



**GOVERNMENT OF PAKISTAN**  
**Intellectual Property Organization of Pakistan**  
**Commerce Division**



16/DD/WIPO2019

Islamabad, the 18<sup>th</sup> March, 2021

**Subject: REQUEST FOR UPDATEED INFORMATION ON THE REFERENCE DOCUMENTS PRODUCED BY STANDING COMMITTEE ON THE LAW OF PATENTS**

Reference Pakistan Mission to the United Nations, Geneva's Fax Message No. WIPO-1/1/2021-dated 09<sup>th</sup> February, 2021 on above subject.

2. Comments from IPO-Pakistan are enclosed as annex.

With Best Regards,

Encl: (as above).

Yours Sincerely,

**(Humaira Shakeel)**  
**Deputy Director (WIPO)**

✓ Ms. Wajeeha Fatima,  
Deputy Director (IC)  
Ministry of Foreign Affairs,  
Islamabad.

CC: **Mr. Salman Khalid Chaudhry, Parepun, Geneva.**



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**Views and Comments of the Patent Office on the reference documents  
produced by Standing Committee on the Law of Patents by WIPO for  
updated information on the SCP documents**

Sr. No.	Response needed from IPO-Pakistan on the point	Response from IPO-Pakistan
1	<p><b>(i) Certain Aspects of National/Regional Patent Laws</b></p> <p><b>1. Prior Art</b></p>	<p>According to the Section 8(2) of the Patent Ordinance, 2000, the state of the art comprises:</p> <ol style="list-style-type: none"> <li>1. Everything disclosed to the public anywhere in the world, by publication in tangible form or oral disclosure, by use or in any other way prior to the, prior to the filing or, where appropriate, the priority date, of the application claiming the invention; or</li> <li>2. Contents of complete specifications and priority documents filed in Pakistan published in the official Gazette, on the acceptance of patent applications.</li> <li>3. Traditionally developed or existing knowledge available or in possession of a local or indigenous community.</li> </ol>
	<p><b>2. Novelty:</b></p>	<p>According to the Section 8(1) of the Patent Ordinance, 2000, an invention shall be considered to be new if it does not form part of the state of the art. The state of the art comprises everything disclosed to the public anywhere in the world, by publication in tangible form or oral disclosure, by use or in any other way before the filing date (priority date), and the contents of complete specifications and priority documents filed in Pakistan published in the official Gazette, on the acceptance of patent applications. The</p>

		state of the art also comprises traditionally developed or existing knowledge available or in possession of a local or indigenous community.
	<b>3. Inventive Step (Obviousness)</b>	<p>According to the Section 9 of the Patent Ordinance, 2000, an invention is 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</p> <p>The state of the art consists of everything disclosed to the public anywhere in the world, by publication in tangible form or oral disclosure, by use or in any other way before the filing date (priority date), the contents of complete specifications and priority documents filed in Pakistan published in the official Gazette, on the acceptance of patent applications and traditionally developed or existing knowledge available or in possession of a local or indigenous community.</p>
	<b>4. Grace Period</b>	<p>According to the Section 8(3) of the Patent Ordinance, 2000, disclosure not to be taken into account in determining novelty if it occurred within 12 months before the filing date due to display of the invention at an official or officially recognized international exhibition. 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.</p>

	<p><b>5. Sufficiency of Disclosure</b></p>	<p>According to the Section 15(3) of the Patent Ordinance, 2000, the specification shall:</p> <ol style="list-style-type: none"> <li>a) fully and particularly describe the invention and the methods by which it is to be performed;</li> <li>b) disclose the invention which is known to the applicant and for which he is entitled to claim protection;</li> <li>c) end with a claim or claims concisely defining the scope of the invention for which protection is claimed.</li> </ol>
	<p><b>6.Exclusions from Patentable Subject Matter</b></p>	<p>According to the Section 7 of the Patent Ordinance, 2000, the following shall not be regarded as invention:</p> <ul style="list-style-type: none"> <li>• Discoveries, scientific theories and mathematical methods.</li> <li>• Literary, dramatic, musical or artistic works.</li> <li>• Schemes, rules and methods for doing business, performing mental acts and playing games.</li> </ul>

		<ul style="list-style-type: none"> <li>• Presentation of information.</li> <li>• Substances that exist in nature or if isolated therefrom.</li> </ul> <p>Inventions the commercial exploitation of which is contrary to public order, morality, including protecting 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 in force.</p> <ul style="list-style-type: none"> <li>• 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</li> <li>• Diagnostic, therapeutic and surgical methods for the treatment of humans or animals</li> <li>• A new or subsequent use of a known product or process</li> <li>• 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.</li> </ul>
	<p><b>7. Exceptions and Limitations of the Rights</b></p>	<p>Under Section 30(5) of the Patents Ordinance, patent rights extend only to acts performed for industrial or commercial purposes. Therefore, acts not covered by patent rights include:</p> <ol style="list-style-type: none"> <li>1. Private acts for non-commercial purposes.</li> <li>2. Acts in respect of articles put on the market anywhere in the world by, or</li> </ol>

