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www.advancelrf.org**Inscribing Identity: A Transnational Analysis of Trademark Law and Cultural Heritage in Pakistan****Dr Fozia Naseem**

Assistant Professor, College of Law, GC University Faisalabad

Email: fozianaseem@gcuf.edu.pk**Waseem Akhtar Manj**

LLM Scholar, College of Law, GC University Faisalabad

Email: advwaseemakhtar@gmail.com**Muhammad Bilal Ahmad**

LLM Scholar, College of Law, GC University Faisalabad

Email: chaudharybilal0603@gmail.com**Abstract**

Trademark law in Pakistan has evolved over decades. This analysis highlights the challenges faces in Trademark enforcement including weak laws, limited resources and lack of public awareness. Pakistan's first trademark law is the Trademark Act, 1940. Pakistani laws covering trademarks and their regulatory framework include Ordinance of Trademark 2001, Rules of Trademark 2004, Pakistan IPO Act 2012, pertinent provisions of PPC 1860 and SRA 1877. The Convention of Paris was the first international convention containing trade rules or their administration (6-9), TRIPS was the first international agreement. There is a detailed discussion of trademarks and the procedures of execution (15-21,41-61). Pakistan has ratified TRIPS and the "Paris Convention". Trademark is a unique symbol that can differentiate goods or services of one organization from the products or services of another organization. This article focuses on legal framework of trademark in Pakistan and its international perspective.

Historical Background of Trademark

In 5000 BC, Bison paintings in the Lascaux Caves in France were the earliest. In 600 BC, unique signs were used in crafts to indicate product origin. In 221 BC, Chinese characters were used on seals in East Asia to prove identity on documents and art. Merchant's marks were personal marks used by traders and merchants throughout Europe in the 1200s, and they served as early trademarks. They displayed the names of sellers and guaranteed the quality of goods, especially bells and paper. The Bakers Marking Law, passed by Parliament in 1266, mandated bakers to place unique marks on bread produced under King Henry III's reign. To protect consumers and identify loaf origins, this set of a standard called as "the Assize of Bread and Ale" regulated bread size, weight, price, and flour purity.

In 1618, England saw the first legal case in England to use a trademark as a badge of origin for cloth, *Southern v How* (1617). This marked the beginning of globalization, as products were sold far from their origin points. For example, French products were sold in India, making it difficult to identify the manufacturer. In 1751, furniture makers in Paris were required to sign their work with a mark. The 19th century saw the rise of International Exhibitions, enabling large-scale production and distribution of products on all continents. The first International Exhibition was held in London in 1851, and Napoleon III organized the Paris Universal Exhibition in 1855. The Austro-Hungarian Empire organized the World Exposition in Vienna in 1873, but in 2021, foreign exhibitors faced FOMO due to fear of theft and commercial exploitation.

Definition of Trademark

- A trademark is a distinguishing symbol that uniquely identifies a business's name or its products or services from those of others. A trademark can be any symbol, name, sign, sound, or fragrance that helps customers identify one company's products and services from those of other companies.
- Every sign or combination of signs, which may be used to differentiate one's goods or services from those of others, is considered a trademark under Article 15 of the TRIPS agreement. Letters, numbers, words, figurative components, and combinations of colours and signs are examples of signs.
- According to Sec 2 (xxiv) Trademark Ordinance 2001, a trademark is any symbol, device, brand, heading, label, ticket, name of natural and legal person, words, letter, numeral, figurative element, colour, sound, certification mark, collective mark, domain name, renowned and service mark that is used for differentiates the products or services of one undertaking from the other undertakings.
- The WIPO states that a trademark can be any word, combination of words, letters, and numbers, as well as drawings, symbols, three-dimensional features such as the shape and packaging of goods, invisible signs such as sounds and fragrances, or colour shades used as distinguishing characteristics on occasion.
- Any symbol that sets a particular company's products apart from those of its rivals and gives them individuality is considered a trademark. In more precise terms, trademarks are "words, phrases, logos, and symbols," while they can also be registered as "shapes, sounds, fragrances, and colours" in some jurisdictions. Several symbols are examples of trademarks: the Apple computer's bitten apple emblem, the McDonald's arching M, and the Nike "Swoosh" symbol.

