

TRADE MARK REGISTRATION PROCEDURE



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Government of Pakistan**

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INTRODUCTION OF SMEDA

The Small and Medium Enterprise Development Authority (SMEDA) was established with the objective to provide fresh impetus to the economy through the launch of an aggressive SME development strategy. Since its inception in October 1998, SMEDA had adopted a sectoral SME development approach. A few priority sectors were selected on the criterion of SME presence. In depth research was conducted and comprehensive development plans were formulated after identification of impediments and retardants. The all-encompassing sectoral development strategy involved overhauling of the regulatory environment by taking into consideration other important aspects including finance, marketing, technology and human resource development.

After successfully qualifying in the first phase of sector development SMEDA reorganized its operations in January 2001 with the task of SME development at a broader scale and enhanced outreach in terms of SMEDA's areas of operation. Currently, SMEDA along with sectoral focus offers a range of services to SMEs including over the counter support systems, exclusive business development facilities, training and development and information dissemination through a wide range of publications. SMEDA's activities can now be classified into the three following broad areas:

1. Creating a Conducive Environment; includes collaboration with policy makers to devise facilitating mechanisms for SMEs by removing regulatory impediments across numerous policy areas
2. Cluster/Sector Development; comprises formulation and implementation of projects for SME clusters/sectors in collaboration with industry/trade associations and chambers
3. Enhancing Access to Business Development Services; development and provision of services to meet the business management, strategic and operational requirements of SMEs.

SMEDA has so far successfully formulated strategies for sectors, including fruits and vegetables, marble and granite, gems and jewellery, marine fisheries, leather and footwear, textiles, surgical instruments, transport and dairy. Whereas the task of SME development at a broader scale still requires more coverage and enhanced reach in terms of SMEDA's areas of operation.

Along with the sectoral focus a broad spectrum of services are now being offered to the SMEs by SMEDA, which are driven by factors like enhanced interaction amongst the stakeholders, need based sectoral research, over the counter support systems, exclusive business development facilities, training and development for SMEs and information dissemination through wide range of publications.

ROLE OF SMEDA LEGAL SERVICES CELL

The Legal Services Cell (LSC) is a part of Business Development Division of SMEDA and plays a key role in providing an overall facilitation and support to SMEs. The LSC provides guidance based on field realities pertaining to SMEs in Pakistan and other parts of the world.

LSC believes that information dissemination among the SMEs on the existing regulatory environment is of paramount importance and it can play a pivotal role in their sustainable development.

In order to facilitate SMEs at the Micro Level LSC has developed user-friendly systems, which provide them detail description of the Laws, and Regulations including the process and steps required for compliance.

The purpose of this document is to provide SMEs either individuals or companies with information pertaining to Trade Mark Registration. Entrepreneurs interested in enhancing their understanding about the procedures and rights can also use the document. For convenience of the readers sample of various forms, instructions how fill up the forms and important addresses are also included.

