

Intellectual Property - Pakistan

Protection of well-known trademarks

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Pakistan is a member of the World Trade Organisation (WTO) and a signatory to the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs). TRIPs is an international treaty administered by the WTO that sets out minimum standards for the regulation of most forms of intellectual property (eg, trademarks, copyrights, patents and designs) in WTO member countries; as such, all member states become bound to a mutual recognition of IP rights at a higher level of protection. Pakistan is obliged to ensure that its laws relating to IP rights, including registration and enforcement, conform to TRIPs.

As a signatory to both the Paris Convention for the Protection of Industrial Property and TRIPs, Pakistan recognises the concept of a well-known trademark and is bound to extend protection to such marks. The Trademarks Ordinance 2001 came into effect on April 12 2004 and contains certain provisions relating to well-known trademarks.

Section 86 of the ordinance specifies that a well-known trademark is entitled to protection under the Paris Convention and states that a tribunal or court – in determining whether a trademark is well known, and without requiring registration or actual use in the form of sales of goods or services under the trademark in Pakistan – will consider the following factors as relevant criteria (supported with strong documentary evidence) for establishing the well-known status of a trademark:

- the degree of Pakistani or worldwide recognition of the trademark (this may include public awareness of the mark in Pakistan, neighbouring countries and the region);
- the degree of inherent or acquired distinctiveness of the trademark (on the basis of worldwide use);
- the duration of the use and advertising of the trademark in Pakistan or worldwide (this may include sales and publicity/advertising and the amount invested in promoting the trademarked product);
- the commercial value attributed to the trademark in Pakistan or worldwide (ie, accrued value of use and registrations);
- the geographical scope of the use and advertising of the trademark in Pakistan or worldwide (this may include the number of countries in which the mark is registered and used, and the geographical extent and duration of its use);
- the quality and image that the trademark has acquired in Pakistan or worldwide; and
- the exclusivity of use and registration attained by the trademark in Pakistan or worldwide and the presence or absence of identical or deceptively similar third-party trademarks validly registered or used in relation to identical or similar goods and services.

Under Section 86(3) of the ordinance, the owner of a well-known trademark is entitled to protection under the Paris Convention and can initiate court action to restrain by injunction the use by others of a mark that is identical or deceptively similar to the well-known trademark and is likely to cause confusion with and/or dilute the distinctive quality of the well-known trademark in Pakistan. 'Dilution' as defined in the ordinance refers to the "lessening of the capacity of a well-known trademark to identify and distinguish the goods or services".

Likewise, under Section 29(4) of the ordinance, the owner of a well-known trademark (registered or not) or a trademark with an acquired reputation in Pakistan may oppose the registration of a mark on the grounds that it is substantially identical or deceptively similar to its own mark and/or would cause dilution or is likely to deceive or cause confusion.

Section 17(3) of the ordinance provides for relative grounds for refusal of registration of a trademark. It specifically states that a mark (ie, the later mark) cannot be registered if

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it is identical or similar to an 'earlier trademark' (defined as a mark entitled to protection as a well-known trademark under Section 18(1)(c) of the ordinance) and used for dissimilar goods if the earlier trademark has a reputation in Pakistan and the use of the later mark without due cause would take unfair advantage of, or be detrimental to the distinctive character or reputation of, the earlier trademark.

Notwithstanding the fact that such protection of well-known trademarks is available in the absence of registration or use in Pakistan (Section 86), it is nonetheless advisable to register such marks, as this would assist in establishing in the first instance the proprietorship with statutory rights of the well-known trademark in Pakistan.

Against all odds, Pakistan has managed to move forward with reforms to its IP laws that strengthen the protection of signs and marks and their corresponding rights. In addition, the Competition Commission, under the Competition Act 2010, hears complaints and imposes penalties on undertakings involved in deceptive marketing practices in relation to "fraudulent use of another's trademark, firm name, or product labelling or packaging", among other things.

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