as may be, be referred to the Board, and the Board shall decide such objection in the manner hereinafter provided.

(2) The Board shall, notwithstanding that no objection has been lodged, take notice of any matter which, in its opinion, is one for objection.

(3) The Board shall give notice in respect of every objection to the performing rights society concerned and shall give to such society and the person who lodged the objection a reasonable opportunity of being heard.

(4) The Board shall, after making the prescribed enquiry, make such alterations in the statements as it may think fit, and shall transmit the statements thus altered or unchanged, as the case may be, to the Registrar, who shall thereupon as soon as practicable after the receipt of such statements, publish them in the official Gazette and furnish the performing rights society concerned and the person who lodged the objection with a copy thereof.

(5) The statements of fees, charges or royalties as approved by the Board shall be the fees, charges or royalties which the performing rights society concerned may respectively lawfully sue for or collect in respect of the issue or grant by it of licences for the performance in public of works to which such fees, charges, or royalties relate.

(6) No performing rights society shall

have any right of action or any right to enforce any civil or other remedy for infringement of the performing rights in any work claimed by such society against any person who has tendered or paid to such society the fees, charges or royalties which have been approved by the Board as aforesaid.

34. EXISTING RIGHTS NOT AFFECTED.—Nothing in this Chapter shall be deemed to affect—

- (a) any rights or liabilities in relation to the performing rights in works accrued or incurred before the commencement of this Ordinance; and
- (b) any legal proceedings in respect of such rights or liabilities pending at such commencement.

CHAPTER VII

LICENCES

35. LICENCES BY OWNERS OF COPYRIGHT.—The owner of the copyright in any existing work or the prospective owner of the copyright in any future work may grant any interest in the copyright by licence in writing signed by him or by his duly authorized agent:

Provided that in the case of a licence relating to copyright in any future work, the licence shall take effect only when the work comes into existence.

Explanation.—When a person to whom a licence relating to copyright in any future work is granted under this section dies before the work comes into existence his legal representatives shall, in the absence of any provision to the contrary in the licence, be entitled to the benefit of the licence.

36. COMPULSORY LICENCE IN WORKS WITHHELD FROM PUBLIC.—(1) If at any time during the term of copyright in any Pakistani work which has been published or performed in public, an application is made to the Board that the owner of the copyright in the work—

- (a) has refused to republish or allow the

republishing of the work or has refused to allow the performance in public of the work and by reason of such refusal the work is withheld from the public; or

- (b) has refused to allow communication to the public by radio-diffusion of such work or, in the case of a record, the work recorded in such record, on terms which the applicant considers reasonable;

the Board, after giving to the owner of the copyright in the work a reasonable opportunity of being heard and after holding such inquiry as it may deem necessary, may, if it is satisfied that such refusal is not in the public interest, or that the grounds for such refusal are not reasonable, direct the Registrar to grant to the applicant a licence to republish the work, perform the work in public or communicate the work to the public by radio-diffusion, as the case may be, subject to payment to the owner of the copyright of such compensation and subject to such other terms and conditions as the Board may determine; and thereupon the Registrar shall grant the licence to the applicant in accordance with the directions of the Board, on payment of such fee as may be prescribed.

(2) Where two or more persons have made applications under sub-section (1), the licence shall be granted to the applicant who, in the opinion of the Board, would best serve the interests of the general public.

37. LICENCE TO PRODUCE AND PUBLISH TRANSLATIONS.—(1) Any citizen of Pakistan or a person domiciled in Pakistan may apply to the Board for a licence to produce and publish a translation of a literary or dramatic work in any Pakistani language or a language ordinarily used in Pakistan.

(2) Every such application shall be made in such form as may be prescribed and shall state the proposed retail price of a copy of the translation of the work.

(3) Every applicant for a licence under this section shall, along with his application, deposit with the Registrar such fee as may be prescribed.

(4) When an application is made to the Board under this section, it may, after holding such inquiry as may be prescribed, direct the Registrar to grant to the applicant a licence, not being an exclusive licence, to produce and publish a translation of the work in the language mentioned in the application, on condition that the applicant shall pay to the owner of the copyright in the work royalties in respect of copies of the translation of the work sold to the public, calculated at such rate as the Board may, in the circumstances of each case, determine in the prescribed manner:

Provided that no such licence shall be granted, unless—

- (a) a translation of the work in the language mentioned in the application has not been published by the owner of the copyright in the work or any person authorized by him within seven years of the first publication of the work, or if a translation has been so published, it has been out of print;
- (b) the applicant has proved to the satisfaction to the Board that he had requested and had been denied authorization by the owner of the copyright to produce and publish such translation or that he was unable to find the owner of the copyright;
- (c) where the applicant is unable to find the owner of the copyright, he had sent a copy of his request for such authorization to the publisher whose name appears on the work, not less than two months before the application for the licence;
- (d) the Board is satisfied, after consulting the representative body of authors recognised as such by the Federal Government for the purpose of this clause, that the applicant is competent to produce and publish a correct translation of the work and possesses the means to pay to the owner of the copyright the royalties payable to him under this section;
- (e) the author has not withdrawn from

circulation copies of the work;

- (f) an opportunity of being heard is given wherever practicable to the owner of the copyright in the work; and
- (g) the Board is satisfied, for reasons to be recorded in writing, that the grant of the licence will be in the public interest.

CHAPTER VIII

REGISTRATION OF COPYRIGHT

38. REGISTER OF COPYRIGHT, INDEXES, FORM AND INSPECTION OF REGISTER.—

(1) The Registrar shall keep at the Copyright Office a register in the prescribed form to be called the Register of Copyrights in which shall be entered the names or titles of works and the names and addresses of authors, publishers and owners of copyright and such other particulars as may be prescribed.

(2) The Registrar shall also keep such indexes of the Register of Copyrights as may be prescribed.

(3) The Register of Copyrights and the indexes thereof kept under this section shall at all reasonable times be open to inspection, and any person shall be entitled to take copies of, or make extracts from, any such register or index on payment of such fee and subject to such conditions as may be prescribed.

39. REGISTRATION OF COPYRIGHTS.—

(1) The author or publisher of, or the owner of, or other person interested in the copyright in any work, may make an application in the prescribed form accompanied by the prescribed fee to the Registrar for entering particulars of the work in the Register of Copyrights.

(2) On receipt of an application in respect of any work under subsection (1), the Registrar shall enter the particulars of the work in the Register of Copyrights and issue a certificate of such registration to the applicant unless, for reasons to be recorded in writing, he considers that

such entry should not be made in respect of any work.

40. REGISTRATION OF ASSIGNMENTS, ETC., OF COPYRIGHTS.—(1) Any person interested in the grant of an interest in a copyright, either by assignment or licence, may make an application in the prescribed form, accompanied by the prescribed fee, the original instrument of such grant and a certified copy thereof, to the Registrar for entering the particulars of the grant in the Register of Copyrights.

(2) On receipt of an application in respect of any work under sub-section (1), the Registrar shall, after holding such inquiry as he deems fit, enter the particulars of the grant in the Register of Copyrights unless, for reasons to be recorded in writing, he considers that such entry should not be made in respect of any grant.

(3) The certified copy of the grant shall be retained at the Copyright Office and the original shall be returned to the person depositing it, with a certificate of registration endorsed thereon or affixed thereto.

41. CORRECTION OF ENTRIES IN THE REGISTER OF COPYRIGHTS AND INDEXES, ETC.—(1) The Registrar may, in the prescribed cases and subject to the prescribed conditions, amend or alter the Register of Copyrights and the indexes by—

- (a) correcting any error in any name, address or particulars; or
- (b) correcting any other error which may have arisen therein by accidental slip or omission.

(2) The Board, on application of the Registrar or of any person aggrieved, may order the rectification of the Register of Copyrights by—

- (a) the making of any entry wrongly omitted to be made in the Register, or
- (b) the expunging of any entry wrongly made in, or remaining on, the Register, or
- (c) the correction of any error or defect in the Register.