Condition for a Trademark Registration

Trade, uniqueness, and public morality are the three main conditions that must be fulfilled in order for a trademark to be registered. In order to be used in commerce or to be used in the future, a trademark must first be registered. For customers to be able to identify the source of the goods, the trademark needs to be unique. Thirdly, the prospective trademark is prohibited from misleading the public about the item's nature, quality, or any other aspect, including their origin.

Nature of Trademark

Trademarks are available for registration under the TRIPS and can relate to products or services. An intangible asset like trademark plays a vital role in an expansion or success of the company. Via licensing agreements, well-known brands like McDonald's or Nike might result in income. Trademark is "a mark under which you trade." A strong trademark should have the ability to convey the prospective quality of the product, be virtually appealing, and maintain its originality. It must be designed such that it can be distinguished from other products in the same category and that it may be registered and protected. It is one that is simple for the general public to pronounce and spell.

Furthermore, it ought to be simple to recall. Trademark law states that a trademark should be unique, non-descriptive, and non-generic. For instance, the word "Yahoo" is fictitious and lacks a dictionary definition. However, it takes on a new role that sets the search engine apart from its owner when it is connected to a good or service like a search engine. If its registered owner does not move quickly to stop infringement, the trademark loses its uniqueness. As a result, trademark enforcement processes need to be sufficient, quick, and free of expense.

Functions of Trademark

A trademark has four primary functions: it indicates the product's place of origin, sets it apart from competing products, promotes it to the general public, and ensures quality. In Pakistan, trademarks can be identified by symbols such as ® for registered trademarks, SM for unregistered service marks and ™ for unregistered trademarks. To ensure that the final consumer can identify the origin of a trade-marked goods by giving him clear and unambiguous means of differentiating it from goods having other origins. With the origins guarantee, buyer and final user will sure that a commodity bearing a trademark that is sold to them hasn't previously been the target of third-party interference without the trademark owner's consent, which could have altered the product's original state. In

addition to serving marketing and advertising objectives, trademarks help raise brand recognition. Trademarks are essential for establishing and preserving consumer confidence in the manufacturer or supplier. A well-known trademark becomes an emblem of excellence, dependability, and consistency.

By guaranteeing that goods or services bearing identical or similar marks do not come from separate sources, trademarks aid in preventing customer misunderstanding. Customers are shielded from making erroneous purchase selections because to this. Due to their exclusionary rights, trademarks encourage the firms to spend in developing distinctive brands. Trademarks are necessary instruments for advertising and marketing. Customers' decision-making process is made easier by trademarks, which act as quick links to recognize and select products and services that they value and find appealing. Trademarks can be registered universally, offering protection in multiple nations and promoting international trades.

An International Gateway to Trademark Registration: The Madrid Protocol

In a present rapid-paced global economy, registering trademark in numerous countries can be difficult and expensive process. The Madrid Protocol is a universal convention is in effect since 1st April 1996 has changed the trademark registration by providing helpful and cost-efficient process for businesses to seek protection in various member nations. The Madrid Protocol governed by International Bureau of WIPO, provides an effective system for universal trademark registration. Pakistan recently joined Madrid Protocol on 24th February 2021 and ratified it on 24th May, 2021 means that an application of trademark under this protocol will be accepted by a Pakistan from 24th May 2021. The Madrid protocol is a part of Madrid system which brings together a collection of countries that constitutes the “Madrid Union”. This simple method uses three official languages for the process of application: French, Spanish and English with the payments submitted in a “Swiss franc”. Instead of filing several applications in multiple trademark offices with different languages and currencies, the applicant may now file a single application in one language and pay the fee in a single currency, in order to simplifying the procedure. To be a member of the Madrid Protocol, country must be a member of Paris Convention for a protection of IP, that Pakistan joined in 2004, making it eligible to admission for the Madrid Protocol.

