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CLIENT UPDATE

Is Pakistan's accession to the Madrid Protocol alone sufficient for the foreign mark owners to seek protection in Pakistan?

While Pakistan's domestic trademark holders may start enjoying benefits of the Madrid System with effect from 24 May 2021, it seems unlikely that the trademark holders from other Contracting States will be able to seek protection in Pakistan under the Madrid System until an enabling domestic legislation is enacted.

The Madrid System

The Madrid System is an international treaty-based system for registration of marks (trademarks and service marks) with the International Bureau (International Bureau) of World Intellectual Property Organization (WIPO). The Madrid System provides for filing a single international application for registration of a mark effective in multiple jurisdictions. The Madrid System serves a twofold purpose – it facilitates the obtaining of protection for a mark in multiple jurisdictions and provides a much easier process for management of that protection.

The Madrid System consists of two separate treaties, the Madrid Agreement Concerning the International Registration of Marks of 1891 (Madrid Agreement), and the Protocol Relating to the Madrid Agreement of 1989 (Madrid Protocol). Both instruments have a similar structure; however, they are independent of each other.

Eligibility criteria to seek protection under the Madrid System.

A person who is a national of, or domiciled in, or has a real and effective industrial or commercial establishment in, a country which is party to the Madrid Agreement or the Madrid Protocol may apply for an international registration of a mark.

Likewise, a person who is domiciled in or has a real and effective industrial or commercial establishment in the territory of an intergovernmental organization which is a party to the Madrid Protocol or is a national of a member State of such an organization may also file an application for an international registration of a mark.

A person who does not have necessary connection through establishment, domicile, or nationality with a member of the Madrid Agreement or the Madrid Protocol cannot recourse to the Madrid System.

The procedure for filing an application under the Madrid System.

An application for an international registration (an International Application) of a mark under the Madrid Agreement may be filed only if the

relevant mark has already been registered in the Trademark Office of the relevant Contracting State. However, this requirement does not apply to an International Application governed by the Madrid Protocol. In such case, the International Application may be filed soon after applying for the domestic registration of a mark in the trademark office of the relevant Contracting State.

An applicant cannot directly submit an International Application to the International Bureau. An international Application must be presented to the International Bureau through the trademark office of the relevant Contracting State. The International Application should comply with certain requirements and the information provided therein should be certified by the relevant trademark office.

An International Application must designate the Contracting State(s) in which the mark is desired to be protected. The scope of protection would depend upon whether the relevant Contracting State is a party to the Madrid Agreement or the Madrid Protocol or both. Each International Application will be subject to the payment of the prescribed fees



depending upon, *inter alia*, the number of Contracting States in respect of which the protection is sought and the classes of goods and services in respect of which the protection is sought.

The nature of protection provided under the Madrid System.

An international registration of a mark is like a bundle of national registrations. An international registration, where no provisional refusal is notified to the International Bureau within the relevant time, entitles the mark to the same protection as if it had been registered by the trademark office(s) of the Contracting State(s) in respect of which the protection is sought. The holder of an international registration may bring an action for infringement of the registered mark in any of the designated Contracting States.

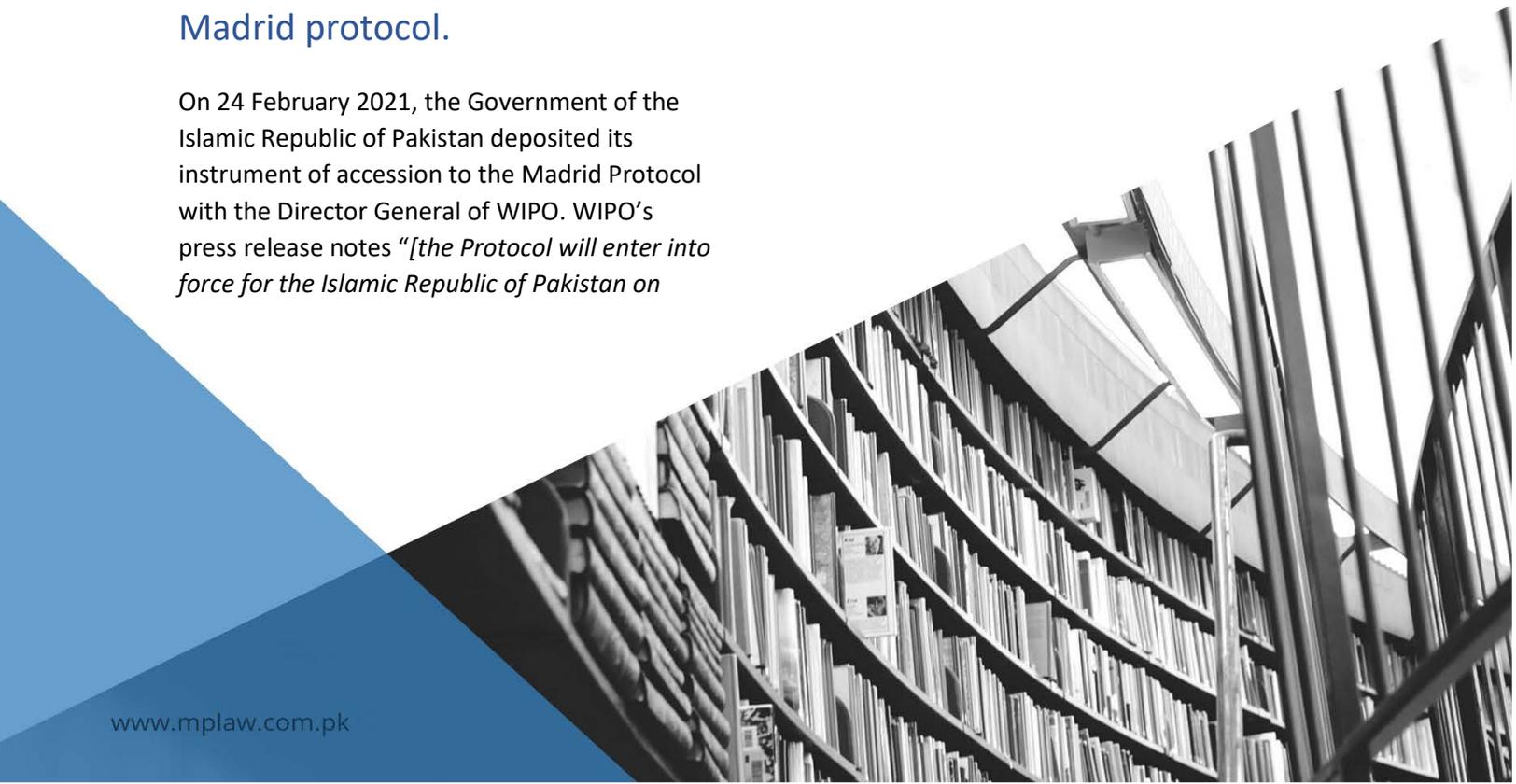
Pakistan's accession to the Madrid protocol.

