

**The proposed amendments  
the Trademarks Ordinance, 2001**

SN	Existing provisions / Sections	Proposed amendments and additions	Feedback
1	Not defined / New addition	<b>Definition 2(i) “Act” means the Intellectual Property Organization of Pakistan Act 2012(Act No. XXII of 2012);</b>	
2	Section 2(i) "advertising" means the making of representation in any form in connection with a trade, business or profession in order to promote the supply of goods or services;	<b>Definition Section 2(i)(a) "advertising" means the making of representation in any form in connection with a trade, business or profession in order to promote the supply of goods or services;</b>	
3	Not defined /New addition	<b>Definition 2(iii)(a) “Board of Appeal” means the Board of Appeal for trademarks constituted by the organization under Section 114(1)(a) of this ordinance, by notification in the official gazette.</b>	
4	Not Defined/New addition	<b>Section 2(xvii)(a) “E-Services of Documents”;</b>	
5	Not defined / New addition	<b>Section 2(xx)b “international application”</b> means an application for the international registration of trademarks in accordance with Madrid Protocol;	
6	(ix) "counterfeit trade mark goods" means any goods including packaging bearing without authorization a trade mark which is identical to the trade mark validly registered in respect of such goods or which cannot be distinguished in its essential aspects from such a trade mark and thereby infringes rights of the	(ix) "counterfeit trade mark goods" means any goods including packaging bearing without authorization a trade mark which is identical or <b>deceptively similar</b> to the trade mark validly registered in respect of such goods or which cannot be distinguished in its essential aspects from such a trade mark and thereby infringes rights of the owner of the trade mark under this ordinance.	

	owner of the trade mark under this ordinance.		
7	<p>Section 2(xix) "Geographical indication" in relation to goods originating in a particular country or in a region or locality of that country, means a mark recognized in that country as a mark indicating that the goods:</p> <p>(a) Originated in that country, region or locality; and</p> <p>(b) Have a quality, reputation or other characteristic attributable to their geographical region;</p>	<p>"Section 2(xix) "<b>Geographical Indication</b>" in relation to goods includes an indication which identifies such goods as originating or manufactured or produced in a territory or a region or locality as determined by the country, where a given quality, reputation or other characteristics of the goods or the ingredients or components, is essentially attributable to its geographical origin and in the case of manufactured goods one of the activities of either the production or processing or preparation of the goods concerned takes place in such territory, region or locality as the case may be.</p> <p><b>Explanation:</b> For the purpose of this clause any name which is not the name of a territory or a region a locality or a country shall also be considered as a Geographical Indication if such name refers to or indicates the origin of goods within or from a specific geographical area within that country and is used upon or in relation to particular goods originating from or with in that country or a territory or a region or locality within that country.</p>	
8	Not defined / New addition	Section 2(xx)(a) " <b>IP Tribunal</b> " means the Tribunal established under Section 17 of the IPO Act, 2012;	
9	Not defined / New addition	<b>Section 2(xxvii)(a) "Organization"</b> means the Intellectual Property Organization of Pakistan established under Section 3 of the Act;	
10	Not defined / New addition	<b>Section 2(xxiii)(a) "Madrid Protocol"</b> as defined in sub <b>Section 92-A (xiii).</b>	

11	Section 2(li) "Tribunal" means the Registrar or, as the case may be, the High Court or a District Court before which the proceedings concerned are pending;	Section 2(li) "Tribunal" means the Registrar , <b>the Board of Appeal</b> , as the case may be, the High Court or <b>IP Tribunal</b> before which the proceedings concerned are pending;	
	New Defined/New Addition	Section 2(xxxi) <b>Policy Board</b> .— constituted under Section 4 of IPO-Pakistan Act, 2012.	
12	Section 2(xiv) "District Court" has the meanings assigned to that expression by the code of Civil Procedure, 1908 (Act v of 1908); Sections 11, 14, 17, 24, 47, 48, 51, 57, 60, 63, 67, 70, 73, 77, 78, 80, 96, 105, 114, 116, 117, 118, 122, 124,132(xlii)	<b>Section 2(xiv) District Court..... OMITTED</b> <b>“IP Tribunal as defined in 2(xx)(a) of this Ordinance has attained jurisdiction as District Court under Section 17 of the IPO Act, 2012”.</b>	
13	Section 11. Evidence of entries in Register and things done by Register.- (1) A printed, written or computer generated copy of any entry in the Register, purporting to be certified by the Registrar and sealed with the seal of the Trade Marks Registry, shall be admitted in evidence in all High Courts or District Courts in Pakistan and in all proceeding without further proof or production of the original.	Section 11. Evidence of entries in Register and things done by Register.- (1) A printed, written or computer generated copy of any entry in the Register, purporting to be certified by the Registrar and sealed with the seal of the Trade Marks Registry, shall be admitted in evidence in all High Courts or IP Tribunal or Board of Appeal in Pakistan and in all proceeding without further proof or production of the original.	
14	Section 14. Absolute grounds for refusal of registration. -(3) No trade mark nor any part thereof in respect of any goods or services shall be registered which consists of, or contains, any scandalous design, or any matter the use of which would- (a) by reasons of its being likely to deceive or to cause confusion or otherwise, be disentitled to protection in a High Courts or District Court;	Section 14. Absolute grounds for refusal of registration. -(3) No trade mark nor any part thereof in respect of any goods or services shall be registered which consists of, or contains, any scandalous design, or any matter the use of which would- (a) by reasons of its being likely to deceive or to cause confusion or otherwise, be disentitled to protection in a Board of Appeal;	
15	Section 17. Relative grounds for refusal of registration. - (6) Where separate applications are made by different persons to be registered as proprietor respectively of trade marks which are identical or nearly resemble each other. in respect of	17. Relative grounds for refusal of registration. - (6) Where separate applications are made by different persons to be registered as proprietor respectively of trade marks which are identical or nearly resemble each other. in respect of the same goods or description of goods, the Registrar, if thanks fit, may refuse to register any of them until their rights have been	

