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Pakistan Drafts Geographical Indication Protection Bill

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Report Highlights:

The report contains the text of Pakistan's proposed Geographical Indication Protection Bill. The Bill is still a draft and will have to pass through various phases of approval before submission to the parliament. The Government of Pakistan is accepting comments. While there is no deadline, parties should act sooner rather than later to submit comments.

Pakistan Prepares Geographical Indication Bill

The Government of Pakistan's Ministry of Commerce is in the process of finalizing a draft Geographical Indication Protection Bill. The bill is still a proposed law and will have to pass through various phases of approval before submission to the parliament. The process is often lengthy and can take considerable time depending on the level of interest from the government. The government of Pakistan is deliberating with stakeholders to finalize the document through meetings and workshops. Many international organizations such as World Trade Organization (WTO) and World Property Intellectual Organization (WPIO) are participating in these deliberations. The last meeting with stakeholders on the proposed bill was held on October 18th, 2016. The Document is still open for comments. Those wishing to submit comments can contact the Office of Agricultural Affairs for additional information. There is no official deadline, but interested parties should act sooner rather than later in submitting comments.

It is proposed in the bill that the Ministry of Commerce will establish an office known as the "Geographical Indication Registry." The Registry is proposed to be entrusted with all functions such as administration, maintenance registration, and matters related to the approval of geographic indicators in Pakistan.

Following is the text of the draft bill:

Draft Geographical Indication Protection Bill

(Updated Version 1.3)

CHAPTER I

GENERAL PROVISION

Short title, Extent and Commencement

- 1-. (1) The Bill may be called the Geographical Indication Protection Act, 2016.
- (2) It extends to the whole Pakistan.
- (3) It shall come into force on such date as the Federal Government may notify in the official Gazette.

Definition and Interpretation

- 2-. (1) In this Bill, unless there is anything repugnant in the subject or context:
 - a. **"Authorized user"** means producer of a Geographical Indication product who is registered under subsection (1) of section 16 ;
 - a. **"Certification Body"** refers to a public or a private organization issuing a certificate to the Geographical Indication Products for compliance with the product specifications entered in the Register;
 - a. **"Control mechanism"** means the verification of the compliance of products with the product specifications by the Registered proprietor and certification body;
 - a. **"Director General"** means Director General, of the Organization appointed under Section 10

of the Intellectual Property Organization Act, 2012;

a. **“Federal Government”** means the Cabinet Division, or any other Division so notified in the Gazette of Pakistan;

a. **“Foreign Country”** means any country or territory which is:-

- i. a member of the World Trade Organization;
- ii. a member of the World Intellectual Property Organization;
- iii. a party to the Paris Convention of 20th March 1883; or
- iv. any other country which the Federal Government may designate as such;

a. **“Geographical Indication”** means an Indication which identifies a product of particular Geographical origin, quality, reputation or other characteristics of which is attributable to its Geographical origin; and at least one of the activities of production, processing or preparation of which takes within the defined Geographical area;

a. **“Geographical origin”** means an area of a country, region, locality and shall also include the sea, lake, river, island, mountain or any other area of a similar nature;

a. **“Geographical Indication Product”** refers to a good for which a Geographical Indication has been registered under this Bill;

a. **“Generic term”** means the name of a product which, although relating to the place, region or a country where the product was originally produced or marketed, have become the common name of that product in Pakistan;

a. **“Homonymous Geographical Indications”** are those that are spelled or pronounced alike, but which identify products originating in different places, within a country or in different countries;

a. **“Indication”** refers to word(s), letter(s) or numeral(s), Geographical name or other name, device or any figurative representation, or a combination thereof, indicating the Geographical origin of the goods to which it is applied;

a. **“Organization”** means the Intellectual Property Organization of Pakistan, established under section 3 of Intellectual Property Organization of Pakistan Act, 2012;

a. **“Paris Convention”** means the Paris Convention of 20th March 1883 for the Protection of Industrial Property, as revised or amended from time to time;

