

## **IPR Toolkit - Pakistan**

### **Designs**

#### **Introduction to Designs**

An “industrial design” or “design” in Pakistan means the features of shape, configuration, pattern and ornament applied to an article by any industrial process, having features that in the finished article appeal to and are judged solely by the eye. It however does not include a method or principle of construction or features of shape or configuration, which are dictated solely by technical and functional considerations. The design may consist of three-dimensional features, such as the shape or surface of an article, or of two-dimensional features, such as patterns, lines or color. Designs are applied to a wide variety of products of different industries such as handicrafts, medical instruments, watches, jewelry, housewares, electrical appliances, vehicles and architectural structures. An industrial design is primarily of an aesthetic nature, and does not protect any technical features of the article to which it is applied. Under the Pakistani law, a trademark or a copyright in artistic, literary, dramatic or musical work cannot be registered as a design.

The first design-related legislation in Pakistan was the Patents and Designs Act, 1911. There were various amendments to this Act and finally this Act was replaced by the Registered Design Ordinance, 2000.

The registration of industrial designs in Pakistan gives the registered proprietor exclusive rights to the same. The right holder is able to prevent unauthorized copying or imitation of his or her design by third parties. Moreover, as an industrial design adds to the commercial value of a product and helps in its commercialization, its protection ensures a fair return on the investment made by the right holder. Industrial designs also produce more aesthetically attractive and diversified products.

Design rights are granted on a country-by-country basis, with a Pakistani registration providing protection only in Pakistan. If the right holder wishes to protect a design in other countries then they have to seek protection in each country separately under the relevant law. Pakistan has not yet acceded to the Hague System for the International Registration of Industrial Designs, which gives the owner of an industrial design the possibility of having his or her design protected in several countries by simply filing one application in one language with the International Bureau of the World Intellectual Property Organization (WIPO).

#### **Market Entry Planning**

Pakistan follows the “first-to-file” system and therefore it is imperative that creators apply for the registration of their design at the earliest possible moment. This is to ensure that no other person can claim prior rights to the design. Furthermore, the

application for design in Pakistan has to be filed before it is published so that the novelty of the design is not lost.

In order to protect rights to the design, creators should include the following as a part of an overall strategy:

- Hire a law firm competent to handle IPR matters in Pakistan.
- Apply for a clearance search at the Patent Office in order to ensure that the design is available for registration.
- If the design is available for registration, immediately apply for the registration of the design.
- If you discover that your design is being infringed, you should take immediate steps to enforce your rights, e.g. filing cancellations, conducting investigations, sending cease and desist notices, or initiating appropriate legal actions.

### **What can be registered as a design and who can apply**

Any person (including a partnership firm or a body corporate) claiming to be the proprietor of a design can apply for its registration so long as the design is:

- New or original;

In the case of *Maniar Industries Ltd. v. Mobin Plstic Industries* {1987 CLC 135 (Karachi)}, the Karachi High Court confirmed that only a new or original design that has not been previously published can be registered by the Controller.

- Not previously published in any country;

In the case of *Universal Brushware (Private) Limited v. Syed Industries* {1991 CLC 382 (Karachi)}, the Karachi High Court refused to grant an injunction to Universal on the ground that “a person, who has imitated a design from abroad, has no right to have a claim over it even if he gets it registered in Pakistan because it is neither new nor original.”

- Not contrary to public order or morality.

### **Registration Procedure**

Suggested steps for the registration of a design in Pakistan are as follows:

- Select an IPR law firm in Pakistan

It is advisable to select a law firm dealing in IP matters with an understanding of the protection and enforcement systems in Pakistan.

- Conduct a design search in order to ascertain the availability of the design.

It is advisable that a right holder conduct a design search to check if the design is available. If it is available the right holder can proceed with the filing of the application in Pakistan.

- Preparing the documents and filing the application.

The application can be filed directly by the Applicant or his/her assignee or authorized agent in the prescribed form. The required application information includes the name, address and nationality of the right holder, the class in which the design is to be filed, representation of the design, name of articles to which the design is to be applied, address for service in Pakistan, and priority details in case the right holder is claiming priority from a Paris Convention application. The application has to be signed by the right holder or their authorized agent. The format of the application to be filed is available at <http://www.ipo.gov.pk/Designs/DesignForms.aspx>. Designs under the Pakistani law have been categorized in 14 separate classes in order to provide for systematic registration. The application can be filed at the Patent Offices in Karachi or Lahore.

- Review by Patent Office

After the application has been filed, the Patent Office reviews it to ensure that it is complete and assigns a number to the application.

- Examination of the Application

During the examination process the Patent Office determines if the design is eligible for registration. Accordingly, the Office may issue a statement of objections and the Applicant must respond within a period of one month from the official communication of objection. Should the Applicant not respond to the objections within this time frame, the Applicant is deemed to have withdrawn its application. Based on the Applicant's response, the Registrar of Designs determines if the application should be refused, accepted, or scheduled for a hearing. If the application is rejected the Applicant can file an appeal in the High Court.

