



## **IPR ENFORCEMENT GUIDELINES FOR CUSTOMS OFFICIALS**



**JOINTLY PREPARED**

**By**

**INTELLECTUAL PROPERTY ORGANIZATION OF PAKISTAN  
(IPO-PAKISTAN)**

**AND**

**DIRECTORATE GENERAL IPR (ENFORCEMENT) PAKISTAN  
CUSTOMS**

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## **INTRODUCTION:-**

Intellectual Property Rights (IPRs) are set of exclusive rights granted by government for a specific time to protect the creations of human mind. Examples of IPRs are Patent, Trademark, Copyright, Layout Designs of Integrated Circuits and Industrial Designs etc. In Pakistan IPRs are protected under a set of IP Laws. Following IP Laws and relevant IP provisions are in force in Pakistan;

- i. Intellectual Property Organization of Pakistan Act, 2012;
- ii. Patents Ordinance 2000 (amended in 2002 and 2006);
- iii. Trade Marks Ordinance 2001;
- iv. Copyright Ordinance 1962 (amended in 2000);
- v. Registered Designs Ordinance, 2000;
- vi. Registered Layout-Designs of Integrated Circuits Ordinance, 2000;
- vii. Customs Act, 1969 (Sections 15, 16 and 17);
- viii. Customs Rules, 2001 (Chapter XXVII Rules 678 to 686).

