

Intellectual Property
for Business Series

No. 1

MAKING A MARK

An introduction to
Trademarks for Small
and Medium-sized
Enterprises





Publications in the “Intellectual Property for Business” Series:

1. Making A Mark - An introduction to Trademarks for Small and Medium-Sized Enterprises.
2. Looking Good – An introduction to Industrial Designs for Small and Medium-Sized Enterprises.
3. Inventing the Future - An introduction to Patents for Small and Medium-Sized Enterprises.
4. Creative Expression - An introduction to Copyright and Related Rights for Small and Medium-Sized Enterprises.

The adapted versions of the above mentioned publications are available at WIPO (WIPO e-bookshop at www.wipo.int/ebookshop) and SMEDA website (SMEDA publications at www.smeda.org.pk)

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Preface

Preface

'Intellectual Property' till recently has been considered a luxury by the industry in general and SMEs in particular. In reality, it is the biggest opportunity for SMEs to establish their credentials at par with the large enterprises. In fact, every business has some valuable intangible property worth protecting. Keeping SMEs abreast on information about Intellectual Property Rights (IPRs) systems so as to protect their IP assets is a must. Ignorance in this field may lead to loss of valuable rights, expensive litigation or both.

This customized version of 'Making a Mark' will provide useful insights to SMEs in Pakistan about trademarks, its benefits, its registration procedure in Pakistan as well as abroad (especially for exporters) and other relevant information, illustrated with the help of examples of Pakistani businesses. It is mainly directed at SMEs engaged in product manufacturing or service delivery activities. The purpose of this endeavour is to enable SMEs to seize the opportunity of trademark protection rather than deferring the decision to adopt IP system on the assumption that IP protection is costly and time consuming or enforcement of the laws are ineffective.

In compilation of this booklet, efforts of SMEDA team comprising Mr. Muhammad Jamil Afaqi, Ms. Aisha Amjad Mir and Mr. Shaheen Tahir have been commendable.

I hope this joint effort on part of the World Intellectual Property Organisation (WIPO) and Small and Medium Enterprises Development Authority (SMEDA), will assist SMEs to build their brand identities. With the help of this Guide, SMEs will be able to create distinctive trademarks to uniquely position their products /services in the marketplace.

Shahid Rashid
CEO, SMEDA

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Trademarks

1 Trademarks

What is a Trademark?

Generally speaking, a trademark is a mark used for the purposes of differentiating goods or services of one business from the goods or services of others.

Any distinctive words, letters, numerals, drawings, pictures, shapes, colors, logotypes, labels or combinations used to distinguish goods or services may be considered a trademark.

In Pakistan, registration and protection of trademarks is regulated under the law called "The Trade Marks Ordinance, 2001" (The Ordinance). Section 2(xlvii) of the Ordinance defines the trade mark as follows:

"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 undertakings;"

There are some less traditional forms of trademarks also, such as single colors, three-dimensional signs (shapes of products or packaging), audible signs (sounds) or olfactory signs (smells). An increasing number of countries recognize these less traditional forms of trademarks for registration. However, many countries have set limits on what can be registered as a trademark, generally only allowing for signs that are visually perceptible or that can be represented graphically.

The definition of "mark" given in Pakistani law also includes sound or scent. However, registration of these marks is only possible if they are capable of graphical representation. This condition of graphical representation substantially restricts the scope of protection extendable to such marks in Pakistan.

Examples:

Word marks:

The logo for Treet Corporation, featuring the word "Treet" in a stylized, cursive font.

[Courtesy: Treet Corporation Ltd.]
Treet Corporation Limited is the manufacturer of top quality blades and razors in Pakistan for the last fifty years.

The logo for Workman, featuring the letters "UN" in a bold, blocky font above the word "WORKMAN" in a smaller, sans-serif font.

[Courtesy Workman]
"WORKMAN" is a registered trademark for furniture and wooden products.

Logo



[Courtesy: Nestlé Pakistan Ltd]
"The logo was adopted and first ever used by Nestlé in the Year 1998 in Pakistan for its bottled water and since then it has continuously been used in numerous countries around the world.

Trademarks

Composite:



[Courtesy: Friends Sons (Pvt.) Ltd.]

Can you register

Advertising slogans as trademark?

In Pakistan advertising slogans are also considered as a trademark and can be protected if they fulfill the criterion fixed for registration of a trade mark. For instance Tapal Tea has registered its advertising slogan.

ٹیپال دانے دار،
اور کیا چاہئے!

TAPAL DANEDAR
AUR KYA CHAHEYE!

[Courtesy: Tapal Tea (Private) Limited]

What are trademarks for?

The main function of a trademark is to enable consumers to identify a product (whether a good or a service) of a particular company so as to distinguish it from other identical or similar products provided by competitors of such company.

Consumers who are satisfied with a given product are likely to buy or use the product again in the future. For this, they need to be able to distinguish easily between identical or similar products.

By enabling companies to differentiate themselves and their products from those of the competitors, trademarks play a pivotal role in the branding and marketing strategies of companies, contributing to the definition of the image, and reputation of the company's products in the eyes of consumers. The image and reputation of a company create trust which is the basis for establishing a loyal clientele and enhancing a company's goodwill. Consumers often develop an emotional attachment to certain trademarks, based on a set of desired qualities or features embodied in the products bearing such trademarks.

Trademarks also provide an incentive for companies to invest in maintaining or improving the quality of their products in order to ensure that products bearing their trademark have a positive reputation.

The Value of Trademarks

A carefully selected and maintained trademark is a valuable business asset for most companies. For some, it may be the most valuable asset they own. Estimates of the value of some of the world's most famous trademarks such as Coca-Cola or IBM exceed 50 billion dollars each. This is because consumers value trademarks, their reputation, their image and a set of desired qualities they associate with the mark, and are willing to pay more for a product bearing a trademark that they recognize and which meets their expectations. Therefore, the very ownership of a trademark with a good image and reputation provides a company with a competitive edge.

Trademarks

Example



[Courtesy: Nestle Pakistan Limited]

The value of Nescafé brand is estimated at 13 billion dollars in 2007.

In Pakistan the recognition of brands is growing with the passage of time and various brands have gained immense value.

Why should your company protect its trademark(s)?

While most businesses realize the importance of using trademarks to differentiate their products from those of their competitors, not all realize the importance of protecting them through registration.

Registration gives your company the exclusive right to prevent others from marketing identical or similar products under the same or a confusingly similar mark.

Without trademark registration, your investments in marketing a product may become wasteful as rival companies may use the same or a confusingly similar trademark for identical or similar products. Just think for a moment, if a competitor adopts a trademark similar or identical to your trademark, your customers could be misled into buying the competitor's product thinking it is your company's product. This could not only decrease your company's profits and confuse your customers, but may also damage the reputation and image of

your company, particularly if the rival product is of inferior quality. Given the value of trademarks and the importance that a trademark may have in determining the success of a product in the marketplace, it is critical to make sure that it is registered in the relevant market(s).