		<p>with the consent of, the patent owner or by an authorized person or in any other legitimate manner such as compulsory licenses.</p> <p>3. Use of articles on foreign aircraft, vehicles or vessels which temporarily or accidentally enter the airspace, territory or waters of Pakistan.</p> <p>4. Acts, including tests, necessary for the approval of a product for its commercialization after the expiration of the patent.</p> <p>5. Acts done only for experimental purposes relating to a patented invention.</p> <p>6. Continued prior use by a person who, in good faith before the filing date (priority date), was using the invention, or making effective and serious preparations for that purpose.</p> <p>7. Acts done for teaching purposes in educational or research institutions.</p> <p>8. Compulsory licenses, subject to remuneration.</p> <p>Notably, patent rights may be limited under compulsory licenses if the state exploits a patented invention for reasons of public interest (e.g. national security, nutrition or health or the development of other vital sectors of the Pakistan economy).</p>
2	<p><b>(ii) Opposition System and other Administrative Revocation and Invalidation Mechanisms in Pakistan.</b></p> <p><b>Pre-Grant Opposition</b></p>	<p>A patent can be opposed on a number of grounds stipulated under section 23 of the Patents Ordinance 2000 at any time within four months from the date of advertisement of the acceptance of a complete specification by giving notice to the Controller of opposition to the grant of the patent.</p> <p>The grounds for invalidating a patent consist of the following:</p> <p>(a) that the applicant for the patent obtained the invention or any part</p>

		<p>thereof from him or from the person of whom the opponent is the legal representative, assignee, agent or attorney;</p> <p>(b) that the invention is not a patentable invention within the meaning of this Ordinance;</p> <p>(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;</p> <p>(d) that the claims are not clear or extend beyond the scope of the disclosures in the complete specification as originally filed; and</p> <p>(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.</p> <p>Where a notice is given, 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.</p> <p>Upon receiving a notice of opposition from the interested person, the Controller shall send the notice of the opposition to the applicant, and shall, before deciding the case, give the applicant and the opponent an</p>
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		<p>opportunity of being heard. In concluding the argument of both parties, the opposition is decided by the Controller of Patents.</p> <p>According to Section 50 of the Patents Ordinance 2000, the Controller of Patents exercises powers of Civil Court in opposition proceedings. An appeal can be filed against the decisions of the Controller of Patents with the High Court under Section 69 of the Patent Ordinance 2000, to be filed within 90 days. If no appeal is filed with the High Court within 90 days, the patent is sealed and granted upon the final determination of the opposition proceedings.</p>
	<p><b>Revocation of Patent</b></p>	<p>In addition to the pre-grant opposition mechanism, a system of revocation of patents by the Controller is provided for under Section 47 of the Patents Ordinance 2000, according to which at any time within twelve months after the sealing of a patent, any interested person 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.</p> <p>Where a request for revocation is made under Section 47, the Controller shall give notice to the patentee and shall give to the person requesting such revocation and the patentee an opportunity of being heard before deciding the case. If the Controller is satisfied that any of the grounds are</p>



		<p>established, he may order 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.</p>
3	<p><b>(iii) International Worksharing and Collaborative Activities for Search &amp; Examination of Patent Applications</b></p>	<p>Worksharing is a tool for patent offices to limit the amount of repeated work that they carry out by reusing, to the extent possible, the work previously generated in related patent applications by other offices. After a first office carries out a search and examination of a patent application, those results are used by other offices to facilitate their own later search / examination of a related application.</p> <p>Currently, Pakistan is not carrying out worksharing collaboration with other offices but rather conduct full international search on every application that came through its office or office also sometimes take advantage of the search results of earlier Patent Cooperation Treaty applications in conducting their own search and examination.</p> <p>Pakistan Patent Office has not yet established any formal worksharing project, however the Patent Office at times require “an applicant for a patent to provide information concerning the applicant’s corresponding foreign applications and grants under section 20 of the Patent Ordinance, 2000.</p> <p style="text-align: center;"><b><u>PROPOSAL:</u></b></p> <p>The Patent Office proposes that IPO-Pakistan should opt for a formal worksharing project/arrangement as it may contribute to making the work of the Patent Office more efficient and effective.</p>