	the same goods or description of goods, the Registrar, if thinks fit, may refuse to register any of them until their rights have been determined by the High Court or a District Court.	determined by the Board of Appeal.	
16	Section 24. Co-ownership of trade mark.- (6) Infringement proceedings may be brought by any co-proprietor but he may not, without the leave of the High Court or District Court, proceed with the action unless the other, or each one of the others, is either joined as a plaintiff or added as a defendant.	24. Co-ownership of trade mark.- (6) Infringement proceedings may be brought by any co-proprietor but he may not, without the leave of the High Court or IP Tribunal proceed with the action unless the other, or each one of the others, is either joined as a plaintiff or added as a defendant.	
17	Section 47. Order for erasure of offending mark.- (1) Where a person is found to have infringed a registered trade mark, the High Court or a District Court may make an order requiring him- (a) to cause the offending trade mark to be erased, removed or obliterated from any infringing goods, material or articles in his possession, custody or control; or (b) to secure the destruction of the infringing goods, material or articles, if is not reasonably practicable for the offending trade mark to be erased, removed or obliterated. (2) If an order under sub-section (1) is not complied with, or it appears to the High Court or District Court likely that such an order would not be complied with, the High Court or District Court may order that infringement goods, material or articles be delivered to such person as the High Court or a District Court may direct for erasure, removal or obliteration of the mark, or for destruction, as the case may be.	47. Order for erasure of offending mark.- (1) Where a person is found to have infringed a registered trade mark, the High Court or an IP Tribunal may make an order requiring him- (a) to cause the offending trade mark to be erased, removed or obliterated from any infringing goods, material or articles in his possession, custody or control; or (b) to secure the destruction of the infringing goods, material or articles, if is not reasonably practicable for the offending trade mark to be erased, removed or obliterated. (2) If an order under sub-section (1) is not complied with, or it appears to the High Court or IP Tribunal likely that such an order would not be complied with, the High Court or IP Tribunal may order that infringement goods, material or articles be delivered to such person as the High Court or an IP Tribunal may direct for erasure, removal or obliteration of the mark, or for destruction, as the case may be.	
18	Section 48. Order for delivery up of infringing goods, material or articles. - (1) The proprietor of a registered trade mark may apply to the High Court or	48. Order for delivery up of infringing goods, material or articles. - (1) The proprietor of a registered trade mark may apply to the High Court or IP Tribunal for an order for the delivery up to him, or such other person as the High Court or	

	<p>District Court for an order for the delivery up to him, or such other person as the High Court or District Court may direct, of any infringement goods, material or articles which a person has in his possession, custody or control in the course of a business. (2) An application shall not be made after the expiry of the period specified in section 50, and no order shall be made unless the High Court or a District Court also makes, or it appears to the High Court or a District Court that there are grounds for making, an order under section 51. (3) A person to whom any infringement goods, material or articles are delivered in pursuance of an order under this section shall, if an order under section 51 has not been made, retain them pending the making of an order, or the decision not to make an order, under that section. (4) Nothing in this section shall affect any other power of the High Court or District.</p>	<p>IP Tribunal may direct, of any infringement goods, material or articles which a person has in his possession, custody or control in the course of a business. (2) An application shall not be made after the expiry of the period specified in section 50, and no order shall be made unless the High Court or an IP Tribunal also makes, or it appears to the High Court or a IP Tribunal that there are grounds for making, an order under section 51. (3) A person to whom any infringement goods, material or articles are delivered in pursuance of an order under this section shall, if an order under section 51 has not been made, retain them pending the making of an order, or the decision not to make an order, under that section. (4) Nothing in this section shall affect any other power of the High Court or IP Tribunal.</p>	
19	<p>Section 51. Order as to disposal of infringing goods, material or articles. - (1) Where infringing goods, material or articles have been delivered up in pursuance of an order under section 48, an application may be made to the High Court or a District Court. - (a) for an order that they be destroyed or forfeited to such person as the High Court or a District may thing fit; or (b) for a decision that no such order should be made. (2) In considering what order, if any should be made, the High Court or District Court shall consider whether other remedies available in an action for infringement of the registered trade mark would be adequate to compensate the proprietor and any licensee and</p>	<p>51. Order as to disposal of infringing goods, material or articles. - (1) Where infringing goods, material or articles have been delivered up in pursuance of an order under section 48, an application may be made to the High Court or an IP Tribunal. - (a) for an order that they be destroyed or forfeited to such person as the High Court or an IP Tribunal may thing fit; or (b) for a decision that no such order should be made. (2) In considering what order, if any should be made, the High Court or IP Tribunal shall consider whether other remedies available in an action for infringement of the registered trade mark would be adequate to compensate the proprietor and any licensee and protect their interests. (3) Where there are more persons than on interested in the goods, materials or articles, the High Court or an IP Tribunal shall make such order as it thinks just. (4) If the High Court or an IP Tribunal decides that no order should be made under this section, then the person, in whose possession, custody or control the goods,</p>	