In addition, you may also grant license of a registered trademark to other companies, thus creating an additional source of revenue for your company. You may also use your trademark for the purpose of a franchising agreement. On occasion, a registered trademark with a good reputation among consumers may also be used to obtain funding from financial institutions that are increasingly aware of the importance of brands for business success.

Trademarks:

- ensure that consumers can distinguish between products;
- enable companies to differentiate their products;
- are a marketing tool and the basis for building a brand image and reputation;
- may be licensed to provide a direct source of revenue through royalties;
- are a crucial component of franchising agreements;
- may be a valuable business asset;
- encourage companies to invest in maintaining or improving product quality;
- may be useful for obtaining financing.

Protecting Trademarks

2|Protecting Trademarks

How can your company protect its trademark(s)?

In Pakistan protection is available for both the registered and unregistered marks. The registered marks are given protection under the Trade Marks Ordinance, 2001, whereas the unregistered marks can seek protection under the common law of "Passing Off". The law of "Passing Off" prohibits a business from presenting its products as if they belong to some other business. A registration certificate is a proof of your entitlement to exclusive use of the mark. However, in order to seek protection for an unregistered mark certain facts are required to be proved. The first and foremost fact which must be proved is that the mark has acquired distinctiveness through extensive use.

Hiring the services of a trademarks agent although is recommendable yet is not compulsory for registration of a trademark in Pakistan.

Applications for registration of trademarks in Pakistan can be filed personally or through post. The Trade Marks Registry of Pakistan is currently being computerized. The application forms are available on its website www.ipo.gov.pk; however, online filing is not yet available.

Unlike some countries, the Trade Marks Registry of Pakistan maintains a single trademark register for entering the particulars of registered trademarks and it does not have part A and part B with different categories of rights.

Can you Register Defensive Marks?

Registration of defensive trademarks is not provided in the Trade Marks Ordinance, 2001. You can only register your marks for goods on which you actually use your trademark or intend to use the same in future within five years from the date of its registration.

Is the registration of the trade name of your company sufficient?

Many people believe that by registering their business and its trade name with the Securities and Exchange Commission of Pakistan or the Registrar of Firms, this name would also be automatically protected as a trademark. This is a rather common misconception. It is important to understand the difference between trade names and trademarks.

A trade name is the full name of your business, such as: "Pak Elektron Limited" and it identifies your company or firm. It means the name and style under which any business is carried on whether in partnership or otherwise as a limited company. It often ends with the words "Limited" or other title that shows the legal character of the company or firm.

A trademark, however, is the sign that distinguishes the product(s) of your company. A company may have various trademarks. For instance, Pak Elektron Limited sells its products under the trademark "PEL".

Protecting Trademarks

Companies or firms may use a specific trademark to identify all their products, a particular range of products or one specific type of product. Some companies may also use their trade name, or a part of it, as a trademark. They should, in that case, register it as a trademark, as for instance ChenOne Stores Ltd. has registered part of its trade name "ChenOne" as a trademark.



The trade names applications are not filed with the Trade Marks Registry. Application for registration of trade name of a company are filed with the Securities & Exchange Commission of Pakistan (SECP) www.secp.gov.pk

Application for registration of trade name of a partnership firm may be filed with the Registrar of Firms in your concerned district.

Who is authorized to apply for trademark registration?

In general, any person who intends to use a trademark or to have it used by third parties can apply for registration. It can be either an individual or a legal entity i.e. a company or a firm.

Is it compulsory to register a company's trademarks?

While it is not compulsory, it is highly advisable, as registration provides the exclusive right to prevent unauthorized use of the trademark. In addition, a registered trademark is also useful when you file

proceedings in a court of law to prevent others from using your trademark or a mark similar to your trademark. Further, the owner of a registered trademark may also claim damages in a court of law.

What are the main reasons for rejecting an application?

While selecting a trademark it is helpful to know which categories of signs are usually not acceptable for registration. Applications for trademark registration are usually rejected by the Trade Marks Registry on what are commonly referred to as 'absolute grounds' in the following cases:

1. Generic terms. These are the actual names of the products in question. For example, if your company intends to register the trademark COMPUTER to sell computers, the mark would be rejected since 'computer' is the generic term for the product.

2. Descriptive terms. These are words that are usually used in trade to describe the product in question. For example, the mark SWEET is likely to be rejected for marketing chocolates as being descriptive. In fact, it would be considered unfair to give any single chocolate manufacturer exclusivity over the word 'sweet' for marketing its products. Similarly, qualitative or laudatory terms such as RAPID, BEST, CLASSIC or INNOVATIVE are likely to give rise to similar objections unless they are part of an otherwise distinctive mark. In such cases, it may be necessary to include a disclaimer clarifying that no exclusivity is sought for that particular part of the mark.

3. Deceptive trademarks. These are

Protecting Trademarks

trademarks that are likely to deceive or mislead consumers as to the nature, quality or geographical origin of the product. For example, marketing margarine under a trademark featuring a COW would probably be rejected, as it would be considered misleading for consumers, who are likely to associate the mark with dairy products (i.e. butter).

4. Marks considered to be contrary to public order or morality. Words and illustrations that are considered to violate commonly-accepted norms of morality and religion are generally not allowed to be registered as trademarks in Pakistan.

5. Flags, armorial bearings, official hallmarks and emblems of states member of Paris Convention for the Protection of Industrial Property (hereinafter "Paris Convention") and international organizations protected under Paris Convention are excluded from registration. For example, the Pakistani Flag may not be registered for marketing a product without authorization from the Government.

6. Shape of Product. The trademarks that consist exclusively of the shape which results from the nature of the goods themselves or the shape of goods which is necessary to obtain a technical result or the shape which gives substantial value to the goods cannot be registered. For instance if a particular shape of the shaving razor is required to accommodate 6 blades then such a shape will not be registered as a trademark.

Relative Grounds

Applications are also rejected on 'relative grounds' in following cases:

- When the trademark conflicts with prior trademark rights.
- Having two identical (or very similar) trademarks for the same type of product could cause confusion among consumers. For example the trademark 'Workmen' would not be accepted for registration as a mark for furniture sale due to the existence of the mark "Workman" for the same products.

The Trademark Registry checks for conflict with existing marks, including unregistered pending marks, as a regular part of the registration process. If the trademark is considered to be identical or confusingly similar to an existing one for identical or similar products, it will be rejected.

What should be kept in mind when selecting or creating a trademark? Selecting or creating an appropriate trademark is a critical step, as it is an important element of the marketing strategy of your business. So what is an appropriate trademark for your product(s) or services? Evidently, there are no hard and fast rules. But the following five-point checklist may be useful.

Five Point Checklist for Selecting Your Trademark

- Check that your trademark of choice meets all the legal requirements for registration (see reasons for rejecting applications on page 7 & 8). Do a trademark search to make sure that it is not identical or confusingly similar to existing trademarks (see page 12).

