

Chapter II - Registrar Trade Marks Registry and Registration of Trade Marks

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.

8. Power of Registrar to review, withdraw or transfer cases- The Registrar may, by order in writing-

(a) review any function, matter, case or decision of any officer; or
(b) withdraw any function, matter or case from any officer or staff,
and deal with such function, matter or case himself of either de novo or from the stage it was so withdrawn, or transfer the same to another officer or staff at any stage.

9. Trade Marks Registry and branches thereof-

(1) For the purposes of this Ordinance, there shall be established a Trade Marks Registry.

The Trade Marks Registry established under the Trade Marks Act, 1940 (V of 1940), shall be the Trade Marks Registry for the purposes of this Ordinance.

(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 officers

of the Trade Marks Registry.

(3) There shall be a seal of the Trade Marks Registry.

10. Register of Trade Marks.-

(1) For the purposes of this Ordinance, a record called the Register of Trade Marks shall be kept at the Trade Marks Registry wherein shall be entered particulars of all registered trade marks with the names, address and description of the proprietors, notifications of assignments and transmission, the names, address and description of licensees, disclaimers, conditions, limitations and such other matters relating to registered trade marks as may be prescribed, but there shall not be entered in the Register any notice of any trust express, implied or constructive, nor shall any such notice be receivable by the Registrar;

(2) Subject to the superintendence and direction of the Federal Government, the Register shall be kept under the control and management of the Registrar.

(3) The Register may be kept in whole, or in part, by using a computer any bona fide record of a particular or other matter made by using a computer for the purposes of keeping the Register shall, for the purposes of this Ordinance, constitute an entry in the Register.

(4) There shall be kept at each branch office of the Trade Marks Registry, a copy of the Register and such of the other documents as the Registrar may, by notification in the Journal, direct;

Provided that if the Register in whole, or any part thereof, is kept by using a computer and access to a computer terminal from which a person in a branch office can read a screen, or obtain a printed copy of, the particulars or other matters recorded in the Register or that part of the Register, requirement under this sub-section of keeping a copy of the Register at that branch office shall be satisfied.

(5) The Register shall at all convenient times be open to the inspection of the public subject to such conditions and restrictions as may be prescribed.

(6) If the Register in whole, or any part thereof, is kept by using a computer, the requirements of sub-section (5) shall be satisfied if a person who wants to inspect the Register or that part of the Register is given access to a computer terminal from which he can read a screen, or obtain a printed copy of the particulars or other matters recorded in the Register or that part of the Register.

11. Evidence of entries in Register and things done by Registrar.-

(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 proceedings without further proof or production of the original.

(2) A certificate purporting to be issued under the hand of the Registrar as to any entry, matter or thing that he is authorised by this Ordinance or the rules to make or do shall be prima facie evidence of the entry having been made and of the contents thereof, or of the matter or thing having been done or not done.

12. Classification of goods and services.-

(1) A trade mark may be registered in accordance with the provisions of this Ordinance in respect of-

- (a) goods;
- (b) services; or
- (c) both goods and services,

comprised in the prescribed classification of goods or services in accordance with the international classification of goods and services.

(2) Any question arising as to the class within which any goods or services fall shall be determined by the Registrar whose decision in the matter shall be final.

13. Publication of an alphabetical index of classification of goods and services-

(1) The Registrar may publish in the prescribed manner an alphabetical index of classification of goods and services.

(2) Where any goods or services are not specified in the alphabetical index of goods and services, published under sub-section (1), the classification of goods and services shall be determined by the Registrar in accordance with sub-section (2) of section 12.

14. Absolute grounds for refusal of registration.-

(1) The following shall not be registered, namely:-

- (a) mark which do not satisfy the requirement of clause (xlvii) of section 2;
- (b) trade marks which are devoid of any distinctive character;
- (c) trade marks which consist exclusively of marks or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services; and
- (d) trade mark which consist exclusively of marks or indications which have become customary in the language or in the bona fide and established practices of the trade;

Provided that a trade mark shall not be refused registration by virtue of clause (b), (c) or (d) if, before the date of application for registration, it has in fact, acquired a distinctive character as a result of the use made of it or is a well know trade mark.

(2) A mark shall not be registered as a trade mark if it consists exclusively of-

- (a) the shape which results from the nature of the goods themselves;

- (b) the shape of goods which is necessary to obtain a technical result; or
- (c) the shape which gives substantial value to the goods.

(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;
- (b) be likely to hurt the religious susceptibilities of any class of citizens of Pakistan, per se, or in terms of goods or services it is intended to be so registered; or
- (c) be contrary to any law, for the time being in force or morality.

(4) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

15. Limitation as to colour.-

(1) A trade mark may be limited wholly or in part to one or more specified colours, and any such limitation shall be taken into consideration by any tribunal having to decide on the distinctive character of the trade mark.

(2) So far as a trade mark is registered without limitation of colour it shall be deemed to be registered for all colours.

16. Use of names of chemical compounds barred.-

(1) No word which is the commonly used and accepted name of any single chemical element or single chemical compound as distinguished from a mixture or which is declared by the World Health Organization and notified in the prescribed manner by the Registrar, from time to time, as an international non-proprietary name shall be registered as a trade mark in respect of a chemical substance or preparation, and any such registration shall, notwithstanding anything in section 44, be deemed for the purposes of section 98 to be an entry made in the Register without sufficient cause or an entry wrongly remaining on the Register, as the circumstances may require.

(2) This section shall not apply to a word which is used to denote only a brand or make of the elements or compound as made by the proprietor or a licensee of the trade mark, as distinguished from the element or compound as made by others, and in association with a suitable name or description open to the public use.

17. Relative grounds for refusal of registration.-

(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services, for which the trade mark is applied for, are identical with the goods or services for which the earlier trade mark is registered.

(2) A trade mark shall not be registered because-

(a) it is identical with an earlier trade mark and is to be registered for goods- or services similar to those for which the earlier trade mark is registered; or

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is registered.

and there exists a likelihood of confusion on the part of the public which includes the likelihood of association with the earlier trade mark.

(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark; and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered.

shall not be registered if, or to the extent that, the earlier trade mark 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 the repute of the earlier trade mark.

(4) A trade mark shall not be registered if, or to the extent that, its use in Pakistan is liable to be prevented-

(a) by virtue of any law, in particular, the law of passing off, protecting an unregistered trade mark or other mark used in the course of trade; or

(b) by virtue of an earlier right other than those referred in sub-section (1), (2) and (3) or clause (a) of this sub-section, in particular by virtue of the law of copyright design right or registered designs.

(5) Nothing in this section shall prevent the registration of a trade mark where the proprietor of the earlier trade mark or other earlier consents to the 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 thinks fit, may refuse to register any of them until their rights have been determined by the High Court or a District Court.

18. Meaning of "earlier trade mark".- In this ordinance. "earlier trade mark" means-

(a) a registered trade mark or a Convention trade mark as per the Paris Convention which has a date of application for registration earlier than that of the trade mark in question, taking account, where appropriate, of the priorities claimed in respect of the trade marks;

(b) a trade mark filed under sub-section(1) of section 26; or

(c) a trade mark which, on the date of application for registration of the trade mark in question, or where appropriate, of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark.

(2) References in this Ordinance to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if