	<p>protect their interests. (3) Where there are more persons than on interested in the goods, materials or articles, the High Court or a District Court shall make such order as it thinks just. (4) If the High Court or a District Court decides that no order should be made under this section, then the person, in whose possession, custody or control the goods, material or articles were before being delivered shall be entitled to their return</p>	<p>material or articles were before being delivered shall be entitled to their return.</p>	
20	<p>Section 57. Notice of seizure.- The Collector of Customs shall, as soon as practicable- (a) (iii) stating that the goods shall be released to the importer, consignee or owner of the goods unless the applicant brings an action for infringement of the registered trade mark in respect of goods before a District Court having jurisdiction in the matter and gives the Collector of Customs notice in writing of the action, within the period of ten working days after the applicant has been given the notice, or if the Collector of Customs extends the period under sub-section (1) of section 60, within such extended period.</p>	<p>57. Notice of seizure.- The Collector of Customs shall, as soon as practicable- (a) (iii) stating that the goods shall be released to the importer, consignee or owner of the goods unless the applicant brings an action for infringement of the registered trade mark in respect of goods before an IP Tribunal having jurisdiction in the matter and gives the Collector of Customs notice in writing of the action, within the period of ten working days after the applicant has been given the notice, or if the Collector of Customs extends the period under sub-section (1) of section 60, within such extended period.</p>	
21	<p>Section 60. Action for infringement against importation goods. (2) A District Court hearing the action- (a) may, on the application of any person, allow that person to be joined as a defendant in the case; and (b) shall allow the Collector of Customs, or his duly authorised officer, to appear and be heard. (3) Subject to sub-section (4), in addition to any relief that a District Court may grant apart from the provisions of this section, the Court may- (a) at any time, if it thinks it just, order that the seized goods be</p>	<p>60. Action for infringement against importation goods. (2) An IP Tribunal hearing the action- (a) may, on the application of any person, allow that person to be joined as a defendant in the case; and (b) shall allow the Collector of Customs, or his duly authorised officer, to appear and be heard. (3) Subject to sub-section (4), in addition to any relief that an IP Tribunal may grant apart from the provisions of this section, the Tribunal may- (a) at any time, if it thinks it just, order that the seized goods be released to their designated owner subject to such conditions that the Tribunal considers fit to impose; or (b) order that the seized goods be forfeited. (4) An IP Tribunal shall not make any order which may facilitate- (a) re-exporting of the counterfeit trade mark goods; (b) removing</p>	

	<p>released to their designated owner subject to such conditions that the Court considers fit to impose; or (b) order that the seized goods be forfeited. (4) A District Court shall not make any order which may facilitate- (a) re-exporting of the counterfeit trade mark goods; (b) removing of the trademarks which have been affixed to the counterfeit trade mark goods without authorization; and (c) local sale of such goods. (5) If a District Court decides that the registered trade mark was not infringement by the importation of the goods and the designated importer, consignee or owner of the goods, satisfies the Court that he has suffered losses or damage because the goods were seized, the Court may order the applicant to pay the defendant compensation, in the amount determined by the Court, for any part of the loss or damage that is attributable to any period beginning on or after the day on which the action was brought. (6) If, after three weeks from the day on which the action was brought, there is not in force at any time an order of a District Court preventing the goods from being released, the Collector of Customs shall release the goods to their designated importer, consignee or owner. (7) If a District Court orders that the goods be released, the Collector of Customs shall, subject to section 63, comply with the order.</p>	<p>of the trademarks which have been affixed to the counterfeit trade mark goods without authorization; and (c) local sale of such goods. (5) If an IP Tribunal decides that the registered trade mark was not infringement by the importation of the goods and the designated importer, consignee or owner of the goods, satisfies the Tribunal that he has suffered losses or damage because the goods were seized, the Tribunal may order the applicant to pay the defendant compensation, in the amount determined by the Tribunal, for any part of the loss or damage that is attributable to any period beginning on or after the day on which the action was brought. (6) If, after three weeks from the day on which the action was brought, there is not in force at any time an order of an IP Tribunal preventing the goods from being released, the Collector of Customs shall release the goods to their designated importer, consignee or owner. (7) If an IP Tribunal orders that the goods be released, the Collector of Customs shall, subject to section 63, comply with the order.</p>	
22	<p>Section 63. Power of the Collector of Customs to retain control of goods. - Notwithstanding anything contained in this Chapter, the Collector of Customs shall not- (a) release, or dispose any goods; or (b) take any action in relation to the goods to give effect to any order of a District Court under section 60. and</p>	<p>63. Power of the Collector of Customs to retain control of goods. - Notwithstanding anything contained in this Chapter, the Collector of Customs shall not- (a) release, or dispose any goods; or (b) take any action in relation to the goods to give effect to any order of an IP Tribunal under section 60. and Collector of Customs shall apply to the IP Tribunal to request that the goods are required and he may be allowed to retain control of the goods under any law for the time being in force.</p>	



