

Intellectual Property  
for Business Series  
No. 2

# LOOKING GOOD

An Introduction to  
Industrial Designs for  
Small and Medium-sized  
Enterprises in Pakistan



Publications in the “Intellectual Property for Business” Series:

1. Making A Mark - An introduction to Trademarks for Small and Medium-sized Enterprises.
2. Looking Good – An introduction to Industrial Designs for Small and Medium-sized Enterprises.
3. Inventing the Future - An introduction to Patents for Small and Medium-sized Enterprises.
4. Creative Expression - An introduction to Copyright and Related Rights for Small and Medium-sized Enterprises.

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# Preface

## Preface

*'Intellectual Property'* till recently has been considered a luxury by the industry in general and SMEs in particular. In fact, it is a major avenue for SMEs to establish their credentials at par with the large enterprises. Every business has some valuable intangible property worth protecting. Keeping SMEs abreast of the latest information on Intellectual Property Rights (IPRs) systems and to enable them to protect their IP assets is, indeed, the need of the hour. Ignorance in this field may lead to a loss of valuable rights and expensive litigation or both.

This customized version of 'Looking Good' is focused on creating awareness among SMEs in Pakistan on benefits of protecting the design/feature/appearance of their products illustrated with the help of examples of Pakistani businesses. The registration procedure of industrial designs in Pakistan as well as abroad (especially for exporters) and other relevant information is also provided in the guide. It is mainly directed at creative SMEs who have designed a unique shape, feature, texture or surface of an article. The purpose of this endeavour is to enable SMEs to seize the opportunity of industrial design protection rather than deferring the decision to adopt IP system on the assumption that IP protection is costly and time consuming or enforcement of the laws are ineffective.

In compilation of this booklet, efforts of SMEDA team comprising Mr. Muhammad Jamil Afaqi, Ms. Aisha Amjad Mir and Mr. Shaheen Tahir have been commendable.

I hope SMEs will benefit from this joint effort on the part of World Intellectual Property Organisation (WIPO) and Small and Medium Enterprises Development Authority (SMEDA), to build their brand identities on the basis of visual aspects of their product. The purpose of this booklet is to motivate creative SMEs to preserve and protect the visual uniqueness of their product that serves to differentiate and distinguish their product from others.

Shahid Rashid  
CEO, SMEDA

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# Industrial Designs

## 1 Industrial Designs

What is an industrial design?

In everyday language, an industrial design generally refers to a product's overall form and function. For example, a sofa is commonly said to have a 'good industrial design' when it is comfortable to sit in and we like the way it looks. For businesses, designing a product generally implies developing the product's functional and aesthetic features taking into consideration issues such as the product's marketability, the costs of manufacturing or the ease of transport, storage, repair and disposal.

From the point of view of intellectual property law, however, an industrial design refers only to the ornamental or aesthetic aspects of a product. In other words, it refers only to the appearance of a sofa. Although the design of a product may have technical or functional features, industrial design, as a category of intellectual property law, refers only to the aesthetic nature of a finished product, and is distinct from any technical or functional aspect.

In Pakistan, registration and protection of industrial design is regulated by the law called "the Registered Designs Ordinance, 2000" (the Ordinance). As per section 2(e) of the Ordinance, "design" means "features of shape, configuration, pattern or 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."



Courtesy: M/s Shoaibee Industries (Pvt.) Ltd.

Industrial design is relevant to a wide variety of products of industry and fashion from technical and medical instruments to watches, jewelry, and other luxury items; from household products, toys, furniture and electrical appliances to cars and architectural structures; textile designs to sports equipment. Industrial design is also important in relation to packaging, containers and the "get-up" of products.

As a general rule, an industrial design consists of:

- three-dimensional features, such as the shape of a product, e.g. cylindrical shape of the cooler



Courtesy: M/s Sitara Textile (Pvt.) Ltd.

# Industrial Designs

- two-dimensional features, such as ornamentation, patterns, lines or color of a product; e.g. the pattern of the print lawn or
  - a combination of one or more such features.
3. Strengthen brands: Creative designs are often also combined with distinctive trademarks to enhance the distinctiveness of a company's brand(s). Many companies have successfully created or redefined their brand image through a strong focus on product design.