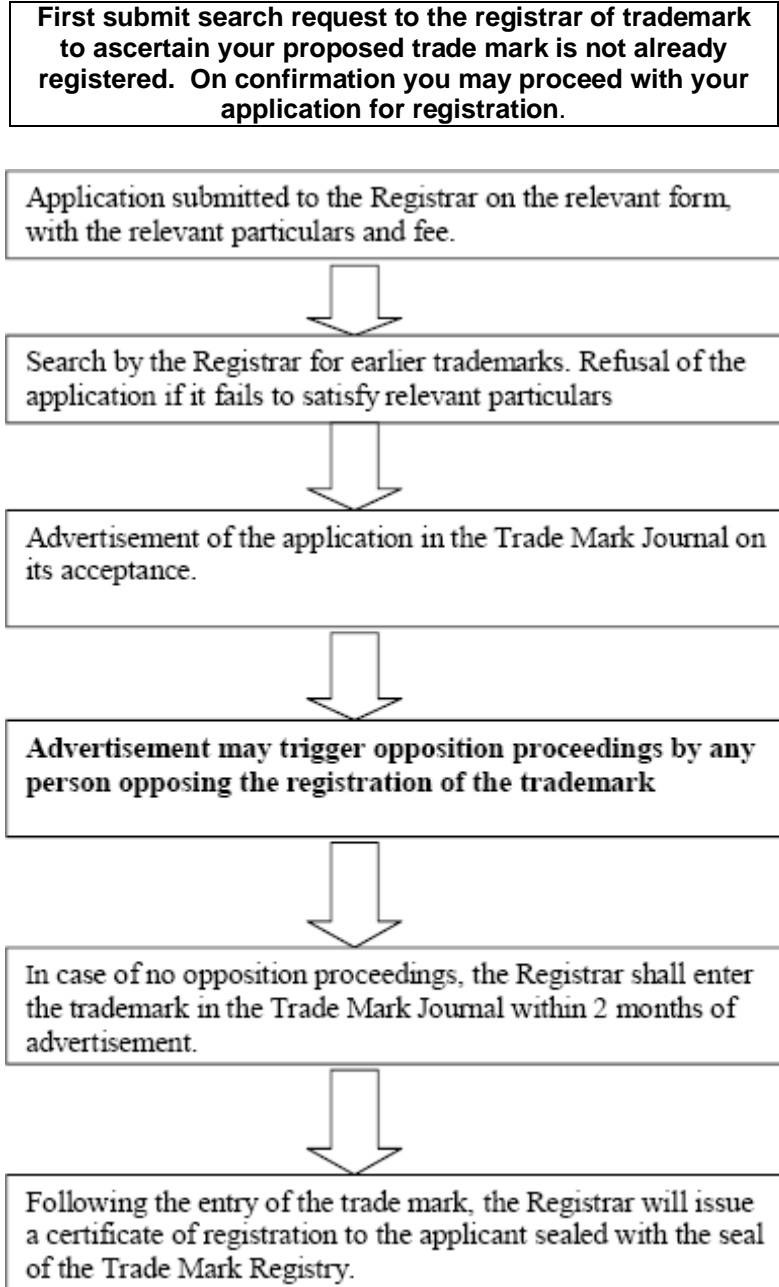
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TRADE MARK REGISTRATION FLOW CHART



WHAT IS TRADE MARK?

For the purpose of having clear understanding these terms should be defined separately: --

Mark:

Mark includes, in particular, a device, brand, heading, label, ticket, name, signature, word, letter, numeral, figurative element, color, sound or any combination thereof.

Trade:

The term trade refers to the buying & selling activities of the goods for the purpose of gaining profits with a risk of having loss.

In the virtue of the above definitions, the term Trade Mark means any mark capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertaking. A trade mark is a distinctive sign which identifies certain goods or services as those produced or provided by a specific person or enterprise. Trade Mark enables consumers to identify a product of a particular company so as to distinguish it from other identical or similar products provided by other companies and also trade mark enables companies to differentiate their products from their competitors products.

LAW OF TRADE MARK APPLICABLE IN PAKISTAN

In Pakistan, registration of trade mark and their protection is governed by the provisions of the Trade Mark Ordinance, 2001 and the Trade Mark Rules, 2004 setout the registration procedure.

IS TRADE MARK REGISTRATION NECESSARY FOR PROTECTION?

Trade mark law does not require mandatory registration of trade mark for its protection. Trade mark protection is obtained through its bona fide use but registration provides certain rights and is highly recommended. Registration of trade mark will provide strong protection, particularly in case of conflict with an identical or confusingly similar trade mark.

WHO MAY APPLY FOR TRADE MARK REGISTRATION?

Any person claiming to be the proprietor of a trade mark used or proposed to be used by him may make an application for its registration. Jointly owned trade marks may be registered by the joint proprietors of trade marks. If the applicant is a sole proprietor of a mark the application shall be in his name and signed by him. In the case of a partnership, the application shall be in the names of all partners and it shall be signed by one of the partners. In case an application is made in the name of body corporate, it shall be signed by the director or other principle officer and the capacity in which he has signed should be stated below the signature. Application may be made either by the owners of the marks, by a legal practitioner or registered trade mark agent who has been authorized by the applicant to act on his behalf.

ESSENTIAL REQUISITES FOR A MARK TO BE REGISTERED

According to the Trade Mark Law, a trade mark shall not be registered unless it is distinctive, and a mark will be registered only when it contains one or more 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 or some predecessor in 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 in its ordinary signification a geographical name or surname or the name of a caste sect or tribe in Pakistan. Having regard to the extent of the mark being inherently adapted to distinguish and by reason of user the mark is in fact adapted to distinguish.
- (e) Any other distinctive mark, provided that a name, signature or any word, other than such as fall within the descriptions of the above clauses, shall not be registrable except on evidence of distinctiveness, which means adapted to distinguish.