	Collector of Customs shall apply to the District Court to request that the goods are required and he may be allowed to retain control of the goods under any law for the time being in force.		
23	<p>CHAPTER VII UNFAIR COMPETITION AND COMPARATIVE ADVERTISEMENT</p> <p>Section 67. Definition of unfair competition and provisions relating thereto. (3) An action against unfair competition may be brought before a District Court of competent jurisdiction.</p>	<p>CHAPTER VII UNFAIR COMPETITION AND COMPARATIVE ADVERTISEMENT</p> <p>Section 67. Definition of unfair competition and provisions relating thereto. (3) An action against unfair competition may be brought before an IP Tribunal of competent jurisdiction.</p>	
24	<p>Section 70. Registration of transactions affecting registered trade mark.- (2) The following shall be registerable transactions, namely:- (a) an assignment of a registered trade mark or any right in it; (b) the grant of a license under a registered trade mark; (c) the granting of any security interest whether fixed or floating over a registered trade mark or any right in or under it; (d) the making by personal representatives of an assent in relation to a registered trade mark or any right in or under it; and (e) an order of the High Court, District Court or other competent authority transferring a registered trade mark or any right in or under it.</p>	<p>70. Registration of transactions affecting registered trade mark.- (2) The following shall be registerable transactions, namely:- (a) an assignment of a registered trade mark or any right in it; (b) the grant of a license under a registered trade mark; (c) the granting of any security interest whether fixed or floating over a registered trade mark or any right in or under it; (d) the making by personal representatives of an assent in relation to a registered trade mark or any right in or under it; and (e) an order of the High Court, IP Tribunal or other competent authority transferring a registered trade mark or any right in or under it.</p>	
25	<p>Section 73. Revocation of registration.- (1) The registration of a trade mark may be revoked on any of the following grounds, namely:- (4) An application for revocation may be made by an interested party to the Registrar, except that- (a) if proceedings concerning the trade mark in question are pending in the High Court or a District Court, the application shall be made to the High Court or, as the case may be, the District Court; and (b) in case the</p>	<p>Section 73. Revocation of registration.- (1) The registration of a trade mark may be revoked on any of the following grounds, namely:- (4) An application for revocation may be made by an interested party to the Board of Appeal, except that- (a) if proceedings concerning the trade mark in question are pending in the High Court or an IP Tribunal, the application shall be made to the High Court or, as the case may be, the IP Tribunal; and (6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from- (a) the date of the application for revocation; or (b) if</p>	

	<p>application is made to the Registrar, he may at any stage of the proceedings refer the application to the High Court or a District Court. (6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from- (a) the date of the application for revocation; or (b) if the Registrar, the High Court or a District Court is satisfied that the grounds for revocation existed at an earlier date, that date.</p>	<p>the Registrar, Board of Appeal or an IP Tribunal is satisfied that the grounds for revocation existed at an earlier date, that date.</p>	
26	<p>Section 77. General provisions as to the rights of licensees in case of infringement.- (2) Where infringement proceedings are brought by a licensee under this section, the licensee may not, without the leave of the High Court or a District Court, proceed with the action unless the proprietor is either joined as a plaintiff or added as a defendant; Provided that this shall not affect the granting of interlocutory relief on an application by a licensee alone: (4) In infringement proceedings brought by the proprietor of a registered trade mark any loss suffered or likely to be suffered by licensees shall be taken into account and the High Court or a District Court may give such directions as it thinks fit as to extent to which the plaintiff shall hold the proceeds of any pecuniary remedy on behalf of licensees.</p>	<p>Section 77. General provisions as to the rights of licensees in case of infringement.- (2) Where infringement proceedings are brought by a licensee under this section, the licensee may not, without the leave of the High Court or an IP Tribunal, proceed with the action unless the proprietor is either joined as a plaintiff or added as a defendant; Provided that this shall not affect the granting of interlocutory relief on an application by a licensee alone: (4) In infringement proceedings brought by the proprietor of a registered trade mark any loss suffered or likely to be suffered by licensees shall be taken into account and the High Court or an IP Tribunal may give such directions as it thinks fit as to extent to which the plaintiff shall hold the proceeds of any pecuniary remedy on behalf of licensees.</p>	
27	<p>Section 78. Exclusive licensee having rights and remedies of assignee.- (4) Where proceedings for infringement of a registered trade mark brought by the proprietor or an exclusive licensee relate wholly or partly to an infringement in respect of which they have concurrent rights of action, the proprietor or, as</p>	<p>Section 78. Exclusive licensee having rights and remedies of assignee.- (4) Where proceedings for infringement of a registered trade mark brought by the proprietor or an exclusive licensee relate wholly or partly to an infringement in respect of which they have concurrent rights of action, the proprietor or, as the case may be, the exclusive licensee may not, without the leave of the High Court or an IP Tribunal, proceed with the action unless the other is either joined as a</p>	