- a. **“Policy Board”** means Policy Board of the organization constituted under Section 4 of Intellectual Property Organization of Pakistan Act, 2012;
- a. **“Prescribed”** means prescribed by the Rules made under this Bill;
- a. **“Producer”** refers to any person engaged in the production, processing, distribution and trade of Geographical Indication Products;
- a. **“Product”** means an article which can be traded including natural, agricultural, industrial products, handicrafts and food stuff on any stage of production;
- a. **“Proprietor”** means any natural or legal person as referred in Section 6, having obtained the registration of a Geographical Indication under this Bill;
- a. **“Register”** means the Register of Geographical Indications established and maintained under sub section (1) of section 23;
- a. **“Registered Geographical Indication”** means a Geographical Indication which has been entered in the Register;
- a. **“IP Tribunal”** means the Intellectual Property Tribunal established under section 16 of Intellectual Property Organization of Pakistan Act, 2012;
- a. **“Trademark”** means a mark as defined in section 2(xlvii) of Trade marks Ordinance, 2001.

(3) Words and expression used and not defined in this Bill but defined in the Trademark Ordinance, 2001 shall have the meaning assigned to them in that Ordinance.

CHAPTER II ADMINISTRATION

Geographical Indication Registry

3-. (1) For the purposes of this Bill, the Organization with approval of the Federal Government shall establish an office known as “Geographical Indication Registry”, which will be under the administrative control of the Organization.

(2) For the facilitation of applicants, the Organization with the prior approval of Policy Board may set up offices of the Registry at such places, as deems necessary, as and when required.

(3) The Registry shall be entrusted with all functions such as administration, maintenance registration and matters related to the control mechanism of Geographical Indication Products in Pakistan under this Bill.

(4) The Organization may, with the prior approval of the Policy Board create posts with such designations and appoint officers, employees, experts and consultants on such terms and conditions as it may consider

necessary for functioning of the Registry, having such qualifications and experience as may be prescribed.

Officers and Employees of the Registry

4-. (1) The Organization shall appoint a Registrar to execute the functions of the Registry with the assistance of such officers and staff as may be appointed under sub-section (4) of section 3, and shall perform his work under the superintendence and direction of the Organization.

(2) The Registry shall function under the direct supervision of the Registrar who shall coordinate its activities with the Organization. The Registrar may, with the prior approval or advice of the Organization, delegate any of its powers and functions to any other officer of the Registry.

CHAPTER III

REGISTRATION OF GEOGRAPHICAL INDICATION

Prohibition of Registration of Geographical Indications

5-. An Indication shall not be registered as a Geographical Indication:

- a. which does not correspond to the definition of Geographical Indication contained in subsection (1)(g) of section 2;
- b. where it conflicts with the name of a plant variety or an animal breed and is likely to mislead the consumers as to the true origin of the product;
- c. which will be contrary to any law for the time being in force;
- d. which will be contrary to public order or morality;
- e. which has become a generic term or indication of good;
- f. which is not or has ceased to be protected in its country of origin, or which has fallen into disuse in that country; and
- g. which, although literally true as to the territory, region or locality in which the goods originate, falsely represents to the public that the goods originate in another territory, region or locality, as the case may be.

Right of Application

6-. (1) Following are entitled to apply for registration of Geographical Indication for a product:

- a. An association of producers of a product;
- b. Public Institution related to the product or Geographical region, representing the interest of producers

Contents of Application

7-. An application for registration of Geographical Indication shall include:

- a. Prescribed application Form, indicating the name and addresses of applicant as specified in section 6;
- b. Prescribed fee; and
- c. Product specification including at least:

- i. Name to be protected as Geographical Indication;
- ii. Description of the product including the raw material, if appropriate, as well as the principle physical, chemical, microbial or organoleptic characteristics of the product;
- iii. Definition of the Geographical area, map and other related documents clearly indicating the boundaries of the area;
- iv. Details establishing the link between given quality, characteristic and other characteristics of product and Geographical area;
- v. Evidence that product originates in the defined Geographical area;
- vi. Production techniques of product and if relevant the authentic specific local/traditional techniques and conditions;
- vii. Names and addresses of the certification body(s) and other information about the inspection/control mechanism required under section 19 and section 20 and section 21; and
- viii. Any other information as may be prescribed.

