

**CHECKLIST OF ISSUES ON ENFORCEMENT<sup>1</sup>**

Responses from Pakistan

**Civil and Administrative Procedures and Remedies**

(a) *Civil judicial procedures and remedies*

**1. Specify the courts which have jurisdiction over IPR infringement cases.**

Under the Patents Ordinance, 2000 (Section 60), the Trade Marks Ordinance, 2001 (Section 117), the Copyright Ordinance, 1962 (Section 65), the Registered Designs Ordinance, 2000 (Section 8) and the Registered Layout-Designs of Integrated Circuits Ordinance, 2000 (Section 15), a District Court has jurisdiction over intellectual property right infringement cases.

An appeal to the decision of the District Court lies to the High Court.

**2. Which persons have standing to assert IPRs? How may they be represented? Are there requirements for mandatory personal appearances before the court by the right holder?**

Infringement action may be initiated by

- an aggrieved copyright owner, his licensee or assignee, under the Copyright Ordinance, 1962;
- a proprietor of a trademark or his licensee, under the Trade Marks Ordinance, 2001;
- a patentee, his assignee, successor-in-interest, or the holder of an exclusive license under a patent under the Patents Ordinance, 2000;
- the creator of a layout-design or his licensee who shall be a beneficiary of protection under the Ordinance under the Registered Layout-Designs of Integrated Circuits Ordinance, 2000;
- a registered proprietor of an industrial design under the Registered Designs Ordinance, 2000.

There are no mandatory requirements for personal appearance in the courts unless special directions are given if there is need for personal evidence.

---

<sup>1</sup> Document IP/C/5.

**3. What authority do the judicial authorities have to order, at the request of an opposing party, a party to a proceeding to produce evidence that lies within its control?**

Under Section 30 of the Civil Procedure Code, a court has the power, either on its own motion or on the application of a party, to make any such orders that may be necessary or reasonable for the production of documents or objects producible as evidence. Under Section 61 of the Patents Ordinance, 2000, the court has the authority to order prompt and effective provisional measures to preserve evidence regarding an alleged infringement.

**4. What means exist to identify and protect confidential information brought forward as evidence?**

The court has the inherent powers (under Section 151 of the Code of Civil Procedure) to make such orders as may be necessary for the ends of justice and to prevent abuse of the process of court including an order to protect confidential information.

**5. Describe the remedies that may be ordered by the judicial authorities and criteria, legislative or jurisprudential, for their use;**

- **injunctions;**
- **damages, including recovery of profits, and expenses, including attorney's fees;**
- **destruction or other disposal of infringing goods and materials/implements for their production;**
- **any other remedies.**

Under the Registered Layout-Designs of Integrated Circuits Ordinance, 2000, the court may grant an injunction to prevent infringement or imminent infringement, and may award damages and grant any other remedy provided for in the relevant law.

Under the Patents Ordinance, 2000, in any suit for infringement the court shall have the power (in addition to ordering provisional measures,

- to order to desist from infringement;
- to prevent the entry into the channels of commerce of imported goods that involve the infringement immediately after customs clearance of such goods;
- to order the infringer to pay to the right holder damages adequate to compensate for the injury he has suffered because of infringement;
- to pay the right holder expenses which may include appropriate attorney's fees;
- in appropriate cases, to order recovery of profits, damages and pre-established damages even where the infringer did not knowingly or with reasonable ground to know, engage in infringing;
- to order that goods found to be infringing be, without compensation of any sort, disposed off outside the channels of commerce;
- to order that material and implements the predominant use of which has been in the creating of infringing goods be, without compensation of any sort, disposed off outside the channels of commerce in such a manner as to minimize risk of further infringement, and in considering such orders, the need for proportionality between

seriousness of infringement and remedies ordered as well as interests of third parties shall be taken into account;

- unless this would be out of proportion to the seriousness of infringement, to order the infringer to inform the right holder of the identity of third parties involved in the production and distribution of the infringing goods and of their channels of commerce;
- to order a party at whose request measures were taken and who has abused an enforcement procedure, to provide to a party wrongfully enjoined or restrained, adequate compensation for injury suffered because of such abuse; and
- to order the applicant to pay the defendant expenses, which may include appropriate attorney's fees.