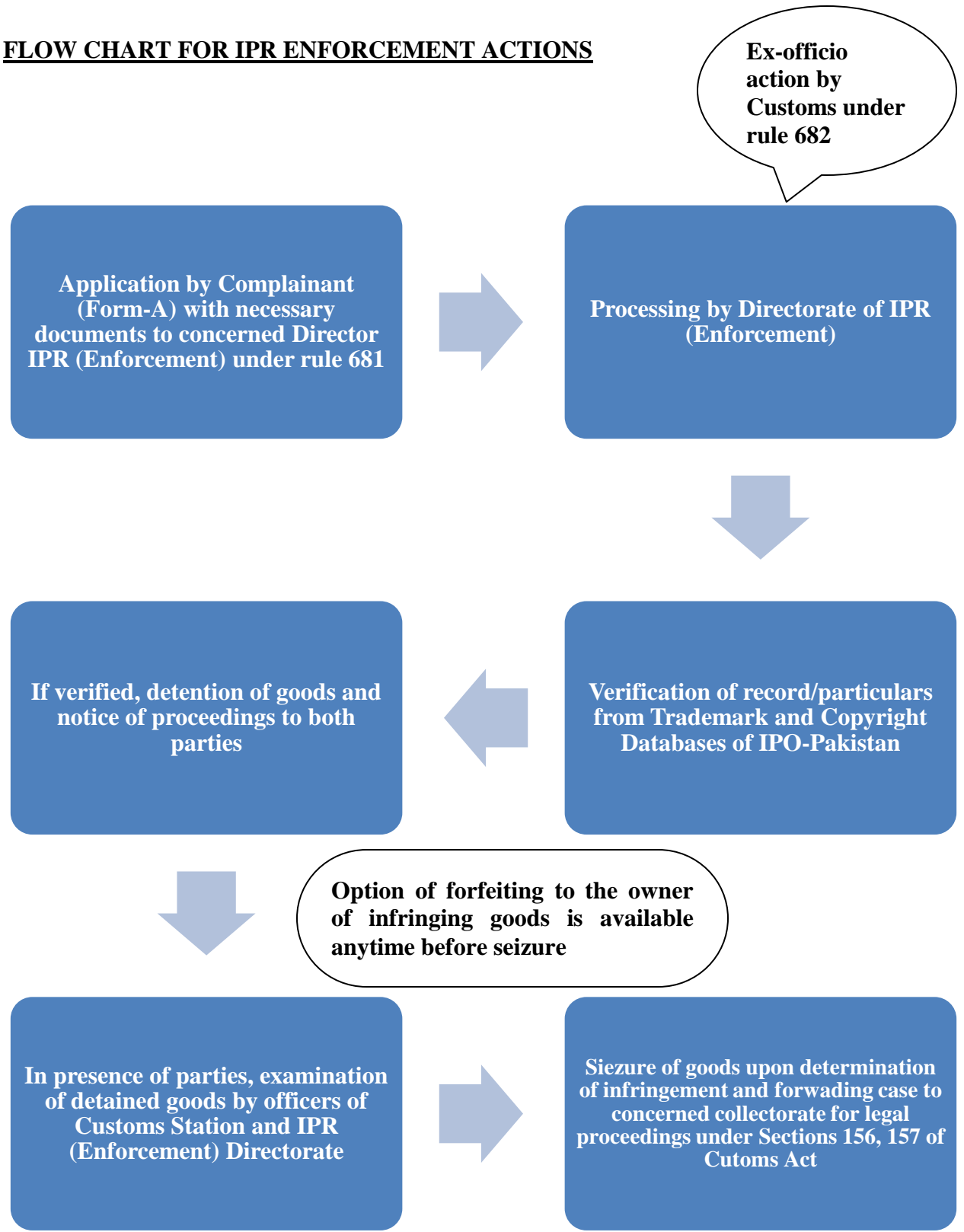
## **CHECKLIST FOR CUSTOMS OFFICERS FOR IPR ENFORCEMENT:-**

In the light of SRO No. 170(I)/2017 (Customs Rules, 2001, Chapter XXVII Rules 678 to 686), following points will be ensured by Customs Officers for IPR enforcement;

- (i) **Complaint by the Complainant:** Written complaint by the complainant on valid grounds that imported goods are infringing his IP Right under the Copyright Ordinance, 1962 or Trademark Ordinance, 2001. Application should be submitted on prescribed form (Annex-A of Customs Rules, 2001 Chapter XXVII);
- (ii) **Required Documents:** Following documents must be submitted with the application;
  - a. IPR registration certificate (from IPO-Pakistan)/certified copy of applied IPR;
  - b. Copy of CNIC;
  - c. Copy of NTN;
  - d. Indemnity Bond to indemnify Customs authorities against all liabilities (Annex-B of Customs Rules, 2001 Chapter XXVII);
  - e. Bank Gaurantee of Rs. 500,000/- or 25% of the value of suspected infringing goods (Annex-C of Customs Rules, 2001 Chapter XXVII);

- f. Certified copy of power of attorney (in case of authorized representative);
  - g. Samples/photos/media (if available);
  - h. A statement of the grounds for detention of counterfeit goods/pirated goods with prima facie evidence.
- (iii) **Verification of Documents:** The Director IPR (Enforcement) upon receipt of the application shall consult Trademark and Copyright Databases maintained by IPO-Pakistan to verify particulars of the right holder;
- (iv) **Detention of the Infringing Goods:** When satisfied with the recordation, Director IPR (Enforcement) shall order for detention of the infringing goods and notify the same in writing to the applicant as well as to the owner of the goods, asking them to join the proceedings;
- (v) **Joint Examination:** Upon joining the proceedings by both the owner of the goods and the complainant, the detained goods shall be examined jointly by an officer of Customs appointed by the Controller having jurisdiction and an officer of Directorate General of IPR (Enforcement), in presence of both parties.
- (vi) **Seizure of Goods:** Upon determination of fact that the detained goods infringe the Intellectual Property Rights of the Complainant (Right holder), such goods shall be seized by the Directorate General of IPR (Enforcement) and the case then shall be forwarded to the concerned Collectorate of Customs having jurisdiction for adjudication. The Collectorate will proceed in the light of Sections 156 and 157 of Customs Act, 1969.
- (vii) **Option of Forfeiture:** The owner of the infringing goods has option at any time prior to the seizure thereof, voluntarily give consent in writing to the Director IPR (Enforcement) for the goods being forfeited, in favor of the Federal Government, and upon receipt of such consent, the Director IPR (Enforcement) shall order forfeiture of the infringing goods.
- (viii) **Action on Receipt of Information from Customs:** An officer of Pakistan Customs, having reasonable grounds to believe that the goods infringing the provisions of Copyright Ordinance, 1962, Trademark Ordinance, 2001 or Section-15 of Customs Act, 1969 have arrived at the Customs station of his jurisdiction, shall, with the prior approval of the concerned Additional Collector, inform in writing the concerned Directorate of IPR (Enforcement) for taking cognizance. Next process will be same as mentioned under points (iii) to (vii) above.

