



## THE PATENTS ORDINANCE, 2000



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# THE PATENTS ORDINANCE, 2000

## ORDINANCE NO. LXI of 2000

[2nd December, 2000]

<sup>1</sup>[An Ordinance to amend and consolidate the law relating to patents in order to give effect in Pakistan to the provisions of the International Convention on Trade Related Intellectual Property Rights, 1994, in accordance with its objectives and principles.

WHEREAS it is expedient to amend and consolidate the law relating to patents;]

AND WHEREAS the National Assembly and the Senate stand suspended in pursuance of the Proclamation of Emergency of the fourteenth day of October, 1999, and the Provisional Constitution Order No. 1 of 1999;

AND WHEREAS the President is satisfied that circumstances exist which render it necessary to take immediate action;

NOW, THEREFORE, in pursuance of the Proclamation of Emergency of the fourteenth day of October, 1999, and the Provisional Constitution Order No. 1 of 1999, read with the Provisional Constitution (Amendment) Order No. 9 of 1999, and in exercise of all powers enabling him in that behalf, the President of the Islamic Republic of Pakistan is pleased to make and promulgate the following Ordinance:—

### CHAPTER I

#### PRELIMINARY

**1. Short title, extent and commencement.**—(1) This Ordinance may be called the Patents Ordinance, 2000.

(2) It extends to the whole of Pakistan.

(3) It shall come into force at once except the provisions relating to examination, sealing, grant and post-grant matters of the patents relating to chemical products intended for use in agriculture and medicines, but excluding the grant of exclusive marketing rights therefore and mail box filings which shall come into force on and from the first day of January, 2005.

**2. Definitions.** In this Ordinance, unless there is anything repugnant in the subject or context,—

- (a) “assignee” includes the legal representative of deceased assignee and references to the assignee of any person includes references to the assignee of the legal representative or assignee of that person;

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<sup>1</sup>Subs. by the Patents (Amdt.) Ordinance, 2002 (95 of 2002), s. 2, for “long title and preamble.”

- (b) “Controller” means the Controller of Patents appointed under section 3;
- (c) “Convention application” means an application made in Pakistan within twelve months after the date of an application made in a Convention country, whether claiming single or multiple priorities from such application;
- (d) “Convention country” means a member country of the World Trade Organization or a country declared as such under section 86;
- <sup>1</sup>[(e) “date of advertisement”, wherever appearing in this Ordinance, shall be the date on which the patents’ journal is published or uploaded on website of the Intellectual Property Organization of Pakistan or printed in hard form in relevant part of the official Gazette, whichever is earlier;]
- (f) “date of filing”, in relation to an application for a patent, means-
  - (i) in case of an application which is post-dated or ante-dated under this Ordinance, the date to which it is so post-dated or ante-dated; and
  - <sup>2</sup>[(ii) the date on which it is filed at the Patent Office or its branch office;]
- (g) “District Court” has the meaning assigned to that expression by the Code of Civil Procedure, 1908 (Act V of 1908);
- (h) “exclusive licence” means a licence from a proprietor of, or an applicant of, a patent which confers on the licensee, or on the licensee and persons authorized by him, to the exclusion of all other persons, including the proprietor or applicant, any right in respect of the invention, to which the patent or application relates, and “exclusive licensee” and “non-exclusive licensee” shall be construed accordingly;
- <sup>3</sup>[(i) “invention” means any new and useful product or process, in any field of technology and includes any new and useful improvement of either of them;]
- (j) “inventor” means the actual devisor of an invention, and joint inventor shall be construed accordingly;
- (k) “legal representative” means a person who in law represents the estate of a deceased person;
- <sup>4</sup>[(ka) “mail box” means the mailbox facility provided under sub-section (9) of section 13;]

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<sup>1</sup>Subs by Act XXIV of 2016, s.2.

<sup>2</sup>Subs by the Patents (Amdt.) Ordinance, 2002 (95 of 2002), s. 3, for sub-clause (ii).

<sup>3</sup>Subs *ibid.*, for clause (i).

<sup>4</sup>New clause (ka) ins. *ibid.*,

- (l) “patent agent” means an advocate or a person for the time being registered under this Ordinance as a patent agent;
- (m) “patentee” in relation to a patent, means the person or persons for the time being entered on the Register as the grantee or proprietor of the patent and includes any subsequent assignee or successor-in-interest of a patent recordal of whose name on the Register is pending with the Controller;
- (n) “patent of addition” means a patent of addition granted in accordance with section 39;
- (o) “Patent Office” means the Patent Office established, or deemed to have been established, under section 4;
- <sup>1</sup>[(p) “person” means any natural or juridical person and includes any association or body of individuals, whether incorporated or not;]
- (q) “person interested” includes a person engaged in, or in promoting, research in the same field as that to which the invention relates;
- (r) “prescribed” means prescribed by rules made under this Ordinance;
- <sup>2</sup>[(s) “process” means any art, process or method or manner of new manufacture of a product;]
- <sup>3</sup>[(t) “product” means any substance, article, apparatus or machine;]
- (u) “published” means made available to the public whether in Pakistan or elsewhere and a document shall be taken to be published under any provision of this Ordinance, if it can be inspected as of right at any place in Pakistan by members of public, whether on payment or free of cost;
- (v) “Register” means the Register of Patents maintained under section 54; and
- (w) “rules” means rules made under this Ordinance.

## CHAPTER II

### ADMINISTRATION

**3. Appointment of Controller and other officers.**—(1) For the purposes of this Ordinance, the Federal Government shall, by notification in the official Gazette, appoint an officer who shall be called the Controller of Patents.

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<sup>1</sup>Subs. by the Patents (Amdt.) Ordinance, 2002 (95 of 2002), s. 3 for clause (p).

<sup>2</sup>Subs. *ibid.*, for clause (s).

<sup>3</sup>Subs. *ibid.*, for clause (t).

(2) The Federal Government shall appoint such other officers with such designations as it deems fit.

**4. Patent Office.**—(1) For the purposes of this Ordinance, there shall be established a Patent Office:

Provided that until such time the Patent Office is established, the Patent Office established under the Patents and Designs Act, 1911, (Act II of 1911) shall be the Patent office for the purposes of this Ordinance.

(2) The Patent office shall be under the immediate control of the Controller who shall act under the superintendence and direction of the Federal Government.

(3) The Patent Office shall be entrusted with all the functions relating to the procedure for the grant of patents and for the administration of granted patents as specified in this Ordinance and rules.

(4) There shall be a seal of the Patent Office and impression of the seal shall be judicially noticed.

**5. Officers and employees incapable of an interest in a patent.** Any officer or a person employed in the Patent Office shall be incapable during the period of his appointment and for one year thereafter of applying for a patent or of acquiring, directly or indirectly, except by inheritance or bequest, any patent issued or to be issued by the Patent Office.

**6. Officers and employees not to divulge certain information or advise in certain matters.** An officer or a person employed in the Patent Office shall not, except when required or authorized by this Ordinance or under a direction in writing of the Controller or by order of the Court:—

- (a) divulge any information available to him by virtue of his office in respect of any application for a patent or a patent granted in Pakistan; or
- (b) advise in a matter which is under consideration or is likely to come under consideration of the Patent Office in pursuance of this Ordinance.

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### CHAPTER III PATENTABILITY

**7. Patentable inventions.**—(1) Any invention is patentable, if it is new, involves an inventive step and is capable of industrial application.

(2) Subject to sub-section (3), the following shall not be regarded as invention within the meaning of sub-section (1), namely:—

- (a) a discovery, scientific theory or mathematical method;

- (b) a literary, dramatic, musical or artistic work or any other creation of purely aesthetic character whatsoever;
- (c) a scheme, rule or method for performing a mental act, playing a game or doing business <sup>1</sup>\*.
- (d) the presentation of information <sup>2</sup>[;and]
- <sup>3</sup>[(e) substances that exist in nature or if isolated therefrom.]

(3) The provisions of sub-section (2) shall prevent anything from being treated as an invention for the purposes of this Ordinance only to the extent that a patent or an application for a patent relates to that thing as such.

(4) A patent shall not be granted:

- <sup>4</sup>[(a) for invention the prevention of commercial exploitation of which would be necessary to protect the “*ordre public*” or morality, including to protect human, animal or plant life or health or to avoid serious prejudice to the environment, provided that such exclusion is not made merely because the exploitation is prohibited by any law for the time being in force;]
- <sup>5</sup>[(b) for plants and animals other than micro-organisms, and essentially biological processes for the production of plants or animals other than non-biological and microbiological processes;]
- (c) for <sup>6</sup>[diagnostic,] therapeutic and surgical methods for the treatment of humans or animals;
- <sup>7</sup>[(d) for a new or subsequent use of a known product or process; and
- (e) for a mere change in physical appearance of a chemical product where the chemical formula or process of manufacture remains the same provided that this clause shall not apply to an invention fulfilling the criteria of patentability.]

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<sup>1</sup>The word “and” omitted by the Patents (Amdt.) Ordinance 2002 (95 of 2002), s. 4.

<sup>2</sup>Subs.and added *ibid.*, for full stop.

<sup>3</sup>New clause (e) added *ibid.*,

<sup>4</sup>Subs. *ibid.*; for clause (a).

<sup>5</sup>Subs. *Ibid.*

<sup>6</sup>Subs. *ibid.*, for “diagnostic”.

<sup>7</sup>New clauses (d) and (e) added *ibid.*,

**8. Novelty.**-(1) An invention shall be considered to be new if it does not form part of the state of the art.

(2) The state of the art shall comprise—

- (a) everything disclosed to the public anywhere in the world, by publication in tangible form or by oral disclosure, by use or in any other way, prior to the filing or, where appropriate, the priority date, of the application claiming the invention; <sup>1</sup>[or]
- (b) contents of the complete specification and priority documents published under section 21 of an application filed in Pakistan.
- <sup>2</sup>[(c) traditionally developed or existing knowledge available or in possession of a local or indigenous community.]

<sup>3</sup>[(3) Notwithstanding the provisions of sub-section (2), disclosure of a patentable invention in respect of goods shall not constitute, ‘state of the art’ if an article is exhibited at any official or officially recognized international exhibition within twelve months preceding the date of filing of an application for grant of patent. If later on, the right of priority is invoked, then the period shall start from the date of introduction of the article into the exhibition. The Controller may require proof, with such documentary evidence as considered necessary, of the identity of the article exhibited and the date of its introduction into the exhibition.]

(4) In this section references to the inventor include references to any proprietor of the invention for the time being.

**9. Inventive step.** An invention shall be considered as involving an inventive step if it has not been obvious to a person, prior to the date of application for a patent, skilled in the art having regard to any matter which forms part of the state of art by virtue of <sup>4</sup>\* \* \* section 8.

**10. Industrial application.** —<sup>5</sup>[(1) An invention shall be considered to be capable of industrial application if it is capable of being manufactured or otherwise industrially used.].

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<sup>1</sup>Subs. by the Patent (Amdt.) Ordinance 2002 (95 of 2002), s.5 for “and”.

<sup>2</sup>New clause (c) added *ibid.*,

<sup>3</sup>Subs. *Ibid* for sub-section (3).

<sup>4</sup>The certain words omitted *ibid.*, s. 6.

<sup>5</sup>Subs. *ibid.*, s. 7 for sub-section (1).

<sup>6</sup>Sub-section (2) omitted *ibid.*,

## CHAPTER IV APPLICATIONS

**11. Persons entitled to make an application for patent.**—(1) Any of the following persons, whether alone or jointly with any other person, may make an application for a patent, namely:—

- (a) the true and the first inventors or inventors of the invention or his or, as the case may be, their assignee or successor in interest; and
- (b) the legal representative of any deceased person who immediately before his death was entitled to make such application.

**12. Right to patent for invention made by employee.** The right to the patent for an invention made by an employee during the course of his employment in the area of activity of the employer shall, in the absence of contractual obligation to the contrary belong to the inventor unless the employer proves that the invention could not have been made without the use of employer's facilities, equipment and the like necessary for the invention:

Provided that an invention of exceptional economic value shall entitle the inventor to an equitable remuneration taking into account the nature of his duties, his salary and the benefits derived by the employer.