Under the Registered Designs Ordinance, 2000, in a suit on infringement, a registered proprietor may be granted relief in the form of recovery of damages, and for an injunction against the continuation of infringement. For the grant of a temporary injunction, the registered proprietor must show that he has a *prima facie* case and that his design is valid and has been infringed by the defendant (Section 9 of the Registered Designs Ordinance, 2000). A registered proprietor shall normally be entitled to full costs in a subsequent suit of infringement if in any previous proceedings contesting the validity of registration, the court has certified in his favour.

Under the Trade Marks Ordinance, 2001, in an action for infringement all such relief by way of damages, injunctions, accounts or otherwise shall be available to the proprietor of the trademark as is available in respect of the infringement of any other property right. Where a person is found to have infringed a registered trademark, the court may make an order requiring him,

- to cause the offending trademark to be erased, removed or obliterated from any infringing goods, material or articles in his possession, custody or control; or
- to secure the destruction of the infringing goods, material or articles, if it is not reasonably practicable for the offending trademark to be erased, removed or obliterated.

If such an order is not complied with, or it appears to the court likely that such an order would not be complied with, the court may order that infringing goods, material or articles be delivered to such person as the court or district court may direct for erasure, removal or obliteration of the mark, or for destruction, as the case may be. Where infringing goods, material or articles have been delivered up in pursuance of an order under the Ordinance, an application may be made to the court or district court,

- for an order that they be destroyed or forfeited to such person as the court may think fit; or
- for a decision that no such order should be made.

In considering what order, if any should be made, the court shall consider whether other remedies available in an action for infringement of the registered trademark would be adequate to compensate the proprietor and any licensee and protect their interests.

Under the Copyright Ordinance, 1962, a copyright owner is entitled to all such remedies by way of injunction, damages, accounts and otherwise. However, if the defendant provides that at the

date of the infringement he was not aware that copyright subsisted in the work and he had reasonable ground for believing that copyright did not subsist in the work, the plaintiff shall not be entitled to any remedy other than an injunction in respect of the infringement and a decree for the whole or part of the profits made by the defendant by the sale of the infringing copies as the court may in the circumstances deem reasonable.

The costs of all parties in any proceedings in respect of infringement of copyright shall be in the discretion of the court.

The owner of the copyright may also initiate proceedings for the recovery of possession or in respect of the conversion thereof of all infringing copies of any work in which copyright subsists, and all plates used or intended to be used for the production of such infringing copies.

A permanent injunction may be granted under the Specific Relief Act.

**6. In what circumstances, if any, do judicial authorities have the authority to order the infringer to inform the right holder of the identity of third persons involved in the production and distribution of the goods of services found to be infringing and of their channels of distribution?**

The courts have an inherent authority to order the infringer to inform the right holder of the identity of third persons involved in the distribution of goods or services found to be infringing.

The Patents Ordinance, has in addition to this, a specific provision (Section 61(1) viii), empowering the court to order the infringer to inform the right holder of the identity of third parties involved in the production and distribution of the infringing goods and of their channels of commerce.

**7. Describe provisions relating to the indemnification of defendants wrongfully enjoined. To what extent are public authorities and/or officials liable in such a situation and what "remedial measures" are applicable to them?**

The court has the authority under Section 35A of the Code of Civil Procedure to award compensatory costs in the case of false or vexatious claims, if such an objection is brought forward by a party.

Where in any suit a temporary injunction, an arrest or attachment has been ordered under Section 94 of the Code of Civil Procedure and it appears to the court that such order was on insufficient grounds or in case the suit fails there was no reasonable or probable ground for instituting the same, the court may upon application by the defendant award compensation to the defendant for the expense or injury caused to him.

Under the Patents Ordinance, the court has the authority to order the applicant to provide a security or equivalent assurance to protect the defendant and to prevent abuse.

Under the Copyright Ordinance, where any interim orders are revoked or cease to have any effect due to any act or omission of the applicant, the court may award costs to the defendant for any injury caused.

**8. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost.**

The length and the cost of proceedings will vary with each case. A suit or civil proceeding regarding infringement of copyright is normally to be decided within twelve months.

No data on the actual duration of proceedings and their costs is available.

(b) *Administrative procedures and remedies*

**9. Reply to the above questions in relation to any administrative procedures on the merits and remedies that may result from these procedures.**

No provisions on administrative procedures exist in relation to infringement of intellectual property rights.