<p>the case may be, the exclusive licensee may not, without the leave of the High Court or a District Court, proceed with the action unless the other is either joined as a plaintiff or added as a defendant: Provided that this shall not affect the granting of interlocutory relief on an application by a proprietor or licensee alone. (6) Where an action for infringement of a registered trade mark is brought which relates wholly or partly to an infringement in respect of which the proprietor and an exclusive licensee have or had concurrent rights of action- (a) the High Court or a District Court shall in assessing damages take into account- (i) the terms of the license; and (ii) any pecuniary remedy already awarded or available to either of them in respect of the infringement; (b) no account of profits shall be directed, in favour of the other of them in respect of the infringement; and (c) the High Court or a District Court shall if an account of profits is directed apportion the profits between them as it, subject to any agreement between them, considers just. (7) The provisions of sub-section (6) shall apply whether or not the proprietor and the exclusive licensee are both parties to the action, the High Court or a District Court may give such direction as it thinks fit as to the extent to which the party to the proceedings shall hold the proceeds of any pecuniary remedy on behalf on the other. (8) The proprietor of a registered trade mark shall inform any exclusive licensee who has a concurrent right of action before applying for an order under section 48, and the High Court or a District Court may, on the application of the licensee,</p>	<p>plaintiff or added as a defendant: Provided that this shall not affect the granting of interlocutory relief on an application by a proprietor or licensee alone. (6) Where an action for infringement of a registered trade mark is brought which relates wholly or partly to an infringement in respect of which the proprietor and an exclusive licensee have or had concurrent rights of action- (a) the High Court or an IP Tribunal shall in assessing damages take into account- (i) the terms of the license; and (ii) any pecuniary remedy already awarded or available to either of them in respect of the infringement; (b) no account of profits shall be directed, in favour of the other of them in respect of the infringement; and (c) the High Court or an IP Tribunal shall if an account of profits is directed apportion the profits between them as it, subject to any agreement between them, considers just. (7) The provisions of sub-section (6) shall apply whether or not the proprietor and the exclusive licensee are both parties to the action, the High Court or an IP Tribunal may give such direction as it thinks fit as to the extent to which the party to the proceedings shall hold the proceeds of any pecuniary remedy on behalf on the other. (8) The proprietor of a registered trade mark shall inform any exclusive licensee who has a concurrent right of action before applying for an order under section 48, and the High Court or an IP Tribunal may, on the application of the licensee, make such order under that section as it thinks fit having regard to the license.</p>	
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	make such order under that section as it thinks fit having regard to th license.		
28	<p>Section 80. Grounds for invalidity of registration.-. (4) An application for declaration of invalidity may be made by an interested party either to the Registrar or to the High Court or a District Court, except that- (a) if proceedings concerning the trade mark in question are pending in the High Court or a District Court, the application shall be made to the High Court or a District Court; and (b) in any other case, if the application has been made to the Registrar, he may at any stage of the proceedings refer the application to the High Court or a District Court. (5) In the case of bad faith in the registration of a trade mark, the Registrar may apply to the High Court or a District Court for a declaration of the invalidity of the registration.</p>	<p>Section 80. Grounds for invalidity of registration.- (4) An application for declaration of invalidity may be made by an interested party to the Board of Appeal, except that- (a) if proceedings concerning the trade mark in question are pending in the High Court or an IP Tribunal, the application shall be made to the High Court or an IP Tribunal; (5) In the case of bad faith in the registration of a trade mark, the Registrar may apply to the Board of Appeal for a declaration of the invalidity of the registration.</p>	
29	<p>CHAPTER XII RECTIFICATION AND CORRECTION OF THE REGISTER</p> <p>Section 96. Rectification or correction of Register. (2) An application for rectification may be made to the Registrar, except that- (a) if proceedings concerning the trade mark in question are pending in the High Court or a District Court, the application shall be made to the High Court or a District Court; and (b) in case the application is made to the Registrar, he may at any stage of the proceedings refer the application to the High Court or District Court. (3) Except where the Registrar or the High Court or a District Court directs otherwise, the effect of rectification of the Register shall be that the error</p>	<p>CHAPTER XII RECTIFICATION AND CORRECTION OF THE REGISTER</p> <p>Section 96. Rectification or correction of Register. (2) An application for rectification may be made to the Registrar except that- (a) if proceedings concerning the trade mark in question are pending in the High Court or an IP Tribunal, the application shall be made to the High Court or an IP Tribunal; and (b) the Registrar may at any stage, if deemed appropriate, refer the application to the Board of Appeal.</p>	

	or omission in question shall be deemed never to have been made.		
30	Section 105. Powers to award compensation for offenses. - (1) In any prosecution under this Ordinance, the High Court or a District Court may, when passing a sentence of fine, direct that an amount not exceeding fifty percent of the fine imposed by it but commensurate with the loss suffered by the party shall be paid as compensation to the person whose right has been infringed or to the heirs or legal representatives of such person. (2) The payment of any compensation to any sub-section (1), shall be without prejudice to his right to any claim in a suit or other proceedings which may be instituted, or may be pending in the High Court or a District Court, in relation to the same matter.	Section 105. Powers to award compensation for offenses. - (1) In any prosecution under this Ordinance, the High Court or an IP Tribunal may, when passing a sentence of fine, direct that an amount not exceeding fifty percent of the fine imposed by it but commensurate with the loss suffered by the party shall be paid as compensation to the person whose right has been infringed or to the heirs or legal representatives of such person. (2) The payment of any compensation to any sub-section (1), shall be without prejudice to his right to any claim in a suit or other proceedings which may be instituted, or may be pending in the High Court or an IP Tribunal, in relation to the same matter.	
31	Section 114. Appeal against the decision of the Registrar.- (1) Save as otherwise expressly provided in this Ordinance, an appeal shall lie, within the prescribed period, against any decision of the Registrar under this Ordinance or rules made thereunder to the High Court having jurisdiction; Provided that if any suit or other proceedings concerning the trade mark in question is pending before the High Court or a District Court, the appeal shall lie 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 21, 22 or 28, it shall be open, save with the express permission of the High Court, to the Registrar or any party opposing the appeal to advance	Section 114. Appeal against the decision of the Registrar.- (1) Save as otherwise expressly provided in this Ordinance, an appeal shall lie against any decision of the Registrar under this Ordinance or rules made thereunder to the Board of Appeal as prescribed; Provided that if any suit or other proceedings concerning the trade mark in question is pending before the High Court or an IP Tribunal, the appeal shall lie to that High Court or, as the case may be, to the High Court within whose jurisdiction that IP Tribunal is situated. (2) In an appeal by an applicant for registration against a decision of the Registrar under section 21, 22 or 28, it shall be open, save with the express permission of the Board of Appeal, 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	