## Creative Designs in Business

Enterprises often devote a significant amount of time and resources to enhance the design appeal of their products. New and original designs are often created to:

1. Customize products to appeal to specific market segments: Small modifications to the design of some products (e.g. a shoe) may make them suitable for different age groups, cultures or social groups. While the main function of a shoe remains the same, children and adults generally have very different tastes in design, e.g. the comfortable chappal customised for warm tropical weather.
2. Create a new niche market: In a competitive marketplace, many companies seek to create a niche market by introducing creative designs for their new products to differentiate them from those of their competitors. This could be the case for ordinary items such as spoons, tables, cloths and fans to potentially expensive items such as jewelry, computers or cars.

## Why protect industrial designs?

An industrial design adds value to a product. It makes a product attractive and appealing to customers, and may even be its unique selling point. So protecting valuable designs should be a crucial part of the business strategy of any designer or a manufacturer. By protecting an industrial design through its registration at the Patent Office, the owner obtains the exclusive right to prevent its unauthorized copying or imitation by others. This makes business sense as it improves the competitiveness of a business and often brings in additional revenue in one or more of the following ways:



Courtesy: M/s Societe des Produits Nestle S.A.

- By registering a design, you are able to prevent it from being copied and imitated by competitors, and thereby

# Industrial Designs

strengthen your competitive position.

- Registering a valuable design contributes to obtaining a fair return on investment made in creating and marketing the relevant product leading to improved profits.
- Industrial designs are business assets that can increase the commercial value of a company and its products. The more successful a design, the higher is its value to the company.
- A protected design may also be

licensed (or sold) to others for a fee. By licensing it, you may be able to enter markets that you are otherwise unable to serve.

- Registration of industrial designs encourages fair competition and honest trade practices, which, in turn, promotes the production of a diverse range of aesthetically attractive products.

## Shedding some light on designs

While the functional elements of a fan do not generally differ significantly from product to product, its appearance is likely to be one of the major determinants of its success in the marketplace. This is why industrial design registers in many countries have a long list of designs for household products such as fans. In Pakistan, many SMEs are dealing in the manufacture and export of fans and predominantly produce fans as per designs given by the customers. However, M/s Lahore Fans is one of the innovative and forward

looking SME, which not only manufactures fans but also introduces its own innovative designs and very carefully protect them through Industrial Design Protection to gain exclusive rights and economic benefits of selling to international clients and local customers.



Courtesy: M/s Lahore Fans

# Protecting Industrial Designs

## 2 | Protecting Industrial Designs

How do you obtain protection for industrial designs?

In Pakistan, an industrial design must be registered under the Registered Designs Ordinance, 2000, in order to be protected. To register an industrial design, you must file an application on the prescribed form (Annex-III) at the Patent Office (a list of addresses of the IP offices is provided at Annex I). For protection abroad, see Section III. While this guide focuses mainly on registered industrial designs, it is important to point out that, in Pakistan, there are alternative ways of protecting industrial designs; the same are as under:

*A limited protection of a design can be availed under the law called "Copyright Ordinance, 1962". In this regard, you must keep in mind that Copyright in a design which can be registered under design law, but which has not been so registered and the copyright for which has been availed, shall cease as soon as any article to which the said design has been applied has been reproduced more than fifty (50) times by an industrial process by the owner of the copyright.*

In addition, it might be possible in rare cases to register the industrial design as a trademark. For more details on protecting your design under copyright or trademark laws, see Section V.

What rights are provided by industrial design protection?

When an industrial design is protected by

registration, the owner is granted the right to prevent unauthorized copying or imitation by third parties. This includes the right to exclude third parties from making, importing, selling, hiring or offering for sale or hire any product bearing or representing a design which is the exact or a substantially similar copy of the registered design.