Trademark certification in Pakistan only offers protection within the country. International registration permits trademark proprietors to protect and apply their marks outside of the Pakistan, restraining third-party applications. WIPO and WTO collaborate with the UN to promote and defend trademarks worldwide. WIPO promotes creative activities and contains 26 international treaties, including the Paris Convention and Madrid Protocol of 1989, which handles industrial property protection, including trademarks. Madrid agreement on the international registration of trademark was formed in 1891, the Madrid protocol was ratified in 1989. Foreign trademark certification is critical for e-commerce enterprises since it permits items to be sold worldwide to foreign customers. It also protects the trademarked products from usage in foreign countries, although they are easily exploited illegally to gather customers.

Number of Foreign Trademark Applications Filed in the U.S.

Country	2013	2014	2015	2016	2017
China	4112	6356	14248	31709	51423
France	3072	2856	3279	3320	3375
Germany	4569	4491	4977	5406	5250
India	491	658	715	806	834
Italy	2357	2482	2506	2784	2642
Japan	3464	3491	3699	3672	4001
Korea	1969	2026	2976	2961	3107
UK	5008	5634	6098	6713	6986

The Protocol of Madrid

International Trademarks certification is carried out in accordance with the Madrid protocol. It was ratified in the Madrid on 27th June, 1989. On 14th April 1891 Madrid agreement about certification of trademark internationally officially approved. Member states of the union are allowed for registration of trademarks according to the Madrid Protocol. Madrid Union have 112 members, represents 128 countries. For instance: Micromax, an Indian maker of mobile phones, has currently gained 1.25 million of a Trademark certification internationally of the 'Micromax' mark. As a result, the trademark 'Micromax' is currently safeguarded over 110 nations. Application for the Internationally Trademark certification of 'Micromax' mark submitted in adherence to the Madrid Protocol, with the purpose of acquiring international registration.

Paris Convention

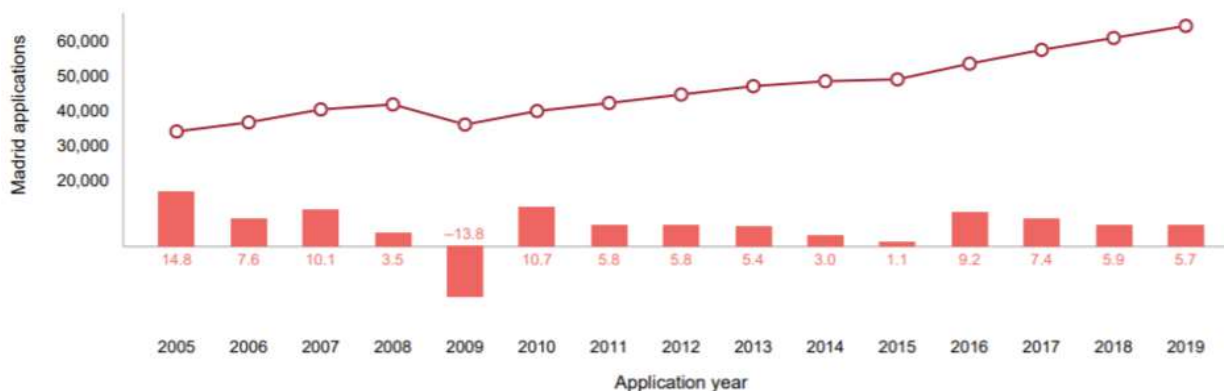
For a protection of industrial property: principle international treaty. Paris convention has been revised at a Brussels, Hague, Washington, London, Stockholm and London. USA became a signatory to this international treaty in 1887. This convention establishes that member countries provide the national protection to owners of trademark from other countries who apply for trademark security and that member countries afford intellectual property a minimum level of protection. This convention also established the organizational structure for administering treaty containing an international bureau which is Secretariat for the Treaty and "Paris Union" (the group name for member nations). International Bureau was incorporated into the WIPO when WIPO took over administration of the Paris and Madrid Unions. US trademark law provides equal protection for the Paris Union trademark proprietors and US citizens. If a trademark is not registered but protected as renowned trademark U/A 6bis of the Paris convention and U/A 16 (2) (3) of the TRIPS, the owner of trademark might initiate a legal proceeding of passing off to gain damages or injunctions to prevent further violation of well-known trademark (Trade Marks Ordinance 2001 Sec # 86).