Protecting Trademarks

- Make sure the trademark is easy to read, write, spell and remember and is suitable to all types of advertising media.
- Make sure the mark does not have any undesired connotations in your own language or in any of the languages of potential export markets.
- Check that the corresponding domain name (i.e. Internet address) is available for registration (for more on the relationship between trademarks and domain names see page 19).

While selecting one or more words as your trademark you should also take into consideration the implications of selecting certain types of words:

- Coined or "fanciful" words. These are invented words without any intrinsic or real meaning. Coined words have the advantage of being easy to protect, as they are more likely to be considered inherently distinctive. On the negative side, however, they may be more difficult to remember for consumers, requiring greater effort to advertise the products.

Example:

The trademark "PEL" is a registered trademark that is pronounceable but does not have any real meaning.



[Courtesy: Pak Elektron Ltd.]

- Arbitrary marks: These are words that have a meaning that has no relation to the product they advertise. While these types of marks will also be easy to protect, they may

also require heavy advertising to create the association between the mark and the Product in the minds of consumers
Example: The trademark ELEPHANT for marketing mobile phones.

- Suggestive marks: These are marks that hint at one or some of the attributes of the product. The appeal of suggestive marks is that they act as a form of advertising. A slight risk, however, is that in some cases Registry may consider a suggestive mark to be too descriptive of the product.

Example:

The trademark "Business Plus" for a news channel hints at the fact that the channel keeps you informed of business activities.



However, since the reference is indirect, therefore the mark has been registered. However, if the reference is direct then the same will become a descriptive mark and may not be registered.

Irrespective of the type of mark you choose, it is important to avoid imitating existing trademarks. A slightly altered competitor's trademark or a misspelt well-known or famous mark is unlikely to be registered.

Example: "WORKMAN" is a registered trademark for furniture and wooden products. It would be unwise to try to sell the same or similar products using the trademark VORKMAN, WERKMAN or WURKMANN etc., as they would probably be considered confusingly similar to the existing mark and are unlikely to be registered.

Protecting Trademarks

REGISTERING A TRADEMARK — STEP BY STEP

The Applicant

As a first step, you have to send or hand in a duly completed trademark application (2 in original & 6 photocopies) on prescribed form TM-1 (Annex III), which includes the contact details of your company, a graphic illustration of its mark, a description of the goods or services and class for which your business wishes to obtain trademark registration, and pay the required fees in form of bank draft or pay order in favour of DG, IPO Pakistan. The applicant may request for search of the trademark that he/she intends to register by submitting TM-55 form (Annex IV) to the Trade Marks Registry, along with fee.

Note that some trademark offices (e.g. US and Canada) may also require proof of use or a declaration that your company intends to use the trademark. In Pakistan no such declaration is required at the time of filing and a trademark can be filed on the basis of its proposed use in future. However, such trademark is required to be used within five years from the date of registration.

The Trademark Registry: The steps taken by the Trademark Registry for registration of a trade mark in Pakistan are as described below:

Formal examination: At the time of filing application and before issuance of any application number the trademark office examines the application to make sure that it complies with the administrative requirements or formalities (i.e., whether the application fee has been paid and the application form is properly filled in).

Application number: The application number is given at the time of filing of application; however, official receipt is usually given within three to four weeks after filing.

Substantive examination: The trademark office examines the application to verify whether it complies with all the substantive requirements (e.g., whether it belongs to a category which is excluded from registration by the trademark law and whether the trademark is in conflict with an existing mark on the register in the relevant class). If there are some objections then an examination report (commonly known as "Show Cause Notice") is sent to the applicant. Reply: The applicant files reply to the objections raised in the examination report.

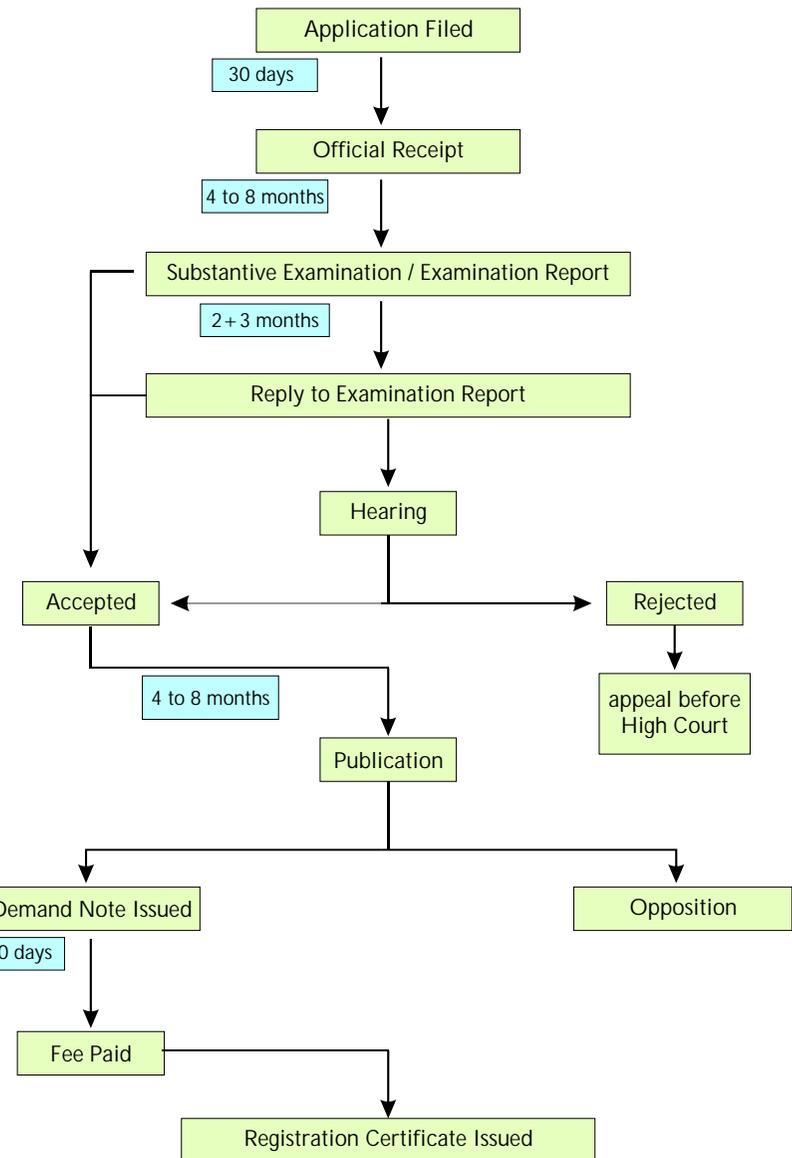
Hearing: In most of the cases, the applicant files a response to the examination report and a hearing is appointed and the Registrar hears the arguments of the applicant or his agent in support of the stance taken in the reply.

Publication and opposition: After hearing if the Registrar is convinced then trademark is accepted for publication in official Trade Marks Journal with a two month's period of time (further extensions, not exceeding two months, may be obtained) for third parties to oppose its registration.