42. REGISTER OF COPYRIGHTS TO BE

PRIMA FACIE EVIDENCE OF PARTICULARS ENTERED THEREIN.—(1) The Register of Copyrights and the indexes shall be *prima facie* evidence of the particulars entered therein and documents purporting to be copies of any entry therein or extract therefrom certified by the Registrar and sealed with the seal of the Copyright Office shall be admissible in evidence in all courts without further proof or production of the original.

(2) A certificate of registration of copyright in a work shall be *prima facie* evidence that copyright subsists in the work and that the person shown in the certificate as the owner of the copyright is the owner of such copyright.

CHAPTER IX

COPYRIGHT OFFICE, REGISTRAR OF COPYRIGHT AND COPYRIGHT BOARD

43. COPYRIGHT OFFICE.—(1) There shall be established for the purposes of this Ordinance an office to be called the Copyright Office.

(2) The Copyright Office shall be under the immediate control of the Registrar of Copyrights who shall act under the superintendence and direction of the Federal Government.

(3) The Copyright Office shall have a seal the impression whereof shall be judicially noticed.

44. REGISTRAR AND DEPUTY REGISTRAR OF COPYRIGHTS.—(1) The Federal Government shall, for the purposes of this Ordinance, appoint a Registrar of Copyrights and may appoint one or more Deputy Registrars of Copyrights.

(2) The Registrar shall,—

- (i) sign all entries made in the Register of Copyrights kept under this Ordinance;
- (ii) sign all certificates of registration of copyrights and certified copies under the seal of the Copyright Office;
- (iii) exercise the powers conferred and

perform the duties imposed upon him by or under this Ordinance;

- (iv) be the Secretary of the Copyright Board; and
- (v) shall perform such other functions as may be prescribed.

(3) A Deputy Registrar of Copyrights shall discharge, under the superintendence and direction of the Registrar, such functions of the Registrar under this Ordinance as the Registrar may, from time to time, assign to him.

45. COPYRIGHT BOARD.—(1) The Federal Government shall constitute a Board to be called the Copyright Board consisting of the following members, namely:—

- (i) a Chairman appointed by the Federal Government;
- (ii) not less than three and not more than five other members appointed by the Federal Government after consultation with the representative bodies of authors, publishers, cinematograph industry and any other interest relating to copyright:

Provided that adequate representation on the Board shall, as far as possible, be given to the residents of each Province; and

- (iii) the Registrar, *ex-officio*.

(2) The members, including the Chairman of the Board, other than the *ex-officio* member, shall hold office for such period and on such terms and conditions as may be prescribed.

(3) The Chairman shall be a person who is, or has been, a Judge of a High Court, or is qualified for appointment as such Judge.

46. POWERS AND PROCEDURE OF THE BOARD.—(1) The Board shall, subject to any rules that may be made under this Ordinance, have power to regulate its own procedure, including the fixing of places and times of its sittings.

(2) If there is a difference of opinion among the members of the Board in respect of any matter coming before it for decision under this Ordinance, the opinion

of the majority shall prevail:

Provided that where there is no such majority the opinion of the Chairman shall prevail.

(3) The Board may authorize any of its members to exercise any of its powers under section 78 and any order made or act done in exercise of any such power by the member so authorized shall be deemed to be the order or act, as the case may be, of the Board.

(4) No act done or proceeding taken by the Board under this Ordinance shall be questioned on the ground merely of the existence of any vacancy in, or defect in the constitution of, the Board.

(5) The Board shall be deemed to be a civil court for the purposes of sections 480 and 482 of the Code of Criminal Procedure, 1898 (Act V of 1898), and all proceedings before the Board shall be deemed to be judicial proceedings within the meaning of sections 193 and 228 of the Pakistan Penal Code (Act XLV of 1860).

(6) No member of the Board shall take part in any proceedings before the Board in respect of any matter in which he has a personal interest.

CHAPTER X

DELIVERY OF BOOKS AND NEWSPAPERS TO PUBLIC LIBRARIES

47. DELIVERY OF BOOKS TO PUBLIC LIBRARIES.—(1) Subject to any rules that may be made under this Ordinance, but without prejudice to the provisions contained in section 40 of the Press and Publication Ordinance, 1960 (XV of 1960), the publisher of every book published in Pakistan after the commencement of this Ordinance shall, notwithstanding any agreement to the contrary, deliver at his own expense, one copy of the book to each of the three public libraries within thirty days from the date of its publication.

(2) The copy delivered to the National Library of Pakistan shall be a copy of the whole book with all maps and illustrations belonging thereto finished and coloured in

the same manner as the best copies of the same, and shall be bound, sewed or stitched together, and on the best paper on which any copy of the book is printed.

(3) The copy delivered to any other public library shall be on the paper on which the largest number of copies of the book is printed for sale, and shall be in the like condition as the books prepared for sale.

(4) Nothing contained in sub-section (1) shall apply to any second or subsequent edition of a book in which edition no additions or alterations either in the letter-press or in the maps, book-prints or other engravings belonging to the book have been made, and a copy of the first or any other edition of which book has been delivered under this section.

48. DELIVERY OF NEWSPAPERS TO PUBLIC LIBRARIES.—Subject to any rules that may be made under this Ordinance, but without prejudice to, the provisions contained in section 42 of the Press and Publications Ordinance, 1960 (XV of 1960), the publisher of every newspaper published in Pakistan shall deliver at his own expense one copy of each issue of such newspaper as soon as it is published to each of the three public libraries.

49. RECEIPT FOR BOOKS DELIVERED.—The person incharge of a public library (whether called a librarian or by any other name) or any other person authorized by him in this behalf to whom a copy of a book is delivered under section 47 shall give to the publisher a receipt in writing therefor.

50. PENALTY.—Any publisher who contravenes any provision of this Chapter or of any rule made thereunder shall be punishable with fine which may extend to fifty rupees and, if the contravention is in respect of a book, shall also be punishable with fine which shall be equivalent to the value of the book; and the Court trying the offence may direct that the whole or any part of the fine realised from him shall be paid, by way of compensation, to the public library to which the book or news-

paper, as the case may be, ought to have been delivered.

51. COGNIZANCE OF OFFENCES UNDER THIS CHAPTER.—(1) No court shall take cognizance of any offence punishable under this Chapter save on complaint made by an officer empowered in this behalf by the Federal Government by a general or special order.

(2) No court inferior to that of a Magistrate of the first class shall try any offence punishable under this Chapter.

52. APPLICATION OF THIS CHAPTER TO BOOKS AND NEWSPAPERS PUBLISHED BY GOVERNMENT.—This Chapter shall also apply to books and newspapers published by or under the authority of the Government, but shall not apply to books meant for official use only.

CHAPTER XI

INTERNATIONAL COPYRIGHT

53. PROVISIONS AS TO WORKS OF CERTAIN INTERNATIONAL ORGANIZATIONS.—(1) The Federal Government may, by notification in the official Gazette, declare that this section shall apply to such organizations as may be specified therein of which one or more sovereign powers or the Government or Governments thereof are members.

(2) Where—

(a) any work is made or first published by or under the direction or control of any organization to which this section applies; and

(b) there would, apart from this section, be no copyright in the work in Pakistan at the time of the making or, as the case may be, of the first publication thereof; and

(c) either—

(i) the work is published as aforesaid in pursuance of an agreement in that behalf with the author, being an agreement which does not reserve to the author the copyright, if any, in the work, or

- (ii) under section 13 any copyright in the work would belong to the organization; there shall subsist copyright in the work throughout Pakistan, except as respects its reprint, translation, adaptation or publication, by or under the authority of the Federal Government, as text-book for the purposes of teaching, study or research in educational institutions.

(3) Any organization to which this section applies which at the material time had not the legal capacity of a body corporate shall have, and be deemed at all material times to have had, the legal capacity of a body corporate for the purpose of holding, dealing with, and enforcing copyright and in connection with all legal proceedings relating to copyright.