### Exclusive Rights

Let us assume that your company has designed a shoe with an innovative design, registered it at the Patent Office, and has therefore obtained exclusive rights over shoes bearing that design. What this means is that if you discovered that a competitor is making, selling or importing shoes bearing the same or substantially the same design you will be able to prevent him from using your design and, possibly, obtain compensation for damages which your business has suffered from the unauthorized use of that design. So, while



Courtesy: M/s Service Industries (Pvt.), Ltd.

you cannot stop competitors from making competitive products you may prevent them from making products that look just like yours and having a free ride on your

# Protecting Industrial Designs

creativity. For details on how to enforce your rights you are advised to consult an IP lawyer.

Traditionally, protectable designs relate to manufactured products such as; the shape of a shoe, the design of an earring or the ornamentation on a teapot. In the digital world, however, protection is gradually extending in some countries to a number of other products and types of design. These include electronic desktop icons generated by computer codes, typefaces, the graphic display on computer monitors and mobile telephones, etc.

What can be registered as an industrial design?

To be able to get registered under the Designs Ordinance, 2000, a design must meet the following basic requirements:

### 1. Novelty

The design must be "new or original". A design may be considered to be new if no identical design has been made available to the public before the date of filing, or the application for registration.



Courtesy: M/s Societe des Produits Nestle S.A.

### 2. Originality

A design may be considered original if it has been independently created by the designer and is not a copy or an imitation of existing designs.



Courtesy: M/s Service Industries (Pvt.), Ltd.

### 3. Non-Publication

A design must not have been published anywhere in the world prior to the grace period allowed by the law.

What cannot be protected by industrial design rights?

In Pakistan, following designs are not allowed for registration under the Designs Ordinance, 2000:

- Designs that do not meet the requirements of novelty or originality (as explained above).
- Designs that are considered to be dictated exclusively by the technical or functional consideration of a product. It is important to note that such technical or functional design features may be protected, depending on the facts of each case, through other IP rights (e.g. patents).

# Protecting Industrial Designs

- Method or principle of construction or an improvement in the construction/arrangement of machinery.
- Designs incorporating official symbols or emblems (such as the national flag of any country, city, town etc.).
- Designs which are considered to be contrary to public order or morality.
- Designs that cannot be judged solely by eye.
- A mere adjunction of two or more known articles of known shape or pattern.
- Mere painting, drawing, sketch or plan on a piece of paper or canvas, not applied or shown as applied to any article for the purpose of manufacture.
- Designs of buildings and structures which are not portable and cannot be delivered to the purchaser as finished articles for the purpose of manufacture.

The Patent Office entertains the applications for registration of handicrafts/articles falling within the parameters of Designs Ordinance, 2000.

## How do you register a design?

To register a design in Pakistan you must generally take the following steps:

- Fill in the prescribed application form i.e., Form 15 (Annex III) provided by the Patent Office (see Annex I for the IP offices where you can register your designs) including your name, contact details and specimen of design, drawings, and/or photographs of the design(s) in question (standard formats have been specified in the law).
- You may also be required to file, or have the option of filing, a written description or statement of novelty of the industrial design(s). The description generally needs to be of the design and not of the product to which it has been applied. It should be accurate and adequate in differentiating it from any similar earlier designs. It should cover all the distinctive aesthetic features of the design and should describe which feature(s) is/are the most important.
- You will also be required to pay the filing fee of Rs. 450/- for one design application.
- You may file application yourself or may choose to employ an IP agent to assist you in filing the application and completing the registration process. In that latter case, you will also have to file

# Protecting Industrial Designs

a power of attorney in favor of your agent.

The Patent Office registers the design after undertaking a substantive examination for checking the existing designs for novelty and/or originality.

Once a design is registered, it is entered into the register of designs and a design registration certificate is issued.