Registration: If there is no opposition or once it has been decided that there are no grounds for refusal, the trademark is registered, and a registration certificate is issued which is valid for 10 years.

Renewal: the mark may be renewed after every ten years, for indefinite term, on payment of required renewal fees, but the registration may be canceled entirely for certain goods or services if the trademark has not been used for a continuous period of five years.

Protecting Trademarks



* The boxes in blue indicate the likely time frame.

* The boxes in green indicate the different stages of application.

Protecting Trademarks

How long does it take to register a trademark?

As the Trade Marks Registry conducts substantive examination, therefore it takes longer to get a trademark registered in Pakistan as compared to some other countries. The registration process used to take three to four years for its completion. However, with ongoing computerization of the Registry, the process has been expedited and now it is completed positively within two years and is likely to get more expedient over time. Application for renewal of a trademark can be filed within six months before the date of expiry. After expiry of a trade mark, the same can be renewed within six months after paying late fee.

What are the costs associated with trademark protection?

It is important to keep in mind, and properly budget, the costs related to trademark creation and registration in Pakistan. These costs may include the following:

1. Costs associated with the creation of a logo or word to be used as a trademark, as many companies outsource this task.
2. Cost for conducting a trademark search i.e. Rupees 500.
3. The other official costs associated with the registration process are as under:

Details	Official Fees
Filing application	1000 Rupees
Publication fee	There is no official fee, but printing blocks have to be provided by the applicant for its mark.
Registration fee	3000 Rupees

4. Companies choosing to use a professional trademark agent to assist in the registration process would face additional costs but would probably save significant time and energy in following the registration process.
5. If you intend to register your trademark in a foreign country you may have to incur additional costs.

The above cost estimates are for registration of one trademark in one class. It may rise if you intend to register your trademark in more than one class.

How can you find out if your chosen trademark might conflict with other registered trademarks? What is a trademark search?

Before submitting an application for registering a trademark, you should ensure that a proper trademark search has been carried out. This is done to make sure that the trademark you intend to use, or a similar one, is not already registered by another company for identical or similar products.

You can either make a trademark search yourself or hire the services of a trademark agent. Either of you can do the search through the Trademark Registry. There is a search section in the Registry and an examiner of trademarks is head of this Section. Always bear in mind that a trademark search is only preliminary. It may be difficult to make sure that your trademark of choice is not "confusingly similar" to existing validly-registered trademarks. This is why the guidance of an experienced trademark agent, who is familiar with the practice of the trademark office and court decisions, may be very helpful.

Protecting Trademarks

Trademarks are grouped into 'classes' according to the goods or services they serve to identify (see the classification of goods and services in Annex II). However, please bear in mind that in Pakistan currently classes 01 to 42 are available and classes 43 to 45 are not yet available (proposed to be included). Appropriate amendments in the Trademark Ordinance, 2001 are however, being considered by the Government of Pakistan. Once these amendments are made Trade Marks Registry will start entertaining applications falling in classes 43 to 45 as well.

A WELL— CLASSIFIED SYSTEM

While filling in your trademark application form you are required to indicate the goods or services for which you wish to register your trademark and to group them according to classes. These refer to the classes in the trademark classification system.

The trademark classification system allows for the storage of data on registered trademarks in an orderly manner in relation to the types of goods or services. This makes it easier to retrieve information from trademark databases. It is critical to register your trademark in all classes in which you intend to use your trademark.

Example:

How are products classified? Let us take an example. If your company is producing knives and forks, then your trademark application should be made for the corresponding goods in class 8. If, however, you wish to market other kitchen utensils (such as containers, pans or pots) using the same trademark you will also have to register the mark for the corresponding goods in class 21 and you would have to make a separate application for each class of product since multiple class applications are not acceptable under the Trade Marks Ordinance, 2001.



Protecting Trademarks

Do you need a trademark agent to file a trademark application?

Pakistani law does not require you to hire a trademark agent to file an application; you may file the application yourself. However, the services of a trademark agent skilled in conducting trademark searches and familiar with the detailed procedure for trademark registration may be used to save time, ensure that you apply for protection in the appropriate trademark class(es) and avoid refusal on absolute grounds. If you apply for trademark registration abroad you may be required to have a trademark agent who is resident in the relevant country. You may find list of IP attorneys on the following websites:

www.smeda.org.pk
www.ip.gov.pk

Outsourcing Trademark Creation

Designing a trademark is a creative process. In Pakistan, a creator automatically owns the copyright over creative or artistic works, such as the artwork of a trademark. Therefore, when the creation of a trademark is outsourced, it is usually best to clarify issues of copyright ownership in the original agreement and/or to make sure the copyright over the trademark is formally assigned to your company.

For how long is your registered trademark protected?

While the term of protection may vary in different countries, in Pakistan registered trademarks are protected for 10 years. However, on payment of prescribed renewal fee trademark registration may be renewed after every ten years as long as you are interested in protection of your

trademark. Make sure that someone in your company or firm is made responsible for ensuring timely renewal of trademark registrations in all countries of continuing interest to your business.

Is trademark registration in Pakistan valid internationally?

The legal rights arising out of a trademark registration are normally limited to the territory to which they pertain; so, ordinarily, valid registration of a trademark in Pakistan gives you rights only within Pakistan unless your mark is considered to be a well-known mark. (For information on well-known marks see page 17).

Should you consider protecting your trademark abroad?

All the main reasons for registering your trademark in Pakistan also apply to the commercialization of your products in foreign markets. It is, therefore, highly advisable to register your trademark abroad if you wish to grant a license to use in other countries. Exporting goods bearing a distinctive trademark will enable your products to be recognized in foreign markets, allowing your company to build a reputation and image among foreign consumers, which may result in higher profits.

How can you register the trademark of your company abroad?

Once you have registered the trademark in Pakistan, you may want to register it in one or more other countries as well if you wish to export your product or grant a license to another company to use your trademark in another country. Typically there are three main ways to register the trademark in other countries:

Protecting Trademarks

1. The National Route: your business may apply to the trademark office of each country in which it is seeking protection by filing the corresponding application in the required language and paying the required fees.

As indicated earlier, a country may require you to use the services of a locally-based trademark agent for this purpose.

2. The Regional Route: if you wish to apply for protection in countries which are members of a regional trademark system you may apply for registration, with effect in the territories of all Member countries, by filing an application at the relevant regional office. The regional trademark offices are:

- The African Regional Industrial Property Office
- The Benelux Trademark Office
- The Office for the Harmonization of the Internal Market of the European Union
- The Organisation Africaine de la Propriété Intellectuelle.

3. The International Route: Madrid system (administered by WIPO) is used to register a trademark in more than 70 countries that are party to the system. Pakistan is not yet a member of Madrid Protocol but is expected to become a member in near future and is currently in process of upgrading its trademark Registry to enable it to fully implement the system.

Advantages of using the Madrid system

The principal advantages of using the Madrid system are that the trademark owner can register his trademark in all the countries party to the system by filing:

- a single international application;
- in one language;
- subject to one set of fees and deadlines.