CLASSIFICATION OF GOODS AND SERVICES

Every application for the registration of trademark shall be in respect of goods or services in one class only of the Fourth Schedule and for textile trade mark Fifth

Schedule of the Trade Mark Rules, 2004. For purpose of registration of trademarks, goods and services have been divided into 42 classes as set out in the Fourth Schedule and for textile trademark classes have been divided into 94 classes as set out in the Fifth Schedule of the Trade Mark Rules, 2004. An application for the registration of the same trade mark in different classes shall be treated as separate and distinct applications, and in all cases where a trade mark is registered under the same official number for goods or services in more than one class, the registration in respect of goods or services included in each separate class shall be deemed to be a separate registration for all the purposes of the Trade Mark Ordinance, 2001.

APPLICATION FOR REGISTRATION OF TRADE MARK

Before making an application it is recommended that you request the registrar to cause a search of your proposed trade mark to ascertain that there is no other registered trade mark or among pending applications for registration that are duplicating or conflicting in any way from your proposed trade mark. To make such request you have to submit a Form TM-55 to the registrar alongwith fee of Rs. 500/- and two sample of your proposed trade mark on sheets of strong paper approximately 13 inches by 8 inches in size. On receiving confirmation from the registrar that there are no other trademarks that duplicate yours, you may proceed with your application.

An application for registration of trademark is required to be made in duplicate in Form TM-1 to the registrar of trademark along with the prescribed fee i.e. Rs.1000/-. The application shall be written, printed or typewritten in English upon strong paper size 13”X8” with a margin of not less than 1-1/2”.

For registration of textile trade mark, consisting exclusively of numerals or letters or any combination thereof, an application shall be made in Form TM-53.

DOCUMENTS TO BE ATTACHED ALONGWITH THE APPLICATION

The application shall comply with the requirements as follows:

- Application should be accompanied with six additional representation of the trade mark (besides two affixed to the application in duplicate) upon strong sheets of paper size 13”X8”.
- Application for registration of a trade mark shall contain a statement of user in application of the period during which, and the person by whom, mark has been used in respect of the goods or services mentioned in the application. In this regard, the Registrar may require the applicant to file an affidavit testifying to such user with exhibits showing the mark as used.

- Serial number and specification of the class of goods or services, for which trade mark to be registered as indicated in Schedule IV or V to the Trade Marks Rules, 2004, should be stated on the registration application.
- Full name, address and contact details of the agent of applicant if applied by agent on behalf of applicant. Authorization should be made in Form TM-48 which has to be stamped by Rs. 500/-.
- Applicant who do not reside or carry on business in Pakistan are required to furnish an address in Form TM-50 for service in Pakistan, to which all correspondence will be sent by the office of the registrar.

PROCEDURE AFTER SUBMITTING THE APPLICATION

On receiving the application, the registrar shall carry out a internal search for earlier trade marks registered. The registrar may refuse to entertain the application if the same trade mark is registered earlier by some one else or it does not satisfy the requirements of the Trade Mark Ordinance, 2001.

Where an application for registration of trade mark has been accepted the registrar shall cause the application accepted advertised in trade mark journal and for all legal purposes constitute a sufficient notice.