Procedure for Trademark Protection Under Protocol of Madrid

Applicant must have to submit an international application to WIPO's International Bureau via the Trademark Registry in Karachi, which presents as the office of origin. The IB formally examines the application before publishing it in the WIPO's International Gazette. Examination of the mark is then done by the specified nations according to their national legislation within 12-18 months followed by the acceptance, and the mark is certified in those countries. After the registration for the first 5 years, an international registration protection depends upon the certified or applied mark in the office of origin, if the basic registration in an office of the origin ended to have effect within this time, international registration loses its protection.

An international certification is valid for a period of 10 years and may renewed by paying fee before each 10-year term expires. The Madrid protocol also provides flexibility in managing trademark registrations, alterations such as the applicant's name or address, change in ownership, or a limitation

of goods or services can be certified and implemented through application after payment of the price. With the Pakistan's adherence to the Madrid Protocol, the trade mark registry in Karachi will now provide two functions: as the office of origin for foreign candidates appearing in Pakistan and as the office of the designated contracting party for applicants seeking trademark safety in Pakistan. This is a big step towards making it easier and more effective for the Pakistani enterprises to get trademark rights.

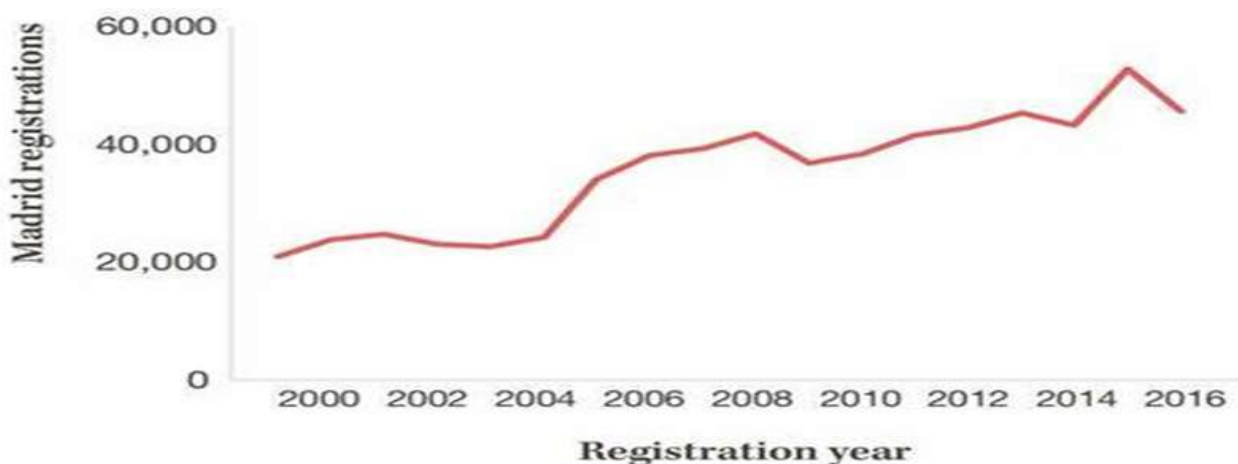


Requirements For Filing International Application Through Office of Origin

- For the filing of an international certification of trademark under the Madrid protocol in the Pakistan, the applicants must meet one of the following three standards:
- Nationality: The claimant must be a national of Pakistan.
- Domicile: The claimant must be domiciled in Pakistan.
- Business Establishment: The claimant should have active business or corporate enterprise in the Pakistan.