**13. Application for patent.**—(1) Every application for the patent shall be made in the prescribed form and shall be filed at the Patent Office in the prescribed manner and shall contain a declaration to the effect that the applicant is in possession of an invention of which he, or in the case of the joint application, at least one of the applicants, claims to be the true and the first inventor or the legal representative or assignee of such inventor or, as the case may be, inventors, provided that where the inventor is not the applicant, he shall be entitled to be mentioned as such in the application and if he is not so mentioned the Controller may, upon an application made in the prescribed manner and after hearing any interested person, insert the name of such person as an inventor or co-inventor, as the case may be, if he is satisfied that he be named as an inventor of the invention for which the applicant desires, to obtain a patent.

(2) Where applications for protection have been made in one or more Convention countries in respect of two or more invention which are cognate or of which one is modification of another, a single Convention application may, subject to the provisions of section 15, be made in respect of those inventions at any time within twelve months from the date of the earliest of the said applications for protection.

(3) Each application shall relate to one invention only <sup>1</sup>\* \* \*.

(4) The applicant may, before the acceptance of the application, divide it into two or more applications, hereinafter referred to as divisional applications, provided that each divisional application shall not go beyond the disclosure in the first application.

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<sup>1</sup>The certain words omitted by the Patents (Amdt.) Ordinance, 2002 (95 of 2002), s. 8.

(5) Each divisional application shall be entitled to the filing date and, where applicable, the priority date of the first application.

(6) The fact that a patent has been granted on an application that did not comply with the requirement of unity of invention shall not be a ground for the invalidation of the patent.

(7) The applicant may at anytime withdraw the application by making a request to the Controller <sup>1</sup>[:]

<sup>1</sup>[Provided that where the application has been withdrawn before the advertisement of its acceptance in the official Gazette or publication in the patents journal, the application and the specification, claims and drawings, if any, shall not be open to public inspection.]

<sup>2</sup>[(8) An application for an invention relating to genetically modified organisms shall require clearance from the Federal Government and shall comply with such requirement as may be prescribed.

(9) An application for availing exclusive marketing rights for a patentable invention relating to pharmaceutical or agricultural chemical product shall be filed in the mailbox provided for this purpose by the Controller who may require the form and manner for submitting such application as may be prescribed] <sup>1</sup>[.]

<sup>1</sup>[\* \* \*]

**14. Complete and provisional application.**—(1) Every application for a patent, other than a Convention application, shall be accompanied by either a complete specification or a provisional specification, and every Convention application shall be accompanied by a complete specification.

(2) Where an application for a patent is accompanied by a provisional specification, a complete specification shall be filed within twelve months from the date of filing of the application, and if the complete specification is not so filed the application shall be deemed to be abandoned.

(3) Where two or more applications in the name of the same applicant are accompanied by provisional specification in respect of invention which are cognate or of which one is a modification of another, and the Controller is of the opinion that the whole of such inventions or such as to constitute a single invention and properly be included in one patent, he may allow one complete specification to be filed in respect of all such provisional specifications.

(4) Where an application for a patent, not being a Convention application, is accompanied by a specification purporting to be a complete specification, the Controller may, if the applicant so requests at any time before the acceptance of the specification, direct that it shall be treated for the purposes of this Ordinance as a provisional specification, and proceed with the application accordingly.

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<sup>1</sup>Subs, Added and Omitted by Act XXIV of 2016, s.3.

<sup>2</sup>New sub-sections (8) and (9) of s. 13 added by s. 8 of Ord.no XCV of 2002.

(5) Where a complete specification has been filed in pursuance of an application for a patent accompanied by a provisional specification or by a specification treated by virtue of a direction under sub-section (4) as a provisional specification the Controller may, if the applicant so requests at any time before the acceptance of the complete specification, cancel the provisional specification and post-date the application to the date of filing of the complete specification.

**15. Contents of specification.**—<sup>1</sup>[(1) Every specification, whether complete or provisional, shall describe in the form and manner as may be prescribed.]

(2) Subject to any rules made in this behalf, drawings may, and shall if the Controller so requires, be supplied for the purposes of any specification, whether complete or provisional, and any drawings so supplied shall, unless the Controller otherwise directs, be deemed to form part of the specification, and reference in this Ordinance to a specification shall be construed accordingly.

<sup>2</sup>[(2A) For a chemical product intended for use in medicine or agriculture, the specification shall be specific to one chemical product only describing the physical, chemical, pharmacological and pharmaceutical properties or, as the case may be, the properties related to its use in agriculture and its impact on environment.

(2B) Where a biological material is used, the specification shall disclose the place of origin and source of such biological material and shall also exhibit compliance with the relevant applicable rules on access, export and use of that material and where such a material is obtained from Pakistan for use outside Pakistan, the permission of the Federal Government shall be necessary as may be prescribed.]

(3) Every complete specification shall—

- (a) fully and particularly describe the invention and the method by which it is to be performed;
- (b) disclose the invention which is known to the applicant and for which he is entitled to claim protection; and
- <sup>3</sup>[(c) end with a claim or claims concisely defining the scope of the invention for which protection is claimed.]

(4) The claim or claims of a complete specification shall relate to a single invention, shall be clear and succinct and shall be fairly based on the matter disclosed in the specification.

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<sup>1</sup>Subs. by the Patents (Amdt.) Ordinance, 2002 (95 of 2002), s. 9, for sub-section (1).

<sup>2</sup>New sub-sections (2A) and (2B) ins. *Ibid* s.9.

<sup>3</sup>Subs. *ibid.*, for clause (c)

(5) Subject to the foregoing provisions of this section, a complete specification filed after a provisional specification, or filed with a Convention application, may include claims in respect of developments of, or additions to, the invention which was described in the provisional specification or, as the case may be, the invention in respect of which the application for protection was made in a Convention country, being developments or additions in respect of which the applicant would be entitled under the provisions of section 11 to make a separate application for a patent.

(6) Every complete specification shall be accompanied by an abstract for the purposes of giving technical information and the Controller shall determine whether the abstract fulfills its purpose and, if it does not, shall instruct the applicant to make modifications to the satisfaction of the Controller.

(7) The abstract shall merely serve the purpose of technical information, in particular, it shall not be taken into account for the purpose of interpreting the scope of protection.

<sup>1</sup>[(8) Claim or claims in respect of a complete specification of a chemical product intended for use in agriculture or medicine shall be structurally defined and shall relate to a single chemical product only, excluding its derivatives and salts, each of which, with a material or a novel improvement in its claim from the main product, shall be filed as a separate invention or where applicable, as a divisional application, Where structural description is not possible, as in the case of biological products, the “product by process” claim shall be made and protection shall be limited to the product obtained with the claimed process only:

Provided that a claim which is based on a mere admixture resulting only in aggregation of the properties of the component substances thereof, or a processing of producing such substance, shall not be allowed].

## CHAPTER V

### EXAMINATION OF APPLICATIONS

**16. Examination of application.**—(1) The Controller shall refer to an examiner every application in respect of which a complete specification has been filed, for making a report to the Controller after detail scrutiny of the application, specification, claims and drawing, if any, to the effect whether the invention is new and involves an inventive step, and to also determine whether other requirements of this Ordinance and rules have been complied with.

(2) The examiner shall make the report to the Controller as soon as is reasonably possible.  
<sup>2</sup>[\* \* \*]

(3) If the examiner reports that any of the requirements of this Ordinance and rules are not complied with, the Controller shall give the applicant an opportunity, or more than one opportunity, to comply with such requirements as may be mentioned in the said report and to amend the application, if necessary, within such time as may be prescribed, failing which the Controller may refuse to proceed with the application.

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<sup>1</sup>New sub-section (8) added by the Patents (Amdt.) Ordinance, 2002 (95 of 2002) s.9.

<sup>2</sup>Omitted and shall be deemed always to have been so omitted by Act IX of 2010, s.2.

(4) If the Controller considers, at any time, before the acceptance of the application, that the invention claimed therein has been wholly or in part claimed in a specification published on or after the date which the patent applied for would bear, if granted appertaining to an application for grant of a patent which, if granted, will be prior date to the patent applied for, he may require that the applicant's specification be amended by the insertion of a reference to such other specification by way of notice to the public.

(5) The investigation required under this section shall not be held in any way to guarantee the validity of any patent, and no liability shall be incurred by the Federal Government or any officer by reason of, or in connection with, any such investigation or any proceeding consequent thereon.

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(6) Notwithstanding anything in the preceding sub-sections, all applications claiming protection for chemical products intended for use in medicine or agriculture filed after the first day of January, 1995, in accordance with Article 70 (8) and 70 (9) of the World Trade Organization Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPs), shall be dealt with in accordance with sub-section (3) of section 1.

**17. Reference to other patent.**—(1) If, in consequence of the investigation under section 16, it appears to the Controller that an invention in respect of which application for a patent has been made cannot be performed without substantial risk of infringement of a claim of any other patent, he may direct that a reference to that other patent shall be inserted in the applicant's complete specification by way of notice to the public unless, within such time as may be prescribed, either—

- (a) the applicant shows to the satisfaction of the Controller that there are reasonable grounds for contesting the validity of the said claim of the other patent; or
- (b) the complete specification is amended to the satisfaction of the Controller.

(2) Where, after a reference to another patent has been inserted in a complete specification in pursuance of a direction under sub-section (1)—

- (a) that other patent is revoked or otherwise ceases to be in force;
- (b) the specification of that other patent is amended by the deletion of the relevant claim; or
- (c) it is found, in proceedings before the court or the Controller, that the relevant claim of that other patent is invalid or is not infringed by any working of the applicant's invention,

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<sup>1</sup>Omitted by Act IX of 2010, s.2.

the Controller may, on the application of the applicant, delete the reference to that other patent.

**18. Substitution of applicants, etc.**—(1) If the Controller is satisfied, on an application made in the prescribed manner at any time before a patent has been granted, that by virtue of any assignment or agreement in writing made by the applicant or one of the applicants for the patent, or by operation of law, the claimant would, if the patent were then granted, be entitled thereto or to the interest of the applicant therein, or to an undivided share of the patent or of that interest, the Controller may, subject to the provisions of this section, direct that the application shall proceed in the name of the claimant or in the names of the claimants and the applicant or the other joint applicant or applicants, as the case may require.

(2) No such direction under sub-section (1) shall be given by virtue of any assignment or agreement made by one of two or more joint applicants for a patent except with the consent of the other joint applicant or applicants.

(3) No such direction under sub-section (1) shall be given by virtue of any assignment or agreement for the assignment of the benefit of an invention unless—

- (a) the invention is identified therein by reference to the number of the application for the patent;
- (b) there is produced to the Controller an acknowledgement by the person by whom the assignment or agreement was made that the assignment or agreement relates to the invention in respect of which that application is made;
- (c) the rights of the claimant in respect of the invention have been finally established by a decision of a court; or
- (d) the Controller gives directions for enabling the application to proceed or for regulating the manner in which it should be proceeded with under sub-section (5).

(4) Where one of two or more joint applicants for patent dies at any time before the patent has been granted, the Controller may, upon a request in that behalf made by the survivor or survivors, and with the consent of the legal representative of the deceased, direct that the application shall proceed in the name of the survivor or survivors alone.

(5) If any dispute arises between joint applicants for a patent whether or in what manner the application should be proceeded with, the Controller may, upon application made to him in the prescribed manner by any of the parties, and after giving to all parties concerned an opportunity of being heard, give such directions as he thinks fit for enabling the application to proceed in the name of one or more of the parties alone or for regulating the manner in which it should be proceeded with, or for both those purposes, as the case may require.

<sup>1</sup>[19. \* \* \*]

**20. Power of Controller to require certain information and documents relating to foreign application.**—(1) The applicant shall, when required by the Controller, furnish him with the date and number of any application for a patent filed by him abroad, hereinafter referred to as foreign application, relating to the same or essentially the same invention as that claimed in the application filed in Pakistan.

(2) The applicant shall, when required by the Controller, furnish him with the following documents relating to one of the foreign applications referred to in sub-section (1), namely:—

- (i) a copy of any communication received by the applicant concerning the results of any search or examination carried out in respect of the foreign application;
- (ii) a copy of the patent granted on the basis of the foreign application; and
- (iii) a copy of any final decision rejecting the foreign application.