Registration of Homonymous Geographical Indications

8-. (1) A Homonymous Geographical Indication may be registered under this Bill, if the Registrar is satisfied, after considering the practical conditions under which the Homonymous Indication in question shall be differentiated from the Registered Geographical Indication, taking into account the need to ensure equitable treatment of the producers of the products concerned, and that the consumers of such products shall not be confused or misled as consequence of such registration.

(2) In case of registration under subsection (1), the Registrar may direct the proprietors of Geographical Indications to provide additional information related to the origin of products on labeling of Geographical Indication products to keep the consumers from being misled.

CHAPTER IV

EXAMINATION PROCEDURE

Substantive Examination of Application

10-. (1) The Registry shall conduct a substantive examination of the application in a prescribed manner, with respect to following matters:

- a. The accuracy of information provided in the application under section 5 ,6 and 7 of this Bill;
- b. Any points prescribed in the definition of Geographical Indications in subsection (1) (g) of section 2 of this law; and
- c. In the case of Homonymous Geographical Indications, compliance with the conditions prescribed by the Registry.
- d. In case of trans border geographical indication, compliance with the conditions prescribed by the Registry.

(2) In the course of the substantive examination of an application, the Registrar may invite the applicant or any interested person to provide additional information or evidence. The Registrar may seek advice from

experts in related fields and if needed, and consider the advice when making its decision.

(3) After examination, the Registrar may refuse the application or may accept it absolutely or subject to such amendments, conditions or limitations as he deems appropriate under this bill.

(4) In case of refusal or conditional acceptance of application for the registration of Geographical Indication, the Registrar shall record in writing and communicate to the applicant the grounds for such refusal or conditional acceptance and material used by him in arriving at the this decision.

Publication and Registration

11-. (1) When an application has been accepted absolutely or with limitations, the Registrar shall immediately publish it in the Geographical Indication Journal in such manner as may be prescribed for inviting opposition against its registration.

(2) If no opposition is received within ninety (90) days of date of publication, The Registry shall register the Geographical Indication by entering it in the Register as provided in subsection (1) of section 23. A certificate of Registration to the applicant shall be issued in prescribed manner.

Opposition

12-. (1) Within the time period as provided in sub section 11(2), any interested person may oppose the registration of Geographical Indication to the Registry.

(2) The Registrar shall notify the applicant of the opposition in writing. The applicant shall submit a counter-statement within prescribed time from the notification date.

(3) The Registrar shall notify its decision and the reason for its decision to the applicant and the opponent.

(4) An appeal against the decision of the Registrar may be lodged in the High Court by the applicant or opponent within ninety (90) days from the date of communication of decision to the parties.

(5) The Registry shall prescribe detailed proceedings to carry out the opposition.

Grounds for Opposition

13-. (1) The grounds for opposing the registration of a Geographical Indication are as follows:

a. Non-compliance with the definitions relating to Geographical Indication under subsection (1)(g) of section 2 of this Bill.

b. The Geographical Indication is unregistrable under section 5 of this Bill.

c. The entitlement to the right of application provided in section 6(1) belongs to another person or entity;

d. The control mechanism required under section 19, section 21 is not properly provided;

(2) The opposition on ground under subsection (1)(c) can only be filed by those who have rights to apply under Section 6.

CHAPTER V

REGISTRATION OF FOREIGN GEOGRAPHICAL INDICATION

Requirements for the Registration of Foreign Geographical Indication

14-. (1) A Geographical Indication of a foreign country shall be registered in Pakistan as long as it is registered in accordance with the local legislation in its country of origin;

(2) The Registry shall not allow the registration of a foreign Geographical Indication which is not or has ceased to be protected in its country of origin or which has fallen into disuse in that country;

(3) The application for registration of foreign Geographical Indication shall be made at the Registry by legal

representative.