**Provisional Measures**

(a) *Judicial measures*

**10. Describe the types of provisional measures that judicial authorities may order, and the legal basis for such authority.**

Under the Code of Civil Procedure, the court has the power to order temporary injunctions, and interlocutory orders. In granting a temporary injunction, there has to be firstly, a strong *prima facie* case; secondly, the accrual of irreparable loss or injury and, lastly, the balance of inconvenience in the favour of the petitioner. An interlocutory order may be passed for the detention, preservation, inspection, etc. of the subject-matter of the suit.

Under Section 61 of the Patents Ordinance, and Section 60A of the Copyright Ordinance, the court has the power to order prompt and effective provisional measures to prevent an infringement and to preserve relevant evidence.

**11. In what circumstances may such measures be ordered *inaudita altera parte*?**

Where delay is likely to cause irreparable harm to the right holder, or where there is a demonstrable risk of evidence being destroyed, or where it appears that the object of granting the injunction will be defeated by the delay, the court has the power to order such measures *inaudita altera parte*.

**12. Describe the main procedures for the initiation, ordering and maintenance in force of provisional measures, in particular relevant time-limits and safeguards to protect the legitimate interests of the defendant.**

The court may grant a temporary injunction or pass an interlocutory order on the application of a party. The duration of the temporary injunction is in the discretion of the court. It continues till the disposal of the suit or may be vacated earlier by the court. The court may ask for a security if it thinks fit.

If an interim order under Section 60A of the Copyright Ordinance has been sought before institution of regular proceedings, such orders shall cease to have effect if a suit for infringement is not instituted within thirty days. Where such orders are revoked or cease to have effect due to any act or omission of the applicant, the court may award appropriate costs to the defendant for any injury caused.

A provisional order under Section 61 of the Patents Ordinance, 22000 ends if revoked on a request by the defendant or ceases to have effect if proceedings leading to a decision on the merits of the case are not initiated within a reasonable period not exceeding twenty working days or thirty one

calendar days. Where the measures are revoked or lapse due to an act or omission of the applicant or no infringement has been found to occur, the court may order the applicant to provide adequate compensation to the defendant for any injury caused by such measures.

**13. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost.**

No data is available on the actual length or costs of such proceedings.

(b) *Administrative measures*

**14. Reply to the above questions in relation to any administrative provisional measures.**

No provisions exist whereby provisional relief can be given by administrative authorities.

**Special Requirements Related to Border Measures**

**15. Indicate for which goods it is possible to apply for the suspension by the customs authorities of the release into free circulation, in particular whether these procedures are available also in respect of goods which involve infringements of intellectual property rights other than counterfeit trademark or pirated copyright goods as defined in the TRIPS Agreement (footnote to Article 51). Specify, together with relevant criteria, any imports excluded from the application of such procedures (such as goods from another member of a customs union, goods in transit or *de minimis* imports). Do the procedures apply to imports of goods put on the market in another country by or with the consent of the right holder and to goods destined for exportation?**

The draft "Enforcement of Intellectual Property Rights Rules" provide for the suspension of release of counterfeit trademark goods and pirated copyright goods by the Customs Authorities in Pakistan. The infringement of intellectual property rights other than counterfeit trademark goods or pirated copyright goods as defined in the Agreement on Trade-Related Aspects of Intellectual Property Rights are not covered in the draft rules. The draft rules would also not apply to goods in transit, *de minimis* imports and on the imports of goods put on the market in another country by or with the consent of the right holder, or to goods destined for exportation.

**16. Provide a description of the main elements of the procedures relating to the suspension of the release of goods by customs authorities, in particular the competent authorities (Article 51), the requirements for an application (Article 52) and various requirements related to the duration of suspension (Article 55). How have Articles 53 (security or equivalent assurance), 56 (indemnification of the importer and of the owner of the goods) and 57 (right of inspection and information) been implemented?**

The draft rules provide for the following:

- The owner of any registered trademark or the holder of a copyright may make an application in writing, to the competent authority (Customs) for suspension of the release of goods, on importation suspected of being counterfeit or pirated copyright goods.