(3) The applicant shall, when required by the Controller, furnish him with a copy of any final decision invalidating the patent granted on the basis of foreign application referred to in sub-section (1).

**21. Acceptance of complete specification.** On the acceptance of a complete specification, the Controller shall give notice thereof to the applicant and shall advertise in the official Gazette <sup>2</sup>[and publish in the patent's journal] the fact that specification has been accepted and thereupon the application and the specification, and the priority documents, if any, filed in pursuance thereof shall be open to public inspection.

**<sup>3</sup>22. Effect of acceptance of complete Specification.** After the acceptance of an application and until the date of sealing a patent in respect thereof, or the expiration of the time for sealing, the applicant shall have the like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance of the application:

Provided that the applicant shall not be entitled to institute any proceedings for infringement until the patent has been sealed.]

## CHAPTER VI OPPOSITION TO GRANT OF PATENT

**23. Opposition to the grant of patent.**—(1) At any time within four months from the date of advertisement of the acceptance of a complete specification under this Ordinance, any person may give notice to the Controller of opposition to the grant of patent on any of the following grounds, namely:—

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<sup>1</sup>Omitted by Act IX of 2010, s.3.

<sup>2</sup>Ins by Act XXIV of 2016, s.4.

<sup>3</sup>Subs. by the Patents (Amdt.) Ordinance, 2002 (95 of 2002), s. 10. for the original section (22).

- (a) that the applicant for the patent obtained the invention or any part thereof from him or from the person of whom the opponent is the legal representative, assignee, agent or attorney;
- (b) that the invention is not a patentable invention within the meaning of this Ordinance;
- (c) that the specification does not disclose the invention in a manner clear and complete enough for it to be carried out by a person skilled in the art;
- (d) that the claims are not clear or extend beyond the scope of the disclosures in the complete specification as originally filed; and
- (e) that the complete specification describes or claims an invention other than that described in the provisional specification and that such other invention either forms the subject of an application made by the opponent for a patent which if granted would bear a date in the interval between the date of the application and the leaving of the complete specification, or has been made available to the public by publication in any document in that interval.

(2) Where a notice is given under sub-section (2), the Controller shall give notice of the opposition to the applicant, and shall, before deciding the case, give to the applicant and the opponent an opportunity of being heard.

**24. Third party observations on patentability.**—(1) At any time after the publication of the specification under section 21, any person may make observations in writing to the Controller on the novelty of the invention giving evidence in support of his observations and the Controller shall consider the observations in the light of the evidence made available to him before the grant of patent.

(2) The person who makes observations under sub-section (1) shall not become a party to the proceedings under this Ordinance before the Controller by reason only that he has made the observations, failing which the observations shall be rejected as if not filed at all.

## CHAPTER VII

### PROVISIONS FOR SECRECY OF CERTAIN INVENTIONS

**25. Information prejudicial to defence of Pakistan or safety of public.**—(1) Where an application for a patent in respect of an invention is filed in the patent Office and it appears to the Controller that the invention is one of the class notified to him by the Federal Government as being one the publication of which might be prejudicial to the defence of Pakistan, or if he himself thinks so, then he may give directions prohibiting or restricting the publication of the invention or its communication to any specified person or class of persons.

(2) If it appears to the Controller that the specification of any application so filed contains information the publication of which might be prejudicial to the safety of the public, he may give

directions prohibiting or restricting the publication of that information or its communication to any person until the end of a period not exceeding three months from the date of the acceptance.

(3) While directions are in force under this section, the application may proceed to the stage where it is in order for acceptance, but specification shall not be published.

(4) Where the Controller gives directions under this section with respect to any application, he shall give notice of the application and of the directions to the Federal Government and the following provisions shall then have effect, namely:—

- (a) the Federal Government shall, on receipt of the notice, consider whether the publication of the invention or the publication or communication of the information in question would be prejudicial to the defence of Pakistan or the safety of the public;
- (b) if the Federal Government determine under clause (a) that the publication of the specification or the publication or communication of that information would be prejudicial to the safety of the public, it shall give notice to the Controller who shall continue his directions under sub-section (2) until they are revoked under clause (e);
- (c) if the Federal Government determine under clause (a) that the publication of the specification or the publication or communication of that information would be prejudicial to the defence of Pakistan or the safety of the public, it shall, unless a notice under clause (d) has previously been given to the Controller, reconsider that question during the period of nine months from the date of filing the application and at least once in every subsequent period of twelve months;
- (d) if on consideration of an application at any time it appears to the Federal Government that the publication of the specification or the publication or communication of the information contained in it would not, or would no longer, be prejudicial to the defence of Pakistan or the safety of the public, it shall give notice to the Controller to that effect; and
- (e) on receipt of a notice under clause (d), the Controller shall revoke the directions and may, subject to such conditions, if any, as he thinks fit, extend the time for doing any thing required or authorized to be done by or under this Ordinance in connection with the application, whether or not that time has previously expired.

(5) Where a complete specification filed in pursuance of an application for a patent for an invention in respect of which directions have been given under this section is accepted before the directions are revoked, then—

- (a) if any use of the invention is made by or on behalf or to the order of the Federal Government, the provisions of section 58 shall apply in relation to that use as if the patent has been granted for the invention; and
- (b) if it appears to the Federal Government that the applicant for the patent has suffered hardship by reason of the continuance in force of the directions, the

Federal Government may make such payment, if any, by way of compensation to the applicant as appears to the Federal Government to be reasonable having regard to the inventive merit and utility of the invention, the purpose for which it is designed and any other relevant circumstances.

(6) Where a patent is granted in pursuance of an application in respect of which directions have been given under this section, no renewal fees shall be payable in respect of any period during which those directions were in force.

**26. Residents not to apply outside Pakistan without permission.**—(1) No person resident in Pakistan shall, without written authority granted by the Controller, file or cause to be filed outside Pakistan an application for the grant of a patent for an invention unless—

- (a) an application for patent for the same invention has been filed in the Patent Office not less than six weeks before the application outside Pakistan; and
- (b) either no directions have been given under section 25 in relation to the application in Pakistan or all such directions have been revoked.

(2) The provisions of sub-section (1) shall not apply in Pakistan to an invention in respect of which an application for a patent has first been filed in a country outside Pakistan by a person resident outside Pakistan.

## CHAPTER VIII

### GRANT AND SEALING OF PATENT

**27. Grant and sealing of Patent.**—(1) Subject to the provisions of this Ordinance with respect to opposition and to any power of the Controller to refuse the grant, a patent sealed with the seal of the Patent Office shall, if the request is made within the time allowed under this section, be granted to the applicant or applicants within that time or as soon as may be thereafter, and the date on which the patent is sealed shall be entered in the Register.

(2) Subject to the provisions of this Ordinance with respect to patents of addition, a request under this section for the sealing of a patent shall be made not later than the expiration of six months from the date of the publication of the complete specification:

Provided that—

- (a) where at the expiration of the said six months any proceedings in relation to the application for the patent is pending in any court or before the Controller, the request may be made within three months after the final determination of that proceedings; and
- (b) where the applicant or one of the applicants has died before the expiration of the time within which under the provisions of this sub-section the request

could otherwise be made, the said request may be made at any time within twelve months after the date of the death or at such later time as the Controller may allow.

**Explanation.**—Any proceedings shall be deemed to be pending so long as the time for any appeal therein has not expired, and any proceedings shall be deemed to be finally determined when the time for any appeal therein has expired without the appeal being brought.

(3) The period for making the request under sub-section (2) for the sealing of a patent may be extended by the Controller by six months if the application is made and the prescribed fee paid within the extended period.

**28. Amendment of patent granted to a deceased person.** Where, at any time after a patent has been sealed in pursuance of an application under this Ordinance, the Controller is satisfied that the person to whom the patent was granted had died, or, in the case of a body corporate, had ceased to exist, before the patent was sealed, he may amend the patent by substituting for the name of that person the name of the person to whom the patent ought to have been granted, and the patent shall have effect, and shall be deemed always to have had effect, accordingly.

**29. Date of patent.**—(1) Subject to the other provisions of this Ordinance, every patent shall be dated as of the filing date of the application and in case of a Convention application the date of such earliest application filed in the Convention country from which priority has been claimed.

(2) The date of every patent shall be entered in the Register.

**30. Rights conferred by patent.** —<sup>1</sup>[(1) Subject to other provisions of this Ordinance, the holder of a valid patent in Pakistan shall have the following rights, namely:-

- (a) Where the subject matter of patent is a product, the holder of valid patent may prevent third parties not having the owner's consent from the acts of making, using, offering for sale, selling, or importing for these purposes that product; and
- (b) where the subject matter of a patent is a process, the holder of a valid patent may prevent third parties not having the owner's consent from the act of using the process, and from the act of using, offering for sale, selling, or importing for these purposes at least the product obtained directly by that process.]

<sup>2</sup>[(2) The holder of a valid patent shall also have the right to assign, or transfer by succession, the patent and to conclude licensing contracts.]

(3) The owner of the patent shall, in addition to any other rights, remedies or actions available to him have the right, subject to sub-section (4) and section 59, to institute court proceedings against any person who infringes the patent by performing, without his agreement, any of the acts referred to in sub-section (2) or who performs acts which make it likely that infringement will occur.

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<sup>1</sup>Subs. by the Patents (Amdt.) Ordinance, 2002 (95 of 2002) s. 11, for sub-section (1).

<sup>2</sup>Subs. *Ibid* s. 11, for sub-section (2).

<sup>1</sup>[(4) Where a person has filed an application in the mailbox, in accordance with sub-section (9) of section 13, for protection of an invention relating to a pharmaceutical or agriculture chemical product, exclusive marketing rights shall be granted for a period of five years after obtaining marketing approved or until a product patent is granted or rejected whichever period is shorter, provided that, subsequent to the first January, 1995, a patent application has been filed and a patent granted for that product in any Convention country and marketing approval obtained in such country;]

<sup>2</sup>[(4A) Where a person has made an invention in Pakistan in respect of a process of manufacture of any of the products referred to in sub-section (4) and has obtained a patent for the same and has filed an application in the mailbox for protection of the invention, and has been granted marketing approval thereof, then he shall have the exclusive marketing rights for that product for a period of five years after obtaining marketing approval or until a product patent is granted or rejected whichever period is shorter.]

(5) The rights under the patent shall not extend to—

- <sup>3</sup>[(a) acts in respect of articles which have been put on the market anywhere in the world by the owner of the patent or with his consent or by an authorized person or in any other legitimate manner such as compulsory licenses;]
- (b) the use of articles on an aircraft, land vehicles or vessels of other countries which temporarily or accidentally enter the airspace, territory or waters of Pakistan;
- (c) acts done only for experimental purposes relating to a patented invention;<sup>4\*</sup>
- (d) acts performed by any person who in good faith, before the filling or, where priority is claimed, the priority date of the application on which the patent is granted in Pakistan, was using the invention or was making effective and serious preparations for such use <sup>5</sup>[;or]
- <sup>3</sup>[(f) acts done for teaching purposes in educational or research institutions.]

(6) The right of prior user referred to in clause (d) of subsection (5), may be transferred or devolve only together with the enterprise or business, or with that part of the enterprise or business, in which the use of preparations for use have been made.

**31. Term of patent.** The term of a patent under this Ordinance shall be twenty years from the filing date.

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<sup>1</sup>Subs. by the Patents (Amdt.) Ordinance, 2002 (95 of 2002), s. 11, for sub-section (4).

<sup>2</sup>New sub-section (4A) ins. *ibid.*,

<sup>3</sup>Subs. *Ibid* for clause (a)."

<sup>4</sup>The word "or" omitted *ibid.*,

<sup>5</sup>Subs. *ibid.*, for full stop.

<sup>6</sup>New clause (f) inserted, *ibid.*

**32. Grant of patents to be subjected to certain conditions.**—(1) Notwithstanding anything in section 31, a patent shall cease to have effect on the expiration of a period for the payment of any renewal fee if that fee is not paid within the prescribed period or within the period as extended under this section.