## Processing an application – step by step

The procedure for registration of a design in Pakistan is as follows: -

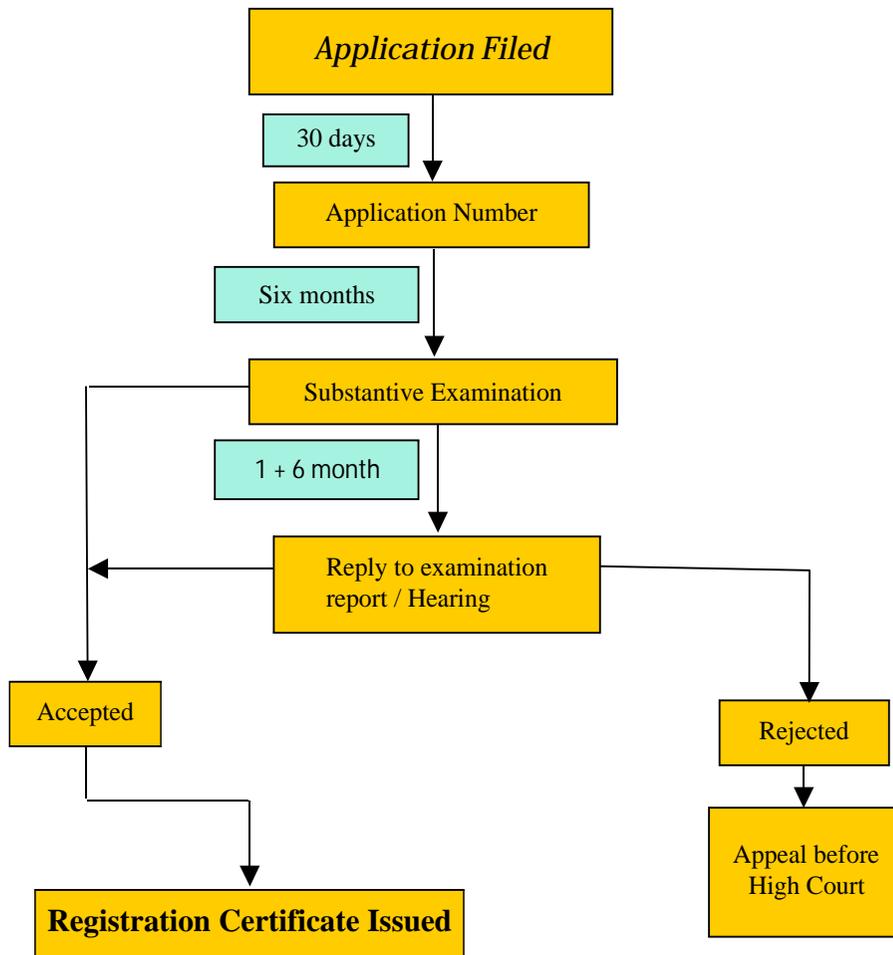
1. **Formal examination:** The Patent Office examines the application to ensure that it complies with the administrative requirements (e.g., that all relevant documentation is included and the application fee has been paid). The application number (official receipt) is issued within thirty days.
2. **Substantive examination:** Substantive examination of the application is conducted usually within 6 months of the filing date. The results of the examination are sent in writing to the applicant (or his attorney) so that the applicant may respond to and remove any objections raised.

**3. Registration Certificate:** If no objections are raised after the examination of the application or the objections are successfully removed by the applicant, the design is registered and the registration certificate is issued.

## How long does it take to register a design?

The process of registration of an industrial design generally takes 8 to 12 months or longer depending on the time taken by the applicant to respond to objections raised by the design examiner. The applicant gets up to 7 months in aggregate (after obtaining extensions) to respond to official objections. The various stages of registration and their likely timeframes are indicated in the below flow chart.

# Protecting Industrial Designs



- \* The boxes in Ocean Blue indicate the likely time frame.
- \* The boxes in Yellow indicate the different stages of application.

# Protecting Industrial Designs

How important is it to keep the design confidential before registration?

If you wish to protect your industrial design through a registration system, keeping the design confidential is absolutely crucial. The reason is that the fundamental requirement for design protection is generally, that the design must be “new”. If you show your design to others it is advisable to have confidentiality clauses in written agreements, clarifying that the design is confidential. A design that has already been disclosed to the public by, for example, advertising it in your company's catalogue or brochure may no longer be considered “new”. It becomes part of the public domain and cannot be protected, once the “grace period” has lapsed or unless the priority of an earlier application can be claimed (see also “How do you protect your industrial designs abroad?”).



