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**PAKISTAN**

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## PRACTICE AREAS:

**Intellectual Property**

**AL-RAHIM**  is involved in all aspects of Intellectual Property Laws, with key areas of specialization in trademarks, designs, copyrights, patents and domain names including filing, registrations, renewals, oppositions, licensing, assignments and post registration procedures, opinions and counseling; prosecution, due diligence and litigation.

**AL-RAHIM** also represents clients on IP issues related to advertising, marketing, and public relations; art law; branded entertainment; celebrity branding; fashion, franchises, IP Finance, technology, sports, publishing, digital media and privacy law, international trade, portfolio management, the internet, e-commerce, parallel imports, antitrust and unfair competition.

**Corporate**

**AL-RAHIM** advises clients on a wide range of general corporate and commercial matters and transactions including company registrations, compliance and regulatory matters, mergers & acquisitions, winding ups and liquidations etcetera. The lawyers at **AL-RAHIM** are frequently appointed as Official Liquidators by the Superior Court of Pakistan and have vast experience as liquidator.

The Firm is actively engaged in all Civil, Commercial, Corporate, Banking and Labour advisory matters.

**Financial and Banking Matters**

**AL-RAHIM** is actively engaged in advising on all banking matters to commercial banks as well as customers including loan negotiations, legal documentation, security documentation, finance agreements, re-structuring, rescheduling, arbitrations and settlements.

The team at **AL-RAHIM** has vast experience of handling and conducting high stake litigation pertaining to recovery of finances etc. The lawyers have represented almost all the national and multinational financial institutions.

**Finance and Islamic Finance**

**AL-RAHIM** has vast experience of advising financial institutions on a variety of banking arrangements. The Islamic finance group has worked on numerous structures, including Ijara, Murabaha, Mudaraba, Takaful, Musharaka, Istisna’a, Wakala and Sukuk transactional structures, actively engaging with the Shari’ah scholars to develop constructs that are both Islamically compliant and commercially viable.

**Litigation, Arbitration and Investigation**

**AL-RAHIM** is one of the few international legal practices with a dedicated and specialist legal team permanently on the ground. The Firm is actively engaged in all civil, commercial, corporate, intellectual property, banking, criminal and labour litigation, involving in a number of leading cases. The Firm also has considerable experience in both domestic and international modes of arbitrations.

**Real Estate**

The firm acts for some of the world’s largest real estate investors and developers and, regionally, many leading master developers and government-owned entities on some of the most high-profile projects. It has considerable experience in the acquisition and development of freehold and leasehold property and the structuring of mixed-use schemes.

**Advisory Services**

**AL-RAHIM** usually provides corporate and commercial legal services to its yearly retained clients. To get an opinion or research for a legal query our clients can use this service.

**PATENTS**

We advise that Pakistan not a signatory to the Patent Co-operation Treaty (PCT) and therefore **PCT based application cannot be filed in Pakistan and likewise utility patents also cannot be filed in Pakistan.**

However, Pakistan is a signatory to Paris Convention and WTO. We confirm that under Pakistani Patent Law a priority can be claimed in Pakistan by filing a Convention Application.

The Convention Application has been defined in section (2) (c) of the Patent Ordinance, 2000, which reads as under:

2. (c) “Convention application” means **an application made** in Pakistan within **twelve months** after the **date of an application** made in a **Convention country**, whether claiming single or multiple priorities from such application.

The term Convention Country has been defined under section (2) (d) of the Patent Ordinance, 2000, which reads as under:

2. (d) “Convention Country” means a member country of the World Trade Organization or a country declared as such under section 86.

Thus, it is clear from the above provisions that in Pakistan a **single or a multiple priorities** can be claimed **within 12 months** after the date of filing of an application in a **Convention country**.

**General Information on Patent Filing and Registration in Pakistan Is As Under:**

Once an application for the grant of a patent is filed, it is examined with respect to compliance with formalities and patentability provided for under the Patent Law, including novelty, inventiveness and industrial application. In case of rejection, the applicant has the right to appeal to the High Court within 90 days as of the date of receiving the notification of rejection.

 Accepted applications are published in the Official Gazette and any interested party has the right to file notice of opposition to the Controller of Patents within 120 days as of the date of publication in the Official Gazette. In the absence of opposition, the letters patent are issued. An estimated time frame from filing till grant of a patent is approx. 18 to 36 months. A patent is valid for 20 years. Annuities are to be paid starting from the fifth year of the patent term and are paid in advance at the beginning of the year.