	<p>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. (3) Subject to the provision of this Ordinance and of rules made thereunder, the provisions of the Code of Civil Procedure, 1908 (Act V of 1908), shall apply to appeal before the High Court or a District Court under this Ordinance.</p>	<p>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. (3) Subject to the provision of this Ordinance and of rules made thereunder, the provisions of the Code of Civil Procedure, 1908 (Act V of 1908), shall apply to appeal before the Board of Appeal under this Ordinance.</p>	
32	<p>Section 117. Suits for infringement to be instituted before District Court- 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.</p>	<p>Section 117. Suits for infringement to be instituted before IP Tribunal- 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 an IP Tribunal having jurisdiction to try the suit.</p>	
33	<p>Section 118. Costs of Registrar in proceedings before the High Court or a District Court.- In all proceedings under this Ordinance before the High Court or a District Court, the costs of the Registrar shall be in the discretion of the High Court or, as the case may be the District Court, but the Registrar shall not be ordered to pay the costs of any of the parties</p>	<p>Section 118. Costs of Registrar in proceedings before the High Court or an IP Tribunal.- In all proceedings under this Ordinance before the High Court or an IP Tribunal, the costs of the Registrar shall be in the discretion of the High Court or, as the case may be the IP Tribunal, but the Registrar shall not be ordered to pay the costs of any of the parties</p>	
34	<p>Section 122. Death of a party to any proceedings under this Ordinance.- If a person who is a party to any proceedings under this Ordinance, not being any proceedings before the High Court or a District Court, dies pending the proceedings, the Registrar may, on request, and on proof to his satisfaction of</p>	<p>Section 122. Death of a party to any proceedings under this Ordinance.- If a person who is a party to any proceedings under this Ordinance, not being any proceedings before the High Court or an IP Tribunal, dies pending the proceedings, the Registrar may, on request, and on proof to his satisfaction of the transmission of the interest of the deceased person, substitute in the proceedings his successor in interest in his place, or if the Registrar is of opinion that the interest of the</p>	

	the transmission of the interest of the deceased person, substitute in the proceedings his successor in interest in his place, or if the Registrar is of opinion that the interest of the deceased person is sufficiently represented by the surviving parties, permit the proceedings to continue without the substitution of his successor in interest.	deceased person is sufficiently represented by the surviving parties, permit the proceedings to continue without the substitution of his successor in interest.	
35	Section 124. Registrar and other officers not compellable to produce Register, etc.- The Registrar or any officer of the Trade Mark Registry shall not, in any legal proceedings to which he is not a party, be compellable to produce the Register or any other document in his custody the contents of which can be proved by the production of a certified copy issued under this Ordinance or to appear as a witness to prove the matters therein recorded unless by order of the High Court or District Court made for special case.	Section 124. Registrar and other officers not compellable to produce Register, etc.- The Registrar or any officer of the Trade Mark Registry shall not, in any legal proceedings to which he is not a party, be compellable to produce the Register or any other document in his custody the contents of which can be proved by the production of a certified copy issued under this Ordinance or to appear as a witness to prove the matters therein recorded unless by order of the High Court or IP Tribunal made for special case.	
36	Section 132. Power of the Federal Government to make rules.- (xlii) the period within which an appeal from any decision of the Registrar under this Ordinance or rules made thereunder may lie to the High Court or a District Court having jurisdiction under sub-section (1) of section 114;	Section 132. Power of the Federal Government to make rules.- (xlii) the period within which an appeal from any decision of the Registrar under this Ordinance or rules made thereunder may lie to the Board of Appeal under sub-section (1) of section 114;	
37	COLLECTIVE MARKS Section 12. Infringement of a registered collective mark.- (7) In infringement proceedings brought by the proprietor of a registered collective mark, any loss suffered or likely to be suffered by authorised user shall be taken into account, and the High Court or a District Court may give such directions as it thinks fit as to the extent to	COLLECTIVE MARKS Section 12. Infringement of a registered collective mark.- (7) In infringement proceedings brought by the proprietor of a registered collective mark, any loss suffered or likely to be suffered by authorised user shall be taken into account, and the High Court or an IP Tribunal may give such directions as it thinks fit as to the extent to which the plaintiff shall hold the proceeds of any pecuniary remedy on behalf of such users. Section 14. The High Court or an IP Tribunal to take into account loss suffered by authorised users.- In infringement	

	<p>which the plaintiff shall hold the proceeds of any pecuniary remedy on behalf of such users.</p> <p>Section 14. The High Court or a District Court to take into account loss suffered by authorised users.- In infringement proceedings brought by the proprietor of the registered certification mark any loss suffered or likely to be suffered by authorised user shall be taken into account and the High Court or a District Court may give such directions as it thinks fit as to the extent to which the plaintiff shall hold the proceeds of any pecuniary remedy on behalf of such users.</p>	<p>proceedings brought by the proprietor of the registered certification mark any loss suffered or likely to be suffered by authorised user shall be taken into account and the High Court or an IP tribunal may give such directions as it thinks fit as to the extent to which the plaintiff shall hold the proceeds of any pecuniary remedy on behalf of such users.</p>	
38	<p>Chapter II - Registrar Trade Marks Registry and Registration of Trade Marks Section (7). Appointment of Register and other officers- (1) The Federal Government may by notification in the official Gazette, appoint an officer who shall be called the Registrar of Trade Marks. (2) The Federal Government may appoint such other officers with such designations as it deems fit for performing under the superintendence and direction of the Registrar, such function of the Registrar, under this Ordinance as he may, from time to time, authorise them to discharge.</p>	<p>Chapter II - Registrar Trade Marks Registry and Registration of Trade Marks Section (7). Appointment of Register and other officers- (1) The Organization may by notification in the official Gazette, appoint an officer who shall be called the Registrar of Trade Marks. (2) The Organization may appoint such other officers with such designations as it deems fit for performing under the superintendence and direction of the Registrar, such function of the Registrar, under this Ordinance as he may, from time to time, authorise them to discharge.</p>	
39	<p>Section 9(2) For the purpose of facilitating registration of trade marks, there may be established at such places, as the Federal Government may think fit, branch offices of the Trade Marks Registry.</p>	<p>Federal Government may be replaced with the IPO Policy Board (as per Section 3(3) of IPO Act 2012) 9(2) Section 9(2) For the purpose of facilitating registration of trade marks, there may be established at such places, as the <b>IPO Policy Board</b> may think fit, branch offices of the Trade Marks Registry.</p>	
40	<p>Section 10(2) Subject to the superintendence and direction of the Federal Government, the Register</p>	<p>Section 10(2) Subject to the superintendence and direction of the Organization, the Register shall be kept under the control and management of the Registrar.</p>	