What is the “grace period”?

A grace period is an exception to the confidentiality requirement for registration of a design. In Pakistan, the legislation allows a grace period for the purpose of registration (of twelve months) from the

moment a design was made public, disclosed or published. As per section 3 (3) of the Designs Ordinance, a grace period can be allowed when the disclosure or publication of a design was by reason or in consequence of acts committed by the applicant or, his predecessor in title or of an abuse committed by a third party with regard to the applicant or his predecessor in title. During that period, you may market your design without losing its “novelty” and you may still apply for registration. However, as this is not the case in all countries, and, in any event, is limited in time, it is often advisable to keep the design confidential until you apply for design protection. In addition, you will have no exclusive design rights during the grace period (although your design may be automatically protected under copyright law; see more on copyright in Section 5).

How long does industrial design protection last?

In Pakistan, the original term of protection for a registered industrial design is ten years. However, on application along with payment of prescribed fee, the same can be extended for two more terms of ten years each. The protection of a registered design cannot be extended beyond thirty years in total.

How much does it cost to protect an industrial design?

As indicated above, the actual costs for registering a design are very low. The only official fees involved in the design

# Protecting Industrial Designs

Details	Official Fees
Filing fee	450 Rupees
Renewal fee (for ten years)	750 Rupees

However, there will also be costs associated with the hiring of the services of an IP agent to assist you in the registration process, in the event that you choose to rely on expert advice to file your application. Please keep in mind that there may be cost associated with the translation of industrial design if it is to be protected abroad.

What should you do if your design combines functional improvements with aesthetic features?

To obtain exclusive rights over the functional improvements of a product, it is generally advisable to apply for patent protection or, where the function is not obvious by reverse engineering in the product, to keep it as a trade secret. However, many a times a new product combines functional improvements with innovative aesthetic features. Let us say you have designed a new mobile phone. While the mobile phone may be the result of a series of improvements to the electronic components and could be protected by patent(s), the original design of your mobile phone could be registered as an industrial design. Can you apply for both? The answer is yes.

Many designers protect different aspects of their products with different intellectual property rights. It is important, however, to keep in mind the basic difference between

patents and industrial designs.

*Patents are for inventions that bring about functional improvements to a product and industrial design protection is for the appearance of the product.*

## Design Protection and Business Strategy

Decisions on how, when and where to protect a company's industrial designs may have an important impact on other areas of design management. It is important to put together the issues of design protection and the broader business strategy of an enterprise. For example, the type of protection, the costs, the effectiveness of protection and issues of ownership of designs, may be important considerations when deciding:

- whether to undertake the design development in-house or to engage an outside agency;
- the timing of the initial use of a new design in advertising, marketing or public display in an exhibition;
- which export markets to target;
- if, when and how to license or assign a design to be commercially exploited by other companies in return for economic remuneration.

# Protecting Industrial Designs

Who may apply for industrial design protection?

In general, the person who created the design or, if working under contract, his employer, can apply for registration. The applicant can be either an individual (e.g. a designer) or a legal entity (e.g. a company). In either case, the application may be made directly or through an agent. If you apply abroad you may be required to be represented by an agent duly authorized by the IP office of that country.

Who owns the rights over an industrial design?

Under the Designs Ordinance, 2000, generally the person who creates a design is considered to be the owner of such design. However, as per the Ordinance there are circumstances in which the creator of a design is not considered the owner of such a design. For example, if an employee has developed a design under the terms of an employment contract, that is, during his working hours within the enterprise and as part of his regular duties within the enterprise, the design (and the related rights) will belong to the employer or may require to be transferred by a formal written assignment to such employer.

Similarly, if the design was developed by an external designer under contract, the rights will generally belong to the company that commissioned the design. In such cases, it is considered that the design was produced for the use of the person who commissioned the design, who is therefore

the owner. Misunderstandings at a later date can be avoided by clarifying the issue of rightful ownership in the original contract with the designer. You should also bear in mind that the designer of the product may have automatic copyright protection over the drawings of the original design and the issue should also be covered under the contract.