(2) The period prescribed for the payment of any renewal fee shall be extended to such period not being more than six months if the request is made to the Controller and the renewal fee and the prescribed additional fee is paid before the expiration of the extended period.

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## **CHAPTER IX MISCELLANEOUS PROVISIONS AS TO RIGHTS IN INVENTIONS**

**33. Priority date in case of invention obtained from other person.**—(1) Where an application is made for a patent for an invention which has been claimed in a complete specification filed in pursuance of any other such application, then if—

- (a) the Controller has refused to grant a patent in pursuance of that other application on the ground specified in clause (a) of sub-section (1) of section 23;
- (b) a patent granted in pursuance of that other application has been revoked by the High Court under section 46 or by the Controller under section 47 on the ground specified in clause (a) of sub-section (1) of section 23; or
- (c) the complete specification filed in pursuance of the said other application has been amended by the exclusion of the claim relating to the said invention in consequence of a finding by the Controller that the invention was obtained by the applicant or patentee from any other person,

the Controller may direct that the first-mentioned application and any specification filed in pursuance thereof shall be deemed, for the purposes of the provisions of this Ordinance relating to the priority date of claims of complete specification, to have been filed on the date on which the corresponding document was or was deemed to have been filed in the proceedings upon the said other application.

**34. Grant of patent to two or more persons.**—(1) Where a patent is granted to two or more persons, each of those persons shall, unless an agreement to the contrary is in force, be entitled to an equal undivided share in the patent.

(2) Subject to the provisions of this section and section 35, where two or more persons are registered as grantee or proprietor of a patent, then, unless an agreement to the contrary is in force, each of those persons shall be entitled, by himself or his agents, to exploit, use, exercise and sell the patented invention for his own benefit without accounting to the other person or persons.

(3) Subject to the provisions of this section and section 35 and to any agreement for the time being in force, where two or more persons are registered as grantee or proprietor of a patent, then, a licence under a patent shall not be granted, and a share in a patent shall not be assigned, by one of

such persons, except with the consent of the other person or persons.

(4) Where a patented article is sold by one of two or more persons registered as grantee or proprietor of the patent relating to that article, the purchaser and any person claiming through him shall be entitled to deal with it in the same manner as if the article had been sold by a sole patentee.

(5) Subject to the provisions of this section, the provisions of law applicable to the ownership and devolution of movable property generally shall apply in relation to patents, and nothing contained in sub-section (1) or sub-section (2) shall affect the mutual rights or obligations of trustees or of the legal representatives of a deceased person or their rights or obligations as such.

**35. Power of Controller to give directions to co-owners.**—(1) Where two or more persons are registered as grantee or proprietor of a patent, the Controller may, upon application made to him in the prescribed manner by any of those persons, give such directions in accordance with the application as to the sale or lease of the patent or any interest therein, the grant of licences under the patent, or the exercise of any right under section 39 in relation thereto, as he thinks fit.

(2) If any person registered as grantee or proprietor of the patent fails to execute any instrument or to do any other thing required for the carrying out of any direction given under this section within fourteen days after being requested in writing so to do by any of the other persons so registered, the Controller may, upon application made to him in the prescribed manner by any such other person, give directions empowering any person to execute that instrument or to do that thing in the name and on behalf of the person in default.

(3) Before giving directions in pursuance of an application under this section, the Controller shall give an opportunity of being heard—

- (a) in the case of an application under sub-section (1), to the other person or persons registered as grantee or proprietor of the patent; and
- (b) in the case of an application under sub-section (2), to the person in default.

(4) No direction shall be given under this section so as to affect the mutual rights or obligations of trustee or of the legal representatives of a deceased person, or their rights or obligations as such.

**36. Power of Controller or Court to determine the matter in dispute between employer and employee.** —(1) Where a dispute arises between an employer and a person who is or was at the material time his employee as to the rights of the parties in respect of an invention made by the employee either alone or jointly with other employees or in respect of any patent granted or to be granted in respect thereof, the Controller may, upon application made to him in the prescribed manner by either of the parties and after giving to each of them an opportunity of being heard, determine the matter in dispute, and may make such orders for giving effect to his decision as he considers expedient:

Provided that, if it appears to the Controller upon an application under this section that the matter in dispute involves questions which should be determined by the Court, he may decline to deal therewith.

(2) In proceedings before the Court between an employer and a person who is or was at the

material time his employee, or upon an application made to the Controller under sub-section (1), the Court or, as the case may be, the Controller may, if satisfied that both the parties are entitled to the benefit of an invention made by the employee, by order provide for the apportionment between them of the benefit of the invention, and of any patent granted or to be granted in respect thereof, in such manner as the Court or, as the case may be, the Controller considers just.

(3) A decision of the Controller under this section shall have the same effect as between the parties and persons claiming under them as a decision of the Court.

**37. Avoidance of restrictive condition in contracts.**—(1) Subject to the provisions of this section, any condition of a contract for the sale or lease of a patented article or of an article made by a patented process or for license to exploit a patented article or process, or relating to any such sale, lease or license, shall be void so far as it purports—

- (a) to require the purchaser, lessee or licensee to acquire from the vendor, lessor or licensor, or his nominees, or prohibit him from acquiring from any specified person, or from acquiring except from the vendor, lessor or licensor, or his nominees, any article other than the patented article or an article made by the patented process; or
- (b) to prohibit the purchaser, lessee or licensee from using articles, whether patented or not, which are not supplied by, or any patented process which does not belong to, the vendor, lessor or licensor, or his nominees, or to restrict the right of the purchaser, lessee or licensee to use any such article or process.

(2) In proceedings against any person for infringement of a patent, it shall be a defence to prove that at the time of the infringement there was in force a contract relating to the patent made by or with the consent of the plaintiff and containing a condition void by virtue of this section.

(3) A condition of a contract shall not be void by virtue of this section if—

- (a) at the time of the making of the contract the vendor, lessor or licensor was willing to sell or lease the article, or grant a license to use or exploit the article or process, as the case may be, to the purchaser, lessee or licensee, on reasonable terms specified in the contract and without any such condition as is mentioned in subsection (1); and
- (b) the purchaser, lessee or licensee is entitled under the contract to relieve himself of his liability to observe the condition upon giving to the other party three months notice in writing and subject to payment to him of a just compensation.

**38. Determination of certain contracts.** Any contract for the sale or lease of a patented article or for license to manufacture, exploit a patented article or process, or relating to any such sale, lease or license, whether made before or after the commencement of this Ordinance, may at any time after the patent or all the patents by which the article or process was protected at the time of the making of the contract has or have ceased to be in force, and notwithstanding anything to the contrary in the contract or in any other contract, be determined by either party on giving three months notice in writing to the other party.

## **CHAPTER X**

### **PATENTS OF ADDITION**

**39. Patents of addition.**—(1) Where an application is made for a patent in respect of any improvement in or modification of an invention, hereinafter referred to as the “main invention” and the applicant also applies or has applied for a patent for that invention or is the patentee in respect thereof, the Controller may, if the applicant so requests, grant the patent for the improvement or modification as a patent of addition.

(2) Where an invention, being an improvement in or modification of another invention, is the subject of an independent patent and the patentee in respect of that patent is also the patentee in respect of the patent for the main invention, the Controller may, if the patentee so requests, by order revoke the patent for the improvement of the modification and grant to the patentee a patent of addition in respect thereof, bearing the same date as the date of the patent so revoked.

(3) A patent shall not be granted as a patent of addition unless the date of filing of the complete specification was the same as or later than the date of filing of the complete specification in respect of the main invention.

(4) A patent of addition shall not be sealed before the sealing of the patent for the main invention, and if the period within which, but for this provision, a request for the sealing of a patent of addition could be made expires before the period within which a request for the sealing of the patent for the main invention may be so made, the request for the sealing of the patent of addition may be made at any time within the last-mentioned period.

**40. Term of patents of addition.**—(1) A patent of addition shall be granted for a term equal to that of the patent for the main invention, or so much thereof as is unexpired, and shall remain in force during that term or until the previous cesser of the patent for the main invention and no longer:

Provided that:

- (a) if the term of the patent for the main invention is extended under the foregoing provisions of this Ordinance, the term of the patent of addition may also be extended accordingly; and
- (b) if the patent for the main invention is revoked under this Ordinance, the court or, as the case may be, Controller may order that the patent of addition shall become an independent patent for the remainder of the term of the patent for the main invention, and thereupon the patent shall continue in force as an independent patent accordingly.

(2) No renewal fees shall be payable in respect of a patent of addition, but, if any such patent becomes an independent patent by virtue of an order under sub-section (1), the same fees shall thereafter be payable, upon the same dates, as if the patent had been originally granted as an independent patent.

**41. Patent of addition not to be refused, etc.** The grant of a patent of addition shall not be refused, and a patent granted as a patent of addition shall not be revoked or invalidated on the

ground only that the invention claimed in the complete specification does not involve any inventive step having regard to any publication or use of—

- (a) the main invention described in the complete specification relating thereto; or
- (b) any improvement in or modification of the main invention described in the complete specification of a patent of addition to the patent for the main invention or of an application for such a patent of addition, and the validity of a patent of addition shall not be questioned on the ground that the invention ought to have been the subject of an independent patent.

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## CHAPTER XI

### AMENDMENT OF SPECIFICATION

**42. Amendment of specification with leave of Controller.**—(1) Subject to the provisions of section 44, the Controller may, upon an application made under this section by an applicant for a patent or a patentee, allow the application for the patent or the complete specification to be amended subject to such conditions, if any, as the Controller thinks fit:

Provided that the Controller shall not allow a specification to be amended under this section upon an application made while any action before the Court for infringement of the patent or any proceeding before the court for the revocation of the patent is pending.

(2) Every application for leave to amend and application for a patent or a specification under this section shall state the nature of the proposed amendment and give full particulars of the reasons for which the application is made.

(3) Every application for leave to amend an application for a patent or a specification under this section made after the acceptance of the complete specification and the nature of the proposed amendment shall be advertised in the prescribed manner.

(4) Within the prescribed period after the advertisement of an application under sub-section (3), any person may give notice to the Controller of opposition thereto, and where such a notice is given within the period aforesaid, the Controller shall give notice to the person by whom the application is made and shall give to that person and to the opponent an opportunity of being heard before he decides the case.

(5) This section shall not apply in relation to any amendment of a specification effected in proceedings in opposition to the grant of a patent or effected in pursuance of any provision of this Ordinance authorizing the Controller to direct a reference to another specification or patent to be inserted, or to refuse to grant a patent, or to revoke a patent, unless the specification is amended to his satisfaction.

**43. Amendment of specification with leave of High Court.**—(1) In any proceeding before the High Court for the revocation of a patent, the High Court may, subject to the provisions of section 44, by order allow the patentee to amend his complete specification in such manner, and subject to such terms as to costs, advertisements or otherwise, as the High Court may think fit, and if

in any such proceedings for revocation the High Court decides that the patent is invalid, the High Court may allow the specification to be amended under this section instead of revoking the patent.

(2) Where an application for an order under this section is made to the High Court the applicant shall give notice of the application to the Controller, and the Controller shall be entitled to appear and be heard, and shall appear if so directed by the High Court.

**44. Supplementary provisions as to amendment of specification.**—(1) No amendment of specification shall be allowed, except for the purpose of correcting an obvious mistake, the effect of which would be that the specification as amended would claim or describe matter not in substance disclosed in the specification before the amendment.

(2) Where, after the date of the publication of a complete specification, any amendment of the specification is allowed or approved by the Controller or the High Court under this Ordinance, the right of the patentee or applicant to make the amendment shall not be called in question except on the ground of fraud, and the amendment shall for all purposes be deemed to form part of the specification:

Provided that in construing the specification as amended reference may be made to the specification as originally published.

(3) Where, after the date of the publication of a complete specification, any amendment of the specification is allowed or approved under this section, the fact that the specification has been amended shall be advertised in the official Gazette <sup>1</sup>[and published in the Patents' journal].