**FLOW CHART FOR IPR ENFORCEMENT ACTIONS**



## **IMPORTANT CONTACT NUMBERS:-**

### **IPO-Pakistan:-**

- i. Mr. Aftab Muhammad Khan, Registrar of Trademarks. Plot # ST 1 & 2, New Broad Casting House (Ground Floor), Behind KDA Civic Center, Block -14, Gulshan-e-Iqbal, Karachi- 75300, Pakistan. Tel: +92-21-99230538, Fax: +92-21-99231001 Email: [tmr@ipo.gov.pk](mailto:tmr@ipo.gov.pk);
- ii. Mr. Muhammad Qazafi Rind, Registrar Copyright Office. Plot # ST 1 & 2, New Broad Casting House (Ground Floor), Behind KDA Civic Center, Block -14, Gulshan-e-Iqbal, Karachi- 75300, Pakistan. Tel: +92-21-99230140, Fax: +92-21-99230140, Email: [copyright@ipo.gov.pk](mailto:copyright@ipo.gov.pk)
- iii. Dr. Muhammad Fayyaz Ahmad, Controller of Patents & Registrar of Designs. Plot # ST 1 & 2, New Broad Casting House (Ground Floor), Behind KDA Civic Center, Block -14, Gulshan-e-Iqbal, Karachi- 75300, Pakistan. Tel: + 92 - 21 – 99230591, Fax:+92 - 21 – 99230592, E-mail: [patent@ipo.gov.pk](mailto:patent@ipo.gov.pk);
- iv. Mr. Muhammad Rafiq, In-Charge, IPO Regional Office, 15-E-1, Gulburg-III, Shahrah-e-Imam Hussain, Lahore, Ph: 042-99231981, Fax: 042-99231984, E-mail: [Lahore@ipo.gov.pk](mailto:Lahore@ipo.gov.pk)
- v. Mr. Muhammad Ismail, Director (IPR Enforcement) IPO-Headquarters: 3rd Floor, NTC Building, G-5/2, Ataturk Avenue (East), Islamabad. Tele. 051-9245892, Fax. 051-9245874 E-mail. [Muhhammad.ismail@ipo.gov.pk](mailto:Muhhammad.ismail@ipo.gov.pk);

### **Pakistan Customs:-**

- i. Mr. Aamer Rashid Shaikh, Director IPR Enforcement, Karachi. Cell: 0301-2790539, Email: [amerrashidsh@gmail.com](mailto:amerrashidsh@gmail.com).
- ii. Dr. Rizwan Basharat, Additional Director, IPR Enforcement, Lahore. Cell: 0300-8263668, Email: [rizwan.basharat@fbr.gov.pk](mailto:rizwan.basharat@fbr.gov.pk).

## ANNEXURE-I

### **RELEVANT PROVISIONS OF CUSTOMS ACT, 1969**

Section-4 of the Customs Act, 1969 mentions duties of a Customs Officer as follows;

**4. Powers and duties of officers of customs.-** *An officer of customs appointed under section 3 shall exercise such powers and discharge such duties as are conferred or imposed on him by or under this Act; and he shall also be competent to exercise all powers and discharge all duties conferred or imposed upon any officer subordinate to him: Provided that, notwithstanding anything contained in this Act or the rules, the Board may, by general or special order, impose such limitations or conditions on the exercise of such powers and discharge of such duties as it thinks fit.*

Section-15 of the Customs Act, 1969 speaks about prohibitions of export and import as follows;

**15. Prohibitions.-** *No goods specified in the following clauses shall be brought into or taken out of Pakistan, namely:-*