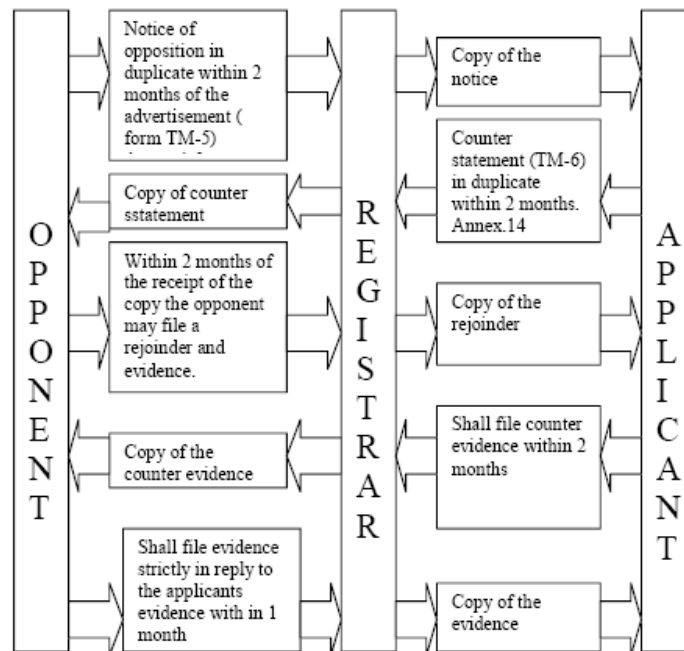
As soon as may be after the expiration of two months from the date of the advertisement in the Journal, if no objection is filed and if no extension has been obtained by a third party to file opposition, the Registrar shall on payment of the registration fee of Rs. 3000/- enter trade mark in the register and issue a certificate of registration to the applicant.

PROCEDURE IN THE CASE OF OPPOSITION

The advertisement of the application in the Trade Mark Journal may trigger of a series of opposition proceedings by any person who opposes the registration of the trade mark.

- The opponent shall send in duplicate a notice of opposition to the Registrar within 2 months of the advertisement.
- The Registrar shall then forward a copy of the notice to the applicant.
- Within 2 months of receiving such a copy, the applicant shall file a counter statement with the Registrar.
- The Registrar shall then forward a copy of the counter statement to the opponent.
- Within 2 months of the receipt of the copy of the counter statement, the opponent may file a rejoinder and evidence.
- The Registrar will then forward a copy of the rejoinder to the applicant.
- The applicant will then file counter evidence within 2 months of the receipt of such copy.
- The Registrar will then forward a copy of the counter evidence to the opponent.
- The opponent shall then file evidence strictly in reply to the applicant's evidence within one month of the receipt of the copy.
- The Registrar will then forward a copy of the evidence to the applicant. Upon completion of evidence, the Registrar shall serve a notice to the parties and fix a date for the hearing of arguments.

- Any party wishing to appear in front of the Registrar shall within 14 days notify the Registrar in the form of TM-7.
- The Registrar shall notify in writing to the applicant and the opponent of his decision.
- The Registrar shall enter the trademark in the Registrar upon the completion of the opposition proceedings.
- In case of no opposition proceedings, he shall enter the trademark within 2 months from the date of advertisement in the Trade Mark Journal.
- Following the entry of the trade mark, the Registrar shall then publish the registration in the prescribed manner and issue to the applicant a Certificate Of Registration sealed with the seal of the Trade Marks Registry.



REGISTRATION OF DEFENSIVE TRADE MARK

A well-known invented word trade mark registered in respect of certain goods may be registered by the proprietor as a Defensive Trade Mark for other goods on which he does not use or propose to use the mark subject to certain conditions. An application for registration of a defensive trade mark is to be made which should be accompanied by a statement of case giving full particulars of the facts on which the applicant relies in support of this application and verified by an affidavit.

GROUNDINGS OF REFUSAL OF REGISTRATION

The registrar may refuse to register the trademark on the following grounds:

- If it is a false trade description.
- Trade mark, which are devoid of any distinctive character.
- It is identical with an earlier registered trademark and its goods and services are also similar.
- It is similar with an earlier registered trademark and its goods and services are also similar.
- A trademark which is identical or similar with an earlier registered trademark and its goods and services are not similar shall not be registered if the earlier has a good reputation in Pakistan and later would take unfair advantages.
- A trademark shall not be registered if its use is liable to be prevented by virtue of law.

CERTAIN GEOGRAPHICAL NAMES IN TRADE MARKS

Geographical names of countries like Pakistan, Great Britain and Egypt can never be registered as trade marks as their registration would embarrass other traders. Geographical names of places which are associated with the manufacturer of particular goods cannot also be registered as trade marks in respect of those goods. Sialkot and Karachi, for example, will not be accepted for registration in respect of sports goods and textile piece goods respectively as those places are well-known for the manufacturer of these goods. So also geographical names which have lost their geographical significance and denote certain kinds of goods are not registrable in respect of those goods. A few such words are Portland in respect of cement, Virginia in respect of tobacco, Kashmir in respect of shawls and Scotch in respect of whisky.