Thereafter, the international registration can be maintained and renewed through a single procedure.

You can find more information on international registration of marks on the WIPO website: www.wipo.int/madrid/. A list of the Member countries of the Madrid Union is available in Annex V.

Types of Trademark

3 Types of Trademark

Trade marks	Marks used to distinguish certain goods or services as those produced or provided by a specific enterprise.
Collective marks	Marks used to distinguish goods or services produced or provided by members of an association.
Certification marks	Marks used to distinguish goods or services that comply with a set of standards and have been certified by a certifying authority.
Well-known marks	Marks that are considered to be well-known in the market and as a result benefit from stronger protection.

What are service marks?

A service mark is a common name given to trademarks registered to distinguish the services of an enterprise from those of others. Pakistani law does not recognize "service mark" as a term independent from a trademark. Services may be of any kind, such as financial, banking, travel, advertising or catering, to name a few.

Example:



[Courtesy: Media Times Ltd]

What are collective marks?

As per the Trademark Ordinance 2001, a collective mark is a mark distinguishing the goods or services of members of an association, which is the proprietor of the mark, from those of other businesses. A collective mark is generally owned by an

association whose members may use a collective mark to market their products under a common trade mark.

An application for registration of a collective mark may be filed with the Registrar along with regulations governing the use of the mark. These regulations will specify the persons authorized to use the mark, the conditions of membership of the association and, where they exist, the conditions of the use of the mark, including any sanctions against misuse. Collective marks may be an effective way of jointly marketing the products of a group of enterprises which may find it more difficult for their individual marks to be recognized by consumers and/or handled by the main distributors.

Example: In Pakistan the Basmati Growers Association has filed an application for registration of mark "Basmati" as a collective mark. This application is not yet registered.

Types of Trademark

What are certification marks?

As per the Trademark Ordinance 2001, a certification mark is a mark indicating that the goods or services in connection with which it is used are certified by the owner of the mark in respect of origin, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics.



[Courtesy: The Woolmark Company]

Certification marks are given for compliance with defined standards, but are not confined to any membership. They may be used by anyone whose products meet certain established standards. In many countries, the main difference between a collective mark and a certification mark is that the former may only be used by a specific group of enterprises, e.g., members of an association, while a certification mark may be used by anybody who complies with the standards defined by the owner of the certification mark.

An important requirement for a certification mark is that the entity which applies for registration is considered "competent to certify" the products concerned.

Example: The Woolmark symbol is the registered trade (certification) mark of the Woolmark Company. The Woolmark is a quality assurance symbol denoting that the products on which it is applied, are made from 100% new wool and comply with strict performance specifications set down by the Woolmark Company. It is registered in over 140 countries including Pakistan, and is licensed to manufacturers who are able to meet these quality standards in 65 countries.

What are well-known marks?

Well-known marks are marks that are considered to be well-known in Pakistan and belong to an entity based in a country, other than Pakistan, which is a member of the Paris Convention. Well-known marks generally benefit from stronger protection. For example, well-known marks may be protected even if they are not registered (or have not even been used) in a given territory. In addition, while marks are generally protected against confusingly similar marks only if used for identical or similar products, well-known marks are protected against confusingly similar marks for even dissimilar products, if certain conditions are met. The main purpose of this stronger protection is to prevent companies from free-riding on the reputation of a well-known mark and/or causing damage to its reputation or goodwill.

Example: Let us assume that WONDERCOLA is the famous trademark of a soft drink. Wondercola Inc. would then benefit from automatic protection in those countries where well-known marks enjoy stronger protection and where the mark is well-known for soft drinks. The protection would also be available for unrelated goods and services. That is to say that if another company decides to market other products, ranging from T-shirts to sunglasses, using the WONDERCOLA mark, it will have to seek the authorization of Wondercola Inc. or risk being sued for infringement of trademark rights.

Using Your Trademark

4|Using Your Trademark

Can you register a trademark without having used it?

You may apply for registration before you have used the trademark but if the trademark is not used for five years following registration the same may be taken off the trademark register. This means you could lose your rights in your trademark.

TM or ®?

The use of ®, TM or equivalent symbols next to a trademark is not a requirement and generally provides no further legal protection. Nevertheless, it may be a convenient way of informing others that a given sign is a trademark, thus warning possible infringers and counterfeiters. The ® symbol is used once the trademark has been registered, whereas TM denotes that a given sign is a trademark. Using the ® symbol for an unregistered mark is an offence under Pakistani law punishable with imprisonment for a term which shall not be less than one month but which may extend to six months, or with fine which shall not be less than twenty thousand rupees, or with both.



[Courtesy: Compmughal Engineering Company]

How should you use trademarks in advertising?

If your mark is registered with a specific design or font, make sure that the trademark

is used exactly as it is registered. Monitor its use closely as it is crucial for the image of your company's products. It is also important to avoid using the trademark as a verb or noun so that it does not come to be perceived by consumers as a generic term.

Can your company use the same trademark for different products?

Different trademarks may be used for the different products lines of a company. Depending on its branding strategy, each company will decide whether to use the same trademark for its products, extending the brand every time a new product is released, or to use a different mark for each product line.

Extending an existing brand to new products enables the new product to benefit from the image and reputation of the mark. However, the use of a new mark, more specific and relevant to the new product, may also prove advantageous and enable the company to target the new product to a specific customer group (e.g. children, teenagers, etc.) or to create a specific image for the new product line.



[Courtesy: Nestle Pakistan Ltd]

Using Your Trademark

Many companies also choose to use a new brand in conjunction with an existing brand. Different companies adopt different strategies. Whatever your choice, you should make sure that your trademark is registered for all categories of goods and/or services for which it is, or will be, used.



What should be kept in mind when using trademarks on the Internet?

The use of trademarks on the Internet has raised a number of controversial legal problems with no easy or uniform solution. One important problem arises from the fact that trademark rights are territorial (that is, they are only protected in the country or region where the mark has been registered or used), whereas the reach of the Internet is global. This creates problems when it comes to settling disputes between persons or companies legitimately owning identical or confusingly similar trademarks for identical or similar goods or services in different countries. Legislation in this area is still developing and treatment may differ from one country to another.

What is a domain name and how does it relate to trademarks?

An important problem concerns the conflict between trademarks and domain names. Domain names are Internet addresses, and are commonly used to find websites. For example, the domain name 'wipo.int' is used to locate the WIPO website at www.wipo.int.

Over time, domain names have come to constitute business identifiers thus often coming into conflict with trademarks. Often national laws, or courts, treat the registration of the trademark of another company or

person as a domain name as trademark infringement, popularly known as cybersquatting. If this happens, then, your business may not only have to transfer or cancel the domain name, but it may also have to pay damages or a heavy fine. Therefore, it is important that you choose a domain name which is not the trademark of another company, particularly a well-known trademark. In order to find out whether a particular trademark is already protected, you can directly contact the Trademark Registry. Many other regional or national trademark offices operate Internet searchable trademark databases. A list of such databases is available on WIPO's website at:

www.arbiter.wipo.int/trademark/.