Procedure for Foreign Geographical Indication Registration

15-. (1) Provisions defined in section 5, section 6, section 7, section 10, and Section 11, section 12 and section 13 of this Bill shall be applied to the Foreign Geographical Indication registration procedure.

(2) During the registration procedure, the Registry may require the applicant to submit any information related to registration in the country of origin which may affect its registration in Pakistan.

CHAPTER VI

USE OF GEOGRAPHICAL INDICATION AND AUTHORIZED USERS

Use of Geographical Indication

16-. (1) When Geographical Indication has been registered for any particular product, the producers of such product who have entered in the Register as authorized users, are entitled to use the Registered Geographical Indication for goods, subject to compliance with product specification.

(2) The use of Registered Geographical Indication includes applying it on products, packages, advertising material, and any other document related to registered Geographical products.

National Logo for Certifying Geographical Indication Products

17-. (1) The Registry shall establish a National Geographical Indication logo to certify all Geographical Indication products registered in Pakistan.

(2) National Geographical Indication logo along with registered name of product and any other mark and detail shall appear on the label of marketed products in a prescribed manner.

Registration as Authorized User

18-. (1) Any person claiming to be producer of product for which Geographical Indication has been registered may apply to the Registrar in prescribed manner for registering him as "Authorized user" of such Geographical Indication.

(2) The registration as authorized user shall be for a period of ten years and renewable after every ten years, with prescribed terms and conditions.

CHAPTER VII

CONTROL MECHANISM FOR COMPLIANCE WITH THE PRODUCT SPECIFICATION

19-. (1) The use of Registered Geographical Indication by the authorized users shall be subject to compliance with the product specification entered in the Register.

(2) The applicant may nominate a certification body to certify the compliance of registered Geographical Indication products with the product specification, if necessary.

(3) The cost of such verification of compliance with the product specification may be borne by the authorized users that are subject to these control. The registered proprietor or government may also contribute to these costs.

(4) The Registry shall make public the name and address of certification bodies as referred in subsection (2) in a prescribed manner.

(5) The Registry shall oversee the efficiency of the certification bodies. In case of inefficiency, the Registry is authorized to deny the certification of a body by outlining the evidences in writing and may direct the registered proprietor to select a new certification body.

Control Mechanism

20-(1) The certification bodies in consultation with the Proprietor and the Registry shall devise detailed control mechanism including scope, frequency, and procedures of control activities and penalties to ensure the compliance of Geographical Indication Products with the product specification.

(2) The certification bodies shall submit their reports regarding the detail of certified authorized users, quantities, measures taken and any other information after such time period as may be prescribed.

(3) In case of non compliance, the certification body may recommend to the Registry, temporary or definitive suspension of use of Registered Geographical Indication for an authorized user with terms and conditions as may be prescribed.

(4) The Registry may approve the suspension under subsection (3) after such investigation and scrutiny as prescribed.

(5) The decision of the Registry shall be published and communicated to the certification body, authorized user and the Proprietor.

(6) The Proprietor shall comply the decision and report the implementation to the Registry.

(7) An appeal against the decision of the Registrar may be lodged at High Court within ninety (90) days of communication of decision to the authorized user.

Characteristics of a Certification Body

21- (1) The certification body shall be technically competent and impartial public or private body registered in Pakistan.

(2) The certification body shall be accredited in accordance with ISO/IEC17065 (general requirement for bodies operating product certification system) and any other standard as may be prescribed and updated from time to time.

(3) Accreditation referred in sub section shall be performed by Pakistan National Accreditation Council (PNAC).

(4) The Foreign certification bodies that certify the Geographical Indication Products of foreign countries should be accredited in accordance with international standards as may be prescribed and updated from time to time.

CHAPTER VIII

REVOCATION OF REGISTERED GEOGRAPHICAL INDICATION

22-(1) The Registrar may on his own motion, or on application by any interested person may revoke the registration of a Registered Geographical Indication on following grounds;

(a) Where Registered Geographical Indication is no longer used;

(b) Compliance with product specification is no longer ensured;

(c) Where proved the conditions for protection specified in subsection (1) (g) of section 2, section 5, section 7 of this bill are not fulfilled; and

(d) Where proved that entitlement to the right of proprietorship under Section 6 actually belongs to another natural or legal person.