	shall be kept under the control and management of the Registrar.		
41	Section (95) The Federal Government may, in such manner, as may be prescribed, constitute one or more Advisory Committees of persons well versed in the usages of the textile trade for the purposes of this Chapter.	Section 95. The Organization may, in such manner, as may be prescribed, constitute one or more Advisory Committees of persons well versed in the usages of the textile trade for the purposes of this Chapter.	
42	111. Procedure before the Registrar.- (1) In all proceedings under this Ordinance 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, issuing commissions for the examination of witness and granting a certificate of contested validity; (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.	111. Procedure before the Registrar.- (1) In all proceedings under this Ordinance 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, issuing commissions for the examination of witness and granting a certificate of contested validity; (b) evidence shall be given by affidavit.	
43	Section (115). Procedure before the Federal Government.-In all proceedings under this Ordinance before the Federal Government, evidence shall be given by affidavit, provided that the Federal Government may, if it thinks fit, take oral evidence in lieu of, or in addition to, such evidence by an affidavit, and shall for that purpose have all the powers of a Civil Court referred to in clause (a) of section 111.	Section (115). Procedure before the Organization.-In all proceedings under this Ordinance before the Organization, evidence shall be given by affidavit and shall for that purpose have all the powers of a Civil Court referred to in clause (a) of section 111.	
44	Section 132(lix) the manner in which, in proceedings under this Ordinance before the Registrar or the Federal Government, application shall be made, notices given and matters advertised;	Section 132(lix) the manner in which, in proceedings under this Ordinance before the Registrar or the Organization, application shall be made, notices given and matters advertised;	
45	Section 132(lxi) any matters generally related to business of the Trade Marks Registry or its branches	Section 132(lxi) any matters generally related to business of the Trade Marks Registry or its branches and for regulating all things by this Ordinance placed under the discretion of the	

	and for regulating all things by this Ordinance placed under the discretion of the Registrar or the Federal Government; and	Registrar or the Organization; and	
46	New Addition	<p><b>Section 10(a): Validity of Electronic Documents</b></p> <p>Electronic submission of all the prescribed application forms and other related documents prescribed by the rules notified under this ordinance for official purpose, by the applicant shall be valid for legal references;</p>	
47	<p>Section 17(6) Relative grounds for refusal of registration;</p> <p>Where separate applications are made by different persons to be registered as proprietor respectively of trade marks which are identical or nearly resemble each other, in respect of the same goods or description of goods, the Registrar, if thinks fit, may refuse to register any of them until their rights have been determined by the High Court or a District Court.</p>	<p>Section 17(6) Relative grounds for refusal of registration;</p> <p>Where separate applications are made by different persons to be registered as proprietor respectively of trade marks which are identical or nearly resemble each other in respect of the same goods and services or description of goods and services, the Registrar, if thinks fit, may refuse to register any of them until their rights have been determined by the High Court or an IP Tribunal.</p>	
48	<p><b>33. Registration</b> (2). A trade mark shall not be registered unless any fee prescribed for the registration is paid within the prescribed period. if the fee is not paid within prescribed period, the application shall be deemed to have been withdrawn.</p>	<p><b>33. Registration</b> (2). A trade mark shall not be registered unless any fee prescribed for the registration is paid within the prescribed period. if the fee is not paid within prescribed period, the application shall be deemed to have been abandoned.</p>	

49	New Addition 114 (1)(a)	<p>Section 114. Appeal against the decision of the Registrar. - (1) Save as otherwise expressly provided in this Ordinance, an appeal shall lie, within the prescribed period, against any decision of the Registrar under this Ordinance or rules made thereunder to the Board of Appeal; except that if any suit or other proceedings concerning the trade mark in question is pending before the High Court or an IP Tribunal, the appeal shall lie to that High Court or, as the case may be, to the High Court within whose jurisdiction that IP Tribunal is situated.</p> <p>1(a). Board of Appeal against the decision of Registrar, the organization, by notification in the official gazette, shall constitute a board to be called as Board of Appeal for trademarks, consisting of the following members: -</p> <ul style="list-style-type: none"><li>a. Chairman of the Board, shall be an officer of the organization, appointed by the organization;</li><li>b. A Member legal, shall be an officer of the organization, having a law degree, appointed by the organization and shall also act as the secretary of Board;</li><li>c. A technical member shall be an officer of the organization appointed by the organization with at least ten years of experience of trademarks.</li></ul> <p>1(b). The powers and procedures of the Board: -</p> <ul style="list-style-type: none"><li>a. 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.</li><li>b. The Board shall have full powers to hear, confirm or set aside the decisions of the Registrar, under the authority vested by this ordinance.</li></ul>	
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		<p>c. 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.</p> <p>d. The Board may authorize any of its members to exercise any of its powers 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.</p> <p>e. 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, and all proceedings before the Board shall be deemed to be judicial proceedings within the meaning of sections 193 and 228 of Pakistan Penal Code (Act XLV of 1860).</p> <p>f. 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.</p>	
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50	<p>Section (129) The Federal Government and a Provincial Government to be bound. -</p> <p>The provision of this Ordinance shall be binding on the Federal Government and a Provincial Government.</p>	<p>Section (129) “The Federal Government and Provincial Governments to be bound-</p> <p>The provision of this Ordinance shall be binding on the Federal Government and Provincial Governments.</p>	
51	<p><b>CHAPTER ON MADRID PROTOCOL FOR INTERNATIONAL REGISTRATION OF MARK</b></p>		
	<p>NEW Addition/not defined</p>	<p>92A. International registration under Madrid Protocol - The provisions of this Chapter shall apply to international applications and international registrations under the Madrid Protocol.</p> <p>92B. Definitions. In this Chapter, unless the context otherwise requires, -"application", in relation to a Contracting State or a Contracting Organization means an application made by a person who is a citizen of, or is domiciled in, or has a real and effective industrial or commercial establishment in, that Contracting State or a State which is a member of that Contracting Organization as the case may be. Explanation: - For the purposes of this clause, "real and effective industrial or commercial establishment" means and includes any establishment where some bona fide industrial or commercial activity takes place and need not necessarily be the principal place of business;</p> <p>(i) "basic 'application" means an application for the registration of a trade mark filed under section 22 and which is used as a basis for applying for an international registration;</p>	