On the other hand, if the trademark of your company is being used in a domain name or is being cybersquatted by another individual or company then you may take action to stop such misuse/infringement of the rights of your company. In such a case, one option would be to use WIPO's very popular online administrative procedure for domain name dispute resolution at: www.arbiter.wipo.int/domains/. This WIPO website includes a model complaint as well as a legal index to the thousands of WIPO domain name cases that have already been decided.

Using Your Trademark

Can you license your trademark to other companies?

Trademarks can be licensed to other companies. In such cases, the trademark owner retains ownership and merely agrees to the use of the trademark by one or more other companies. This is usually done on payment of royalties and involves the consent of the trademark owner, which is usually specified in a formal licensing agreement. Depending on the nature of the agreement, the licensor often retains some degree of control over the licensee to guarantee that a certain quality is maintained.

In practice, trademark licenses are frequently granted within broader licensing agreements, for example, franchising agreements or agreements including the licensing of other intellectual property rights such as patents, know-how and some degree of technical assistance for the production of a given product. Please note that a grant of license must be registered with the Trade Marks Registry otherwise some restrictions on the use of license are imposed by the law.

What does a franchising agreement have to do with trademarks?

The licensing of a trademark is central to a franchising agreement. In franchising agreements the degree of control of the trademark owner over the franchisee is generally greater than is the case for standard trademark licensing agreements. In the case of franchising, the franchiser allows another person (the franchisee) to use his way of doing business (including trademarks, know-how, customer service, software, shop decoration etc.) in accordance with a set of prescriptions and

in exchange for compensation or royalty.

Example



A very popular beauty salon of Pakistan operating under the trademark Depilex, developed a successful model of franchising saloons. It started with Depilex Institute and Beauty Salon business in Karachi. During 1990s, till 1998 there were 3 branches in Karachi and Lahore. But today in just 10 years, the business network has grown to more than 30 franchises in Pakistan. The system includes proper training manuals for franchisees on all aspects of running/managing the Depilex Saloon, standardization of products used, quality of services, staff/worker uniforms, corporate colour etc. Depilex imparts its knowledge to its franchisees and retains the right to supervise the franchisees. As a crucial component of franchising Agreement the franchisees are also authorized and obliged to use the "Depilex" trademark. Depilex has now taken trademark protection in UAE, USA, and UK and own Salons in Dubai, London and New York.

Is there any restriction in selling or assigning the trademark of your company to another company?

It is increasingly possible to sell or assign a trademark independently from the business that currently owns it. In the case of sale or assignment of a trademark, it is required to deposit a copy of the agreement, or parts of it, at the Trademark Registry.

Using Your Trademark

Do you need to register all small modifications to your trademark?

Many trademarks, including some of the most famous, have slightly changed or evolved over the years in order to modernize the image of a company or adapt to new advertising media. Marks may be changed or adapted, but your company will have to be careful and consult with the trademark office(s) concerned or a competent trademark agent as to whether a specific change will require the submission of a new application and payment of relevant fees.

Example



5 | Enforcing your Trademark

What should your business do if its trademark is being used by others without authorization?

It is up to your company as a trademark owner to identify any infringement and to decide what measures should be taken to enforce trademark rights.

It is always useful to seek expert advice if you believe that someone is infringing your trademark. An intellectual property lawyer would be the right person to give you information on the existing options in Pakistan and, presumably, also in neighboring countries to initiate action against counterfeiting and infringement and will provide you with advice on how to enforce your rights.

If you are faced with infringement of your trademark rights, then you may choose to begin by sending a letter preferably through your lawyer (commonly known as a 'Legal Notice') to the alleged infringer informing him/her of the possible existence of a conflict.

If the infringement does not stop after your letter or legal notice, then you may consider taking one or more of the following steps:

1. You may seek injunctive/restraining order from the court by filing an action under section 46 of the Trade Marks Ordinance, 2001 and courts generally issue an order restraining the infringer from using the infringing mark till the decision of the case. As an effective deterrent to

infringement, the judicial authorities may under sections 47 to 51 of Trade Marks Ordinance, 2001 order, upon your request, the offending trade mark to be erased, removed or obliterated from any infringing goods, material or articles; or secure the destruction of the infringing goods, material or articles, if it is not reasonably practicable for the offending trade mark to be erased, removed or obliterated. The penalties for applying false trade description, etc. under Section 99 of the Trade Marks Ordinance, 2001 are punishable with imprisonment for a term which shall not be less than three months but which may extend to two years, or with fine which shall not be less than fifty thousand rupees, or with both;

2. If your business considers the infringement to be willful and knows the location of the infringing activity, then it may wish to take surprise action by lodging, preferably with the help of a trademark lawyer, a complaint under sections 482, 484, 485, 486 or 487 of Pakistan Penal Code, 1860, with the police who may conduct a raid without prior notice to the allegedly offending company/person;

3. In order to prevent the importation of counterfeit trademark goods, measures at the international border are available to trademark owners. As a trademark owner, your company may seek the assistance of the customs authorities at the border in accordance with section 53 of the Trade Marks Ordinance, 2001, that is, before the counterfeit goods have been distributed in

Pakistan. The assistance of customs would require a security or equivalent assurance sufficient to protect the importer, consignee or owner of the goods and an undertaking to indemnify the customs authorities.

In some instances, an effective way of dealing with infringement is through arbitration or mediation. Arbitration generally has the advantage of being a less formal, shorter and cheaper procedure than court proceedings, and an arbitral award is more easily enforceable. In Pakistan arbitration matters are governed by Arbitration Act, 1940.

An advantage of mediation is that the parties retain control of the dispute resolution process. As such, it can help to preserve good business relations with another enterprise with which your company may like to collaborate in the future.

For more information on arbitration and mediation, you can also see the website of the WIPO Arbitration and Mediation Center at www.arbitrator.wipo.int.

The above actions can be taken by the registered proprietor or by a person holding a valid license or assignment deed from the registered proprietor, duly registered with Trade Marks Registry.



Annex I

1. Intellectual Property Organization of Pakistan (IPO Pakistan) IPO Pakistan Headquarter:
House No. 23, Street 87, Ataturk Avenue (West), Sector G-6/3, Islamabad
Tel: +92-51-9208146 Fax: +92-51-9208157
Website: www.ipo.gov.pk Email: info@ipo.gov.pk

IPO-Pakistan's Trade Marks Registry provides following services to its clients with special focus on SMEs:

- Advice on Trade Marks filing (detailed procedure of filing of applications for grant of Trade Marks, different application forms for the purpose, Trade Marks Journal, Classification for Goods and Services etc. may be downloaded by visiting IPO website at www.ipo.gov.pk);
- Processing of Trade Marks registrations;
- Hearings of the applications;
- Organising seminars through out the country for providing information regarding the registration of Trade Marks to the members of the Chambers that mostly comprises small and medium enterprises;
- Online application filing and tracking;
- Online search of trade mark database.