(2) An application for cancellation may be made by an interested party to the Registrar, except that:

(a) if proceedings concerning the Geographical Indication in question are pending in the High Court or Intellectual property Tribunal, the application shall be made to the High Court or, as the case may be, the Intellectual Property Tribunal; and

(b) in case the application is made to the Registrar, he may at any stage of the proceedings refer the application to the High Court or Intellectual Property Tribunal

(3) An appeal against the decision of Registrar may be lodged at High Court within ninety (90) of date of

communication of decision to the Proprietor.

(4) The detailed proceeding for cancellation cases shall be prescribed in Rules under this Bill

CHAPTER IX

REGISTER OF REGISTERED GEOGRAPHICAL INDICATIONS AND ITS RECTIFICATION

Register of Registered Geographical Indication

23-. (1) For the purposes of this Bill, a record called the "Register of Geographical Indications" shall be established and kept at the Registry wherein shall be entered Registered Geographical Indications, product specification, names and addresses of proprietors and authorized users, control bodies and such other matters related to Registered Geographical Indication as may be prescribed.

(2) Subject to the provisions of this Bill and Rules, certified copies, sealed with the seal of the Registry, of any entry in the Register shall be given to any person on request in prescribed manner.

Rectification of Register

24-. (1) The Registrar may, on request by an interested person may:

- a. rectify an error in any entry of the Register;
- b. enter any change in name, addresses or description of Registered proprietor, authorized user or certification body.

(2) The Proprietor may request for amendment in product specification in prescribed manner, in particular in response to scientific and technical developments, or to redefine the Geographical area.

(3) The application referred in sub section (2), when involves substantial amendments to product specification, procedures laid down in Section 10 and Section 11 and section 12 shall be followed.

(4) For minor amendments, the Registrar may decide to approve the amendment of product specification without following the procedures referred in Subsection (3).

(5) All amendments and rectifications in the Register shall be published as may be prescribed.

CHAPTER X

EFFECT OF REGISTRATION

Rights Conferred by Registration of Geographical Indication

25-. (1) A Registered Geographical Indication shall grant:

- a. Right to the proprietor and authorized users to initiate proceeding against infringers and counterfeiters, and obtain relief as provided in this Bill;
- b. An exclusive right to the authorized users to use the Geographical Indication in relation to products for which it is registered, subject to compliance with the product specification.

(2) The rights conferred under subsection (1) shall not be transferable.

(3) No person shall be entitled to institute any proceeding for the infringement of unregistered Geographical Indication under this Bill.

(4) Nothing in this Bill shall affect the right of action against any person for passing off goods and any remedies thereof.

Scope of Protection

26-. (1) In Pakistan, Registered Geographical Indications shall be protected against any:

- a. Direct or indirect commercial misuse of a registered Geographical Indication in respect of identical or comparable goods to those of the registered Geographical Indication where the misuse benefited or would benefit from the reputation of the Geographical Indication;
- b. unauthorized use, imitation, translation of the Geographical Indication even if the true origin of the goods is accompanied by the expression such as “style”, “type”, “method”, “manner”, “imitation”, or translations of such expressions, or of similar expressions likely to mislead the public;
- c. Any usage in respect of dissimilar products which exploits the reputation of registered Geographical Indication;
- d. false or misleading Indication as to origin, nature, or specific quality of the goods appearing on packaging, or in advertising materials or on other documents concerning the goods that are likely to mislead its origin; and
- e. Any other practice liable to mislead the consumer as to the origin of the product.

(2) When Registered Geographical Indication contains a generic name of product, the use of generic name shall not fall within the scope of subsection (1)(a)-(e).

Duration of Protection

27-. The registration of Geographical Indication shall be for ten years from the date of the filing of the application, and renewable after every ten years in a prescribed manner, provided that its registration is not cancelled under this Bill.