## CHAPTER XII

### RESTORATION OF LAPSED PATENTS

**45. Restoration of lapsed patents.**—(1) Where a patent has ceased to have effect by reason of a failure to pay any renewal fee within the prescribed period, an application for the restoration of the patent may be made to the Controller under this section within eighteen months from the date on which the patent ceased to have effect.

(2) An application under this section may be made by the person she was the proprietor of the patent or by any other person who would have been entitled to the patent if it had not ceased to have effect, and where the patent was held by two or more persons jointly, the application may, with the leave of the Controller, be made by one or more of them without joining the others.

(3) If the Controller is satisfied that—

- (a) the proprietor of the patent took reasonable care to see that any renewal fee was paid within the prescribed period or that the fee and any prescribed additional fee were paid within six months immediately following the end of that period; and

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<sup>1</sup>Ins. by Act of XXIV of 2016,s.5.

(b) those fees were not so paid because of circumstances beyond his control,

the Controller shall by order restore the patent on payment of any unpaid renewal fee and any prescribed additional fee.

(4) An order under this section may be made subject to such conditions as the Controller thinks fit and if the proprietor of the patent does not comply with any condition of such an order, the Controller may revoke the order and give such directions consequential on the revocation as he thinks fit.

(5) Where an order is made under this section and, between the end of the period of six months beginning with the date when the patent concerned ceased to have effect and the date of the application under this section, any person has begun in good faith to use the patented invention has made effective and serious preparations to make use of the invention, he shall, after the order comes into force, have the right to make use of the invention and the said use shall not amount to an infringement of the patent concerned.

(6) Where a patented product is disposed of by any person to another in exercise of a right conferred by sub-section (5), that other and any other person claiming through him shall be entitled to deal with the product in the same way as if it had been disposed of by a sole registered proprietor.

## CHAPTER XIII

### REVOCATION AND SURRENDER OF PATENTS

**46. Revocation of patent by High Court.**—(1) Subject to the provisions of this Ordinance, a patent may, on the petition of any person interested or of the Federal Government or on a counter-claim in a suit for infringement of the patent, be revoked in part or in whole by the High Court on any one or more of the grounds upon which grant of patent may be refused.

(2) Without prejudice to the provisions contained in sub-section (1), a patent may be revoked by the High Court on the petition of the Federal Government, if the High Court is satisfied that the patentee has without reasonable cause failed to comply with the request of the Federal Government to make, use or exercise the patented invention for the services of the Government upon reasonable terms.

(3) A notice of any petition for revocation of a patent under this section shall be served on all persons appearing from the Register to be proprietor of that patent or to have shares or interests therein, and it shall not be necessary to serve a notice on any other person.

**47. Revocation of patent by Controller.**—(1) At any time within twelve months after the sealing of a patent, any person interested who did not oppose the grant of the patent may apply to the Controller for an order revoking the patent on any one or more of the grounds upon which the grant of the patent could have been opposed:

Provided that when an action for infringement, or proceedings for the revocation, of a patent are pending in any court, an application to the Controller under this section shall not be made except with the leave of the court.

(2) Where an application is made under this section, the Controller shall give notice to the patentee and shall give to the applicant and the patentee an opportunity of being heard before deciding the case.

(3) If, on an application under this section, the Controller is satisfied that any of the grounds specified in sub-section (1) are established, he may by order direct that the patent shall be revoked either unconditionally or unless within such time as may be specified in the order the complete specification is amended to his satisfaction:

Provided that the Controller shall not make an order for the unconditional revocation of a patent under this section unless the circumstances are such as would have justified him in refusing to grant the patent.

**<sup>1</sup>[48.— Revocation of patent by the Federal Government.** Where the Federal Government is of the opinion that:—

- (a) a patent or the made in which it is exercised is mischievous to the State or generally prejudicial to the public; or
- (b) a patent has been obtained through concealment or misrepresentation in the application; or
- (c) where the compulsory licence granted to prevent the abuse which might result from the exercise of the exclusive rights conferred by the patent, for example, failure to work or in relation to anti-competitive practices, has not been sufficient, it may, after giving the patentee an opportunity of being heard, make a declaration to that effect in the official Gazette, <sup>2</sup>[and in the Patents' journal] and thereupon the patent shall be deemed to have been revoked:

Provided that proceedings upon clause (c) and shall not begin before the expiration of two years from the grant of first compulsory licence.]

**49. Revocation of surrendered patent by Controller.**—(1) A patentee may, at any time by giving notice in the prescribed manner to the Controller, offer to surrender his patent.

(2) Where an offer under sub-section (1) is made, the Controller shall advertise the offer in the prescribed manner, and also give notice to every person other than patentee whose name appears in the Register as having an interest in the patent.

(3) Any person interested may, within the prescribed period after such advertisement, give notice to the Controller of opposition to the surrender, and where any such notice is given, the Controller shall give notice to the patentee.

(4) If the Controller is satisfied, after hearing the patentee and any opponent, if desirous of being heard, that the patent may properly be surrendered, he may accept the offer and, by order, revoke the patent.

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<sup>1</sup>Subs. by the Patents (Amdt.) Ordinance, 2002 (95 of 2002), s. 12, for the original section 48.

<sup>2</sup>Ins. by Act XXIV of 2016,s.6.

## POWERS OF CONTROLLER

**50. Controller to have certain powers of a civil court.**—(1) Subject to any rules made in this behalf, the Controller in any proceedings before him under this Ordinance shall have the powers of a civil court while trying a suit under the Code of Civil Procedure, 1908 ([Act V of 1908](#)) in respect of the following matters, namely:—

- (a) summoning and enforcing the attendance of any person and examining him on oath;
- (b) requiring the discovery and production of any document;
- (c) receiving evidence on affidavits;
- (d) issuing commissions for the examination of witnesses or documents; and
- (e) awarding costs.

**51. Power of Controller to correct clerical errors.**—(1) The Controller may, in accordance with the provisions of this section, correct any clerical error in any patent or in any specification or other document filed in pursuance of such application or in any application for a patent or any clerical error in any matter which is entered in the Register.

(2) A correction may be made in pursuance of this section either upon a request in writing made by any person interested and accompanied by the prescribed fee, or without such a request.

(3) Where the Controller proposes to make any such correction as referred to in sub-section (1), otherwise than in pursuance of a request made under this section, he shall give notice of the proposal to the patentee or the applicant for the patent, as the case may be, and to any other person who appears to him to be concerned, and shall give them an opportunity of being heard before making the correction.

(4) Where a request is made under sub-section (2), for the correction of any clerical error in a patent or application for a patent or any document filed in pursuance of such an application, and it appears to the Controller that the correction would materially alter the meaning or scope of the document to which the request relates and ought not to be made without notice to persons affected thereby, he shall require notice of the nature of the proposed correction to be advertised in the prescribed manner.

(5) Within the prescribed time after any such advertisements as referred to in sub-section (4), any person interested may give notice to the Controller of opposition to the request, and, where such notice of opposition is given, the Controller shall give notice thereof to the person by whom the request was made, and shall give to him and to the opponent as opportunity of being heard before he decides the case.

**52. Evidence before Controller.** Subject to any rules made in this behalf, in any proceedings under this Ordinance before the Controller, evidence shall be given by affidavit in the absence of directions by the Controller to the contrary, but in any case in which the Controller thinks it right so to do he may take oral evidence in lieu of, or in addition to, evidence by affidavit, or may allow any party to be cross-examined on the contents of his affidavit.

**53. Exercise of discretionary powers by Controller.** Without prejudice to any provision of this Ordinance requiring the Controller to hear any party to the proceedings thereunder or to give any such party an opportunity of being heard, the Controller shall give to any applicant for a patent or for amendment of a specification, if within the prescribed time the applicant so requires, an opportunity of being heard before exercising adversely to the applicant any discretion vested in the Controller by or under this Ordinance.

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## CHAPTER XV

### REGISTER OF PATENTS

**54. Register of Patents.**—(1) There shall be kept at the Patent Office a Register of Patents, wherein shall be entered the names and addresses of grantees of patents, notifications of assignments and of transmissions of patents, of licenses under patents, and of amendments, extensions, and revocations of patents and particulars of such other matters affecting the validity or proprietorship of patents as may be prescribed.

(2) The Register of Patents kept under the Patents and Designs Act, 1911 (Act II of 1911) shall be incorporated in, and form part of, the Register to be kept under this Ordinance.

(3) No notice of any trust, whether express, implied or constructive, shall be entered in the Register, and the Controller shall not be affected by any such notice.

(4) Subject to the superintendence and direction of the Federal Government, the Register shall be kept under the control and management of the Controller.

**55. Registration of assignments, transmissions, etc.**—(1) Where any person becomes entitled by assignment, transmission or operation of law to a patent or to a share in a patent or becomes entitled as a mortgagee, licensee or otherwise to any other interest in a patent, he shall apply in writing in the prescribed manner to the Controller for the registration of his title or, as the case may be, of notice of his interest in the Register.

(2) Without prejudice to the provisions of sub-section (1), an application for the registration of the title of any person becoming entitled by assignment to a patent or a share in a patent or becoming entitled by virtue of a mortgage, license or other instrument to any other interest in a patent may be made in the prescribed manner by the assignor, mortgagor, licensor or other party to that instrument, as the case may be.

(3) Where an application is made under this section for the registration of the title of any person, the Controller shall, upon proof of title to his satisfaction.

(a) where that person is entitled to a patent or a share in a patent, register him in the Register as proprietor or co-proprietor of the patent, and enter in the Register particulars of the instrument or event by which he derives title; or

(b) where that person is entitled to any other interest in patent, enter in the Register notice of his interest, with particulars of the instrument, if any, creating it.

(4) Subject to the provisions of this Ordinance relating to co-ownership of patents and subject

also to any rights vested in any other person of which notice is entered in the Register, the person or persons registered as grantee or proprietor of a patent shall have power to assign, grant licenses under, or otherwise deal with, the patent and to give effectual receipts for any consideration for any such assignment, license or dealing:

Provided that any equities in respect of the patent may be enforced in like manner as in respect of any other movable property.

**56. Power of High Court regarding rectification of the Register.**—(1) The High Court may, on the application of any person aggrieved:—

- (a) by the absence or omission from the Register of any entry;
- (b) by any entry made in the Register without sufficient cause;
- (c) by any entry wrongly remaining on the Register; or
- (d) by any error or defect in any entry in the Register, make such order for the making, variation or deletion, of any entry therein as it may think fit.

(2) In any proceeding under this section, the High Court may decide any question that may be necessary or expedient to decide in connection with the rectification of the Register.

(3) Notice of any application to the High Court under this section shall be given in the prescribed manner to the Controller who shall be entitled to appear and be heard on the application, and shall appear if so directed by the High Court.

(4) Any order of the High Court under this section rectifying the Register shall direct that notice of the rectification shall be served in the prescribed manner upon the Controller, who shall upon receipt of such notice rectify the Register accordingly.

**57. Inspection of, and extracts from, the Register, etc.**—(1) Subject to the provisions of this Ordinance and rules, the Register shall at all convenient times be open to inspection by the public, and certified copies, sealed with the seal of the Patent Office, of any entry in the Register shall be given to any person requiring them on payment of the prescribed fee.

(2) The Register shall be *prima facie* evidence of any matters required or authorized by or under this Ordinance to be entered therein.

(3) Except in the case of an application made under section 55, a document in respect of which no entry has been made in the Register under sub-section (3) of section 54 shall not be admitted in any Court as evidence of title of any person to a patent or share of or interest in the patent unless the Court otherwise directs.

## **CHAPTER XVI**

### **COMPULSORY LICENCES, LICENCES OF RIGHT, EXPLOITING OF PATENTS AND REVOCATION**

**58. Exploitation by a Government agency or third person.**—(1) Subject to sub-section (2), where—

- (i) the public interest, in particular, national security, nutrition, health or the development of other vital sectors of the national economy so requires; or
- (ii) the Federal Government has determined that the manner of exploitation, by the owner of the patent or his licensee, is anti-competitive, and the Federal Government is satisfied that the exploitation of the invention in accordance with this sub-section would remedy such practices <sup>1</sup>[; or]
- <sup>2</sup>[(iii) the patent holder refuses to grant a licence to a third party on reasonable commercial terms and conditions; or
- (iv) where patent has not been exploited in a manner which contributes to the promotion of technological innovation and to the transfer and dissemination of technology.]

the Federal Government may, even without the consent of the owner of the patent, decide that a Government agency or a third person designated by the Federal Government may exploit a patented invention.