54. POWER TO EXTEND COPYRIGHT TO FOREIGN WORKS.—(1) The Federal Government may, by order published in the official Gazette, direct that all or any of the provisions of this Ordinance shall apply—

- (a) to works first published in a foreign country to which the order relates in like manner as if they were first published within Pakistan;
- (b) to unpublished works, or any class thereof, the authors whereof were at the time of making of the work, subjects or citizens of a foreign country to which the order relates, in like manner as if the authors were citizens of Pakistan;
- (c) in respect of domicile in a foreign country to which the order relates in like manner as if such domicile were in Pakistan;
- (d) to any work of which the author was at the date of the first publication thereof, or, in a case where the author was dead at that date, was at the time of his death, a subject or citizen of a foreign country to which the order relates in like manner as if the author was a citizen of Pakistan at the date or time;

and thereupon, subject to the provisions of

this Chapter and of the order, this Ordinance shall apply accordingly:

Provided that—

- (i) before making an order under this section in respect of any foreign country (other than a country with which Pakistan has entered into a treaty or which is a party to a convention relating to copyright to which Pakistan is also a party), the Federal Government shall be satisfied that that foreign country has made, or has undertaken to make, such provisions, if any, as it appears to the Federal Government expedient to require for the protection in that country of works entitled to copyright under the provisions of this Ordinance;
- (ii) the order may provide that the provisions of this Ordinance shall apply either generally or in relation to such classes of works or such classes of cases as may be specified in the order;
- (iii) the order may provide that the term of copyright in Pakistan shall not exceed that conferred by the law of the foreign country to which the order relates;
- (iv) the order may provide that the provisions of this Ordinance as to delivery of copies of books to public libraries shall not apply to works first published in such foreign country except so far as is provided by the order;
- (v) in applying the provisions of this Ordinance as to ownership of copyright, the order may make such modification as appears necessary, having regard to the law of the foreign country;
- (vi) the order may provide that this Ordinance or any part thereof shall not apply to works made, or first published, before the commencement of the order.

55. POWER TO RESTRICT RIGHTS IN WORKS OF FOREIGN AUTHORS FIRST PUBLISHED IN

PAKISTAN.—If it appears to the Federal Government that a foreign country does not give, or has not undertaken to give, adequate protection to the works of Pakistani authors, the Federal Government may, by order published in the official Gazette, direct that such of the provisions of this Ordinance as confer copyright on works first published in Pakistan shall not apply to works published after the date specified in the order, the authors whereof are subjects or citizens of such foreign country and are not domiciled in Pakistan, and thereupon those provisions shall not apply to such works,

CHAPTER XII

INFRINGEMENT OF COPYRIGHT

56. WHEN COPYRIGHT INFRINGED.—
Copyright in a work shall be deemed to be infringed—

- (a) when any person, without the consent of the owner of the copyright or without a licence granted by such owner or the Registrar under this Ordinance or in contravention of the conditions of a license so granted or of any condition imposed by a competent authority under this Ordinance,—
 - (i) does anything, the exclusive right to do which is by this Ordinance conferred upon the owner of the copyright; or
 - (ii) permits for profit any place to be used for the performance of the work in public where such performance constitutes an infringement of the copyright in the work unless he was not aware, and had no reasonable ground for suspecting, that such performance would be an infringement of copyright; or
- (b) when any person—
 - (i) makes for sale or hire, or sells or lets for hire, or by way of trade displays or offers for sale or hire, or

- (ii) distributes either for the purpose of trade to such an extent as to affect prejudicially the owner of the copyright, or
- (iii) by way of trade exhibits in public, or
- (iv) imports into Pakistan, any infringing copies of the work.

Explanation.—For the purposes of this section, the reproduction of a literary, dramatic, musical or artistic work in the form of a cinematographic work shall be deemed to be an “infringing copy”.

57. CERTAIN ACTS NOT TO BE INFRINGEMENT OF COPYRIGHT.—(1) The following acts shall not constitute an infringement of copyright, namely:—

- (a) a fair dealing with a literary, dramatic, musical or artistic work for the purpose of—
 - (i) research or private study;
 - (ii) criticism or review, whether of that work or of any other work;
- (b) a fair dealing with a literary, dramatic, musical or artistic work for the purpose of reporting current events—
 - (i) in a newspaper, magazine or similar periodical, or
 - (ii) by radio-diffusion or in a cinematographic work or by means of photographs;
- (c) the reproduction of a literary, dramatic, musical or artistic work for the purpose of a judicial proceeding or for the purpose of a report of a judicial proceeding;
- (d) the publication in a newspaper of a report of an address of political nature delivered at a public meeting unless the report is prohibited by conspicuous written or printed notice affixed before and maintained during the lecture at or about the main entrance of the building in which the lecture is given and, except whilst the building is being used for public worship, in a position near the lecturer; but nothing in this clause shall affect the provisions as to newspaper summaries;

- (e) the reproduction of any literary, dramatic or musical work in the certified copy made or supplied in accordance with any law for the time being in force;
- (f) the reading or recitation in public of any reasonable extract from a published literary or dramatic work;
- (g) the publication in a collection, mainly composed of non-copyright matter, *bona fide* intended for the use of educational institutions and so described in the title and in any advertisement issued by or on behalf of the publisher, of short passages from published literary or dramatic works, not themselves published for the use of educational institutions, in which copyright subsists:

Provided that not more than two such passages from works by the same author are published by the same publisher during any period of five years;

Explanation.—In the case of a work of joint authorship references in this clause to passages from works shall include references to passages from works by any one or more of the authors of those passages or by any one or more of those authors in collaboration with any other person.

- (h) the reproduction or adaptation of a literary, dramatic, musical or artistic work—
 - (i) in the course and for the sole purpose of instruction, whether at an educational institution or elsewhere, where the reproduction or adaptation is made by a teacher or a pupil otherwise than by the use of a printing process; or
 - (ii) as part of the questions to be answered in an examination; or
 - (iii) in answers to such questions;
- (i) the performance, in the course of the activities of an educational institution, of a literary, dramatic or musical work by the staff and stu-

dents of the institution, or of a cinematographic work or a record, if the audience is limited to such staff and students, the parents and guardians of the students and persons directly connected with the activities of the institution;

- (j) the making of records in respect of any literary, dramatic or musical work, if—

- (i) records recording the work have previously been made by or with the licence or consent of, the owner of the copyright in the work; and

- (ii) the person making the records has given the prescribed notice of his intention to make the records, and has paid in the prescribed manner to the owner of the copyright in the work royalties in respect of all such records to be made by him, at the rate fixed by the Board in this behalf:

Provided that in making the records such person shall not make any alterations in, or omissions from, the work, unless records recording the work subject to similar alterations and omissions have been previously made by, or with the licence or consent of the owner of the copyright, or unless such alterations and omissions are reasonably necessary for the adaptation of the work to the records in question;

- (k) the causing of a recording embodied in a record to be heard in public utilising the record,—

- (i) at any premises where persons reside, as part of the amenities provided exclusively or mainly for residents therein, or

- (ii) as part of the activities of a club, society or other organization which is not established or conducted for profit;

- (l) the performance of a literary, dramatic or musical work by an amateur

club or society, if the performance is given to a non-paying audience, or for the benefit of a religious, charitable or educational institution;

- (m) the reproduction in a newspaper, magazine or other periodical of an article on current economic, political, social or religious topics, unless the owner of copyright in such article has expressly reserved to himself the right of such reproduction;
- (n) the publication in a newspaper, magazine or other periodical of a report of a lecture delivered in public;
- (o) the making of not more than three copies of a book (including a pamphlet, sheet of music, map, chart or plan) by or under the direction of the person in charge of a public library or a non-profit library available for use by the public free of charge or a library attached to an educational institution for the use of such library if such book is not available for sale;
- (p) the reproduction, for the purpose of research or private study or with a view to publication, of an unpublished literary, dramatic or musical work kept in a library, museum or other institution to which the public has access:

Provided that where the identity of the author of any such work, or in the case of a work of joint authorship, or any of the authors, is known to the library, museum or other institution, as the case may be, the provision of this clause shall apply only if such reproduction is made at a time more than fifty years from the date of the death of the author or, in the case of a work of joint authorship, from the death of the author whose identity is known or, if the identity of more authors than one is known, from the death of such one of those authors who dies last;
- (q) the reproduction or publication of—
 - (i) any matter which has been published in any official Gazette, or

the report of any committee, commission, council, board or other like body appointed by the Government unless the reproduction or publication of such matter or report is prohibited by the Government;

- (ii) any judgement or order of a court, tribunal or other judicial authority, unless the reproduction or publication of such judgement or order is prohibited by the court, tribunal or other judicial authority, as the case may be;
- (r) the making or publishing of a painting, drawing, engraving or photograph of an architectural work of art;
- (s) the making or publishing of a painting, drawing, engraving or photograph of a sculpture or other artistic work if such work is permanently situated in a public place or any premises to which the public has access;
- (t) the inclusion in a cinematographic work of—
 - (i) any artistic work permanently situated in a public place or any premises to which the public has access; or
 - (ii) any other artistic work, if such inclusion is only by way of background or is otherwise incidental to the principal matters represented in the work;
- (u) the use by the author of an artistic work, where the author of such work is not the owner of the copyright therein, of any mould, cast, sketch, plan, model or study made by him for the purpose of the work:

Provided that he does not thereby repeat or imitate the main design of the work;
- (v) the making of an object of any description in three dimensions of an artistic work in two dimensions, if the object would not appear to persons who are not experts in

relation to objects of that description, to be a reproduction of the artistic work;

- (w) the reconstruction of a building or structure in accordance with the architectural drawings or plans by reference to which the building or structure was originally constructed:

Provided that the original construction was made with the consent or licence of the owner of the copyright in such drawings or plans;

- (x) in relation to a literary, dramatic or musical work recorded or reproduced in any cinematographic work, the exhibition of such work after the expiration of the term of copyright therein:

Provided that the provisions of sub-clause (ii) of clause (a), sub-clause (i) of clause (b) and clauses (f), (g), (m), and (p) shall not apply as respects any act unless that act is accompanied by an acknowledgement—

- (i) identifying the work by its title or other description; and
- (ii) unless the work is anonymous or the author of the work has previously agreed or required that no acknowledgement of his name should be made, also identifying the author.

Explanation.—For the purposes of clause

(a) or clause (b) of this sub-section—

- (i) in relation to a literary or dramatic work in prose, a single extract up to four hundred words, or a series of extracts (with comments interposed) up to a total of eight hundred words with no one extract exceeding three hundred words; and
- (ii) in relation to a literary or dramatic work in poetry, an extract or extracts up to a total of forty lines and in no case exceeding one fourth of the whole of any poem may be deemed to be fair dealing with such work:

Provided that in a review of a newly-published work, reasonably longer extracts may be deemed fair

dealing with such work,

(2) The provision of sub-section (1) shall apply to the doing of any act in relation to the translation of a literary, dramatic or musical work or the adaptation of a literary, dramatic, musical or artistic work as they apply in relation to the work itself.

58. IMPORTATION OF INFRINGING COPIES.—

(1) The Registrar, on application by the owner of copyright in any work or by his duly authorized agent and on payment of the prescribed fee, may, after making such enquiry as he deems fit, order that copies made out of Pakistan of the work which if made in Pakistan would infringe copyright, shall not be imported.

(2) Subject to any rules that may be made under this Ordinance, the Registrar or any person authorized by him in this behalf may enter any ship, vehicle, dock or premises where any such copies as are referred to in sub-section (1) may be found and may examine such copies.

(3) All copies to which any order made under sub-section (1) applies shall be deemed to be goods of which the bringing into Pakistan has been prohibited or restricted under section 19 of the Sea Customs Act, 1878 (VIII of 1878), and all the provisions of that Act shall have effect accordingly.

CHAPTER XIII

CIVIL REMEDIES

59. DEFINITION.—For the purposes of this Chapter, unless the context otherwise requires, the expression "owner of copyright" shall include—

- (a) an exclusive licensee;
- (b) in the case of an anonymous or pseudonymous literary, dramatic, musical or artistic work, the publisher of the work, until the identity of the author or, in the case of an anonymous work of joint authorship or a work of joint authorship published under names all of which are pseudonyms, the

identity of any of the authors, is disclosed publicly by the author and the publisher or is otherwise established to the satisfaction of the Board by that author or his legal representatives.

60. CIVIL REMEDIES FOR INFRINGEMENT OF COPYRIGHT.—(1) Where copyright in any work has been infringed, the owner of the copyright shall, except as otherwise provided by this Ordinance, be entitled to all such remedies by way of injunction, damages, accounts and otherwise as are or may be conferred by law for the infringement of a right:

Provided that if the defendant proves that at the date of the infringement he was not aware that copyright subsisted in the work and he had reasonable ground for believing that copyright did not subsist in the work, the plaintiff shall not be entitled to any remedy other than an injunction in respect of the infringement and a decree for the whole or part of the profits made by the defendant by the sale of the infringing copies as the court may in the circumstances deem reasonable.

(2) Where, in the case of a literary, dramatic, musical or artistic work, a name purporting to be that of the author or the publisher, as the case may be, appears on copies of the work as published, or, in the case of an artistic work, appeared on the work when it was made, the person whose name so appears or appeared shall, in any proceeding in respect of infringement of copyright in such work, be presumed, unless the contrary is proved, to be the author or the publisher of the work, as the case may be.

(3) The costs of all parties in any proceedings in respect of the infringement of copyright shall be in the discretion of the court.

61. PROTECTION OF SEPARATE RIGHTS.—Subject to the provisions of this Ordinance, where the several rights comprising the copyright in any work are owned by different persons, the owner of any such right shall, to the extent of that right, be entitled to the remedies provided by this

Ordinance and may individually enforce such right by means of any suit, action or other proceeding without making the owner of any other right a party to such suit or proceeding.

62. AUTHOR'S SPECIAL RIGHTS.—(1) Notwithstanding that the author of a work may have assigned or relinquished the copyright in the work, he shall have the right to claim the authorship of the work as well as the right to restrain, or claim damages in respect of any distortion, mutilation or other modification of the said work, or any other action in relation to the said work which would be prejudicial to his honour or reputation.

(2) The right conferred upon an author of a work by sub-section (1) may be exercised by the legal representatives of the author.

63. RIGHTS OF OWNER AGAINST PERSONS POSSESSING OR DEALING WITH INFRINGING COPIES.—All infringing copies of any work in which copyright subsists, and all plates used or intended to be used for the production of such infringing copies, shall be deemed to be the property of the owner of the copyright, who accordingly may take proceedings for the recovery or possession thereof or in respect of the conversion thereof:

Provided that the owner of the copyright shall not be entitled to any remedy in respect of the conversion of any infringing copies, if the opponent proves—

(a) that he was not aware that copyright subsisted in the work and he had reasonable ground for believing that copyright did not subsist in the work of which such copies are alleged to be infringing copies; or

(b) that he has reasonable ground for believing that such copies or plates do not involve infringement of the copyright in any work.

64. RESTRICTION ON REMEDIES IN THE CASE OF WORKS OF ARCHITECTURE.— (1) Where the construction of a building or other structure which infringes or which, if completed, would infringe the copy-

right in some other work has been commenced, the owner of the copyright shall not be entitled to obtain an injunction to restrain the construction of such building or structure or to order its demolition.

(2) Nothing in section 63 shall apply in respect of the construction of a building or other structure which infringes or which, if completed, would infringe the copyright in some other work.

65. JURISDICTION OF COURT AND LIMITATION.—(1) Every suit or other civil proceeding regarding infringement of copyright shall be instituted and tried in the court of the District Judge.