On 24 February 2021, the Government of the Islamic Republic of Pakistan deposited its instrument of accession to the Madrid Protocol with the Director General of WIPO. WIPO's press release notes "*[the Protocol will enter into force for the Islamic Republic of Pakistan on*

May 24, 2021". This announcement appears to be made pursuant to paragraph 4(b) of Article 14 of the Madrid Protocol which provides that the Madrid Protocol shall enter into force three months after the date on which the accession of a Contracting State has been notified by WIPO's Director General.

The current position of the Madrid System under Pakistani law.

The Madrid System has a dual purpose. It provides an enabling mechanism for a person from a Contracting State to apply for and obtain an international registration of a mark using the domestic channel, *i.e.*, the national trademark office of such Contracting State. At the same time, it also enables the holder of an international registration of a mark from another Contracting State to use the legal means provided under the domestic laws of such Contracting State to protect his mark within the territory of such Contracting State.



Obtaining an international registration from Pakistan.

In case of Pakistan, the first purpose of the Madrid System may be achieved with effect from 24 May 2021 as all that is required for enabling the mark owners from Pakistan to obtain international registration for their marks is an administrative setup at the Intellectual Property Organization of Pakistan (IPOP) for receipt and transmission of international applications to the International Bureau and for ancillary processes.

Under the Constitution of Pakistan authorizes the Government of Pakistan (GOP) to sign, execute, ratify, accede to or and become party to international agreements and treaties. GOP may validly discharge its obligations under a treaty provided that such obligations do not interfere with the rights of Citizens of Pakistan or involve having recourse to local courts.

Enforcing international registrations in Pakistan.

The second and if not more but an equally important purpose of the Madrid System, *i.e.*, allowing the international registration holders from other Contracting States access to the legal means provided under Pakistan's Trademarks Ordinance and the Intellectual Property Organization of Pakistan Act, 2012, for

protection of their marks in Pakistan, appears to be difficult to achieve in near future.

Pakistan adopts a dualist approach to international law. Any obligations under an international agreement or treaty signed by GOP cannot be enforced by the local courts or curtail any liberties of the Citizens of Pakistan unless and until an enabling domestic legislation is enacted to give effect to such obligations. The Constitution of Pakistan declares that “[n]o court shall have any jurisdiction save as is or may be conferred on it by the Constitution or by or under any law.”

It was held by the Supreme Court of Pakistan in a reported judgment: *“The treaty unless [it] was incorporated into the law so that it become part of Municipal Laws of the Country, no Court shall have jurisdiction to enforce any right arising therefrom.”*

In another reported judgment, the Supreme Court observed: *“Without framing a law in terms of the international agreement the covenants of such agreement cannot be implemented as a law nor do they bind down any party.”*



Thus, till such time that either Pakistan's Trademarks Ordinance, 2001, is amended or a new domestic legislation is enacted in Pakistan to implement the Madrid Protocol, the holders of international registrations of marks from other Contracting States may not be able to seek protection from the courts in Pakistan.

Government of Pakistan has not yet presented any bill in the Parliament for enactment of a permanent enabling legislation for implementing the Madrid Protocol in Pakistan.

No information is available in the public domain to indicate any efforts being made by the Government in this behalf. Therefore, it seems unlikely that a permanent enabling legislation for implementing the Madrid Protocol in Pakistan will be enacted by 24 May 2021. However, a workaround for the Government in this situation may be to promulgate an ordinance to implement the Madrid Protocol. An ordinance is a temporary legislation having a life of only one hundred and twenty days.

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