IPO Pakistan Regional Office
3rd Floor, Farid Tower,
19 Temple Road, Lahore.
Tel: +92-42-7224395
Fax: +92-42-7224396
Email: lahore@ipo.gov.pk

Trademarks Registry
Registrar Trade Marks Registry
Plot No. CD-3, Behind KDA Civic Centre,
Gulshan-e-Iqbal Block- 14, Karachi.
Tel: +92-21-9230538
Fax: +92-21-9231001
Email: tmr@ipo.gov.pk

Patent Office
Controller of Patents & Designs
2nd Floor Kandawala Building,
M. A. Jinnah Road, Karachi.
Tel: +92-21-9215488
Fax: +92-21-9215489
Email: patent@ipo.gov.pk

Copyright Office
Registrar Central Copyright Office
Ground Floor, Liaqat Memorial Library
Building, National Stadium Road, Karachi.
Tel: +92-21-9230140
Fax: +92-21-9230140
Email: copyright@ipo.gov.pk

2. Small and Medium Enterprises Development Authority (SMEDA)
SMEDA Head Office:
6th Floor, L.D.A Plaza, Egerton Road, Lahore-54792
Tel: 111-111-456
Fax: (042) 6304926
Website: www.smeda.org.pk

In order to encourage and urge small businesses to effectively use IP system for their business success, SMEDA is providing following services to SMEs:

- a) IP Helpline:
SMEDA 'IP Helpline' assist SMEs on all forms of IPs including trademarks, patent, copyrights and industrial designs. SMEs may contact our regional legal services officer for solving their queries on IP matters.
- b) Training Programs:
Keeping in view the information needs of SMEs, SMEDA conducts on regular basis IP awareness programs across Pakistan in collaboration with local chambers of commerce and industry, IPO Pakistan and Trade Associations. Likewise, IP awareness programs are planned especially for small trade bodies in different regions for wider outreach.

REGIONAL OFFICES

PUNJAB
8th Floor, L.D.A Plaza, Egerton Road
Lahore-54792
Tel: 111-111-456
Fax: (042) 6304926
Email: helpdesk@smeda.org.pk

SINDH
5th Floor, Bahria Complex 2,
M.T.Khan Road,
Karachi
Tel: (021) 111-111-456
Fax: (021) 5610572
Email: helpdesk-khi@smeda.org.pk

NWFP
Ground floor, State Life Building
The Mall, Peshawar
Tel: (091) 9213046-47
Fax: (091) 286908
Email: helpdesk-pew@smeda.org.pk

BALUCHISTAN
Bungalow No. 15-A
Chaman Housing Scheme
Airport Road, Quetta.
Tel: (081) 2831702/2831623
Fax: (081) 2831922
Email: helpdesk-qta@smeda.org.pk

Annex II

CLASSIFICATION OF GOODS AND SERVICES

Names of the Classes

(Parts of an article or apparatus are, in general, classified with the actual article or apparatus, except where such parts constitute articles included in other classes).

1. Chemicals used in industry, science and photography, as well as agriculture, horticulture, forestry; manures (natural and artificial); fire extinguishing compositions, tempering substances and chemicals preparations for soldering, chemical substances for preserving foodstuff, tanning substances, adhesives used in industry, unprocessed artificial resins; unprocessed plastics.
2. Paints, varnishes, lacquers, preservatives against rust and against deterioration of wood, coloring matters, dyestuffs; mordents; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.
3. Bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices.
4. Industrial oils and greases (other than edible oils and fats and essential oils); lubricants, dust absorbing wetting and binding compositions; fuels (including motor spirit) and illuminants, candles, tapers, nightlights and wicks.
5. Pharmaceutical, veterinary and sanitary substances; infants' and invalids' foods; dietetic substances adapted for medical use; plasters, materials for bandaging; material for stopping teeth, dental wax, disinfectants, preparations for killing weeds and destroying vermin; fungicides, herbicides.
6. Common metals and their alloys, anchors, anvils, bells, rolled and metal building materials, transportable building of metals; materials of metal for railway tracks, chains (except driving chains for vehicles); non-electric cables and wires of common metal; locksmith's work; metallic pipes and tubes; safes and cash boxes; steel balls; horseshoes; nails and screws; ironmongery; small items of metal hardware; other goods in non-precious metal not included in other classes; ores.
7. Machines and machine tools, motors and engines (except for vehicles), machine coupling and transmission components (except for land vehicles) agricultural implements, incubators for eggs.
8. Hand tools and implements (hand-operated); cutlery, forks and spoons; side arms; razors.
9. Scientific, nautical, surveying and electrical apparatus and instruments (including wireless), photographic, cinematographic, optical, weighing, measuring, signaling, checking (supervision), life-saving and teaching apparatus and instruments, coin or counter-freed apparatus; talking machines; cash registers, calculating machines, apparatus for recording, transmission reproduction of sound or images, magnetic data carriers, recording discs, automatic vending machines and mechanisms for coin apparatus, data processing equipment and computers; fire extinguishing apparatus.
10. Surgical, medical, dental and veterinary instruments and apparatus, artificial limbs, eyes and teeth, orthopedic articles; suture materials.
11. Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.
12. Vehicles, apparatus for locomotion by land, air or water.
13. Firearms, ammunition and projectiles, explosives; fireworks.
14. Precious metals and their alloys and goods in precious metals or coated therewith (except cutlery,

- forks and spoons), jewellery, precious stones, horological and other chronometric instruments.
15. Musical Instruments (other than talking machines and wireless apparatus).
 16. Paper and paper articles, cardboard and cardboard articles; printed matter, newspapers and periodicals, books; book-binding materials, photographs, stationery, adhesives materials (stationery), artists' materials, paint brushes, typewriters and office requisites (other than furniture), instructional and teaching material (other than apparatus), playing cards; (printers') type and cliches (stereotype); plastic materials, for packaging (not included in other classes).
 17. Gutta percha, rubber, balata and substitutes, articles made from these substances and not included in other classes, materials for packing, stopping or insulating, asbestos, mica and their products; hose pipes (non-metallic); plastics in extruded form for use in manufacture.
 18. Leather and imitations of leather, and articles made from these materials, and not included in other classes, animal skins, hides, trunks and travelling bags, umbrellas, parasols and walking sticks, whips, harness and saddlery.
 19. Building materials (non-metallic), natural and artificial stone, cement, lime, mortar, plaster and gravel; pipes of earthenware or cement; road-making, materials; asphalt, pitch and bitumen, portable buildings; monuments; not of metal, chimney pots; non-metallic rigid pipes for building; non-metallic; transportable buildings.
 20. Furniture, mirrors, picture frames; articles (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.
 21. household and kitchen utensils and containers (not of precious metal or coated therewith), combs and sponges, brushes (other than paint brushes), brush-making materials, articles for cleaning purposes, steelwool, glassware, porcelain and earthenware not included in other classes; unworked or semi-worked glass (except glass used in building).
 22. Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes) padding and stuffing materials (except of rubber or plastics) raw fibrous textile materials.
 23. Yarns and threads, for textile use.
 24. Textiles and textile goods, not included in other classes, bed and table covers.
 25. Clothing, footwear, headgear.
 26. Lace and embroidery, ribbons and braid, buttons, hooks and eyes, pins and needles, artificial flowers.
 27. Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors, wall hangings (non-textile).
 28. Games and playthings, gymnastic and sporting articles not included in other classes, decorations for Christmas trees.
 29. Meat, fish, poultry and game, meat extracts, preserved, dried and cooked fruits and vegetables, jellies, jams, fruit sauces, eggs, milk and milk products; edible oils and fats; pickles.
 30. Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, biscuits, cakes, pastry and confectionery, ices, honey, treacle, yeast, baking-powder, salt, mustard, pepper, vinegar, sauces, (condiments), spices; ice.
 31. Agricultural, horticultural and forestry products and grains not included in other classes, live animals, fresh fruits and vegetables, seeds, natural plants and flowers, foodstuffs for animals, malt.
 32. Beers, mineral and aerated waters and other non-alcoholic drinks, syrups and other preparations for making beverages; fruit drinks and fruit juices.
 33. Alcoholic beverages (except beers).
 34. Tobacco; smokers' articles, matches.