(2) Where all the parties to a suit or other proceeding regarding infringement of copyright in any work agree in writing that the suit or proceeding, as the case may be, be referred to the decision of the Board, the suit or other proceeding shall, notwithstanding anything contained in sub-section (1), be referred to the Board for decision, and no court or other tribunal shall hear, try or entertain such suit or proceeding.

(3) The decision of the Board in any matter referred to it for decision under sub-section (2) shall, subject to the provisions as to appeal, be final, and shall be executed in the manner provided in section 79.

CHAPTER XIV

OFFENCES AND PENALTIES

66. OFFENCES OF INFRINGEMENT OF COPYRIGHT OR OTHER RIGHTS CONFERRED BY THIS ORDINANCE.—Any person who knowingly infringes or abets the infringement of—

- (a) the copyright in a work, or
- (b) any other right conferred by this Ordinance,

shall be punishable with fine which may extend to five thousand rupees, or with imprisonment which may extend to two years, or with both.

Explanation.—Construction of a building or other structure which infringes or which, if completed, would infringe the copy-

right in some other work, shall not be an offence under this section.

67. POSSESSION OF PLATES FOR PURPOSE OF MAKING INFRINGING COPIES.—If any person knowingly makes or has in his possession any plate for the purpose of making infringing copies of any work in which copyright subsists, or knowingly and for his private profit causes any such work to be performed in public without the consent of the owner of the copyright, he shall be punishable with fine which may extend to five thousand rupees, or with imprisonment which may extend to two years, or with both.

68. PENALTY FOR MAKING FALSE ENTRIES IN THE REGISTER, ETC., OR PRODUCING OR TENDERING FALSE EVIDENCE.—Any person who,—

- (a) makes or causes to be made a false entry in the Register of Copyrights, or
- (b) makes or causes to be made a writing falsely purporting to be a copy of any entry in the register, or
- (c) produces or tenders or causes to be produced or tendered as evidence any such entry or writing, knowing the same to be false,

shall be punishable with fine which may extend to five thousand rupees, or with imprisonment which may extend to two years, or with both.

69. PENALTY FOR MAKING FALSE STATEMENTS FOR THE PURPOSE OF DECEIVING OR INFLUENCING ANY AUTHORITY OR OFFICER.—Any person who,—

- (a) with a view to deceiving any authority or officer in the performance of any of his functions under any of the provisions of this Ordinance, or
- (b) with a view to inducing or influencing the doing or omission of anything in relation to this Ordinance or any matter thereunder,

makes a false statement or representation knowing the same to be false, shall be punishable with fine which may extend to five thousand rupees, or with imprison-

ment which may extend to two years, or with both.

70. FALSE ATTRIBUTION OF AUTHORSHIP, ETC.—Whosoever—

- (1) inserts or affixes the name of any person in or on a work of which that person is not the author, or in or on a reproduction of such a work, in such a way as to imply that such person is the author of the work; or
- (2) publishes, or sells or lets for hire, or by way of trade offers, exposes for sale or hire, or by way of trade exhibits in public a work in or on which the name of a person has been inserted or affixed in such a way as to imply that such person is the author of the work, or the publisher of the work, who to his knowledge is not the author or the publisher, as the case may be, of such work; or
- (3) does any of the acts mentioned in clause (2) in relation to, or distributes reproductions of a work, being reproductions in or on which any person's name has been inserted or affixed in such a way as to imply that such person is the author of the work, who to his knowledge is not the author of such work, or performs in public, or broadcasts the work as being the work of a particular author, who to his knowledge is not the author of such work;

shall be punishable with fine which may extend to five thousand rupees, or with imprisonment which may extend to two years, or with both.

71. OFFENCES BY COMPANIES.—(1) Where any offence under this Ordinance has been committed by a company, every person who at the time the offence was committed was in charge of, and was responsible to the company for, the conduct of the business of the company, as well as the company, shall be deemed to be guilty of such offence and shall be liable to be proceeded against and punished accordingly:

Provided that nothing contained in this sub-section shall render any 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 under this Ordinance has been committed by a company, and it is proved that the offence was committed with the consent or connivance of, or is attributable to any negligence 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 firm or other association of persons; and
- (b) "director" in relation to a firm means a partner in the firm.

72. COGNIZANCE OF OFFENCES.—No court inferior to that of a Magistrate of the first class shall try any offence under this Ordinance.

73. POWER OF THE COURT TO DISPOSE OF INFRINGING COPIES OR PLATES FOR PURPOSE OF MAKING INFRINGING COPIES.—The court before which any offence under this Ordinance is tried may, whether the alleged offender is convicted or not, order that all copies of the work or all plates in the possession of the alleged offender, which appear to it to be infringing copies, or plates for the purpose of making infringing copies, be destroyed or delivered to the owner of the copyright or otherwise dealt with as the court may think fit.

74. POWERS OF POLICE TO SEIZE INFRINGING COPIES.—(1) Where a Magistrate has taken cognizance of any offence under section 72 in respect of the infringement of copyright in any work, it shall be lawful for any police officer, not below the rank of sub-inspector, to seize, with warrant from

the Magistrate, all copies of the work which appear to him to be infringing copies of the work and all copies so seized shall, as soon as practicable, be produced before the Magistrate:

Provided that no such copy as is owned by any public library, or a library attached to an educational institution or a non-profit library available for use by the public free of charge or is in the possession of any person for his *bona fide* use shall be seized.

(2) Any person having an interest in any copies of a work seized under sub-section (1) may, within fifteen days of such seizure, make an application to the Magistrate for such copies being restored to him and the Magistrate, after hearing the applicant and the complainant and making such further inquiry as may be necessary, shall make such order on the application as he may deem fit.

CHAPTER XV

APPEALS

75. APPEALS AGAINST CERTAIN ORDERS OF MAGISTRATE.—Any person aggrieved by an order made under section 73 or sub-section (2) of section 74 may, within thirty days of the date of such order, appeal to the court to which appeals from the court making the order ordinarily lie, and such appellate court may direct that execution of the order be stayed pending disposal of the appeal.

76. APPEALS AGAINST ORDERS OF REGISTRAR.—Any person aggrieved by any final decision or order of the Registrar may, within three months from the date of the decision or order, appeal to the Board:

Provided that the Registrar shall not sit as a member of the Board when the Board hears an appeal under this section.

77. APPEALS AGAINST ORDERS OF THE BOARD.—(1) Any person aggrieved by any final decision or order of the Board, not being a decision or order made in an appeal under section 76 may, within three months from the date of such decision or order,

appeal to the High Court within whose jurisdiction the appellant actually and voluntarily resides or carries on business or personally works for gain:

Provided that no such appeal shall lie against a decision of the Board under sub-section (2) of section 4 and sub-section (2) of section 6.

(2) In calculating the period of three months provided for an appeal under section 76 and sub-section (1), the time taken in granting a certified copy of the order or record of the decision appealed against shall be excluded.

CHAPTER XVI

MISCELLANEOUS

78. REGISTRAR AND BOARD TO POSSESS CERTAIN POWERS OF CIVIL COURT.—The Registrar and the Board shall have the powers of a civil court when trying a suit under the Code of Civil Procedure, 1908 (Act V of 1908), in respect of the following, namely:—

- (a) summoning and enforcing the attendance of any person and examining him on oath;
- (b) requiring the discovery and production of any document;
- (c) receiving evidence on affidavits;
- (d) issuing commissions for the examination of witnesses or documents;
- (e) requisitioning any public record or copy thereof from any court or office;
- (f) any other matter of procedure which may be prescribed.

Explanation.—For the purpose of enforcing the attendance of witnesses, the local limits of the jurisdiction of the Registrar or the Board, as the case may be, shall be the whole of Pakistan.

79. ORDER FOR PAYMENT OF MONEY PASSED BY REGISTRAR OR BOARD TO BE EXECUTABLE AS A DECREE.—Every order made by the Registrar or the Board under this Ordinance for the payment of any money or by the High Court in any appeal

against any such order of the Board shall, on a certificate issued by the Registrar, the Board or the Registrar or the High Court, as the case may be, be deemed to be a decree of a civil court and shall be executable in the same manner as a decree of such court.