The right to a patent may be assigned or licensed. An assignment shall have no effect against third parties unless it has been recorded at the Patent Office and published in the Official Gazette.

Under the Patents Ordinance, three kinds of patents are granted:

I. An ordinary patent, which is dated as of the official date of the application
for the patent.

II. A patent claiming "priority" which is dated as of the official date of the corresponding application for patent first made in a country which is the member to the WTO.

III. A patent of addition, for the purpose of improving or modifying an invention for which a patent has already been applied or granted.

**Patents Filing Requirements**

1. Power of Attorney signed by the Applicant(s) (Form P-28).

2. Specification and claims (three copies in English on pages of International A-4 size (8 ½ X 11 ¾”).

3. Three copies of drawings, if any, on stout white paper. Sheet of drawings should be in the International A-4 size.

4. In case of convention application where the true or first Inventor is not a party to the application, Form P-2A duly endorsed by Inventor(s) is required. (No legalization is required on this form). The form should be signed by two witnesses also, whose names and complete addresses should also be mentioned on the reverse side of the form.

5. Full name, address, nationality and profession/business of the Applicant(s).

6. Full name, address, nationality and profession/business of the Inventor(s).

7. In case of priority application, a certified copy of the basic specification should be filed along with the application in Pakistan or be filed within three months from the date of filing of the Pakistani Application.

**Professional Fee and Charges for a Single Patent Application**

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**Cost for Official Objections**

REQUEST A QUOTE

**DESIGNS**

**The necessary general information, documents required and the cost for filing a design application is as under:**

**1. Duration**

 10 (Ten) years from the date of application, can be renewed for two further terms of 10 years each.

2. **Necessary** **Filing requirements/documents:**

a. Power of Attorney (Form 31) signed by the applicant(s) and notarized up to a Notary Public (enclosed).

b. Name given to the design.

c. 6 (six) photographs of post-card size or drawings or tracings of each view of the design.

d. Full name, address, nationality and kind of business of Applicant.

e. The class in which and the Article to which the design is to be applied. If it is desired to register the same design in more than one class, a separate application shall be made in each class.

f. Statement of novelty.

g. Duly sworn affidavits of Applicant and Author of design along with assignment ` by author in favor of Applicant.

h. In case of priority application, a certified copy of the basic application.

**3. Priority**

Priority can be claimed in Pakistan within six months from the date of the earliest application for the registration of design in any WTO member country.

4. **Annuity Processing of a Design**

The Registrar shall extend the period of registration for a second period of ten years from the expiration of the original period and for a third period of ten years from the expiration of the second period if an application for extension of the period of registration for the second or third period is made in the prescribed form before the expiration of the original period-or the second period, as the case may be, and if the prescribed fee is paid before the expiration of the relevant period or if such application is made and the said fee is paid within such further period, not exceeding six months, as may be, specified in a request made to the Registrar and accompanied by the prescribed additional fee.

5. **Is multiple design application allowed to be filed in Pakistan?**

 Multiple class design application is not allowed in Pakistan. If it is desired to register the same design in more than one class, a separate application must be filed in each class.

6. **Is there a grace period for filing from the moment of public disclosure of a design, and what are the novelty requirements in Pakistan?**

 In Pakistan, novelty and originality of a design is a must requirement and shall not be registered in respect of any article if it is the same as a design which before the date of the application for registration has been registered in Pakistan or published anywhere in the world in respect of the same or any other article or differs from such a design only in immaterial details or in features which are variants commonly used in The trade.

 However, for the purposes of novelty, any disclosure to the public of the industrial design shall not be taken into consideration if it occurred within twelve

months preceding the filing date or, where applicable, the priority date, of the application.

 Thus, there is a grace period of 12 months.

7. Cost

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**Trademarks**

1. **Procedure and Time Frame:**

Upon filing of a trademark application, the Trademarks Registry scrutinizes the same and if there is any identical or similar mark registered or pending, the Trademarks Registry issues show cause notices. The objections, if any are satisfactorily resolved then the application is accepted by the Registry and is advertised in the Trade Marks Journal (TMJ) for public objections. Any interested party may file its objections within two months from the publication of the mark in TMJ. If no opposition is filed within the stipulated period and/or any extended time (maximum 2 months beyond initial period of 2 months), the mark is registered. The approximate time span for registration of a trademark in Pakistan is 2 to 3 years and official search is 10 to 15 days.