- a. *counterfeit coins, forged or counterfeit currency notes, and any other counterfeit product;*
- b. *any obscene book, pamphlet, paper, drawing, painting, representation, figure, photograph, film, or, article, video or audio recording, CDs or recording on any other media;*
- c. *goods having applied thereto a counterfeit trade mark within the meaning of the Pakistan Penal Code, 1860 (Act XLV of 1860), or a false trade description within the meaning of the Copyright Ordinance, 1962 (XXXIV of 1962), the Registered Layout-Designs of Integrated Circuits Ordinance, 2000 (XLIX of 2000), the Registered Designs Ordinance, 2000 (XLV of 2000), the Patents Ordinance, 2000 (LXI of 2000), and the Trade Marks Ordinance, 2001 (XIX of 2001), or goods imported or exported in contravention of the provisions of section 32;*
- d. *goods made or produced outside Pakistan and having applied thereto any name or trade mark, being or purporting to be the name or trade mark of any manufacturer, dealer or trader in Pakistan, unless,-*
  - (i) *the name or trade mark is, as to every application thereof, accompanied by a definite indication of the goods having been made or produced in a place outside Pakistan; and*
  - (ii) *the country in which that place is situated is in that indication shown in letters as large and conspicuous as any letter in the name or trade mark, and in the same language and character as the name or trade mark;*
- e. *goods involving infringement of copyright, layout-design of integrated circuits, industrial designs, patents within the meaning of the Copyright Ordinance, 1962 (XXXIV of 1962), the Registered Designs Ordinance,*

2000 (XLV of 2000), and the Patents Ordinance, 2000 (LXI of 2000), respectively; and

- f. goods made or produced outside Pakistan and intended for sale, and having applied thereto, design in which copyright exists under the Copyright Ordinance, 1962 (XXXIV of 1962), the Registered Layout-Designs of Integrated Circuits Ordinance, 2000 (XLIX of 2000), the Registered Designs Ordinance, 2000 (XLV of 2000), the Patents Ordinance, 2000 (LXI of 2000), and the Trade Marks Ordinance, 2001 (XIX of 2001), in respect of the class to which the goods belong or any fraudulent or obvious imitation of such design, patent, copyright except when the application of such design has been made with the license or written consent of the registered proprietor, right holder of the design, patent or copyright, as the case may be.

Section-16 of the Customs Act, 1969 mentions about power to prohibit or restrict importation and exportation of goods as follows;

**16. Power to prohibit or restrict importation and exportation of goods.-** The Federal Government may, from time to time, by notification in the official Gazette, prohibit or restrict the bringing into or taking out of Pakistan of any goods of specified description by air, sea or land.

Section-17 of the Customs Act, 1969 empowers Customs Officers about Detention, seizure and confiscation of imported goods as follows;

**17. Detention, seizure and confiscation of goods imported in violation of section 15 or section 16.-** Where any goods are imported into, or attempted to be exported out of, Pakistan in violation of the provisions of section 15 or of a notification under section 16, such goods shall, without prejudice to any other penalty to which the offender may be liable under this Act or the rules made thereunder or any other law, be liable to detention, for seizure or confiscation subject to approval of an officer not below the rank of an Assistant Collector of Customs, and seizure for confiscation through adjudication, if required.

## ANNEXURE-II

### **COPYRIGHT LAW PROVISIONS (COPYRIGHT ORDINANCE, 1962 (AMENDED IN 2000)):-**

**65A. Prohibition, --** No infringing copies of any work, whether themselves or depicted or applied to any article or goods or in any form, shall be allowed to be imported into or exported out of Pakistan either by sea, air, land or through any other means of channel of communication.

**65B. Jurisdiction of Officers of customs, --** (1) An officer of custom functioning under the Custom Act, 1969 (IV of 1969), may, upon an application by the owner of copyright in the work or any other person having an interest in the copyright in the work, detain



any consignment intended to be imported into or exported out of Pakistan which is suspected to contain infringing copies of any work. (2) A consignment detained under subsection (1), shall be examined by an officer of customs in the presence of parties and upon determination that such consignment contains infringing copies of any work the same shall be ordered to be confiscated and the importer or exporter thereof, as the case may be, shall be liable to such penalties as provided in this behalf in the Customs Act, 1969 (IV of 1969) Provided that all the process of detention and examination of the consignment as provided in this section shall be completed ordinarily within a period of fifteen days of the filing of the application by the aforesaid person : Provided further that an order passed by any officer of customs under this section shall be deemed to be an order passed under the Customs Act, 1969 (IV of 1969), and shall be appealable as such.

**65C. Release of detained consignment, --** in case where the consignment intended to be imported into or exported out of Pakistan has been detained by an officer of customs under section 65B and requirements of the first proviso to that section are not completed, the importer or exporter of such consignment, as the case may be, may apply to the concerned custom authorities for release of such goods subject to furnishing such security as may be deemed appropriate by the officer of customs.

