

Regulatory Procedure For Trade Mark Registration



Small and Medium Enterprises Development Authority

Ministry of Industries & Production

Government of Pakistan

www.smeda.org.pk

HEAD OFFICE

4th Floor Building # 3, Awan-e-Iqbal Complex Edgerton Road

Lahore

Tel: (9242) 111 111 456, Fax (9242) 3 6304926-7

helpdesk@smeda.org.pk

REGIONAL OFFICE PUNJAB	REGIONAL OFFICE SINDH	REGIONAL OFFICE KHYBER PAKHTUNKHWA	REGIONAL OFFICE BALOCHISTAN
3 rd Floor, Building No. 3 Aiwane-Iqbal Complex Edgerton Road, Lahore. Tel: (042) 11111-456 Fax: (042) 363049267 helpdesk.punjab@smeda.org.pk	5 th Floor, Bahria Complex II, M.T. Khan Road Karachi. Tel: (021) 11111-456 Fax: (021) 5610572 helpdesk.khi@smeda.org.pk	Ground Floor State Life Building The Mall, Peshawar. Tel: (091) 92130447 Fax: (091) 286908 helpdesk.pew@smeda.org.pk	Bungalow No. 15A Chaman Housing Scheme Airport Road, Quetta. Tel: (081) 831623, 831702 Fax: (081) 831922 helpdesk.qta@smeda.org.pk

December 2022

Table of Contents

1. Legal Services, SMEDA-Punjab.....	3
2. Purpose of the Regulatory Procedure	3
3. Disclaimer	3
4. Words and Phrases	4
5. Relevant Laws	4
6. Relevant Authority for Application	4
7. IPO Pakistan-HQs:.....	4
8. List of IPO Offices in Pakistan:	5
9. Essential Requirements for a Trade Mark to be Registered:	5
10. Classification of Goods & Services:.....	6
11. Trade Mark Search.....	6
12. Trade Mark Registration Procedure:	6
13. Trade Mark Registration Flow Chart.....	8
14. Procedure in Case of Online Registration:.....	9
15. Procedure in Case of Opposition:	9
16. Rights Conferred by Registration	10
17. Duration & Renewal of Registration	10
18. Fee & Forms.....	10
19. Annexure: A	11
20. Annexure - B	12

1. Legal Services, SMEDA-Punjab

The Legal Services (LS) is a part of Punjab office of the Small Medium Enterprises Development Authority (SMEDA) and plays a key role in providing an overall facilitation and support to the small and medium businesses. Information dissemination among the SMEs on the existing legal & regulatory environment and business to business and business to client contracting is of paramount importance and plays a pivotal role in their sustainable development.

2. Purpose of the Regulatory Procedure

This document will guide new entrepreneurs regarding obtaining certificate of Trade Mark Registration in Pakistan. This will also help in understanding the procedure, registration options and compliance requirements.

3. Disclaimer

The information contained in this template is meant to facilitate the businesses in documenting transactions. However, SMEDA, accepts no responsibility and expressly disclaim any and all liabilities for any and all losses/shortfalls caused by or motivated by recommendations from the information contained within this document. Although SMEDA's ambition is to provide accurate and reliable information; yet, the document is not an alternative to expert legal advice and should ideally be used in conjunction with the same. Any person using this document and or benefiting from the information contained herein shall do so at his/her own risk and costs and be deemed to have accepted this disclaimer.

All information contained in this document may be freely used provided that relevant acknowledgement is accurately quoted with each usage.

4. Words and Phrases¹

Serial #	Words and Phrases	Definition
1	Damages	A pecuniary compensation or indemnity, which may be recovered in the courts by any person who has suffered loss.
2	Injunctions	Court order prohibiting someone from doing some specified act or commanding someone to undo some wrong or injury.
3	Mark	Mark includes, in particular, a device, brand, heading, label, ticket, name, signature, word, letter, numeral, figurative element, color, sound or any combination thereof.
4	TM	Trade Mark
5	Trade	The term trade refers to the buying & selling activities of the goods for the purpose of gaining profits with a risk of having loss.