(2) The Federal Government shall, before taking any decision under sub-section (2), give the owner of the patent and any interested person an opportunity of being heard if he wishes to be heard.

(3) The exploitation of the patented invention shall be limited to the purpose for which it was authorized and shall be subject to the payment to the said owner of an adequate remuneration therefore, taking into account the economic value of the Federal Government authorizations, as determined in the said decision, and where a decision has been taken under sub-section (1), the need to correct anti-competitive practices.

(4) A request for the Federal Government authorization shall be accompanied by evidence that the owner of the patent has received, from the person seeking the authorization, a request for a contractual license, but that person has been unable to obtain such a license on reasonable commercial terms and conditions and within a reasonable time:

Provided that this sub-section shall not apply in cases of—

- (i) national emergency or other circumstantial urgency provided that in such cases the owner of the patent shall be informed of the decision of the Federal Government as soon as reasonably practicable;
- (ii) public non-commercial use; and
- (iii) anti-competitive practices determined as such by a judicial or administrative body in accordance with clause (ii) of sub-section (1).

<sup>1</sup>Subs. by the Patents (Amdt.) Ordinance, 2002 (95 of 2002), s. 13, for “Comma”.

<sup>2</sup>New sub-clauses (iii) and (iv) ins. *ibid.*,

(5) The exploitation of a patented invention in the field of semi-conductor technology shall only be authorized either for public non-commercial use or where a judicial or administrative body has determined that the manner of exploitation of the patented invention, by the owner of the patent or his licensee, is anti-competitive and if the Federal Government is satisfied that the issuance of the non- voluntary license would remedy such practices.

(6) <sup>1</sup>[The authorization shall be considered on its individual merits and shall not prohibit.]

- (i) the conclusion of license contracts by the owner of the patent;
- (ii) the continued exercise, by the owner of the patent, of his rights under section 30; or
- (iii) the issuance of a non-voluntary license under section 59.

(7) Where a third person has been designated by the Federal Government, the authorization may only be transferred with the enterprise or business of the person or with the part of the enterprise or business within which the patented invention is being exploited.

(8) Where the exploitation of the invention by the Government agency or third person designated by the Federal Government is authorized under clause (i) of sub-section (1), it shall be predominantly for the supply of the market in Pakistan.

(9) Upon request of the owner of the patent, or of the Government agency or of the third person authorised to exploit the patented invention, the Federal Government may, after hearing the parties, if either or both wish to be heard, vary the terms of the decision authorizing the exploitation of the patented invention to the extent that changed circumstances justify such variation.

(10) Upon the request of the owner of the patent, the Federal Government shall <sup>2</sup>[subject to adequate protection of the legitimate interest of the persons so authorized,] be inserted; and shall terminate an authorization if it is satisfied, after hearing the parties, if either or both wish to be heard, that the circumstances which led to <sup>3</sup>[the] decision have ceased to exist and are unlikely to recur or that the Government agency or third person designated by it has failed to comply with the terms of the decision.

(11) Notwithstanding the provisions of sub-section (10), the Federal Government shall not terminate an authorization if it is satisfied that the need for adequate protection of the legitimate interests of the Government agency or third person designated by it justifies the maintenance of the decision.

(12) Any appeal shall lie to the High Court against the decisions of the Federal Government under sub-sections (1) to (9).

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<sup>1</sup>Subs. by the Patents (Amdt.) Ordinance, 2002 (95 of 2002), s. 13, for “the authorization shall both exclude.”

<sup>2</sup>Ins. *Ibid* s. 13.

<sup>3</sup>Subs. *ibid.*, for “his”.

**59. Powers of Controller in granting compulsory licenses.**—<sup>1</sup>[(1) On request, made to the Controller after the expiration of a period of four years from the date of filing of the patent application or three years from the date of the grant of the patent, whichever period expires last, the Controller may issue a non-voluntary licence to prevent the abuses which might result from the exercise of the rights conferred by the patent, for example, failure to work.]

(2) Notwithstanding the provisions of sub-section (1), a non-voluntary license shall not be issued if the owner of the patent satisfies the Controller that circumstances exist which justify the non-exploitation or insufficient exploitation of the patented invention in Pakistan.

(3) The decision issuing the non-voluntary license shall fix—

- (i) the scope and function of the license;
- (ii) the time limit within which the licensee must begin to exploit the patented invention; and
- (iii) the amount of the adequate remuneration to be paid to the owner of the patent and the conditions of payment.

(4) The beneficiary of the non-voluntary license shall have the right to exploit the patented invention in Pakistan according to the terms set out in the decision issuing the license, shall commence the exploitation of the patented invention within the time limit fixed in the said decision and, thereafter, shall exploit the patented invention sufficiently.

(5) If the invention claimed in a patent, hereinafter referred to as “later patent”, cannot be exploited in Pakistan without infringing a patent granted on the basis of an application benefiting from an earlier filing or, where appropriate, priority date, hereinafter referred to as “earlier patent”, and provided that the invention claimed in the later patent involves an important technical advance of considerable economic importance in relation to the invention claimed in the earlier patent, the Controller, upon the request of the owner of the later patent, may issue a non-voluntary license to the extent necessary to avoid infringement of the earlier patent.

(6) Where a non-voluntary license is issued under sub-section <sup>2</sup>[(5)] the Controller upon the request of the owner of the earlier patent shall issue a non-voluntary license in respect of the later patent.

(7) In the case of a request for the issuance of a non-voluntary license under sub-sections <sup>3</sup>[(5)] and <sup>3</sup>[(6)] sub-section <sup>3</sup>[(3)] shall apply *mutatis mutandis* with the provision that no time limit needs to be fixed.

(8) In the case of a non-voluntary license issued under sub-section <sup>4</sup>[(5)] the transfer may be made only with the later patent, or, in the case of a non-voluntary license issued under sub-section <sup>4</sup>[(6)] only with the earlier patent.

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<sup>1</sup>Subs. by the Patents (Amdt.) Ordinance, 2002 (95 of 2002) s. 14, for sub-section (1).

<sup>2</sup>Subs. *Ibid.*, for “the brackets and figure (4)”.

<sup>3</sup>Subs. *ibid.*, for the brackets and figures (3), (4) and (2).

<sup>4</sup>Subs. *ibid.*, for the brackets and figures (3) and (4).

(9) The request for the issuance of a non-voluntary license shall be subject to payment of the prescribed fee.

(10) The provisions of sub-sections (2) to (10) of section 58 shall apply mutatis mutandis for issuance of a non-voluntary license under this section.

## **CHAPTER XVII**

### **PROCEEDINGS FOR INFRINGEMENT OF PATENTS**

**60. Suit for infringement of a patent.**—(1) A patentee may institute a suit in a District Court having jurisdiction to try the suit against any person who, during the continuance of a patent acquired by him under this Ordinance in respect of an invention, makes, sells or uses the invention without his license, or counterfeits it, or imitates it:

Provided that, where a counter-claim for revocation of the patent is made by the defendant, the suit, along with the counter-claim, shall be transferred to the High Court for decision.

(2) Every ground on which a patent may be revoked under the provisions of this Ordinance shall be available by way of defence to a suit for infringement.

**61. Reliefs in suits for infringement.**—<sup>1</sup>[(1) In any suit for infringement the Court shall have the power,—

- (a) to grant relief by way of damages, injunctions or accounts provided that, where permitted, effective provisional measure may also be ordered by the Court;
- (b) to order, if the subject matter of a patent is a process for obtaining a product, the defendant to prove that the process to obtain an identical product is different from the patented process and that the identical product in question shall, in the absence of proof to the contrary, be deemed to have been obtained by the patented process provided that the product obtained by patented process is new if it has not been put into the market for more than one year before the date of the initiation of the judicial action by the patentee:

Provided that this provision shall apply subject to the prior proof by the plaintiff that the allegedly infringing product is identical to the product directly produced by the patented process:

Provided further that in the adduction of proof to the contrary, the legitimate interests of defendants in protecting their manufacturing and business secrets shall be taken into account.]

(2) In any suit for infringement-

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<sup>1</sup>Subs. by the Patents (Amdt.) Ordinance, 2002 (95 of 2002), s. 15, for sub section (1).

- (a) the Court shall have the authority to order prompt and effective provisional measures—
  - (i) to prevent an infringement, and in particular, to prevent the entry into the channels of commerce of goods, including imported goods after custom clearance, and
  - (ii) to preserve relevant evidence in regard to the alleged infringement;
- (b) the Court shall have the authority to order provisional measures, *inaudita altera parte* where appropriate, in particular, where any delay is likely to cause irreparable harm to the right holder, or where there is a demonstrable risk of evidence being destroyed;
- (c) the Court shall have the authority to require the applicant to provide any reasonably available evidence to satisfy it with a sufficient degree of certainty that the applicant is the right holder and that the applicant's right is being infringed or that such infringement is imminent, and to order the applicant to provide a security or equivalent assurance sufficient to protect the defendant and to prevent abuse;
- (d) where provisional measures have been adopted *inaudita altera parte*, the parties affected shall be given notice, without delay after the execution of the measures at the latest, and a review, including a right to be heard, shall take place upon request of the defendant with a view to deciding within a reasonable period after the notice of the measures, whether these measures shall be modified, revoked or confirmed;
- (e) the Court may require the applicant to supply other information necessary for identification of the goods concerned;
- (f) without prejudice to the provisions of clause (d), provisional measures taken on the basis of clauses (a) and (b) shall upon the request of the defendant, be revoked or otherwise cease to have effect if proceedings leading to a decision on the merit of the case are not initiated within a reasonable period not to exceed twenty working days or thirty-one calendar days, and
- (g) where the provisional measures are revoked or where they lapse due to any act or omission by the applicant, or where it is subsequently found that there has been no infringement or threat of infringement, the Court shall have the authority to order the applicant, upon request of the defendant, to provide the defendant appropriate compensation for an injury caused by these measures.

**62. Damages not to be awarded against defendant in certain cases.** —(1) In proceedings for the infringement of a patent, damages shall not be awarded against a defendant who proves that at the date of the infringement he was not aware, and had not reasonable ground for supposing, that the patent existed, and a person shall not be deemed to have been aware or to have had reasonable grounds for supposing as aforesaid by reason only of the application to an article of the word “patent”, “patented”, or any word or words expressing or implying that a patent has been obtained

for the article, unless the number of the patent accompanied the word or words in question.

(2) Nothing in this section shall affect the power of the Court to grant an injunction in any proceedings for infringement of patent.

**63. Relief for infringement of partially valid specification.**—(1) If in any proceedings for infringement of a patent it is found that any claim of the specification, being a claim in respect of which infringement is alleged, is valid, but that any other claim is invalid, the Court may grant relief in respect of any valid claim which is infringed:

Provided that the Court shall not grant relief by way of damages or costs except in the circumstances mentioned in sub-section (2).

(2) Where the plaintiff proves that the invalid claim was framed in good faith and with reasonable skill and knowledge, the Court shall grant relief in respect of any valid claim which is infringed subject to the discretion of the Court as to costs and as to the date from which damages should be reckoned.

**64. Proceedings for infringement by exclusive licensee.** The holder of an exclusive license under a patent shall have the like right as the patentee to take proceedings in respect of any infringement of the patent committed after the date of the license, and in awarding damages or granting any other relief in any such proceedings the Court shall take into consideration any loss suffered or likely to be suffered by the exclusive licensee as such or, as the case may be, the profits earned by means of the infringement so far as it constitutes an infringement of the rights of the exclusive licensee as such.

**65. Certificate of contested validity of specification.**—(1) If in any proceedings before the Court the validity of any claim of a specification is contested, and that claim is found by the Court to be valid, the Court may certify that the validity of that claim was contested in those proceedings.