80. INDEMNITY.—No suit or other legal proceeding shall lie against any person in respect of anything which is in good faith done or intended to be done in pursuance of this Ordinance.

81. CERTAIN PERSONS TO BE PUBLIC SERVANTS.—Every officer appointed under this Ordinance and every member of the Board shall be deemed to be a public servant within the meaning of section 21 of the Pakistan Penal Code (Act XLV of 1860).

82. POWERS TO MAKE RULES.—(1) The Federal Government may, after previous publication, make rules for carrying out the purposes of this Ordinance.

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

- (a) the term of office and conditions of service of the Chairman and other members of the Board;
- (b) the form of complaints and applications to be made, and the licences to be granted, under this Ordinance;
- (c) the procedure to be followed in connection with any proceeding before the Registrar or the Board;
- (d) the manner of determining any royalties payable under this Ordinance, and the security to be taken for the payment of such royalties;
- (e) the form of Register of Copyrights to be kept under this Ordinance and the particulars to be entered therein;
- (f) the matters in respect of which the Registrar and the Board shall have powers of a civil court;
- (g) the fees which may be payable under this Ordinance;
- (h) the regulation of business of the

Copyright Office and of all things by this Ordinance placed under the direction or control of the Registrar.

83. REPEAL.—The Copyright Act, 1914 (III of 1914), and the Copyright Act of 1911 passed by the Parliament of the United Kingdom (1-2, Geo. 5, Ch. 46), as modified in its application to Pakistan by the Copyright Act, 1914 (III of 1914), are hereby repealed.

84. SAVINGS AND TRANSITORY PROVISIONS.—(1) Where any person has, before the commencement of this Ordinance, taken any action whereby he has incurred any expenditure or liabilities in connection with the reproduction or performance of any work in a manner which at the time was lawful or for the purpose of or with a view to the reproduction or performance of a work at a time when such reproduction or performance would, but for the coming into force of this Ordinance, have been lawful, nothing in this section shall diminish or prejudice any rights or interests arising from or in connection with such actions which are subsisting and valuable at the said date, unless the person who, by virtue of this Ordinance, becomes entitled to restrain such reproduction or performance agrees to pay such compensation as, failing agreement, may be determined by the Board.

(2) Copyright shall not subsist by virtue of this Ordinance in any work in which copyright did not subsist immediately before the commencement of this Ordinance under any Act repealed by section 83.

(3) Where copyright subsisted in any work immediately before the commencement of this Ordinance, the rights comprising such copyright shall, as from the date of such commencement, be the rights specified in section 3 in relation to the class of works to which such work belongs, and where any new rights are conferred by that section the owner of such rights shall be—

- (a) in any case where copyright in the work was wholly assigned before the

commencement of this Ordinance, the assignee or his successor-in-interest; and

(b) in any other case, the person who was the first owner of the copyright in the work under any Act repealed by section 83 or his legal representatives.

(4) Except as otherwise provided in this Ordinance, where any person was entitled immediately before the commencement of this Ordinance to copyright in any work

or any right in such copyright or to an interest in any such right, he shall continue to be entitled to such right or interest for the period for which he would have been entitled thereto if this Ordinance had not come into force.

(5) Nothing contained in this Ordinance shall be deemed to render any act done before its commencement an infringement of copyright if that act would not otherwise have constituted such an infringement.

ANNEX VII

**THE COPYRIGHT RULES,
1967**

Copyright Rules, 1967

[omissions]

CHAPTER I

PRELIMINARY

1. SHORT TITLE AND COMMENCEMENT.—

(1) These rules may be called the Copyright Rules, 1967.

(2) These shall come into force at once.

2. DEFINITIONS.—In these rules, unless there is anything repugnant in the subject or context,—

(a) "Form" means a form set out in the First Schedule;

(b) "Ordinance" means the Copyright Ordinance, 1962 (XXXIV of 1962);¹

(c) "Register" means the Register of Copyrights;

(d) "Schedule" means a Schedule annexed to these rules; and

(e) "section" means a section of the Ordinance.

CHAPTER II

REGISTRATION OF COPYRIGHT

3. REGISTER.—(1) The Register shall be kept in four parts as follows:—

Part I Literary, Dramatic and Musical Works.

Part II Artistic Works.

Part III Cinematographic Works.

Part IV Records.

(2) The Register shall contain the particulars specified in Form I.

4. APPLICATION FOR REGISTRATION OF COPYRIGHT.—(1) Every application for registration of copyright shall be made in triplicate in Form II and every application for registration of changes in the particulars of copyright entered in the Register shall

be made in triplicate in Form III.

(2) Every application for registration shall be in respect of one work only and shall be accompanied by a copy of the work and the fee specified in the Second Schedule.

(3) The person applying for registration shall simultaneously send a copy of the application to every other person interested in the copyright of the work.

(4) If no objection to such registration is received by the Registrar within thirty days of the receipt of the application by him, he shall, if satisfied about the correctness of the particulars given in the application, enter such particulars in the Register.

(5) If the Registrar receives any objections for such registration within the time specified in sub-rule (4), or, if he is not satisfied about the correctness of the particulars given in the application, he may, after holding such inquiry as he deems fit, enter such particulars of the work in the Register as he considers proper.

(6) The Registrar shall, as soon as may be, send, wherever practicable, a copy of the entries made in the Register to the parties concerned.

5. CORRECTION OF ENTRIES IN THE REGISTER.—The Registrar may, on his own motion or on application of any interested person, amend or alter the Register for the purposes specified in section 41 after giving, wherever practicable, to the person affected by such amendment or alteration, an opportunity of being heard against such amendment or alteration and communicate to such person the amendment or alteration so made.

6. INDEXES.—(1) There shall be kept at the Copyright Office the following

Date of Regulations (S.R.O. 1005(K)67): May 23, 1967.

Official English text published by the Government of Pakistan, Ministry of Education, Copyright Office, 1967.

1. Pakistan: Item 1.

indexes for each part of the Register, namely:—

- (a) a general Author Index;
- (b) a general Title Index;
- (c) an Author Index of works in each language; and
- (d) a Title Index of works in each language.

(2) Every index shall be arranged alphabetically in the form of cards.

7. INSPECTION OF THE REGISTER AND INDEXES.—(1) Any person shall be entitled to take copies of, or make extracts from, the Register or indexes on payment of the fee specified in the Second Schedule subject to such supervision as the Registrar may arrange.

(2) The Registrar shall, on an application made in that behalf and on payment of the fee specified in the Second Schedule, furnish a certified copy of any entries made in the Register and indexes.

CHAPTER III

LICENCES FOR TRANSLATIONS

8. APPLICATION FOR LICENCE.—(1) An application for a licence under section 37 to produce and publish a translation of a literary or dramatic work in any language in Pakistan or a language ordinarily used in Pakistan shall be made to the Board in triplicate in Form IV and shall be accompanied by the fee prescribed in the Second Schedule.

(2) Every such application shall be in respect of one work only for translation of that work into one language only.

(3) When any such application has been made the Board shall, as soon as possible, give notice of the application in the official Gazette and also, if the Board thinks fit, in one or two newspapers and shall send a copy of the notice to the owner of the copyright, wherever practicable.

(4) Every such notice shall contain the following particulars, namely:—

- (a) the date of the application;
- (b) the name, address and nationality of the applicant;
- (c) particulars of the work which is to be translated;

(d) the date and country of the first publication of the work;

(e) the name, address and nationality of the owner of the copyright;

(f) the language in which the work is to be translated; and

(g) the Registration number of the work in the Register, if any.

9. CONSIDERATION OF THE APPLICATION.

—(1) The Board shall consider the application after the expiry of not less than one hundred and twenty days from the date of the publication of the notice in the official Gazette.

(2) The Board shall give an opportunity to the applicant and also, wherever practicable, to any person claiming any interest in the copyright of the work, to be heard and may take such evidence in respect of the application as it thinks fit.