Also, the claimant must own the filing number of national trademark application or registration number which is issued by the trademark's registry, Karachi. This interstate mark will serve as the basis for international application. The trade mark used in the international application must be the same as the one mentioned in the nationwide trade mark appliance. As the name of the products or services enlisted inside the international application must coincide with those described in the basic mark. The claimant can designate various other member nations of the Madrid protocol where they intended to secure their mark. International application can be submitted using form MM2, following the instructions connected to it. This form can be submitted in either the form of paper through email or via Madrid e-filing. This form is available on the official website www.ipo.gov.pk or on WIPO's website. For the completion of filing process, the applicant is required to pay a fee of Rs. 5000/- through designated payment gateway. By adhering to these prerequisites, claimants can proceed with the international certification of their trademark through office of origin in the Pakistan and get the benefits of Madrid protocol for the protection of their mark in the multiple member nations.

Trend in international registrations



Pre-Requisites for The International Trademark Certification Procedure Under the Protocol of Madrid and Benefits of Their Registration

Trademark claimant must comply with the below mentioned conditions before apply for the certification of international trademarks:

- Claimant must have the domicile of Pakistan, has efficient and actual business and corporate facility within Pakistan.
- The claimant should have a mark certified along the Pakistan trademark registry. The application of the national trademark serves as the basis for the international registration.
- Claimant must be applied for an application internationally for similar mark where national certification of mark is gained and specified in the appliance of national trademark.
- List of the service and products in the international appliance must be same as the appliance of National Trademark.
- Claimant should choose one or more member of Madrid Agreement nations in which he/she wants security under the international appliance.

Advantages of the Certification of International Trademark

1. Legally Protected:

Certification of international trademark lawfully secures Trademark from the violation of that mark internationally. Certified trademark is protected against the third party who used it without the approval in foreign nation where it is certified. When the trademark is certified it is easy to prove the lawful rights in the trademark in front of the court.

2. Business Chances:

The trademark is incorporeal asset of an enterprise or play an important part in brands development. The successful mark gave a chance to the brand for earning profit. Internationally Trademark certification helps the progress of a brands and goods. Enterprises of Nike and McDonald's attained royalties with the licensing contracts because of gaining an international certification.

3. Rare Characteristics:

Certification of International trademark gave worldwide identification for the goods. Internationally certification of the mark helps to fight for the violation to ensure that the proprietors obtain rights one of their valued resources.

4. Valuable In Favor of the E-Operators:

It plays an important part in the growth of online business. Where the company is involved in the sale of goods online, it provides a way for the goods world widely usable for the intercontinental buyers. When the products have acquired identification in a market globally, it turns into easy for trademarks to get prevalence in between a giant buyer. It's better to acquire universal certification for these goods to elude chaos between the consumers for products.

5. Protection Of Brand During the Exportation or Importation:

Intercontinental certification secures the trademark goods of any incorrect use in the foreign nations by the foreign parties. When the mark gain reputation in the foreign nations, its inclined to be transcribed deceitful, by other enterprises to obtain consumers, by usage of the mark. If any such violation happens during the importation and exportation, the universal certification gave the rights to a lawful activity alongside such a violation or protects a mark connected to the goods and services.

Universal Certification of Trademark Procedure under the Protocol of Madrid

1. Searching of Trademarks:

The claimant firstly conducts a search of the trademark before apply to the universal certification. The claimant conducts a search on the Global Database of WIPO for the determination of any same or exactly alike certified mark exist. The claimant should insure of that no same and comparable certified mark already available in the Madrid Protocol nations where he/she is making a plan to apply for the certification. If the similar trademark already available, appliance will be refused.

2. Filing the Application of Certification:

Secondly, claimant should file the certification appliance in the form of MM2 (E). The claimant must file the application of global registration in the TMR within Pakistan because it is office of the origin of Pakistani enterprises. Registrar will process and validate the application. Then the registrar will file it with World Intellectual Property Organization in Geneva. This filing of international application should be online through the official website of IP Pakistan with the payment of requisite fees.

3. Examining The Application by the WIPO:

When registrar send any certification application to WIPO, then examination of application will be conducted, If WIPO considers the certification appliance accurate, in the intercontinental register trademark is listed or advertised it in the official gazette of WIPO, the universal trademarks.