	<p>(ii) "basic registration" means the registration of a trade mark under section 33 and which is used as a basis for applying for an international registration;</p> <p>(iii) "Common Regulations" means the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement;</p> <p>(iv) "Contracting Organization" means a Contracting Party that is an inter- governmental organization;</p> <p>(v) "Contracting Party" means a Contracting State or Contracting Organization party to the Madrid Protocol;</p> <p>(vi) "Contracting State" means a country party to the Madrid Protocol;</p> <p>(vii) "Designation", with its grammatical variations, is a request for the extension of protection under Article 3ter(1) or (2) of the Madrid Protocol, as the case may be; it also means such extension as recorded in the International Register;</p> <p>(viii) "Designated Contracting Party" is a Contracting Party for which the extension of protection has been requested under Article 3ter(1) or (2) of the Madrid Protocol, as the case may be, or in respect of which such extension has been recorded in the International Register;</p> <p>(ix) "International application" means an application for international registration or for extension of the protection resulting from an international registration to any Contracting Party made under the Madrid Protocol;</p>	
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(x) "International Bureau" means the International Bureau of the World Intellectual Property Organization

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

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

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

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

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

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

	<p>international registration of that trade mark.</p> <p>(2) A person holding an international registration may make an international application on the form prescribed by the Common Regulations for extension of the protection resulting from such registration to any other Contracting Party.</p> <p>(3) An international application under sub-section (1) or sub-section (2) shall designate the Contracting Parties where the protection resulting from the international registration is required.</p> <p>(4) The Registrar shall certify in the prescribed manner that the particulars appearing in the international application correspond to the particulars appearing, at the time of the certification, in the application under section 22 or the registration under section 33, and shall indicate the date and number of that application or the date and number of that registration as well as the date and number of the application from which that registration resulted, as the case may be, and shall within the prescribed period, forward the international application to the International Bureau for registration, also indicating the date of the international application.</p> <p>(5) Where at any time before the expiry of a period of five years of an international registration, whether such registration has been transferred to another person or not, the application under section 22 or the registration under section 33, as the case may be, has been withdrawn or cancelled or has expired or has been finally refused in respect of all or some of the goods or services listed in the international registration, the protection resulting from such international registration shall cease to have effect:</p>	
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Provided that where an appeal is made against the decision of registration and an action requesting for withdrawal of application or an opposition to the application has been initiated before the expiry of the period of five years of an international registration, any final decision resulting into withdrawal, cancellation, expiration or refusal shall be deemed to have taken place before the expiry of five years of the international registration.

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

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

92E. International registrations where Pakistan has been designated. - (I)

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

(2) Where, after recording the particulars of any international registration referred to in sub-section (I), the Registrar is satisfied that in the circumstances of the case the protection of trade mark in Pakistan should not be granted or such protection should be granted subject to conditions or

	<p>limitations or to conditions additional to or different from the conditions or limitations subject to which the international registration has been accepted, he may, after hearing the applicant if he so desires refuse grant of protection and inform the International Bureau in the prescribed manner within eighteen months from the date on which the notification referred to in sub-section ( 1) was received.</p> <p>(3) Where the Registrar finds nothing in the particulars of an international registration to refuse grant of protection under sub-section (2), he shall within the prescribed period cause such international registration to be advertised in the prescribed manner.</p> <p>( 4) The provisions of sections 14 to 31 (both inclusive), 82 and 83 shall apply mutatis mutandis in relation to an international registration as if such international registration was an application for registration of a trade mark under section 22.</p> <p>(5) When the protection of an international registration has not been opposed and the time for notice of opposition has expired, the Registrar shall within a period of eighteen months of the receipt of notification under subsection (1) notify the International Bureau its acceptance of extension of protection of the trade mark under such international registration and, in case the Registrar fails to notify the International Bureau, it shall be deemed that the protection has been extended to the trade mark.</p> <p>(6) International registration designating Pakistan shall enjoy the right of priority provided for in Article 4 of the Paris Convention and are exempt from the need to comply with the formalities prescribed in Section D of that Article.</p>	
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(7) Where a same registered proprietor of a trade mark makes an international registration of trade mark with all goods or services in the national registration and designates Pakistan, the international registration from the date of the registration shall be deemed to replace the registration held in Pakistan without prejudice to any right acquired under such previously held registration and the Registrar shall, upon request by the applicant, make necessary entry in the register referred to in subsection (1) of section 6.

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

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

92F. Effects of international registration. - (I) From the date of the international registration of a trade mark where Pakistan has been designated or the date of the recording in the register of the International Bureau about the extension of

the protection resulting from an international registration of a trade mark to Pakistan, the protection of the trade mark in Pakistan shall be the same as if the trade mark had been registered in Pakistan.

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

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

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

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

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

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

		transmissions thereof.	