(3) If more than one application for translation of the work in the same language is pending before the Board at the expiry of one hundred and twenty days after the publication of the notice in the official Gazette, all such applications shall be considered together.

(4) If the Board is satisfied that the licence for a translation of the work in the language applied for may be granted to the applicant, or, if there are more applications than one, to such one of the applicants as, in the opinion of the Board, would best serve the interest of the general public, it may direct the Registrar to grant a licence in Form VII.

(5) Every such licence shall be subject to the conditions provided in sub-section (4) of section 37 relating to the payment of royalties and shall specify—

(a) the period within which the translation shall be produced and published;

(b) the language in which the translation shall be produced and published;

(c) the rate at which royalties in respect of the copies of the translation of the work sold to the public shall be paid to the owner of the copyright in the work; and

(d) the person or persons to whom such royalties shall be payable.

(6) The grant of every such licence shall,

as soon as possible, be notified in the official Gazette and in the newspapers, if any, in which the notice under rule 8 was published and the other parties shall be informed about the grant of the licence.

10. MANNER OF DETERMINING ROYALTIES.—The Board shall determine the royalties payable to the owner of the copyright under sub-section (4) of section 37, after taking into consideration—

- (a) the proposed retail price of a copy of the translation of the work;
- (b) the prevailing standards of royalties in regard to translation of works; and
- (c) such other matters as may be considered relevant by the Board.

11. EXTENSION OF THE PERIOD OF LICENCE.—The Board may, on the application of the licensee, and after notice to the owner of the copyright, wherever practicable, if it is satisfied that the licensee was, for sufficient reasons, unable to produce and publish the translation within the period specified in the licence, extend such period.

12. CANCELLATION OF LICENCE.—The Board may, after giving the licensee an opportunity of being heard, cancel the licence on any of the following grounds, namely:—

- (a) that the licensee has failed to produce and publish the translation within the time specified in the licence or within the time extended on the application of the licensee;
- (b) that the licence was obtained by fraud or misrepresentation as to any essential fact;
- (c) that the licensee has contravened any of the terms and conditions of the licence.

CHAPTER IV

MAKING OF RECORDS

13. MAKING OF RECORDS.—(1) Any person intending to make records under clause (j) of sub-section (1) of section 57 shall give notice of such intention to the owner of the copyright and to the Board at least sixty days in advance of the making of the records and shall, before making

the records, pay to the owner of the copyright, the amount of royalties due in respect of all such records to be made at the rate fixed by the Board in this behalf.

(2) Such notice shall contain the following information, namely:—

- (a) the particulars of the work in respect of which records are to be made;
- (b) alterations and omissions, if any, which are proposed to be made for the adaptation of the work to the records;
- (c) the name, address and nationality of the owner of the copyright in the work;
- (d) particulars of the records made previously recording the work;
- (e) the number of records intended to be made.

CHAPTER V

PERFORMING RIGHTS SOCIETIES

14. PUBLICATION OF STATEMENT OF FEES, ETC.—(1) Every performing rights society having authority to grant licences for performance in public of any work shall, within three months of the commencement of the Ordinance or within such further period as the Registrar may, for sufficient reasons, allow in respect of any such society on an application made by it in this behalf, prepare and publish, at its own cost, in the official Gazette and in one newspaper in English language published in each province, the statements of all fees, charges or royalties which it proposes to collect for the grant of such licences.

(2) Every performing rights society shall, within one month of its acquiring the authority to grant licences for performance in public of any work or within such further period as the Registrar may, for sufficient reasons, allow in respect of any such society on an application made by it in this behalf, prepare and publish, at its own cost, in the official Gazette and in one newspaper in the English language published in each province, the statements of all fees, charges or royalties which it purposes to collect for the grant of such licences.

(3) Every performing rights society shall file with the Registrar two copies of the

statements prepared under sub-rule (1) or sub-rule (2) within the time specified therein, together with two copies of each of the newspapers in which such statements have been published.

15. DETERMINATION OF OBJECTIONS.—The Board may take such evidence as it deems fit in determining any objection lodged under section 32.

16. PUBLICATION OF ALTERATIONS IN THE STATEMENT OF FEES, ETC.—The Registrar shall publish the alterations made by the Board in the statements of fees, charges or royalties in the official Gazette and in the two newspapers in which the original statements were published under rule 14 or in such other newspapers as he may deem fit.

CHAPTER VI

RELINQUISHMENT OF COPYRIGHT

17. NOTICE OF RELINQUISHMENT.—The owner of the copyright in a work desiring to relinquish all or any of the rights comprised in the copyright shall give notice to the Registrar in Form V.

CHAPTER VII

RELINQUISHMENT OF COPYRIGHT COPIES

18. IMPORTATION OF INFRINGING COPIES.—Every application under subsection (1) of section 58 shall be made to the Registrar in Form VI and shall be accompanied by the fee specified in the Second Schedule.

19. PROCEDURE FOR EXAMINATION OF INFRINGING COPIES.—The Registrar or any person authorised by him in this behalf shall take action under sub-section (2) of section 58 and act in collaboration with customs authorities.

CHAPTER VIII

THE COPYRIGHT BOARD

20. TERMS AND CONDITIONS OF OFFICE OF THE CHAIRMAN AND MEMBERS OF THE

BOARD.—(1) The Chairman and other members of the Board shall be appointed for such period not exceeding three years as the Central Government may, in each case, deem fit.

(2) The Chairman and other members of the Board shall, on the expiry of the period of their appointment, be eligible for re-appointment.

(3) The Chairman or any other member of the Board may resign his office by giving three months' notice in writing to the Central Government.

(4) The Chairman and other members of the Board shall be paid such salary or honorarium as may be determined by the Central Government in each case.

(5) A non-official appointed as the Chairman or other member of the Board shall be entitled to travelling allowances for journeys performed on duty and to daily allowances for the period spent on duty according to rules and orders for the time being applicable to such corresponding class of Government servants as shall be specified by the Central Government.

(6) An official appointed as the Chairman or other member of the Board shall be entitled to such travelling allowances for journeys performed on duty and to such daily allowances for the period spent on duty as may be admissible to him as such official.

(7) The other conditions of service of the Chairman and other members of the Board shall be regulated by orders made in that behalf by the Central Government from time to time.

21. FUNCTIONS OF THE SECRETARY OF THE BOARD.—The Registrar shall perform all secretarial functions relating to the Board under the directions and control of the Chairman of the Board.

CHAPTER IX

MISCELLANEOUS

22. MODE OF MAKING APPLICATIONS, ETC.—Every application, notice, statement or any other document to be made, given, filed or sent under the act or under these

rules may, unless otherwise directed by the authority concerned, be sent by hand or registered post.

23. MODE OF COMMUNICATION BY BOARD, ETC.—Every written intimation from the Board, the Copyright Office or the Registrar shall be deemed to have been duly communicated to any person if such intimation is sent to the known address of such person by registered post.

24. FEES.—(1) The fees payable under the act in respect of any matter shall be as specified in the Second Schedule.

(2) The fees shall be paid to the Registrar by a bank draft or by deposit into a Government treasury or sub-treasury or a branch of the National Bank of Pakistan under the Head of Account "XLVI—Misc.—Copyright Fees".

(3) Bank drafts shall be crossed and drawable in favour of the Registrar by designation only.

(4) Where payment is made by deposit in a Government treasury or sub-treasury or a branch of the National Bank of Pakistan, the original and duplicate copies of the challan evidencing the payment shall be sent to the Registrar by registered post.

25. RIGHT OF AUDIENCE.—In any proceedings before the Board or the Registrar, any party may appear and be heard either in person or by a pleader or other person duly authorised by such party.

26. COSTS.—The cost of the proceedings before the Board or the Registrar shall be awarded at the discretion of the Board or the Registrar, as the case may be.

