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2016 – Study Question (Designs)

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Requirements for protection of designs

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I. Current law and practice

- 1) Does your Group's current law provide for an intellectual property right (registered or patented) that specifically protects the outward appearance or ornamentation of an object or article of manufacture?

As set out in the Study Guidelines, copyrights and trademarks are not such rights in the context of this Study Question.

yes

Please explain:

In Pakistan, Designs are registered under The Registered Designs Ordinance, 2000.

Definition of Design under Section 2(e) of The Registered Designs Ordinance, 2000 states "Design means **features of shape, configuration, pattern ornament applied to an article by any industrial process or means, being features which in the finished article appeal to and are judged solely by the eye** but does not include a method or principle of construction or features of shape or configuration which are dictated solely by technical and functional considerations".

- 2) If yes, what is this right called? (e.g. registered design, design patent, industrial design, industrial design patent)

References to design below are to be read as references to this right, irrespective of what it is called in your jurisdiction.

Registered Design.

- 3) What are the statutory requirements for such right? Please tick any relevant boxes and explain the basis and application of these requirements.

a) novelty

Novelty is the main criteria for registrability of a Design in Pakistan.

Section 3(2) of the Registered Designs Ordinance, 2000 states that "Subject to the provisions of this Ordinance, a design shall not be registered unless it is **new or original** and, in particular, shall not be so registered in respect of any article if it is the same as a design which before the date of the application for registration has been registered in Pakistan or published anywhere in the world in respect of the same or any other article or differs from such a design only in immaterial details or in features which are variants commonly used in The trade".

b) non-obviousness

c) inventive step

d) individual character

e) originality

f) aesthetic

g) ornamental

h) other, namely ...

- 4) Does your Group's current law deny design protection to a design with an appearance that is dictated solely by its function?

yes

Please explain:

The Definition of Design under Section 2(e) of the Registered Design Ordinance specifically states "Design means features of shape, configuration, pattern ornament applied to an article by any industrial process or means, being features which in the finished article appeal to and are judged solely by the eye **but does not include a method or principle of construction or features of shape or configuration which are dictated solely by technical and functional considerations**".

- 5) If yes, what are the relevant factors to determine whether or not a design is deemed unprotectable as being functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

I will refer you to our answer of Question No 4 above

b) whether each portion of the overall appearance is dictated solely by its technical function

c) the availability of alternative appearances that can obtain the same functional result

d) the need to achieve the product's technical function was the only relevant factor when the design in question was selected

e) other, namely ...

6) Does your Group's current law deny design protection to any portions (e.g. a "feature", "element") of the overall design that are deemed functional?

yes

Please explain:

The Definition of Design under Section 2(e) of the Registered Design Ordinance specifically states "Design means features of shape, configuration, pattern ornament applied to an article by any industrial process or means, being features which in the **finished article** appeal to and are judged solely by the eye but does not include a method or principle of construction or features of shape or configuration which are dictated solely by technical and functional considerations".

In Pakistan, Design protection is for Final Product and not for components of a finished product

7) If yes, what are the relevant factors to determine whether or not a portion is deemed functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

In Pakistan, Design protection is for Final Product and not for components of a finished product

b) the availability of alternative appearances for the portion to obtain the same functional result

c) the need to achieve the product's technical function was the only relevant factor when the portion in question was selected

d) other, namely ...

8) What is the effect on the scope of protection of a design with one or more functional portions? Please tick any relevant boxes and explain as applicable:

a) any portions deemed functional will not be taken into account when assessing infringement

b) any portions deemed functional will not be taken into account when assessing validity

c) any portions deemed functional will not be taken into account separately when assessing infringement, but can play a role in the overall comparison

d) any portions deemed functional will not be taken into account separately when assessing validity, but may play a role in the overall comparison

e) no effect (e.g. so long as the overall appearance is not dictated solely by its technical function, all portions of the design are included in the scope of protection, irrespective as to whether any portions may be functional)

In Pakistan, Similarity/identity is the criteria for judging Infringement of Design.

f) the Group's current law is unsettled

g) other, namely ...