4. Announcement of the Registration of Trademarks by the WIPO's:

WIPO will notify about the international application of trademark to all the countries of the member of Madrid protocol in which the claimant wants to gain certification. These members nation will examine the appliance according to their Trademark regulations. Then the member nations will submit their examining report or notifies the approval and rejection of appliance between the 12-18 month the receipt of the certification application of the mark to the WIPO.

5. Objections to the Trademarks Certification:

When member nations hold any hostility to the certification appliance, it should be presented to WIPO in the predetermined manner. The procedure of opposition will be carried out between the claimant and concerned member nation of a protocol. This proceeding includes the hearing, appeal, response and prosecution. WIPO will be a part of the entire proceedings.

6. Allowance of the International Trademarks Certification:

When a member nation accepted the appliance, trademark will be certified for 10 years in a chosen respective member nation under the protocol. After the approval, a statement of the allowance will issue to a claimant, which certifies the registration of universal trademark of the Pakistani Trademark.

7. Application Or Subsequent Designation:

- Until June 30, 2023: 75 Swiss francs per type of goods or services.
- Starting from July 1, 2023: each class of goods or services will cost 54 Swiss francs.

8. Renewal:

- Until June 30, 2023: 66 Swiss francs for each category of goods or services.
- Starts from 1st July 2023: 48 Swiss francs for each class of goods and services.

9. Accession to Madrid System:

Upon its accession, Pakistan will rank 108th among the member states of the Madrid System, bringing the total number of countries covered to 124. This figure includes the three Benelux countries and a member nation of EU.

Advantages of Madrid System

Madrid system presents numerous benefits for a business's aiming to secure their trademarks on international level.

- **Efficiency & Easement:** The Madrid System centralizes trademark security across numerous countries with sole application. This excludes the need for many applications in numerous language each maintained by the separate legal entity.
- **Cost-efficient:** By filing of one application in single currency reduce the administrative procedures and an expense for enterprises. Changes such as renewals and recording assignments require only one procedural step, resulting in a price savings during the trademarks term.
- **Flexibility:** The Madrid System is flexible which allowing enterprises to easily maintain and to increase their security. More Madrid union members also join at a later date, allowing them to sustain their trademark protection tactics as their company and markets expands.
- **Continual Security:** The Madrid System provides continued protection by renewal of registration after every 10 years, excluding the requirement for national renewals in every assigned member nation.
- **Centralized administration:** Allows for an easy recording and management of registration changes containing name, ownership, address and limitations on products and services. This notably simplifies managing a trademark portfolio.

In brief, the Madrid System provides a fast, simplified, and cost-efficient ways to establish and retain global trademark rights. This makes it a very appealing choice for companies seeking worldwide trademark protection.

Registering a mark in the Pakistan only grants security within Pakistan. A trademark proprietor must seek international trademark protection in order to secure their brand outside of the Pakistan. When trademark proprietor gets international certification, they may use the mark outside of the Pakistan while ensuring other parties cannot register for similar brand world widely.

Conclusion

In conclusion, the Madrid Protocol has revolutionized trademark registration. Pakistan has joined the Madrid Protocol so that businesses in Pakistan can now avail the benefits of this system. It helps in protecting their trademarks internationally. The Madrid Protocol allows businesses to secure trademark protection in multiple countries through a single application. It eliminates the need for multiple applications in different languages and currencies. The Madrid System provides a flexible process of trademark registrations. International trademark registration provides legal protection against violation in foreign countries. It ensures that the trademark owner has exclusive rights to their valuable asset. International trademark registration protects the brand during export or import by preventing trademark misuse by foreign parties. The process of international trademark registration under the Madrid Protocol includes several steps like a trademark search, completing the registration application, WIPO examination, notice to member countries, any opposition proceedings (if any) and then the international trademark registration is granted. The Classification system of nice helps to classify goods and services for trademark registration. It makes the process recognized world-widely. The Madrid protocol is cost-effective procedure for achieving global trademark rights. It is valuable for those global businesses which seeks an international trademarks protection.

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