### ANNEXURE-III

#### **RELEVANT PROVISIONS OF TRADEMARK ORDINANCE, 2001**

Chapter VI (Section 53 to 66) of Trademark Ordinance, 2001 gives detailed information about importation of infringing goods, material or article as follows;

**53. Infringing goods, material or articles may be treated as prohibited.-** (1) The proprietor of the registered trade mark may give notice in writing to the Collector of Customs that- (a) he is the proprietor of the registered trade mark; (b) at a time and place specified in the notice, goods which, in relation to that registered trade mark are infringing goods, material or article, or bear false indications as to their source or the identity of their manufacture are expected to arrive in Pakistan from outside Pakistan and that they are subject to the control of the customs authorities under the Customs Act, 1969 (IV of 1969): and (c) he requests the Collector of Customs to treat such goods as prohibited goods.

**54. Notice for intervention by customs authorities.-** When any notice to the Collector of Customs is made under section 53, it shall be accompanied by an undertaking by the person sending the notice to indemnify the customs authorities concerned and to compensate any importer, consignee or owner of the goods for loss or damage resulting from the wrongful suspension of clearance of goods.

**55. Furnishing of security or equivalent assurance to customs authority.-** The Collector of Customs may require an applicant to provide a security or equivalent assurance sufficient to protect the importer, consignee or owner of the goods but such security or

*equivalent assurance shall not be such as to unreasonably deter recourse to these procedures.*

**56. Collector of Customs may seize goods bearing infringing trade mark.-** *If goods to which section 53 applies- (a) bear on them a trade mark which, in the opinion of the Collector of Customs, is identical with, or deceptively similar to the registered trade mark; and (b) are goods in respect of which the trade mark is registered, the Collector of Customs shall seize the goods unless he is satisfied that there are no reasonable grounds of believing that the trade mark shall be infringed by the importation of the goods and the seized goods shall be kept in a secure place as directed by the Collector of Customs.*

**57. Notice of seizure.-** *The Collector of Customs shall, as soon as practicable- (a) give, either personally or by urgent post, to the importer, consignee or owner of the goods a notice of seizure in writing identifying the goods and stating that they have been seized under section 56; and (b) give to the applicant a notice in writing- (i) identifying the goods and stating that they have been seized under section 56; (ii) giving the full name and address of the importer, consignee or owner of the goods and any information that the Collector of Customs has and believes, on reasonable grounds, to be likely to help the applicant to identify the importer or the owner of the goods; and (iii) stating that the goods shall be released to the importer, consignee or owner of the goods unless the applicant brings an action for infringement of the registered trade mark in respect of goods before a District Court having jurisdiction in the matter and gives the Collector of Customs notice in writing of the action, within the period of ten working days after the applicant has been given the notice, or if the Collector of Customs extends the period under sub-section (1) of section 60, within such extended period.*

**58. Forfeiture of goods.-** *If the importer, consignee or owner of any seized goods, at any time before the applicant starts an action for infringement of the trade mark in respect of goods, by notice in writing to the Collector of Customs, gives consent to the goods being forfeited by the Collector of Customs, the goods shall be so forfeited by the Collector of Customs.*

**59. Release of goods.-** *(1) The Collector of Customs shall release the seized goods to their designated importer, consignee or owner if, within the specified period, the applicant has not- (a) brought an action for infringement of the registered trade mark in respect of the goods, and (b) given to the Collector of Customs notice in writing of the action. (2) The Collector of Customs shall also release the seized goods to their designated importer, consignee or owner if- (a) before the end of the prescribed period, the applicant, by notice in writing to the Collector of Customs, consented to the release of the goods; and (b) at that time- (i) the applicant has not brought an action for infringement of the registered trade mark in respect of the goods; or (ii) the action brought by the applicant has been withdrawn. (3) The Collector of Customs may release the seized goods to their designated importer, consignee or owner before the end of the specified period if, (a) having regard to information that has come to his knowledge after the goods were seized, he is satisfied that there are no reasonable grounds of believing that the registered trade mark has been infringed by the importation of the goods; and (b) the applicant has not so far brought an action for infringement of the registered trade mark in respect of the goods, or has not informed him of such an action.*