II. Policy considerations and possible improvements to your current law

9) How can the following aspects of your Group's current law be improved, if at all?

a) the definition or meaning of a "design"

1. Parts of a design should also be included in the definition of design.
2. Copyright Protection should be made available to Industrial Designs.
3. The term of Copyright Protection should be independent of term of any Industrial Design (if registered).

b) the requirements for protection of a design

The law does not give any opportunity to third parties to oppose applications for the registration of design. The only remedy available to any aggrieved party is to institute Cancellation Proceedings after registration.

This lacune is against the principles of natural justice and results in multiplicity of proceedings.

c) the treatment of functionality in the sense described in paragraph 14) of the Study Guidelines or aspects of such functionality

10) Are there any other policy considerations and/or proposals for improvement to your current law falling within the scope of this Study Question?

yes

Please explain:

1. In Pakistan, Infringement of a Design should also be made a Criminal Offence besides the remedies of Injunction and Damages already available under law.
2. 3D Designs should be specifically protected.
3. Concept of Passing Off should be recognized in cases of Design Infringement.

III. Proposals for harmonisation

11) Does your Group consider that harmonisation in the three areas in question 9) above is desirable?

If yes to some but not all of those three areas, please state in relation to which of the areas your Group considers harmonisation is desirable.

If yes in relation to any of those areas, please respond to the following questions without regard to your Group's current law.

Even if no in relation to any of those areas, please address the following questions to the extent your Group considers your Group's current law could be improved.

yes

Please explain:

We believe that harmonisation will lead to standardization of law which will lead to uniformity of its application and remove any uncertainty. This will also result in uniform development of law.

12) Should there be harmonisation of the definition of an intellectual property right that specifically protects the outward appearance or ornamentation of an object or article of manufacture?

yes

Please explain:

See our answer to Question No 11 above.

13) If so, what should that right be called?

Registered Design

14) What should the requirements for such right be? Please tick any relevant boxes and explain the basis and application of these requirements:

a) novelty

Novelty is the main requirement for registrability of Design.

b) non-obviousness

c) inventive step

d) individual character

e) originality

f) aesthetic

g) ornamental

h) other, namely ...

15) Should design protection be denied to a design with an appearance that is dictated solely by its function?

yes

Please explain:

See our answers above

16) If yes, what should the relevant factors be to determine whether or not a design is deemed unprotectable as being functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

See our answers above

b) whether each portion of the overall appearance is dictated solely by its technical function

c) the availability of alternative appearances that can obtain the same functional result

d) the need to achieve the product's technical function was the only relevant factor when the design in question was selected

e) other, namely ...

17) Should design protection be denied to any portions (e.g. a "feature", "element") of the overall design that are deemed functional?

yes

Please explain:

See our answers above

18) If yes, what should the relevant factors be to determine whether a portion of a design is functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

See our answers above

b) the availability of alternative appearances for the portion to obtain the same functional result

c) the need to achieve the product's technical function was the only relevant factor when the portion in

question was selected

d) other, namely ...

19) What should the effect be on the scope of protection of a design with one or more functional portions? Please tick any relevant boxes and explain as applicable:

a) any portions deemed functional will not be taken into account when assessing infringement

b) any portions deemed functional will not be taken into account when assessing validity

c) any portions deemed functional will not be taken into account separately when assessing infringement, but can play a role in the overall comparison

d) any portions deemed functional will not be taken into account separately when assessing validity, but may play a role in the overall comparison

e) no effect (e.g. so long as the overall appearance is not dictated solely by its technical function, all portions of the design are included in the scope of protection, irrespective as to whether any portions may be functional)

See our answers above

f) the Group's current law is unsettled

g) other, namely ...

20) If your answer to question 11) is no, is it your Group's view that a (registered or patented) intellectual property right that specifically protects the outward appearance or ornamentation of an object or article of manufacture should not be available at all?

no

21) If yes, why?

Not Applicable

22) If your answer to question 11) is no in relation to some but not all of the three areas set out in question 9) above, please state why your Group does not consider that harmonisation in that area(s) is desirable.

Not Applicable

23) Please comment on any additional issues concerning any aspect of the definition and requirements for protection of designs, or the role of functionality, you consider relevant to this Study Question.

Please indicate which industry sector views are included in part “**III. Proposals for harmonization**” of this form:

Summary