Courtesy: M/s Kalamkaar

Can you apply for the registration of many different designs through a single application?

As per the Registered Designs Ordinance, 2000, a single application can be made for registration of a "Set of Articles" containing the same design with modifications or variations. The term "set of articles" has been defined by the Designs Ordinance to mean "a number of articles of the same general character ordinarily on sale or intended to be used together, to each of which the same design, or the same design with modifications or variations not sufficient to alter the character or substantially to affect the identity thereof, is applied". For example, a dinner set consisting of plates, glasses, dishes etc. may be considered a set of articles.

# Protecting Industrial Designs

However, you cannot apply through a single application for registration of two different designs. For that you will be required to make separate applications. For example, if you want to register the new design of a bottle and a watch, you will have to file two separate applications.

## The Designs Classification System

Industrial designs are generally classified or grouped into classes for ease of retrieval. You may be asked to refer to the class of products for which you intend to use the design in question in your application form. Many countries use the classification of the Locarno Agreement Establishing an International Classification for Industrial Designs but Pakistan does not use the same. Pakistan currently uses classification system which is based on the material of which an article is composed. According to this system a class of a design is determined on the basis of material it is made of and not by the nature of the product. For example, a wooden chair would not be classified with other chairs made of steel rather it will be classified with other wooden products. (see List of Classes at Annex II). For international applications, you may visit the following link for the identification of the appropriate classes: [www.wipo.int/classifications/en/locarno/about/](http://www.wipo.int/classifications/en/locarno/about/)

**Can you license your industrial designs?**  
A registered industrial design can also be licensed. A license takes effect when the owner of the design (licensor) grants

permission to another person (the licensee) to use the design for mutually agreed purposes. In such cases, a licensing contract is generally signed between the two parties specifying the terms and scope of the agreement. Licensing contracts often include limitations as to the areas where the licensee may use the design, the time for which the license is granted and the type of products for which it can be used. In order to license the use of the design in foreign countries you would need to have previously obtained, or at least applied for, industrial design protection in the countries concerned.

Authorizing others to use your industrial designs through a licensing contract will enable your business to receive an additional source of revenue and is a common means of exploiting a company's exclusivity over its registered designs. Agreements to license industrial designs are often included in broader licensing agreements, which cover all aspects (i.e. not just the visual elements) of a product.

# Protecting Designs Abroad

## 3 | Protecting Designs Abroad

### Why protect designs abroad?

If your company intends to export products bearing an original design, or intends to license the manufacture, sale or export of such products to other firms in foreign countries, it should consider protecting its designs in such countries in order to enjoy the same benefits of protection abroad as it enjoys in the domestic market.

### How do you protect your industrial designs abroad?

Industrial design protection is territorial. This means that industrial design protection is generally limited to the country or region where you have registered your design. Hence, if you wish to have your industrial design protected in export markets, you would have to make sure that protection is applied for in those specific countries.

It is important to bear in mind that you usually have six months from the date on which you applied for protection in the first country to claim the right of priority when you apply for design protection in other countries. Once this period has lapsed, you will be unable to apply for design protection in foreign countries, as your design will no longer be considered new. There are three ways of protecting your industrial designs abroad.

1. **The National Route:** Companies may seek protection by applying

separately to the national IP offices of each country in which they intend to obtain protection. The process can be rather cumbersome and expensive as translation into the national languages is generally required as well as payment of administrative (and sometimes legal) fees.