MARKS EXPRESSLY PROHIBITED FOR REGISTRATION

The Central government has directed the Registrar not to register

- (1) the word national,

- (2) any trade mark containing the crossed device of arrow and letter 'P' denoting the property of Government;
- (3) the letters C.S.P. denoting the Civil Service of Pakistan, and letters P.S.I., and P.I.D.C., denoting Pakistan Standard Institution and Pakistan Industrial Development Corporation respectively, if applied for by any person or body other than these institutions.

RIGHTS CONFERRED BY REGISTRATION

A registered Trademark is a personal property of the applicant. The person having a registered Trademark have exclusive rights which are infringed by use of mark in Pakistan without his consent. The rights are vested to the applicant right from the date of registration. An infringement of a registered trademark shall be actionable by the proprietor of the trademark. The proprietor of the trade mark has following relief available against the infringement of the trademark:

1. Damages.
2. Injunctions.
3. Accounts.

DURATION AND RENEWAL OF REGISTRATION

The registration of trade mark shall be valid for a period of ten years from the date of registration which may be renewed for further 10 years from the date of expiration or date of the last renewal. Application for renewal shall be made in form TM-12 within 6 months of the expiration of the current registration.

REGISTRAR OF TRADEMARKS

Mr. Khalid Hidayat Khan– Registrar
Plot # CD # 3 Behind Civic Centre,
Gulshan-e-Iqbal,
Karachi
Phone:92-021-9230538
Fax 92-021-9231001
Web: www.tmr.gov.pk

FORM TM-1

Fee: See entry No.1
of the First Schedule

Application for registration of trade mark for goods or services and to register a domain name Under section 22(1), section 84(2); rule 12

(To be accompanied by a duplicate of this Form and by six additional representations affixed on a durable paper of size 13" x 8")
On representation to be fixed within this space and six others to be sent separately. Representation of the larger size may be folded but must then be mounted upon linen or other suitable material affixed thereto. See rule 17.

Application is hereby made for registration in the register of the accompanying trade mark in class (a) _____ in respect of (b) _____ in the name(s) of (c) _____ trading as (d) _____ whose trade or business address is (e) _____ who claim(s) to be the proprietor(s) thereof and by whom the said mark is proposed to be used/being used since _____ in respect of said goods or services (f) _____

If the application is for a series of marks, indicate how many marks in the series (g)

If the application is for domain name indicate whether it is in respect of goods or services

If colour is claimed, indicate here and state the colour(s) (h) _____

Address for service in Pakistan to which all correspondence should be sent(i)_

Dated this _____ day of _____ 200__.

Signature (j) _____
Name of signatory in block letters.

To,
The Registrar of Trade Marks,
Trade Marks Registry,
Karachi.

INSTRUCTIONS TO FILL IN THE FORM TM-1

(a) Insert the serial number of the class as indicated in Schedule IV to the Trade Marks Rules 2004.

(b) Specify the goods or services. Only goods and services included in one and the same class should be specified.

Please consult Schedule IV attached to the rules to check the class of goods and services or the Book on International Classification of goods issued by the International Bureau for the Protection of Intellectual Property, Geneva.

(c) Insert legible the full name, description and nationality of the applicant.

(d) Insert the trading style, if any.

(e) Insert the full trade or business address of the applicant.

(f) Strike out whichever is not applicable. If the mark is already in use, file the proof thereof by way of affidavits, publicity material, sale figures etc.

(g) Indicate how many marks are in the series.

(h) Indicate whether domain name is in respect of goods or services.

(i) State the colour(s) claimed.

(j) State address for service in Pakistan.

(k) Signature of the applicant. If the mark is owned by an individual, he must sign it, if owned by a partnership firm, by the Managing Partner, if the applicant is a limited company, by the Managing Director or Director.

Notes – (1) The prescribed fee should be paid alongwith this application either through a cheque drawn in favour of or through a money order address to the Registrar of Trade Marks.

(2) Where the application is being filed through an attorney, a power of attorney on Form TM-48 duly stamped must accompany this application.

(3) If the word mark is in a language other than English, Urdu or regional Pakistani languages, its translation and transliteration in the form of an affidavit must accompany this application.