**60. Action for infringement against importation goods.-** (1) The applicant may bring an action for infringement of a registered trade mark in respect of the seized goods and give a notice to the Collector of Customs, subject to the provisions of clause (b), within ten working days specified in the notice given to the applicant in respect of the goods, under section 57 or if- (i) the applicant has, before the expiry of the specified period, applied in writing to the Collector of Customs, being satisfied that in the circumstances of the case it is fair and reasonable to do so, has extended the specified period for a number of working days not exceeding ten days, within that period so extended by the Collector of Customs. (2) A District Court hearing the action- (a) may, on the application of any person, allow that person to be joined as a defendant in the case; and (b) shall allow the Collector of Customs, or his duly authorized officer, to appear and be heard. (3) Subject to sub-section (4), in addition to any relief that a District Court may grant apart from the provisions of this section, the Court may- (a) at any time, if it thinks it just, order that the seized goods be released to their designated owner subject to such conditions that the Court considers fit to impose; or (b) order that the seized goods be forfeited. (4) A District Court shall not make any order which may facilitate- (a) re-exporting of the counterfeit trade mark goods; (b) removing of the trade marks which have been affixed to the counterfeit trade mark goods without authorization; and (c) local sale of such goods. (5) If a District Court decides that the registered trade mark was not infringement by the importation of the goods and the designated importer, consignee or owner of the goods, satisfies the Court that he has suffered losses or damage because the goods were seized, the Court may order the applicant to pay the defendant compensation, in the amount determined by the Court, for any part of the loss or damage that is attributable to any period beginning on or after the day on which the action was brought. (6) If, after three weeks from the day on which the action was brought, there is not in force at any time an order of a District Court preventing the goods from being released, the Collector of Customs shall release the goods to their designated importer, consignee or owner. (7) If a District Court orders that the goods be released, the Collector of Customs shall, subject to section 63, comply with the order.

**61. Action for infringement by licensee in relation to any seized goods.-** If an exclusive licensee of a registered trade mark is an applicant in relation to any seized goods, the licensee may commence an action for the infringement of the registered trade mark in respect of the goods within the required period without first ascertaining whether the proprietor is willing to bring the action.

**62. Disposal of forfeited goods.-** (1) Subject to sub-section (2), any goods forfeited under the provisions of this Chapter shall be disposed of by the Collector of Customs in the manner as if the goods were forfeited the Customs Act, 1969 (IV of 1969). (2) The Collector of Customs shall not dispose of goods in a manner which may facilitate- (a) re-exporting of the Counterfeit trade mark goods; (b) removing of the trade marks, which have been affixed to the counterfeit trade mark goods without authorization; and (c) local sale of such goods.

**63. Power of the Collector of Customs to retain control of goods.-** Notwithstanding anything contained in this Chapter, the Collector of Customs shall not- (a) release, or dispose any goods; or (b) take any action in relation to the goods to give effect to any order of a District Court under section 60. and Collector of Customs shall apply to the

*District Court to request that the goods are required and he may be allowed to retain control of the goods under any law for the time being in force.*

**64. Insufficient security.-** *If security given under section 55 by the applicant who gave notice in respect of a registered trade mark under section 53 or 61 is not sufficient to meet the expenses incurred by the Federal Government as a result of the action taken by the Collector of Customs under this Chapter, because of the notice, the amount of the difference in the expenses and the amount of security- (a) shall be a debt due by the applicant to the Federal Government; and (b) shall be recovered by the Federal Government under section 202 of the Customs Act, 1969 (IV of 1969).*

**65. The Federal Government not be liable to loss, etc., suffered because of seizure.-** *The Federal Government shall not be liable to any loss, damage or delays suffered by a person- (c) because the Collector of Customs seized or failed to seize goods under this Chapter; or (d) because of release of any seized goods.*

**66. Power of the Collector of Customs to make regulations.-** *The Collector of Customs may make regulation prescribing the form in which notices shall be made and requiring the person making the notice to furnish evidence to the ownership and to comply with such other conditions as may be specified which may include the payment of a fee to cover the administrative costs.*

#### **ANNEXURE-IV**

### **CHAPTER-XXVIII, ENFORCEMENT OF INTELLECTUAL PROPERTY RIGHTS, CUSTOMS RULES, 2001 (SRO NO. 170(I)/2017.**

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