Annex II

SERVICES

35. Advertising, business management, business administration, office functions.
36. Insurance, financial affairs; monetary affairs; real estate affairs.
37. Building construction; repair, installation services.
38. Telecommunications.
39. Transport, packaging and storage of goods, travel arrangement.
40. Treatment of materials.
41. Education, providing of training, entertainment, sporting and cultural activities.
42. Providing of food and drink, temporary accommodation, medical, hygienic and beauty care, veterinary and agricultural services, legal services; scientific and industrial research; computer programming, services that can not be classified in other classes.

Note:

In order to conform to the Nice Classification System, following classes are being considered to be included in the list of classification of goods and services under Trademark Ordinance

43. Services for providing food and drink; temporary accommodation.
44. Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services.
45. Personal and social services rendered by others to meet the needs of individuals; security services for the protection of property and individuals.

Annex III

Annex III

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.

Annex III

INSTRUCTIONS TO FILL 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.

Annex IV

Annex IV

FORM TM-55

Fee: See entry No.54
of the First Schedule

Request for Search under Rule 87

The Registrar is hereby request under rule 88 to search in Class* _____ in respect of (a) _____ to ascertain whether any trade marks are on record which resemble the trade mark sent herewith in duplicate (each representation being mounted on a sheet of strong paper approximately 13 inches by 8 inches in size).

Dated this _____ day of _____ 20____.

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

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

*The Registrar' s direction should be obtained if the class is not known.

(a) Here specify the goods (in the class stated) in respect of which the search is to be made.

(b) Signature.

(c) Address.

Annex V

Annex V

List of the Member Countries of the Madrid Union

- | | | | |
|---|--------------------------------------|---------------------------|--|
| 1. Albania | 29. Ghana | 57. Poland | 72. Sweden |
| 2. Algeria | 30. Greece | 58. Portugal | 73. Switzerland |
| 3. Antigua and Barbuda | 31. Hungary | 59. Republic of Korea | 74. Syrian Arab Republic |
| 4. Armenia | 32. Iceland | 60. Romania | 75. Tajikistan |
| 5. Australia | 33. Iran (Islamic Republic of Iran) | 61. Russian Federation | 76. The former Yugoslav
Republic of Macedonia |
| 6. Austria | 34. Ireland | 62. San Marino | 77. Turkey |
| 7. Azerbaijan | 35. Italy | 63. Sao Tome and Principe | 78. Turkmenistan |
| 8. Bahrain | 36. Japan | 64. Serbia | 79. Ukraine |
| 9. Belarus | 37. Kazakhstan | 65. Sierra Leone | 80. United Kingdom |
| 10. Belgium | 38. Kenya | 66. Singapore | 81. United States of America |
| 11. Bhutan | 39. Kyrgyzstan | 67. Slovakia | 82. Uzbekistan |
| 12. Bosnia and Herzegovina | 40. Latvia | 68. Slovenia | 83. Viet Nam |
| 13. Botswana | 41. Lesotho | 69. Spain | 84. Zambia |
| 14. Bulgaria | 42. Liberia | 70. Sudan | |
| 15. China | 43. Liechtenstein | 71. Swaziland | |
| 16. Croatia | 44. Lithuania | | |
| 17. Cuba | 45. Luxembourg | | |
| 18. Cyprus | 46. Madagascar | | |
| 19. Czech Republic | 47. Moldova | | |
| 20. Democratic People's Republic of Korea | 48. Monaco | | |
| 21. Denmark | 49. Mongolia | | |
| 22. Egypt | 50. Montenegro | | |
| 23. Estonia | 51. Morocco | | |
| 24. European Community | 52. Mozambique | | |
| 25. Finland | 53. Namibia | | |
| 26. France | 54. Netherlands | | |
| 27. Georgia | 55. Norway | | |
| 28. Germany | 56. Oman | | |

Note:

For up-to-date information, visit website at the following url: www.wipo.int/madrid/en/members/

NOTE:

For further information on the other business-oriented content and publications on intellectual property rights please visit WIPO's SME website at www.wipo.int/sme/en/. In addition, you may also subscribe to the free electronic monthly newsletter of the SMEs Division of WIPO, available at www.wipo.int/sme/en/documents/wipo_sme_newsletter.html Recent activities on IP matters by SMEDA are available at www.smeda.org/services/Intellectual-Property-for-Bussines-Success.html

For more information contact

Small and Medium Enterprises Development Authority (SMEDA)

SMEDA Head Office:

6th Floor, L.D.A Plaza, Egerton Road, Lahore-54792

Tel: 111-111-456

Fax: (042) 6304926

Website: www.smeda.org.pk

Intellectual Property Organization of Pakistan (IPO Pakistan)

IPO Pakistan Headquarter:

House No. 23, Street 87, Ataturk Avenue (West), Sector G-6/3, Islamabad

Tel: +92-51-9208146 Fax: +92-51-9208157

Website: www.ipa.gov.pk Email: info@ipo.gov.pk

World Intellectual Property Organization (WIPO)

34, Chemin des Colombettes

P.O. Box 18

CH-1211 Geneva 20

Switzerland

Telephone: +41 22 338 91 11

Fax: +41 22 733 54 28

e-mail: wipo.mail@wipo.int

or its New York Coordination Office at:

2, United Nations Plaza

Suite 2525

New York, N.Y. 10017

United States of America

Telephone: +1 212 963 6813

Fax: +1 212 963 4801

e-mail: wipo@un.org

Visit the WIPO website at: www.wipo.int

or its SMEs Division at:

34, chemin des Colombettes

P.O. Box 18

CH-1211 Geneva 20

Switzerland

Fax: +41 22 338 87 60

e-mail: sme@wipo.int

Web page: www.wipo.int/sme

Available at SMEDA Head Office and downloadable from
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