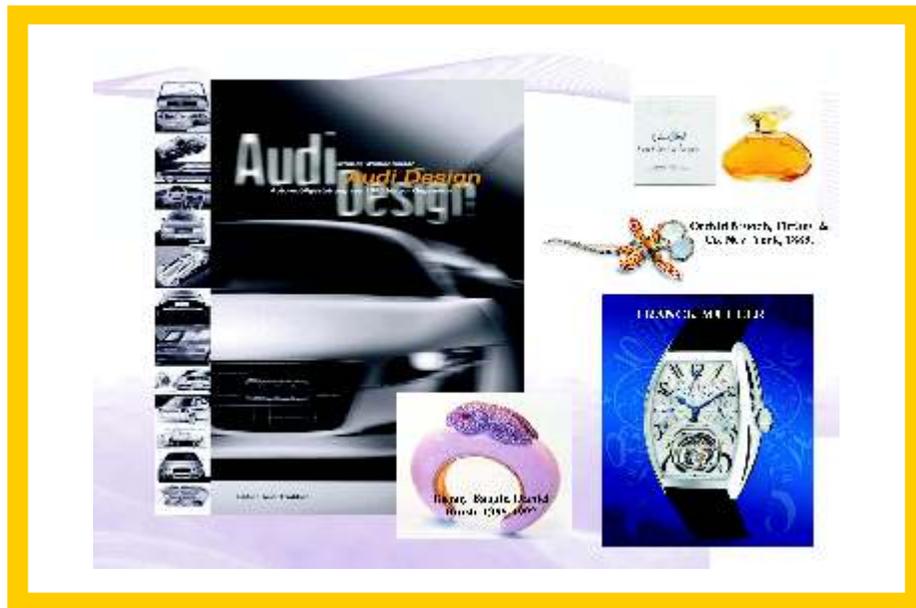
2. **The Regional Route:** If you are interested in group of countries that are members of regional agreements which enable the registration of designs in more than one country, then you can consider filing a single application at the regional IP office concerned. Regional IP offices include: the African Regional Industrial Property Office (ARIPO) for industrial design protection in English-speaking African countries; the Benelux Designs Office (BDO) for protection in Belgium, the Netherlands and Luxembourg; the Office for Harmonization in the Internal Market (OHIM) for Community Designs in the countries of the European Union; the *Organisation Africaine de la Propriété Intellectuelle* (OAPI) for protection in French-speaking African countries.

3. **The International Route:** Companies that wish to register their designs internationally in several countries may also use the procedures offered by the Hague Agreement

# Protecting Designs Abroad

Concerning the International Deposit of Industrial Designs, a WIPO-administered treaty. An applicant from a Member country to the Hague Agreement can file a single international application with WIPO; the design will then be protected in as many Member countries of the treaty as the applicant wishes. The agreement provides applicants with a simpler and cheaper mechanism for applying for industrial design registration in various countries. For full information about the Hague Agreement including a list of Member States and the application form, visit the WIPO website at: [www.wipo.int/hague/](http://www.wipo.int/hague/).

Please note that Pakistan is not yet a member of the Hague Agreement. However, Pakistan might have become a member of the Hague system or any other multilateral treaty by the time you decide to get your design registered abroad. It is advisable that you consult an IP attorney at the time you wish to get your design registered abroad, with reference to the International Deposit of Industrial Designs and thus the filing of the application through the international route.



Courtesy: WIPO

# Enforcing Industrial Designs

## 4 Enforcing Industrial Designs

How can you enforce your rights when your design is being imitated, copied or infringed?

Enforcing any IP right may be a complex issue for which it is usually advisable to seek professional assistance from a competent IP lawyer. It is important to bear in mind that the main responsibility for identifying and taking action against imitations or infringement of an industrial design lies with its owner. In other words, you are responsible for monitoring the use of your design in the marketplace, identifying any imitators or counterfeiters and deciding whether, how and when to take action against them.

An IP lawyer would normally be the competent person to give you information about the possibilities to take legal action against imitators, infringers and counterfeiters and provide you with advice on how to settle any dispute.