CHAPTER XI

INTERACTION BETWEEN TRADEMARK AND GEOGRAPHICAL INDICATION

28-. (1) Where a Geographical Indication is registered under this Bill, an application for a Trademark consisting or containing of Geographical Indication for the same type of products, use of which contravenes the Section 26(1) shall be refused, if the application for trademark is submitted after the date of submission of Geographical Indication application.

(2) The trademarks registered in breach of subsection (1) shall be invalidated suo moto by the Registrar Trademarks or on the request of an interested party.

(3) A Trademark containing or consisting of Geographical Indication, the use of which contravenes the Section 26(1), which have been applied for, registered, or established by use under Trademark Ordinance, 2001 in good faith before the Registered Geographical Indication was protected in its country of origin or before the coming in effect of this Bill, may continue to be used. In such cases Trademark and Geographical Indication shall be allowed to coexist.

CHAPTER XII

OFFENCES, PENALTIES AND PROCEDURES

29.- (1) Any person who causes any offense mentioned under section 26(1) shall be liable to imprisonment for minimum of one year and may extend to five years and fine of minimum one million which may extend to five million rupees.

(2) In all legal proceedings related to a Geographical Indication under this Bill, the fact that a person is registered

as an authorized user of a Geographical Indication shall be prima facie evidence of his being so authorized.

Offences by companies

30.- (1) If the person committing an offence under this Ordinance is a company, the company as well as every person in charge of, and responsible to, the company for the conduct of its business at the time of the commission of the offence shall be deemed to be guilty of the offence and shall be liable to be proceeded against and punished accordingly;

Provided that nothing contained in this sub-section shall render any such person liable to any punishment if he proves that the offence was committed without his knowledge or that he exercised all due diligence to prevent the commission of such offence.

(2) Notwithstanding anything contained in sub-section (1), where an offence has been committed by a company and it is proved that the offence has been committed with the consent or connivance of, or that the commission of the offence is attributable to any neglect on the part of any director, manager, secretary or other officer of the company, such director, manager, secretary or other officer shall also be deemed to be guilty of the offence and shall be liable to be proceeded against and punished accordingly.

Implementation of the Provisional Measures and Border Measures

31.- The provisions of the provisional measures and border measures as prescribed in the "Trade Marks Ordinance, 2001 shall be also applied for geographical indications.

CHAPTER XIII

MISCELLANEOUS

Adaptation of Classification of Goods

32.- For the purpose of this Bill, the Registrar shall use the classification of goods as may be prescribed.

Conversion of Application

33.- At any time within one year from the commencement of this Bill, an application for registration of Trademark under Trade Marks Ordinance 2001, may upon payment of prescribed fee, be converted to an application filed under this Bill provided that such application fulfills the condition of sub-section 1 (g) of section 2.

Fee Determination and Collection

34.- The Organization shall prescribe a schedule of fee and charges for services rendered to the applicants and the public or as otherwise required under this Bill. Any fee collected under this Bill or the rules shall be deposited in the Organization Fund.

Power to make Rules

35. - The Organization with approval of the Federal Government, by notification in the official Gazette, may make rules to carry out the provisions of this Act.

Power to make Regulations

36.- The Organization with the approval of the Board, by notification in the official Gazette may make regulation to carry out the provisions of this Act.

Power to Remove Difficulties

37-. If any difficulty arises in giving effect to the provisions of this Bill, the Federal Government may, by notification in the official Gazette, make such provisions not inconsistent with the provisions of this Bill as may appear to be necessary for removing the difficulty.

Provided that no order shall be made under this section after the expiry of five years from the commencement of this Bill.

Repeal and Savings

38-. (1) Clause (xix) of Section 2 of the Trade Marks Ordinance, 2001 is hereby repealed.

(2) Any Geographical Indication registered as collective mark or a certification mark, under section 82 or section 83 read with section 3 of Schedule-I or section 3 of Schedule-II, respectively, under the Trademark Ordinance, 2001 shall be deemed to have been registered under this Bill.