- An application in respect of a trademark or copyright is to be accompanied by
  - adequate evidence of the existence of intellectual property right; and
  - a statement of the grounds for the application, and in particular the *prima facie* evidence that such intellectual property right has been infringed.
- The Customs Authorities shall have the authority to require the applicant to provide a security to protect the importer or owner of the goods.
- Customs may allow the right holder to examine the goods, clearance of which has been suspended.

**17. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost. How long is the validity of decisions by the competent authorities for the suspension of the release of goods into free circulation?**

The draft rules provide that if within a period of ten working days after the applicant has served notice of suspension, the Customs Authorities have not been informed that the proceedings leading to a decision on the merits of a case have been initiated or that the authority has extended the period of suspension, the goods shall be released. If proceedings leading to a decision on the merits of the case have been initiated, the suspension may be revoked on the application by the defendant.

**18. Are competent authorities required to act upon their own initiative and, if so, in what circumstances? Are there any special provisions applicable to *ex officio* action?**

The Customs may, on its own initiative, suspend the clearance of goods in respect of which it has acquired *prima facie* evidence that an intellectual property has been or may be infringed.

**19. Describe the remedies that the competent authorities have the authority to order and any criteria regulating their use.**

The draft rules provide that the disposal of the counterfeit or pirated copyright goods shall be:

- by destruction under official supervision;
- by such other manner that the disposal shall be outside normal channels of commerce and would be without detriment to the owner of the trademark or the copyright holder.

**Criminal Procedures**

**20. Specify the courts which have jurisdiction over criminal acts of infringement of IPRs.**

The court of a magistrate of first class (or second class in a few cases) is the competent court to hear criminal cases of infringement of intellectual property rights.

**21. In respect of which infringements of which intellectual property rights are criminal procedures and penalties available?**

- Copyright

Under the Copyright Ordinance,

- Any person who knowingly infringes or abets the infringement of,
  - the copyright in a work;
  - the rental rights in cinematographic works and computer programmes;
  - the rights of performers or producers of sound recording; or
  - any other right conferred by the Ordinance,shall be punishable with imprisonment which may extend to three years, or with a fine which may extend to one hundred thousand rupees, or with both.
- Any person who knowingly publishes, or causes to be published, a collection or compendium of works which have been adapted translated or modified in any manner without the authority of the owner of the copyright in the original works, or who fraudulently employs a title which tends to mislead the public or create confusion with another work published earlier, shall be punishable with imprisonment which may extend to three years, or with a fine which may extend to one hundred thousand rupees, or with both.
- Any person who unauthorizedly makes or distributes counterfeit of sound recordings and cinematographic works for the purpose of business, profit or gain shall be punishable with imprisonment which may extend to three years, or with a fine which may extend to one hundred thousand rupees, or with both.
- Any person who for the purpose of business, profit or gain exploits or appropriates any sound recording or audio-visual work intended for private use, shall be punishable with imprisonment which may extend to three years, or with a fine which may extend to one hundred thousand rupees, or with both.
- Any person who, without authorization of the copyright owner or his licensee rents out the original or copies of the cinematographic works or computer programmes, shall be punishable with imprisonment which may extend to three years or with a fine which may extend to one hundred thousand rupees or with both.
- Any person who produces, or causes to be produced copies or reproductions in excess of the number authorized by the copyright owner or his successor-in-title, shall be punishable with imprisonment which may extend to three years, or with a fine which may extend to one hundred thousand rupees, or with both.



- Whosoever,
  - (1) inserts or affixes the name of any person in or on a work of which that person is not the author, or in or on a reproduction of such a work, in such a way as to imply that such person is the author of the work;
  - (2) publishes, or sells or lets for hire, or by way of trade offers, exposes for sale or hire, or by way of trade exhibits in public a work in or on which the name of a person has been inserted or affixed in such a way as to imply that such person is the author of the work, or the publisher of the work, who to his knowledge is not the author or the publisher, as the case may be, of such work; or
  - (3) does any of the acts mentioned in clause (2) in relation to or distributes, reproductions of a work, being reproductions in or on which any person's name has been inserted or affixed in such a way as to imply that such person is the author of the work, who to his knowledge is not the author of the work, who to his knowledge is not the author of such work, or performs in public, or broadcasts the work as being the work of a particular author, who to his knowledge is not the author of such work;

shall be punishable with imprisonment which may extend to two years, or with a fine, which may extend to one hundred thousand rupees, or with both.