FORM TM-53

Fee: See entry No.52
of the First Schedule

Application for registration of trade marks consisting exclusively of letters or numerals or any combination thereof relating solely to textile goods for specification of goods included in any of the items of the Fifth Schedule. (Rule 96)

(To be filed in duplicate accompanied by six additional representations of the trade mark).

One representation to be fixed within this space and six others to be sent separately.

Application is hereby made for registration of the accompanying trade mark in class(1)____ in respect of (2)_____ in the name of (3) _____ whose address is(4) _____, who claim(s) to be the proprietor(s) thereof and by whom the said mark is proposed to be used(5) being used since _____ in respect of said goods or services.

All communications relating to this application may be sent to the following address in Pakistan:

Dated this _____ day of _____ 20____.

Signature: _____

Name of signatory in block letters

To,
The Registrar of Trade Marks,
The Trade Marks Registry,
Karachi.

INSTRUCTIONS TO FILL IN THE FORM TM-53

1. The Registrar' s direction may be obtained if the class of goods or services is not known. The duly signed additional representation by the applicant or his agent should bear the mark, the name, address and description of the applicant, the description of goods or services, the item of textile goods mentioned on the Fifth Schedule, the period of use of the trade mark, the trade description and address for service in Pakistan.
2. Specify the items of textile goods mentioned in the Fifth Schedule consisting exclusively of letters or numerals or any combination thereof in respect of which application is made. A separate sheet detailing the goods or services may be used.
3. Insert legibly the full name, description (occupation or calling and nationality of the applicant. In the case of a body corporate or firm the country or incorporation or the names and descriptions of the partners composing the firm and the nature of registration, if any, as the case may be should be stated.
4. Insert full trade or business address of the applicant.
5. Strike out the words if not applicable. If use is claimed the date of commencement of use by the applicant should be stated.

FORM TM-48

(To be stamped under the Stamp Act, 1899)

Form of Authorization of Agent in a matter or proceeding under the Ordinance
(Section 127, Rule 10)

I (or We) (a) _____ hereby
authorize (b) _____ of
_____ to Act as my (or our) agent for
(c) _____
_____ and request that all notices,
requisitions and communications relating thereto may be sent to such agent at
the above address.

I (or we) hereby revoke all previous authorizations, if any, in respect of
the same matter or proceeding.

Dated this _____ day of _____ 20__

Signature (d) _____
Name of signatory in block letters
Address (e) _____

(To be struck out if the person appointing the agent desires his own address to be
treated as the address for
service after registration).

I (or we) also authorize the said (b) _____ to complete Form TM-50
requesting the entry of address for service as part of my (or our) registration
obtained under the above authorization.

Dated this _____ day of _____ 20__

Signature (d) _____
Name of signatory in block letters
Signature (e) _____
Name of signatory in block letters

To
The Registrar of Trade Marks,
The Trade Marks Registry,
Karachi.



INSTRUCTIONS TO FILL IN THE FORM TM-48

- (a) Insert full name, address and nationality. See rule 8.
- (b) Insert name and address of agent.
- (c) State the particular matter or proceeding for which the agent is appointed, giving the reference number if known.
- (d) To be signed by the person appointing the agent.
- (e) Insert the full trade or business address of the person appointing the agent.



FORM TM-50

Fee: See entry No.49
of the First Schedule

Form of request by a Registered Proprietor or a registered Licensee of a trade mark or a person about to be so registered, to enter, alter or substitute an address for service as part of his registration.

Section 126, Rules 9 & 70

Request is made by (a) _____ who is about to be registered as (or) who is the Registered (b) Proprietor (Licensee) of Trade Marks(s) No. _____ *registered in class _____ for the (c) inclusion, addition, alteration or substitution of an address for service in Pakistan in or to the entry thereof so that the address for service in Pakistan may read : (d) _____

Dated this _____ day of _____ 20____

Signature (e) _____
Name of signatory in block letters

To,
The Registrar of Trade Marks,
The Trade Marks Registry,
Karachi.

(a) Here insert the full name and trade or business address of the person making the request.

(b) Strike out from the italicized words those that are not applicable and strike out one of the words 'Proprietor' of 'Licensee' as the case may be.

(c) Cancel words that are not applicable.

(d) State here the precise entry or changed entry desired.

(e) Signature.

*Additional numbers may be given in a signed schedule on the back of the form.