- Registration

When the design application is accepted, the Controller of Designs directs the registration of the design. The details of the application and any figures representing the articles to which the design has been applied is published in the

Official Gazette. After registration of the design, the details are entered in the Register of Designs.

- **Term of Registration**

A design is valid for a period of 10 years from the date of registration. It is further renewable for two terms of 10 years each.

After the design has been registered, any party aggrieved by the registration of the design can file an application for its cancellation to the High Court, or if within two years of registration, to the Registrar of Designs. The application for cancellation has to be filed in the prescribed format. Any aggrieved person can initiate a cancellation action on the grounds that the specific substantive requirements prescribed in the Ordinance have not been fulfilled, the industrial design is contrary to public order or morality, or the person in whose name the industrial design is registered has no right to it. The decision of the Registrar of Designs in these proceedings can be appealed before the High Court. The Registrar might at any time during the cancellation proceeding refer the matter to the High Court and the High Court will thereafter decide the same.

Any aggrieved person can also file a petition for rectification to rectify any entry that has been made in the Register of Designs before the High Court and the High Court may order the Register of Designs to be rectified by the making of any entry or varying it or deleting it.

### **Infringement & Enforcement Remedies**

It is an infringement of a right holder's industrial design if any person makes, sells, or works articles bearing or embodying a design which is a copy of the registered design without the consent of the rights holder, for commercial purposes.

In the case of *Select Sports A.S. Company v. Tempo Enterprises* {PLD 1998 Lahore 69}, the Lahore High Court while granting a temporary injunction in favor of Select Sports stated that because the design of Select Sports is registered, it would be unlawful for any other person to apply the design or cause it to be applied to any product.

A rights holder can initiate a civil suit against an infringer seeking an injunction and recovery of damages. The rights holder also has the right to initiate a criminal action against the infringer. A guilty verdict is punishable with up to two years in prison, fine of PKR 20,000 (approximately \$331) or both.

### **Administrative Provisions**

Besides the civil and the criminal remedies mentioned above, there are also provisions under the Customs Act, 1959 which prohibit the import or export of infringing goods. Goods seized for the violation of these provisions may be liable for

detention, seizure, or confiscation by the Customs authorities and subject to penalties as described under the Customs Act, 1969.

### **Expected Developments**

Regulations under the Registered Designs Ordinance, 2000 have not yet been formed. The government of Pakistan will soon draft and promulgate these rules.

### **Design Legislation in Pakistan**

Registered Design Ordinance, No. XLV of 2000

### **International Industrial Design: Treaties to which Pakistan is a Signatory**

Paris Convention for the Protection of Industrial Property  
Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS)

### **Designs Related Websites**

<http://www.ipo.gov.pk/Designs/Default.aspx>

<http://www.wipo.int/designs/en/>

<http://www.uspto.gov>

### **FAQs**

1. What is the duration of protection for a registered design? Can it be extended?

The duration of the registration of a design is initially ten years from the date of registration, but in cases where a priority claim has been allowed the duration is ten years from the priority date. This initial period of registration may be extended by two terms of ten years each if an extension application is timely filed.

2. Is it necessary to produce an article by an industrial process prior to application for registration of the design?

No, it is not necessary for an article to have been made by an industrial process before filing.

3. Are the registered designs open for public inspection?

Yes, registered designs are open for public inspection once they have been published in the Official Gazette.

4. What is the fee for filing an application to register a design?

The filing fee for filing of an application for one design as of 2010 is PKR 450 (approximately \$7). The details of the fees for this and other types of applications are available at <http://www.ipo.gov.pk/Designs/DesignForms.aspx>

5. Is it possible to transfer the rights in the design to another party?

Yes it is possible to transfer the rights in the design to another party either through an assignment, transmission, or by operation of law (e.g. by court order in bankruptcy proceedings).

6. Can I write “Registered” on the product without it being registered?

No. Falsely representing that the design applied to the good you are selling is registered is an offense punishable with a fine of up to PKR 1000 (approximately \$17). Moreover, it is an offense to stamp, engrave, or impress the word “Registered” or any similar word on any design applied to an article when it is not registered. Indicating that the design is registered when such registration has expired is also an offense that is punishable with a fine, of up to PKR 200 (approximately \$3 USD).

7. Is there any way I can find out if a particular design is registered in Pakistan?

You can file an application by attaching a representation of the design and filing the prescribed fee. The Registrar of Designs will inform you if the design is registered or not.

8. Is there a procedure for opposing an application for designs before the same is registered with the Patent Office?

No pre-registration opposition procedure is presently available in Pakistan in the case of designs.