- Any person who published a record or a video film in contravention of the provisions of section 57A, shall be punishable with imprisonment which may extend to three years, or with a fine which may extend to one hundred thousand rupees, or with both.

The court before which any offence under the Copyright Ordinance is tried may, whether the alleged offender is convicted or not, order that all copies of the work or plates or recording equipment in the possession of the alleged offender, which appear to it to be infringing copies, or plates, or recording equipment used or intended to be used for the purpose of making infringing copies, be destroyed or delivered to the owner of the copyright or otherwise dealt with as the court may think fit.

- Trademarks

Criminal penalties are available under the following provisions of the Pakistan Penal Code:

- Section 482: Whoever uses any false trademark or any false property mark shall, unless he proves that he acted without intent to defraud, be punished with imprisonment of either description for a term which may extend to one year, or with a fine, or with both.

- Section 483: Whoever counterfeits any trademark or property mark used by any other person shall be punished with imprisonment of either description for a term which may extend to two years, or with a fine, or with both.
- Section 484: Whoever counterfeits any property mark used by a public servant, or any mark used by a public servant to denote that any property has been manufactured by a particular person or at a particular time or place, or that the property is of a particular quality or has passed through a particular office, or that it is entitled to any exemption or used as genuine any such mark knowing the same to be counterfeit, shall be punished with imprisonment of either description for a term which may extend to three years, and shall also be liable to a fine.
- Section 485: Whoever makes or has in his possession any die, plate or other instrument for the purpose of counterfeiting a trademark or property mark, or has in his possession a trademark or property mark for the purpose of denoting that any goods are the manufacture or merchandise of a person whose manufacture or merchandise they are not, or that they belong to a person to whom they do not belong, shall be punished with imprisonment of either description for a term which may extend to three years, or with a fine, or with both.
- Section 486: Selling goods marked with a counterfeit trademark or property mark. Whoever sells, or exposes, or has in possession for sale or any purpose of trade or manufacture, any goods or thing with a counterfeit trademark or property mark affixed to or impressed upon the same or to or upon any case, package or other receptacle in which such goods are contained, shall, unless he proves,
  - (a) that, having taken all reasonable precautions against committing an offence against this section, he had at the time of the commission of the alleged offence no reason to suspect the genuineness of the mark, and
  - (b) that, on demand made by or on behalf of the prosecutor, he gave all the information in his power with respect to the persons from whom he obtained such goods or things, or
  - (c) that otherwise he had acted innocently,be punished with imprisonment of either description for a term which may extend to one year, or with a fine or with both.
- Section 487: Making a false mark upon any receptacle containing goods. Whoever makes a false mark upon any case, package or other receptacle containing goods, in a manner reasonable calculated to cause any public servant or any other person to believe that such receptacle contains goods which it does not contain or that it does contain goods which it does contain, or that the goods contained in such receptacle are of a nature or quality different from the real nature or quality thereof, shall unless he proves that he acted without intent to defraud, be punished with imprisonment of either

description for a term which may extend to three years, or with a fine, or with both.

- Section 488: Punishment for making use of any such false mark. Whoever makes use of any such false mark in any manner prohibited by the last foregoing section shall, unless he proves that he acted without intent to defraud, be punished as if he had committed an offence against that section.

**22. Which public authorities are responsible for initiating criminal proceedings? Are they required to do this on their own initiative and/or in response to complaints?**

In respect of cognisable offences the police is authorised to initiate criminal proceedings on its own on information of the offence being committed. In the case of non-cognisable offences, the police initiates criminal proceedings at the order of a magistrate to whom a complaint has been made under Section 190 of the Code of Criminal Procedure.

**23. Do private persons have standing to initiate criminal proceedings and, if so, who?**

Criminal proceedings can be initiated by an aggrieved copyright owner or a registered proprietor of a trademark or his licensee.

**24. Specify, by category of IPR and type of infringement where necessary, the penalties and other remedies that may be imposed:**

- **imprisonment;**
- **monetary fines;**
- **seizure, forfeiture and destruction of infringing goods and materials and implements for their production;**
- **other.**

Please see the response to question 21 above.

**25. Describe provisions governing the length and any cost of proceedings. Provide any available data on the actual duration of proceedings and their cost, if any.**

No such provisions or data exist.

---