5. Relevant Laws

The Pakistani law that deals with Trade Mark issues are as following:

- Trade Mark Ordinance 2001
- Trade Mark Rules 2004
- Notification of Revision of Fee

6. Relevant Authority for Application

Intellectual Property Organization of Pakistan (IPO-Pakistan)

7. IPO Pakistan-HQs:

3rd Floor, NTC-HQs Building, Attaturk Avenue (East), Sector G-5/2, Islamabad.

Tel: +92-51-9245830-32

Fax: +92-51-9245874

¹ <https://thelawdictionary.org/>

8. List of IPO Offices in Pakistan:

Karachi Office:

IP-House: Plot # CD-3 behind KDA Civic Centre, Gulshan-e-Iqbal, Karachi

Tel: + 92 - 21 - 99230591

Fax: +92 - 21 - 99230592

Email: patent@ipo.gov.pk

Lahore Office:

Basement of Lahore Chamber of Commerce Building

11-Shahrah-e-Aiwan-e-Sanat-o-Tijarat (Near China Chowk), Lahore

Tel: +92-42-99205850

Fax: +92-42-99205855

Email: lahore@ipo.gov.pk

Peshawar Office:

Office Address: Plot No. 24, Phase-V, Hayatabad, Peshawar.

Tel: 091-9217185

Fax: 091-9217126

Email: peshawar@ipo.gov.pk

9. Essential Requirements for a Trade Mark to be Registered:

According to the Trade Mark Law, a trade mark shall not be registered unless it is distinctive, and a mark will be registered only when it contains one or more of the following essential particulars namely: -

- (a) the name of a company, individual or firm, represented in a special or particular manner.
- (b) the signature of the applicant or some predecessor in business.
- (c) one or more invented words;

(d) one or more words having no direct reference to the character or quality of the goods and not being in its ordinary signification a geographical name or surname or the name of a caste sect or tribe in Pakistan.

(e) any other distinctive mark, provided that a name, signature or any word, other than such as fall within the descriptions of the above clause, shall not be registrable exception evidence of distinctiveness, which means adapted to distinguish.

10. Classification of Goods & Services:

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

11. Trade Mark Search

Before making an application it is recommended that you request the registrar to cause a search of your proposed trade mark to ascertain that there is no other registered trade mark or among pending applications for registration that are duplicating or conflicting in any way from your proposed trade mark. To make such request you have to submit a Form TM-55 to the registrar along with fee of Rs. 1000/ and two sample of your proposed trade mark on sheets of strong paper approximately 13 inches by 8 inches in size. On receiving confirmation from the registrar that there are no other trademarks that duplicate yours, you may proceed with your application. One application form for search would be applicable for one trade mark search in one class only. Personal search facility is also available at IPO offices at Karachi, Lahore and Islamabad on receipt of bank draft of Rs. 200 for 15 minutes per client.