(2) Where any such certificate has been granted, then, if in any subsequent proceedings before the Court for infringement of the patent or for revocation of the patent, a final order or judgement is made or given in favour of the party relying on the validity of the patent, that party shall, unless the Court otherwise directs, be entitled to the full costs so far as they concern the claim in respect of which the certificate was granted:

Provided that this sub-section shall not apply to the costs of any appeal in any such proceedings as aforesaid.

**66. Remedy for groundless threats of infringement proceedings.**—(1) Where any person, whether entitled to or interested in a patent or an application for a patent or not, threatens any other person by circulars, advertisements or otherwise with proceedings for infringement of a patent, any person aggrieved thereby may bring suit against him for any such relief as is specified in sub-section (2).

(2) Unless in any suit under sub-section (1) the defendant proves that the acts in respect of which proceedings were threatened constitute or, if done, would constitute, an infringement of a patent or of rights arising from the publication of a complete specification in respect of a claim of the specification not shown by the plaintiff to be invalid, the plaintiff shall be entitled to the following reliefs, namely:—

- (a) a declaration to the effect that the threats are unjustifiable;
- (b) an injunction against the continuance of the threats; and
- (c) such damages, if any, as he has sustained thereby.

(3) For the avoidance of doubt, it is hereby declared that a mere notice of the existence of a patent does not constitute a threat of proceedings within the meaning of sub-section (1).

**67. Power of Court to make declaration as to non-infringement.**—(1) A declaration that the use by any person of any process, or the making or use or sale by any person of any article, does not or would not constitute an infringement of a claim of a patent may be made by the Court in proceedings between that person and the patentee or the holder of an exclusive license under the patent, notwithstanding that no assertion to the contrary has been made by the patentee or licensee, if it is shown—

- (a) that the plaintiff has applied in writing to the patentee or licensee for a written acknowledgement to the effect of the declaration claimed, and has furnished him with full particulars in writing of the process or article in question; and
- (b) that the patentee or licensee has refused or neglected to give such an acknowledgement.

(2) The costs of all parties in proceedings for a declaration brought by virtue of this section shall, unless for special reasons the Court thinks fit to order otherwise, be paid by the plaintiff.

(3) The validity of a claim of the specification of a patent shall not be called in question in proceedings for a declaration brought by virtue of this section, and accordingly the making or refusal of such a declaration in the case of a patent shall not be deemed to imply that the patent is valid.

(4) Proceedings for a declaration may be brought by virtue of this section at any time after the date of the publication of the complete specification in pursuance of an application for a patent, and references in this section to the patentee shall be construed accordingly.

**68. Power of Court to appoint scientific advisers.**—(1) In any suit for infringement or in any proceedings before a Court under this Ordinance, the Court may at any time, and whether or not an application has been made by any party for that purpose, appoint an independent scientific adviser to assist the Court or to inquire and report upon any such question of fact or of opinion, not involving a question of interpretation of law, as it may formulate for the purpose.

(2) The remuneration of the scientific adviser appointed under sub-section (1) shall be fixed by the Court and shall include the costs of making a report and a proper daily fee for any day on which the scientific adviser may be required to attend before the Court, and such remuneration shall be defrayed out of moneys provided by the Federal Government for the purpose.

## CHAPTER XVIII

### APPEALS

**69. Appeals.**—(1) No appeal shall lie from any decision, order or direction made or issued under this Ordinance by the Federal Government, or from any act or order of the Controller for the purpose of giving effect to any such decisions, order or direction.

(2) The public authorities and officials shall be exempted from liability to appropriate remedial measures where actions are taken or intended in good faith in course of administration of this Ordinance.

(3) Subject to sub-section (1), an appeal shall lie to the High Court from any decision, order or direction of the Controller or, as the case may be, the Federal Government under any of the provisions of this Ordinance.

(4) Every appeal under this section shall be in writing and shall be made within three months from the date of the decision, order or direction of the Controller, as the case may be, of the Federal Government, or within such further time as the High Court may allow.

**70. Procedure for hearing appeals.**—(1) Every appeal before the High Court shall be by petition and shall be in such form and shall contain such particulars as may be provided by rules made by the High Court.

(2) Every appeal under this section shall be heard by a single Judge of the High Court:

Provided that any such Judge may, if he so thinks fit, refer the appeal at any stage of the proceedings to a larger Bench of the High Court.

(3) Every appeal under this section shall be heard as expeditiously as possible and endeavor shall be made to decide the appeal within a period of twelve months from the date on which it is filed.

## THE PAKISTAN CODE

### CHAPTER XIX

#### PENALTIES

**71. Penalty for contravention of secrecy provisions relating to certain inventions.** If any person fails to comply with any direction given under section 25 or makes or causes to be made an application for the grant of a patent in contravention of section 26, he shall be punishable with imprisonment for a term which may extend to two years, or with fine not exceeding twenty thousand rupees, or with both.

**72. Penalty for false entry in any register, etc.** If any person makes, or causes to be made, a false entry in any register kept under this Ordinance, or a writing falsely purporting to be a copy of an entry in such a register, or produces or tenders, or causes to be produced or tendered, in evidence any such writing knowing the entry or writing to be false, he shall be punishable with imprisonment for a term which may extend to two years, or with fine not exceeding twenty thousand rupees, or with both.

**73. Penalty for false representation.** If any person falsely represents that any article sold by him is patented in Pakistan or is the subject of an application for a patent in Pakistan, he shall be punishable with fine which may extend to five thousand rupees.

**Explanation 1.**—For the purposes of this section, a person shall be deemed to represent—

- (a) that an article is patented in Pakistan if there is stamped, engraved or impressed on, or otherwise applied to, the article the word “patent” or “patented” or some other word expressing or implying that a patent for the article has been obtained in Pakistan; or
- (b) that an article is the subject of an application for a patent in Pakistan, if there are stamped, engraved or impressed on, or otherwise applied to, the article the words “patent applied for”, “patent pending”, or some other words implying that an application for a patent for the article has been made in Pakistan.

**Explanation 2.**—The use of words “patent”, “patented”, “patent applied for”, “pending” or other words expressing or implying that an article is patented or that a patent has been applied for shall be deemed to refer to a patent in force in Pakistan, or to a pending application for a patent in Pakistan, as the case may be, unless there is an accompanying indication that the patent has been obtained or applied for in any country outside Pakistan.

**74. Penalty for wrongful use of Words “patent office”.** If any person uses on his place of business or any document issued by him or otherwise the words “patent office” or any other words which would reasonably lead to the belief that his place of business is, or is officially connected with, the patent Office, he shall be <sup>1</sup>[punishable with imprisonment for a term which may extend to two years, and with fine which may extend to one million rupees].

**75. Penalty for refusal or failure to supply information.** —(1) If any person refuses or fails to furnish to the Controller any information or statement which he is required to furnish by or under this Ordinance, he shall be punishable with fine which may extend to <sup>2</sup>[five thousand rupees].

(2) If any person, being required to furnish any such information as is referred to in sub-section (1), furnishes information or a statement which is false, and which he either knows or has reasons to believe to be false or does not believe to be true, he shall be punishable with fine which may extend to <sup>3</sup>[fifty thousand rupees].

**76. Penalty for contravention of section 20.** If the applicant fails to file the statement required under section 20 or has furnished information which in any material particular is false to his knowledge or if he fails to comply with the Controller’s request within the specified time, he shall be punishable with fine which may extend to <sup>4</sup>[five thousand rupees].

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<sup>1</sup>Subs. by the Patents (Amdt.) Ordinance, 2002 (95 of 2002) s. 16 for certain words.

<sup>2</sup>Subs. *ibid.*, s. 17 for “two thousand rupees”.

<sup>3</sup>Subs. *ibid.*, for “ten thousand rupees”.

<sup>4</sup>Subs. *ibid.*, s.18, for “two thousand rupees”.

**77. Penalty for practice by non-registered patent agents.** If any person contravenes the provisions of section 82, he shall be punishable with fine which may extend to <sup>1</sup>[twenty five thousand rupees] in the case of a first offence and <sup>2</sup>[one hundred thousand rupees] in the case of a second or subsequent offence.

<sup>3</sup>**[78. Offences by companies etc.** Where the person guilty of an offence under this Ordinance is a company, corporation, firm or institution, every owner, director, and employee of the company, firm, institution, or corporation, having knowledge of the offence and consented to the commission of the offence shall be guilty of the offence].

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## CHAPTER XX PATENT AGENTS

**79. Register of patent agents.** There shall be kept at the Patent Office a register of patent agents wherein shall be entered the names and addresses of all person qualified to practice before the Patent Office as patent agents.

**80. Registration as patent agent.** The Controller may, on an application made in the prescribed manner, register as a patent agent any person who is a citizen of Pakistan, has completed the age of twenty-one years, possesses the prescribed qualifications and has paid the prescribed fee.

**81. Subscription and verification of certain documents by patent agents.**—(1) Subject to sub-section (2) and rules, all applications and communications to the Controller under this Ordinance may be signed by a patent agent authorized in writing in this behalf by the person concerned.

(2) The following documents, namely,—

- (i) applications for patents;
- (ii) applications for the restoration of lapsed patents;
- (iii) notices of opposition;
- (iv) applications for leave to amend;
- (v) applications for compulsory licences or for revocation; and
- (vi) notices of surrender of patents,

shall be signed and verified in the prescribed manner by the person making such applications or giving such notices:

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<sup>1</sup>Subs. Ibid., s.19, for “five thousand rupees”.

<sup>2</sup>Subs. Ibid., for “one thousand rupees”.

<sup>3</sup>Subs. Ibid., s.20, for original section 78.

Provided that, if such person is absent from Pakistan, they may be signed and verified by a patent agent authorized by him in writing in that behalf.

**82. Restrictions on practice as patent agent.**— (1) No person, either alone or in partnership with any other person, shall practice or describe or hold himself out as a patent agent, or permit himself to be so described or held out, unless he is registered as a patent agent or, as the case may be, unless he and all his partners are so registered.

(2) No company or other body corporate shall practice or describe or hold itself out as a patent agent or permit itself to be so described or held out.

**Explanation.**—For the purposes of this section, practice as a patent agent includes any of the following acts, namely:—

- (a) applying for or obtaining patents in Pakistan or elsewhere;
- (b) preparing specifications or other documents for the purposes of this Ordinance or of the patent law of any other country; and
- (c) giving advice, other than advice of a scientific or technical nature, as to the validity of patents or their infringement.

**83. Removal from register of patent agents and restoration.**—(1) The Federal Government may remove the name of any person from the register of patent agents when it is satisfied, after giving that person a reasonable opportunity of being heard and after such further inquiry, if any, as it thinks fit to make—

- (i) that his name has been entered in the register of patent agents by error or on account of misrepresentation or suppression of material facts; or
- (ii) that he has been convicted of any offence and sentenced to a term of imprisonment or has been guilty of misconduct in his professional capacity which in the opinion of the Federal Government renders him unfit to be kept in the register of patent agents.

(2) The Federal Government may, on application and on sufficient cause being shown restore to the register of patent agents the name of any person removed therefrom.

**84. Power of controller to refuse to recognize as agent.**—(1) Subject to any rules made in this behalf, the Controller may refuse to recognize as agent in respect of any business under this Ordinance—

- (a) any person whose name has been removed from and not restored to, the register of patent agents;
- (b) any person who has been convicted of an offence under section 77;
- (c) any person, not being registered as patent agent, who in the opinion of the Controller is engaged wholly or mainly in acting as agent in applying for

patents in Pakistan or elsewhere in the name or for the benefit of the person by whom he is employed; or

- (d) any company or firm, if any person whom the Controller could refuse to recognize as patent agent in respect of any business under this Ordinance, is a director or manager of the company or is a partner in the firm.

(2) The Controller shall refuse to recognize as agent in respect of any business under this Ordinance any person who neither resides nor has a place of business in Pakistan.

**85. Saving in respect of other persons authorize to act as agents.** Nothing in this Chapter shall be deemed to prohibit.

- (a) the applicant for a patent or any person, not being a patent agent, who is duly authorized by the applicant from drafting any specification or appearing or acting before Controller; or
- (b) an advocate, not being a patent agent, from taking part in any proceedings under this Ordinance otherwise than by way of drafting any specification.