2. **Multi-Class System is not available in Pakistan.**

**3. Period of Validity of Registration**

The trademark in Pakistan is registered for ten years and is renewable for a term of ten years each.

**4. Information/Documents required for registration of a Trademarks/Service marks:**

a. **A Letter of Authorization of Agent/Power of attorney TM-48 duly executed by any principal officer of the Applicant’s company and thereafter notarized upto a notary public**. Consular legalization is not necessary. Copy of AOA is attached herewith. Kindly note that we may immediately file the trademark Application and may file the AOA/POA lateron without additional cost.

b. 20 (twenty) prints or labels and an electrotype, which may be prepared locally. For word marks labels are not required.

c. List of goods or services and class or classes according to the International Classification of Goods and Services (Nice Classification 10th Edition).

d. Date of first use of the mark in Pakistan, if any, or whether it is intended to be used.

e. Full name, address, nationality and the nature of business of the Applicant(s).

f. Priority can be claimed within six months of the application filed in Convention Country. If priority is being claimed under the Paris Convention, a certified copy of the priority application should be filed along with the application in Pakistan OR within three months of the date of application without additional cost.

**5. Flow Chart in case of Straight Application**

1. Filing is followed by Examination. ( 3 to 6 months)
2. Examination is followed by Acceptance. ( 6 to 8 months, if no objection by Registry)
3. Acceptance is followed by Publication. (3 to 6 months after acceptance).
4. Publication is followed by payment of final registration fee. (4 to 6 months)
5. Payment of final registration fee is followed by issuance of Registration Certificate. (4 to 8 months after payment of Registration fee). **(Total : 2 to 3 years in smooth /straight registration)**

**6. Costs: For Single Trademark Application in Single Class (Straight Application from filing upto registration)**

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**7. Search of Trademark**

**Is official search available**

Yes.

**Costs**

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**Time Frame**

5 to 8 working days

**Is the search mandatory**

No

1. **Renewal of Trademark**

Please note that our Schedule of Charges for filing and prosecution of a trademark application in a single class warrants a much higher professional fee. However, in order to begin a strong and ever lasting relationship with your firm, our most restricted and discounted lump sum professional fee along with the official fee, ***for handling a renewal of a trademark in a Single Class in Pakistan*** is as under:

REQUEST A QUOTE

**Documents Required for filing a renewal application in Pakistan**

1. A Power of Attorney (TM-48) duly signed by the authorized signatory of the Registrant which should be duly notarized up to the notary public. A suitable form of the Power of Attorney (TM-48) is attached herewith for your necessary use.
2. A simple copy of the Registration Certificate of the Trademark to be renewed.

**Renewal Time Frame**

In Pakistan, it normally takes 5 to 6 months to complete the renewal procedure and to issue the Certificate of Renewal and a mark is renewed for another ten years.

**Grace Period**

Kindly, note that under Pakistani Law a request for renewal is to be made at any time within the period of six months before the expiry of the registration. However, a grace period of 6 months is available to file the renewal application in case the renewal request has not been filed before the expiry of registration subject to payment of additional fee.

**Procedure**

Once a renewal application is filed with the Trademark Office of Pakistan, the same is examined upon its turn by the relevant department of the said office. If, no objection whatsoever is raised by the examining officer the orders for the issuance of the renewal certificate are made and the renewal certificate is issued in due course of time.

1. **Change of Name and Address**

**Documents Required for Change of Name**

Following documents are required for recording a change of Name:

* A change of name certificate issued by a competent authority along with its sworn English translation (in case the said certificate is not in English language which should be notarized up to the notary public.
* A simply signed and notarized Power of Attorney showing the new name of the applicant. (Suitable form enclosed).

**Cost for a single Trademark in a single class of good**

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**Documents Required for Change of Address**

* A change of address certificate issued by a competent authority along with its sworn English translation (in case the said certificate is not in English language which should be notarized up to the notary public.
* A simply signed and notarized Power of Attorney showing the new name of the applicant. (Suitable form enclosed).