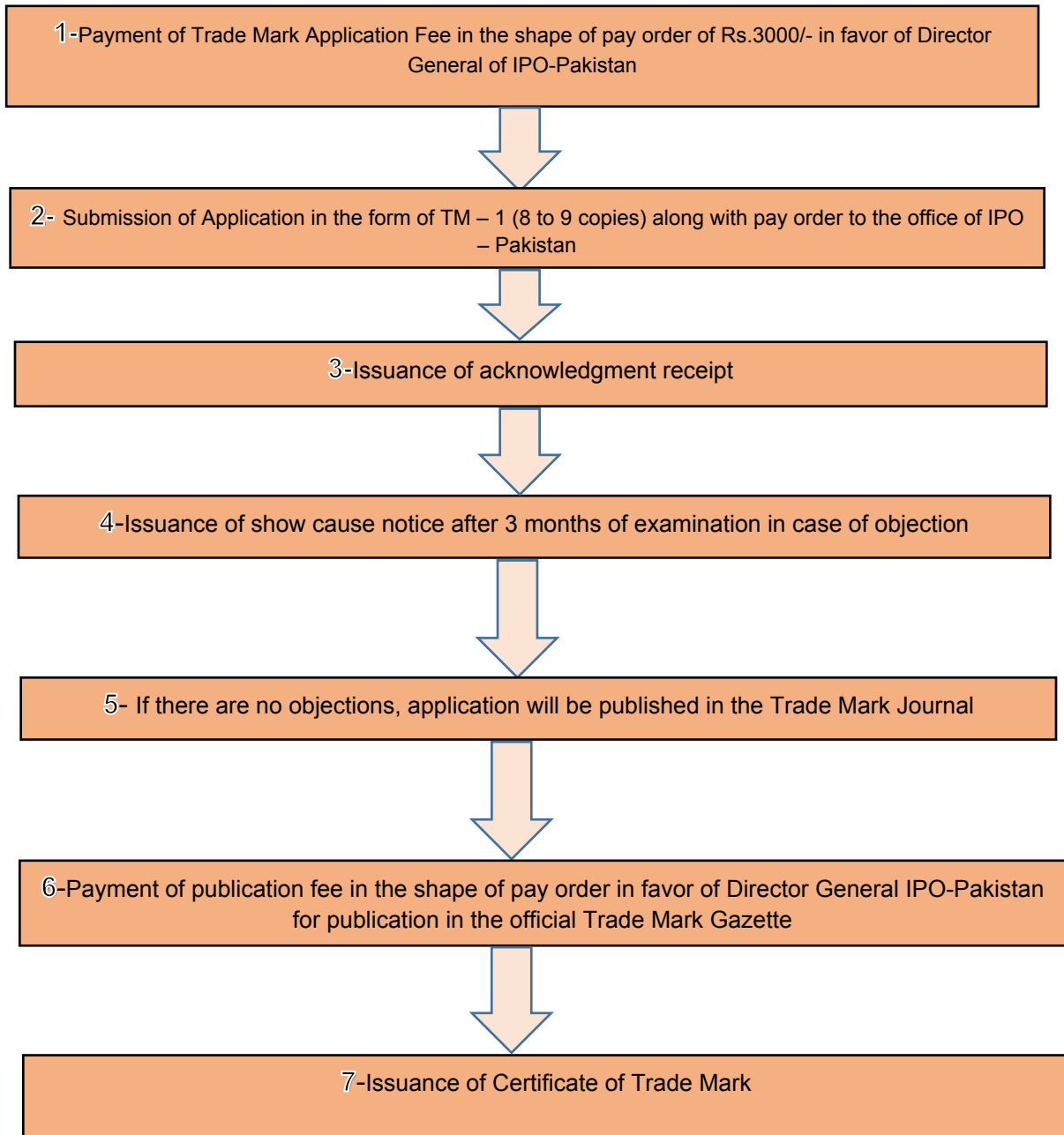
12. Trade Mark Registration Procedure:

Cash receipt and trademark number is allotted to the applicant when the application is received;

- The Acknowledgement Receipt by the Trade Marks Registry is issued to the applicant within 10-15 days of filing an application;
- Examination Report is generated after 3 months of filing an application. If there are any objections on the applied trademark, they are communicated to the applicant immediately in the form of a Show Cause Notice. The applicant is required to submit a reply within two months from the date of issuance of a Show Cause Notice;

- If there are no objections, application will be published in the Trade Marks Journal. If no oppositions are filed to the published application within two months from date of publication of the Trade Marks Journal, the application stands accepted and Demand Notice is issued to the applicant requesting him/her to submit Form TM-11 along with prescribed fee from scheduled bank in form of a pay order/ bank draft in the name of Director General IPO-Pakistan for issuance of the Registration Certificate; and
- On the receipt of registration fee, the Registration Certificate is issued by the Registrar of Trademarks.

13. Trade Mark Registration Flow Chart



14. Procedure in Case of Online Registration:

Following is the link for online trade mark registration;

https://ipo.gov.pk/online_filing_guidelines

15. Procedure in Case of Opposition:

The advertisement of the application in the Trade Mark Journal may trigger of a series of opposition proceedings by any person who opposes the registration of the trade mark. The Registrar will then forward a copy of the rejoinder to the applicant.