## CHAPTER XXI INTERNATIONAL ARRANGEMENTS

**86. Power of the Federal Government to declare a country as Convention country.**—(1) With a view to the fulfillment of a treaty, convention or arrangement between Pakistan and any other country, the Federal Government may, by notification in the official Gazette, declare such country to be the Convention country for the purposes of this Ordinance, in addition to the members of the World Trade Organization.

(2) A declaration under sub-section (1) may be made for the purposes either for all or for some only of the provisions of this Ordinance, and a country in the case of which a declaration made for the purposes of some only of the provisions of the Ordinance is in force shall be deemed to be a Convention country for the purposes of those provisions only.

**87. Supplementary provisions as to Convention application.** For the purposes of this Ordinance, any matter shall be deemed to have been disclosed in an application for protection in a Convention country if it was claimed or disclosed, otherwise than by way of disclaimer or acknowledgement of prior art, in that application or in any document submitted by the applicant for protection in support of and at the same time as that application, but no account shall be taken of any disclosure effected by any such document unless a copy of the document is filed in the Patent Office with the Convention application in accordance with the provisions of section 88.

**88. Documents to be filed with a Convention application.**—(1) Where a Convention application is made under this Ordinance, the applicant shall furnish, in addition to the complete specifications, copies of the specifications or corresponding documents filed or deposited by the applicant in the patent office of the Convention country in which the relevant application was made, certified by the official chief or head of the patent office of the Convention country, or otherwise verified to the satisfaction of the Controller, along with the application or within three months

thereafter, or with in such further period as the Controller may on good cause allow.

(2) If any such specification or other document referred to in sub-section (1) is in a foreign language, a translation into English of the specification or document, verified by affidavit or otherwise to the satisfaction of the Controller, shall be annexed to the specification or document.

(3) For the purposes of this Ordinance, the date on which an application was made in a Convention country is such date as the Controller is satisfied, by certificate of the official chief or head of the patent office of the Convention country or otherwise, is the date on which the application was made in that Convention country.

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## CHAPTER XXII MISCELLANEOUS

**89. Fees.**—(1) There shall be paid in respect of the grant of patents and applications therefor, and in respect of other matters in relation to patents under this Ordinance, such fees, to the Patent Office, as may be prescribed by the Federal Government.

(2) Any proceedings in respect of which a fee is payable under this Ordinance or the rules shall be of no effect unless the fee has been paid.

**90. Restrictions upon publication of specifications, etc.** Subject to the provisions of Chapter VII, an application for a patent, and any specification filed in pursuance thereof, shall not, except with the consent of the applicant, be published by the Controller or be open to public inspection at any time before the date of advertisement of acceptance of the application in the official Gazette <sup>1</sup>[or in the Patents' journal].

**91. Reports of examiners to be confidential.** The reports of examiners to the Controller under this Ordinance shall not be open to public inspection or be published by the Controller, and such reports shall not be liable to production or inspection in any legal proceedings unless the Court certifies that the production or inspection is desirable in the interests of justice, and ought to be allowed.

**92. Publication of Patented Inventions.** The Controller shall issue periodically a publication containing such information relating to patented inventions as the Federal Government may direct.

**93. Power of Controller to call for information from patentees.**—(1) The Controller may, at any time during the continuance of the patent, by notice in writing, require a patentee or a licensee, exclusive or otherwise, to furnish to him within two months from the date of such notice or within such further time as the Controller may allow, such information or such periodical statements as to the extent to which the patented invention has been commercially worked in Pakistan as may be specified in the notice.

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<sup>1</sup>Ins. by Act No. XXIV of 2016,s.7

(2) Without prejudice to the provisions of sub-section (1), every patentee and every licensee, whether exclusive or otherwise, shall furnish in such manner and form and at such intervals, not being less than six months, as may be prescribed, statement as to the extent to which the patented invention has been worked on a commercial scale in Pakistan.

(3) The Controller may publish the information received by him under sub-section (1) or sub-section (2) in such manner as may be prescribed.

**94. Evidence of entries, documents, etc.**—(1) A certificate purporting to be signed by the Controller as to any entry, matter or thing which he is authorized by this Ordinance or any rule to make or do, shall be *prima facie* evidence of the entry having been made and of the contents thereof and of the matter or thing having been done or omitted to be done.

(2) A copy of any entry in any Register or of any document kept in the Patent Office or of any patent, or an extracts from any such Register or document, purporting to be certified by the Controller and sealed with the seal of the Patent Office shall be admitted in evidence in all courts, and in all proceedings, without further proof or production of the original.

(3) The Controller or any other officer of the Patent Office shall not, in any legal proceedings to which he is not a party, be compellable to produce the Register or any other document in his custody, the contents of which can be proved by the production of a certified copy issued under this Ordinance or to appear as a witness to prove the matters therein recorded unless by order of the Court made for special causes.

**95. Declaration by infants, lunatics, etc.**—(1) If any person is, by reason of minority, lunacy or other disability, incapable of making any statement or doing anything required or permitted by or under this Ordinance, the lawful guardian, committee or manager, if any, of the person subject to the disability, or if there be none, any person appointed by any Court having jurisdiction in respect of his property, may make such statement or a statement as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of the person subject to the disability.

(2) An appointment may be made by the Court for the purposes of this section upon the petition of any person active on behalf of the person subject to the disability or of any other person interest in the making of the statement or the doing of the thing.

**96. Service of notice, etc., by post.** Any notice required or authorized to be given by or under this Ordinance, and any application or other document so authorized or required to be made or filed, may be given, made or filed by post.

**97. Security for cost.** If any party by whom notice of any opposition is given under this Ordinance or by whom application is made to the Controller for the grant of a licence under a patent neither resides nor carries on business in Pakistan, the Controller may require him to give security for the costs of the proceedings, and in default of such security being given may treat the opposition or application abandoned.

**98. Transmission of orders of High Court or Court to the Controller.**—(1) Every order of the High Court on a petition for revocation, including an order granting certificate of validity of any claim, shall be transmitted by the High Court to the Controller who shall cause an entry thereof and reference thereto to be made in the Register.

(2) Where in any suit for infringement of a patent or in any suit under section 60 the validity of any claim or a specification is contested and that claim is found by the Court to be valid or not valid, as the case may be, the Court shall transmit a copy of its judgement and decree to the Controller who shall on receipt thereof cause an entry in relation to such proceedings to be made in the prescribed manner in a supplemental record.

(3) The provisions of sub-sections (1) and (2) shall also apply to the Court to which appeals are referred against decisions of the Court referred to in those sub-sections.

**99. Transmission of copies of specifications, etc. and inspection thereof.** Copies of all such specifications drawings and amendments left at the Patent Office as become open to public inspection under the provisions of the Ordinance shall be transmitted, as soon as may be, after the printed copies thereof are available, to such authorities as the Federal Government may appoint in this behalf, and shall be open to the inspection of any person at all reasonable times at places to be specified by those authorities with the approval of the Federal Government.

**100. Information relating to patents.** Any person making a request to the Controller in the prescribed manner for information relating to any such matter, as may be prescribed, as respects any patent specified in the request or as respects any application for a patent so specified shall be entitled, subject to the payment of the prescribed fee, to have information supplied to him accordingly.

**101. Loss or destruction of patents.** If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the Controller, the Controller may at any time, on application made in the prescribed manner and on payment of the prescribed fee, cause a duplicate thereof to be sealed and delivered to the applicant.

<sup>1</sup>[\* \* \* \* \*]

**103. Right of the Government to sell or use forfeited articles.** Nothing in this Ordinance shall affect the power of the Government or of any person deriving title directly or indirectly from the Government to sell or use any articles forfeited under any law for the time being in force.

**104. Power of High Court to make rules.** The High Court may make rules consistent with this Ordinance as to the conduct and procedure in respect of all proceedings before it under this Ordinance.

**105. Power of the Federal Government to make rules.**—(1) The Federal Government may, by notification in the official Gazette, make rules for carrying out the purposes of this Ordinance.

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<sup>1</sup>Section 102 Omitted by the Patent (Amdt.) Ordinance, 2002 (95 of 2002), s.21.

(2) In particular and without prejudice to the generality of the foregoing power, such rules may provide for all or any of the following matters, namely:—

- (i) the form and manner in which any application for a patent, any specifications or drawings, and any other application or document may be filed in the Patent Office;
- (ii) the time within which any act or thing may be done under this Ordinance, including the manner in which and the time within which any matter may be advertised under this Ordinance;
- (iii) the fees which may be payable under this Ordinance and the manner of payment of such fees;
- (iv) the matters in respect of which an examiner may make a report to the Controller;
- (v) the form of request for sealing of patent;
- (vi) the form and manner in which and the time within which any notice may be given under this Ordinance;
- (vii) the provisions which may be inserted in an order for restoration of a patent for the protection of the person who may have availed themselves of the subject-matter of the patent after the patent had ceased;
- (viii) the maintenance of the Register and the matters to be entered therein;
- (ix) the time when and the manner in which the Register and any other document open to inspection may be inspected under this Ordinance;
- (x) the qualifications of and the preparation of a role of scientific advisers for the purpose of section 68;
- (xi) the manner in which any compensation for acquisition by the Government of an invention may be paid;
- (xii) the manner in which the register of patent agents may be maintained, and matters connected with the practice and conduct of the patent agents; <sup>1\*</sup>
- (xiii) the regulation of the making, printing, publishing and selling of indexes to, and abridgements of, specifications and other documents in the Patent Office, and inspection of indexes and abridgements and other documents <sup>2</sup>[;].
- <sup>3</sup>[(xiv) the manner to establish the regime for exhaustion of intellectual property rights;

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<sup>1</sup>The word “and” omitted by the Patents (Amdt.) Ordinance, 2002 (95 of 2002) s. 22.

<sup>2</sup>Subs. *ibid.*, for the full stop.

<sup>3</sup>New clauses (xiv), (xv), (xvi), (xvii) and (xviii) added *ibid.*

- (xv) the details in respect of inventions referred to in sub-section (4) of section 7;
- (xvi) the manner in which an invention shall be disclosed including the best mode known for the execution of the invention, the forms and limits of allowable claims and, in the case of inventions relating to microorganisms, the requirement and the manner of submission of a culture for experimental purposes in relation to the scope of the claim and the procedure for grant of such patents;
- (xvii) the procedure and the criteria for determining the remuneration for a compulsory licence and the terms and conditions for licensing agreements including, in particular, those which do not adversely affect competition or cause impediment to the research and development in the country or to bind the licensee to transfer the improvements made by him to the licensor or to force the licensee to acquire technologies or inputs not needed or desired by him; and
- (xviii) the form of filing application and manner of grant of exclusive marketing rights].

(3) The power to make rules under this section shall be subject to the condition of the rules being made after previous publication.

**106. Repeal and savings.**—(1) The Patents and Designs Act, 1911 (Act II of 1911) is hereby repealed.

(2) Notwithstanding the repeal of the Patents and Designs Act, 1911 (Act II of 1911) the renewal fee in respect of a patent granted under that Act shall be as fixed thereunder.

(3) Save as otherwise provided in sub-section (2), the provisions of this Ordinance shall apply to any application for a patent pending on the commencement of this Ordinance and to any proceedings consequent thereon, and to any patent granted in pursuance thereof.

(4) Notwithstanding anything contained in this Ordinance, any suit for infringement of a patent, or any proceedings for revocation of a patent, pending in any Court on the commencement of this Ordinance, may be continued and disposed of under the Patents and Designs Act, 1911 (Act II of 1911) as if this Ordinance had not come into force, <sup>1</sup>\* \* \*.

<sup>2</sup>[**107. Acts done in good faith.** No suit, prosecution, or any other legal proceedings shall lie against any government employee or any person exercising any powers or performing any functions under this Ordinance or the rules made thereunder for any act or thing which has been done in good faith.

**108. Removal of difficulties.** If any difficulty arises in giving effect to any of the provisions of this Ordinance, the Federal Government may, by notification in the official Gazette, make such provisions as it deems fit for removing that difficulty].

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<sup>1</sup>The certain words omitted by the Patents (Admt.) Ordinance, 2002 (95 of 2002), s.23.

<sup>2</sup>New sections 107 and 108 added *ibid.*, s.24