ANNEX VIII

**THE INTERNATIONAL COPYRIGHT ORDER,
1968**

PROTECTION OF WORKS ORIGINATING IN COUNTRIES PARTIES TO THE UNIVERSAL COPYRIGHT CONVENTION OR MEMBERS OF THE BERNE UNION

The International Copyright Order, 1968

[as amended up to December 15, 1972]

1. (1) This Order may be called the International Copyright Order, 1968.

(2) It shall come into force at once.

2. In this Order, unless there is anything repugnant in the subject or context,—

(a) "country of the Berne Copyright Union" means a country mentioned in Part I of the Schedule;

(b) "country party to the Universal Copyright Convention" means a country mentioned in Part II of the Schedule; and

(c) "Schedule" means the schedule to this Order.

3. Subject to the provisions of paragraph 4, all the provisions of the Copyright

Ordinance, 1962 (XXXIV of 1962)¹, read with Copyright (Amendment) Ordinance, 1972, hereinafter referred to as "the Ordinance", other than those of Chapter IV thereof and those which apply exclusively to Pakistani works, shall apply—

(a) to any work first published in a country mentioned in the Schedule in like manner as if it was first published within Pakistan;

(b) to any work first published in a country other than a country mentioned in the Schedule, the author of which was at the date of such publication, or where the author was dead at that date, was at the time of his death, a subject or citizen of a

Date of basic Order (S.R.O. 709(K)/68): March 13, 1968; of amendatory Order: December 15, 1972.

Official English text of basic Order published by the Government of Pakistan, Ministry of Education, Copyright Office, 1967; of amendatory Order in The Gazette of Pakistan, Extraordinary, on December 26, 1972.

Observation: Accession to the Universal Copyright Convention: Pakistan deposited its instrument of accession to the Universal Copyright Convention and the annexed Protocols 1, 2 and 3 with the Director-General of the United Nations Educational, Scientific and Cultural Organization on April 28, 1954, and became bound by the Convention on September 16, 1955 (*Unesco Copyright Bulletin*, Vol. VIII, page 135).

See text of Convention and annexed Protocols 1, 2 and 3 as well as list of contracting states under *Universal Copyright Convention*.

*Membership in the Berne Union*²: Pakistan is bound by the Rome Convention, 1928, as of July 5, 1948 (*Le Droit d'Auteur*, 1948, page 61).

See text of Convention and list of countries members of the Berne Union under *Berne Copyright Union*.

1. See Pakistan: Item 1.

2. Pakistan deposited on November 26, 1969, a declaration dated July 21, 1969, according to which, with reference to Article 5(1)(a) of the Protocol Regarding Developing Countries, it intends to apply for a period of ten years in the first instance the reservations provided in Article 1 of the said Protocol, with the exception of the reservation provided in paragraph (a) of that Article (*Copyright*, 1969, p. 234).

Pakistan deposited on November 26, 1969, its instrument of accession dated July 30, 1969, to the Berne Convention for the Protection of Literary and Artistic Works of September 9, 1886, as revised at Stockholm on July 14, 1967*, availing itself, for a period of ten years in the first instance, of the reservations provided in Article 1 of the Protocol Regarding Developing Countries, with the exception of the reservation provided in paragraph (a) of that Article (*Copyright*, 1969, p. 234).

* The Stockholm Act of the Berne Convention has not yet come into force.

country party to the Universal Copyright Convention in like manner as if the author was a citizen of Pakistan at that date or time;

(c) to an unpublished work, the author whereof was at the time of the making of the work, a subject or citizen of, or domiciled in, any country mentioned in the Schedule in like manner as if the author was a citizen of, or domiciled in, Pakistan; and

(d) in relation to a body incorporated under any law of a country mentioned in the Schedule, in like manner as if it was incorporated under a law in force in Pakistan.

4. Notwithstanding anything contained in paragraph 3,—

(a) the term of copyright for a work shall not exceed that enjoyed by it in its country of origin; and

(b) the Ordinance or any part thereof shall not apply to a work published before the commencement of this Order in a country party to the Universal Copyright Convention or a country of the Berne Copyright Union;

(c) Copyright shall not subsist in any work referred to in section 10, sub-section 2 of the Copyright Ordinance, 1962 (XXXIV of 1962) read with Copyright (Amendment) Ordinance, 1972 as respects its reprint, translation, adaptation or publication, by or under the authority of the Federal Government, as textbook for the purposes of teaching, study or research in educational institutions.

EXPLANATION.—In this paragraph, “country of origin” means,

(a) in the case of a work first published in a country of the Berne Copyright Union or a country party to the Universal Copyright Convention, that country;

(b) in the case of a work published simultaneously in a country of the Berne Copyright Union and a country which is not a country of the Berne Copyright Union, the former country;

(c) in the case of a work which is published simultaneously in a country party to the Universal Copyright Con-

vention and a country which is neither a country of the Berne Copyright Union nor a country party to the Universal Copyright Convention, the former country;

(d) in the case of a work which is published simultaneously in several countries of the Berne Copyright Union, the country whose laws give the shortest term of copyright in such a work;

(e) in the case of a work which is published simultaneously in several countries parties to the Universal Copyright Convention, the country whose laws give the shortest term of copyright in such a work; and

(f) in the case of an unpublished work or a work first published in a country other than a country of the Berne Copyright Union or a country party to the Universal Copyright Convention, the country of which the author was a subject or citizen or the country in which he was domiciled at the time of making the work or a substantial part of it or, as the case may be, at the time of its first publication, whichever gives the longer term of copyright.

5. All Orders in Council made under Copyright Act, 1911 (1 & 2 Geo. 5C. 46), so far as they form part of the law of Pakistan, are hereby repealed.

Provided that where, by virtue of any such Order in Council, copyright subsisted in a work immediately before the commencement of this Order, and copyright does not subsist therein under this Order, it shall continue to subsist therein as if such Order in Council had not been repealed.

THE SCHEDULE

[See Paragraph 3(a)]

PART I

COUNTRIES OF THE BERNE COPYRIGHT UNION

Australia
Nauru, New Guinea, Papua and Northern
Territory
Argentina

Austria
 Belgium
 Brazil
 Bulgaria
 Cameroon
 Canada
 Ceylon
 Congo (Brazzaville)
 Congo (Kinshasa)
 Cyprus
 Czechoslovakia
 Dahomey
 Denmark
 Finland
 France (Overseas Departments and Territories)
 Gabon
 Germany (Fed. Rep.)
 Greece
 Holy See (Vatican City)
 Hungary
 Iceland
 India
 Ireland
 Italy
 Ivory Coast
 Japan
 Lebanon
 Liechtenstein
 Luxembourg
 Madagascar
 Mali
 Mexico
 Monaco
 Morocco
 Netherlands
 Surinam and Netherlands Antilles
 New Zealand
 Niger
 Norway
 Pakistan
 Philippines
 Poland
 Portugal
 Rumania
 Senegal
 Spain
 Sweden
 Switzerland
 Thailand
 Tunisia
 Turkey

United Kingdom
 Colonies, Possessions and certain Protectorate Territories
 Upper Volta
 Yugoslavia
 Uruguay

PART II

 COUNTRIES PARTIES
 TO THE UNIVERSAL
 COPYRIGHT CONVENTION

Andorra
 Argentina
 Austria
 Belgium
 Brazil
 Cambodia
 Canada
 Chile
 Costa Rica
 Cuba
 Czechoslovakia
 Denmark
 Ecuador
 Finland
 France
 Germany (Fed. Rep.)
 Ghana
 Greece
 Guatemala
 Haiti
 Holy See
 Iceland
 India
 Ireland
 Italy
 Japan
 Kenya
 Laos
 Lebanon
 Liberia
 Liechtenstein
 Luxembourg
 Malawi
 Mexico
 Monaco
 New Zealand
 Nicaragua
 Nigeria
 Norway

Pakistan
Panama
Paraguay
Peru
Philippines
Portugal
Spain

Sweden
Switzerland
United Kingdom
United States of America
Venezuela
Yugoslavia
Zambia