- The applicant will then file counter evidence within 2 months of the receipt of such copy.
- The Registrar will then forward a copy of the counter evidence to the opponent.
- The opponent shall then file evidence strictly in reply to the applicant's evidence within one month of the receipt of the copy.
- The Registrar will then forward a copy of the evidence to the applicant. Upon completion of evidence, the Registrar shall serve a notice to the parties and fix a date for the hearing of arguments.
- Any party wishing to appear in front of the Registrar shall within 14 days notify the Registrar in the form of TM-7.
- The Registrar shall notify in writing to the applicant and the opponent of his decision.
- The Registrar shall enter the trademark in the Registrar upon the completion of the opposition proceedings.
- In case of no opposition proceedings, he shall enter the trademark within 2 months from the date of advertisement in the Trade Mark Journal.
- Following the entry of the trade mark, the Registrar shall then publish the registration in the prescribed manner and issue to the applicant a Certificate of Registration sealed with the seal of the Trade Marks Registry.
- The opponent shall send in duplicate a notice of opposition to the Registrar within 2 months of the advertisement.
- The Registrar shall then forward a copy of the notice to the applicant.

- Within 2 months of receiving such a copy, the applicant shall file a counter statement with the Registrar.
- The Registrar shall then forward a copy of the counter statement to the opponent.
- Within 2 months of the receipt of the copy of the counter statement, the opponent may file a rejoinder and evidence.

16. Rights Conferred by Registration

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

- Damages.
- Injunctions.
- Accounts.

17. Duration & Renewal of Registration

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

18. Fee & Forms

Following is the link for Fee & Forms:

<https://ipo.gov.pk/trademarks-fee-forms>

19. Annexure: A

TM-1

(To be accompanied by a duplicate of this Form and by six additional representations affixed on a durable paper of size 13" x 8")
 Fee: See entry No.1of 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

One representation to be fixed within this space and six others to be sent separately. Representation of 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 _____ Nationality _____
 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 ^h _____.
 If colour is claimed, indicate here and state the colour(s) ⁱ _____.
 Address for service in Pakistan to which all correspondence should be sent ^j _____

Dated this _____ day of _____, 202__.

Signature^k _____

Name and Designation of signatory in block letters _____
 Telephone: _____ Fax: _____
 Email: _____

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

^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 along with this application either through a cheque drawn in favour of or through a money order addressed to the Director General, IPO- Pakistan.

(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.

Website: www.ipo.gov.pk : email: tmr@ipo.gov.pk

20. Annexure - B

TM-1

اس فارم کو پُر کر کے دو اصل اور چھ کاپیاں لوگو/مارک کے ساتھ جمع کروانی جائیں۔ فیس کے لئے پہلے شیڈول کی (انٹری 1 پر عمل کیا جائے)
درخواست برائے رجسٹریشن ٹریڈ مارک اشیاء، سروسز، ڈومین نام وغیرہ، سیکشن(1)(22) ، 84(2) اور رولز 12 کے تحت

یہ درخواست ٹریڈ مارک کی رجسٹریشن کے لئے جمع کروانی جا رہی ہے، کلاس ----- کے لئے
چیز/سروس ----- کے لئے بنام ----- حکومت ----- کاروباری
نام ----- جس کا کاروباری پتہ ----- ہے۔
درخواست گزار اس بات کا دعویدار ہے کہ یہ ٹریڈ مارک ----- (عرصے) سے استعمال کیا جا رہا ہے یا
----- تاریخ سے استعمال کرے گا۔
اگر یہ درخواست ایک سے زیادہ سیریز مارکوں کے لئے ہے تو واضح کریں کتنے مارکے ہیں -----
اگر یہ درخواست ڈومین نام کے لئے ہے تو واضح کریں کہ یہ ڈومین نام اشیاء کے لئے ہے یا سروسز کے لئے -----
اگر مارکے کے لئے مختلف رنگوں کا دعوائی ہے تو رنگ واضح کریں -----
پاکستان میں خط و کتابت کا پتہ -----
یہ درخواست مورخہ ----- کو جمع کروانی گئی۔
دستخط درخواست گزار -----
مکمل نام -----
فون ----- فیکس -----
ای میل -----

بنام رجسٹرار ٹریڈ مارک،
ٹریڈ مارک رجسٹری،
کراچی

Website: www.ipo.gov.pk : email: tmr@ipo.gov.pk