		<p>Various frameworks, mechanisms and tools have been developed in order to share such search and examination work products. These arrangements include:</p> <ul style="list-style-type: none"> <li>• Use of search and examination results of other patent office;</li> <li>• Cooperation on the use of search and examination capacity i.e. when conducting patent search and examination, search and examination expertise and resources available in other offices may be utilized;</li> <li>• Collaboration between/among patent offices to jointly search patent applications i.e. examiners from different patent offices with complementary skills may work together on the corresponding patent applications filed with those patent offices.</li> </ul> <p>For instance, there are various worksharing regional/bilateral/plurilateral frameworks available:</p> <p><b><u>ASEAN Patent Examination Co-operation Program (ASPEC):</u></b></p> <p>A work-sharing program with the purpose of sharing search and examination results between the participating intellectual property offices of the Member States of the Association of Southeast Asian Nations (ASEAN), namely, Brunei Darussalam, Cambodia, Indonesia, Lao PDR, Malaysia, the Philippines, Singapore, Thailand, and Viet Nam.</p> <p>The availability of external patent</p>
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		<p>information through such collaborative frameworks is substantially effective, however such information including examination reports should not be binding on the Pakistan Patent Office as such. This means that granting a patent in one country of the worksharing framework does not force other countries to grant the patent for the same invention. Also, the refusal of the patent in one country does not mean that it will be terminated in all the countries rather the shared patent information and examination work products should merely serve the purpose of facilitating the evaluation of patentability claimed in the application filed in Pakistan or in the patent granted on the basis of that application. In this way Pakistan will have the opportunity to ensure the quality of patents granted within Pakistan as well as the safeguarding of public national interest including availing the flexibilities accorded by the patent system.</p>
4	<p><b>(iv) Client Attorney Privilege and its applicability to Patent Advisors</b></p>	<p>Client privilege is the right of a client not to have to disclose information (communications and/or documents*) which would otherwise have been required. In common law countries, client privilege may allow a client or a patent professional to keep communications and/or documents secret and to be silent on certain issues under a discovery system.</p> <p>Please note that there are no provisions of professional confidentiality or privilege in Pakistan in the Patent Ordinance, 2000. The act which deals with such provisions is the Qanun-e-Shahadat (1984). The relevant section i.e. Article 9 is quoted below:</p>

		<p>No advocate shall at any time be permitted, unless with his client's express consent, to disclose any communication made to him in the course and for the purpose of his employment as such advocate by or on behalf of his client, or to state the contents or condition of any document with which he has become acquainted in the course and for the purpose of his professional employment, or to disclose any advice given by him to his client in the course and for the purpose of such employment:</p> <p>Provided that nothing in this Article shall protect from disclosure –</p> <ol style="list-style-type: none"> <li>1. any such communication made in furtherance of any illegal purpose; or</li> <li>2. any fact observed by any advocate, in the course of his employment as such, showing that any crime or fraud has been committed since the commencement of his employment, whether the attention of such advocate was or was not directed to such fact by or on behalf of his client.</li> </ol> <p>Broadly speaking, Pakistani law confers attorney-client privilege upon certain communication/information in two situations:</p> <ol style="list-style-type: none"> <li>a. communications with an “advocate” and</li> <li>b. communications with a “legal adviser.”</li> </ol> <p>In Pakistan, an “advocate” is defined as a lawyer who is registered with a bar council. The law prevents an advocate from disclosing or stating any communication, document or advice that the former has received from, become acquainted with or given to his client during the course of and for the purpose of his</p>
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		<p>employment/engagement as such, unless the client expressly consents otherwise. This obligation continues even after the engagement/employment ceases. However, there are limitations on the extent of this privilege as it does not extend to:</p> <p>(1) any such communications made in furtherance of any illegal purpose, and</p> <p>(2) any fact observed by an advocate, in the course of his employment/engagement as such, showing that any crime or fraud has been committed since the commencement of his employment/engagement, whether his attention was or was not directed to such fraud by or on behalf of his client.</p> <p>The term "legal adviser" is broader than the term "advocate" as it may include any professionally qualified lawyer even if he is not registered with Bar Council. Under Pakistani law, a client may not be compelled to disclose to the Court or any judicial authority any confidential communication that took place between him and his legal adviser. However, where such a client offers himself as a witness he may be compelled to disclose only such communications as may appear to the court necessary in order to explain any evidence which he has given.</p> <p>When the in-house counsel is an "advocate," professional communications between him and his client would be protected under both the above-mentioned types of privileges. In the event that the in-house counsel is not an advocate, then only the second category of the attorney-client privilege, as mentioned above, may be conferred upon communications/information passed</p>
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		<p>between the counsel and his client.</p> <p>It is necessary that the communications must have been made in the course of and for the purpose of professional engagement/employment. Also, the privilege extends only to those communications which are confidential and circumstances have to be examined in order to see whether the presumption of confidentiality has been raised or not.</p> <p>Pakistani law in this area is developing and, therefore, whether attorney-client privilege regarding any connection/information can be invoked requires a contextual examination.</p>
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