**Cost**

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The total cost for change of name and change of address would be US$ 240.

**Time Frame**

The normal time frame for recordal of Change of Name and/or Change of Address of the Applicant/Registrant of a trademark is 8 to 12 months.

1. **Official Objections**

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1. **Trademark Oppositions**

**1)** **Costs Involved**

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 **2)** **Procedure of Opposition Action**

For your information and necessary actions the time frame and the procedure for filing of Notice of Opposition and the evidence in support thereof under the new trademark law in Pakistan i.e. Trade Marks Ordinance, 2001 (actually promulgated on April 10, 2004) hereinafter to be referred as the “Ordinance”) is as follows:

**a. Time For Filing of Notice of Opposition**

Under Section 28 (2) of the Ordinance, any person may within two months from the date of publication of advertisement in the Trade Marks Journal and/or within such further extended period not exceeding two months in aggregate, may file Notice of Opposition.

Therefore, the Notice of Opposition (Form TM 5) can be filed against the noted Application within the **initial deadline** of two months of the actual publication of a mark and/or within extended term of two months by filing two extensions of one month each.

**b. Filing of Counter Statement**

After the filing of Notice of Opposition, a copy of the same is served on the Applicant, who within One Month of the receipt of said copy and/or within such further extended period not exceeding two months in aggregate, may file its Counter Statement (Reply to Notice of Opposition and the Grounds on which the Applicant relies on its application). The mark is deemed to be abandoned if the Applicant does not submit its Counter Statement.

**c. Filing of Rejoinder by the Opponent**

If the Applicant, files its Counter Statement the same is served on the Opponent who may file Rejoinder within one month of receipt of Counter Statement and/or likewise within two months of extended period.

**d. Filing of Evidence and Affidavits in Evidence**

Within two months from the receipt of a copy of counter-statement or within such further period as the Registrar may allow, the Opponent shall file such evidence by way of statutory declaration or affidavit, as he may consider necessary to adduce in support of his opposition and shall send a copy thereof to the Applicant.

If the person opposing the registration files no evidence, he shall be deemed to have abandoned his opposition.

Within two months from the receipt of a copy of opponent’s evidence or within such further period as the Registrar may allow, the Applicant shall file such evidence by way of a statutory declaration or affidavit as he may consider necessary to adduce in support of his application and shall send a copy thereof to the Opponent.

Within one month of the date on which a copy of the Applicant’s evidence is sent to him or within such further period as the Registrar may allow, the person opposing the application may file evidence in reply by way of statutory declaration or affidavit which shall be confined to matters strictly in reply to the Applicant’s evidence, and shall send a copy thereof to the Applicant.

**e. Hearing Before Registrar**

After the completion of evidence, the Registrar hears the Opposition and on conclusion of arguments by both the parties, he passes an order accepting or rejecting the Opposition. Any party to the proceeding may file an appeal.

3) **Information/Documents Required to Prepare and File Opposition**

In order to prepare a suitable Notice of Opposition against registration of trademark application for imitated trademark we require the following information and documents:

* The necessary corporate information.
* The dates of first use of trademark in world.
* The dates of first use of trademark in Pakistan.
* The details of the goods/services for which trademark is used.
* The details of the trademark registrations obtained anywhere in world and in Pakistan, if registered and/or pending applications in world and Pakistan, along
* with certificate of registrations and/or trademark applications along with filing receipts.
* The details regarding the approximate year wise sales/annual sales of the goods/services under trademark in Pakistan and worldwide sales.
* A randomly selected sale invoices from each year since the beginning of the use of trademark in Pakistan and in the world
* Likewise, a randomly selected sales tax invoices.
* The details regarding the approximate year wise advertisement expenses incurred by the Company on promotion of its trademark
* The randomly selected clippings of advertisements of trademark in newspapers, magazines, periodicals etc. published around the world.
* The randomly selected advertisers’ invoices.
* The certificate from the advertising agent re: television transmissions, etc.
* Any other relevant information and/or documents.

The costs for trademark rectification and infringement actions are settled and decided mutually with clients and it varies on basis of the trademarks involved, expected stakes of Parties and expected time consumed etc.

**OUR CLIENTS**

  

 

 

 

 

 

 

 

  

 

 

 

 

 

 

 

 

 

 

 

 

 

 

 

 

 