Whenever you believe there is infringement, you may choose to begin by sending a letter preferably through your lawyer (commonly known as a 'Legal Notice') to the alleged infringer informing him/her of the possible existence of a conflict. If the infringement persists, you may consider taking one or more of the following steps:

1. You may seek an injunctive / restraint order from the court by filing an action

under section 8 of the Registered Designs Ordinance, 2000, for the recovery of damages and for an injunction against the continuation of the infringement and courts generally issue an order restraining the infringer from using the infringing mark till the decision of the case;

2. Action may be taken under section 27 of the Registered Designs Ordinance, 2000, seeking punishment of the person who infringes the design with imprisonment which may extend to two years or with fine or with both; or

3. In some instances, an effective way of dealing with infringement is through arbitration or mediation. Arbitration generally has the advantage of being a less formal, shorter and cheaper procedure than court proceedings, and an arbitral award is more easily enforceable. An advantage of mediation is that the parties retain control of the dispute resolution process. As such, it can help to preserve good business relations with another enterprise with which your company may like to collaborate in the future. In Pakistan arbitrations are regulated under the Arbitration Act, 1940.

4. For more information on arbitration and mediation, see the website of the

# Enforcing Industrial Designs

WIPO Arbitration and Mediation Center at [www.arbiter.wipo.int](http://www.arbiter.wipo.int).

As a general rule, if you find any person or a company imitating or copying your design, it is highly advisable to seek professional legal advice. The above actions can be taken by the registered proprietor or by a person holding a valid license or assignment deed from the registered proprietor, duly registered with the Patent Office.

## Brimful Designs, Pakistan



For the past eleven years Brimful Designs, a textile design studio based in Lahore, Pakistan, has produced and marketed a successful brand of high quality, printed cotton designer clothing under the label Yhsir Waheed Designer Lawn. But in 2003 the very existence of the company was threatened by large scale copying from local print manufacturers. Inferior quality copies of Yhsir Waheed's original print designs for its spring/summer collection flooded the market under various labels at a third of the price of the original product. Salesmen used the Yhsir Waheed Designer Lawn's product catalogue to sell the fake designs, thus confusing Brimful's loyal customers.

A negative backlash from customers led to a rapid decline in the company's

market share. Brimful consulted local experts at an IP training seminar organized by Small and Medium Enterprise Development Authority (SMEDA), who recommended seeking protection under Pakistan's Industrial Design Ordinance 2000.



*Courtesy: M/s Brimful Designs*

Brimful engaged legal counsel and since 2004 has registered all designs for the Yhsir Waheed Designer Lawn Collection with the aim of deterring infringers and providing the possibility of legal action. They did not just stop at the point of registering their designs, they used the media to launch an effective campaign against these copiers plus with the cooperation of law enforcement agencies and their legal

# Enforcing Industrial Designs

consultant, raided shops selling fake Yhsir Waheed prints and seized their stock. The same effort was carried out in the subsequent summer and thereafter in 2005, the extent of copying was curtailed.

As yet, their battle continues. Being an innovative enterprise like Brimful Designs, strength it's may not be underestimated by its size rather be evaluated on the basis of effective enforcement of their protection rights. The infringers are no longer replicating the exact designs, but the copies are still close enough to confuse buyers. While IP legal counsel are becoming widely available in Pakistan, this remains an expensive route; Brimful owners note that the process of obtaining and implementing a court injunction currently takes too long. Also they feel that the infringement of the Industrial Design Ordinance should be made a criminal offence. They would like to see strong, high profile punitive action by the authorities against IP violators in the textile sector in order to give teeth to design protection legislation and to deter further wide scale copying.

## 5 Other Legal Instruments for Protecting Industrial Designs

What are the differences between copyright protection and industrial design protection for designs?

In Pakistan, the applicable law recognizes copyright protection for designs. However, the copyright protection is only extended to the designs that do not qualify to be registered under the designs law. The designs that qualify to be registered under relevant designs law are granted limited protection. Copyright in a design, which is capable of being registered independently, but has not been so registered, shall cease as soon as any article to which the design has been applied, has been reproduced more than fifty times by an industrial process by the owner of the copyright or, by any other person with his license.



Courtesy: M/s Sitara Textile (Pvt.), Ltd.

The first step before taking any decision on how to best protect your design is to understand the differences between these two forms of protection. Some of the main differences are outlined below:

### Registration

Under industrial design law, the industrial design needs to be registered by the applicant before publication or public use anywhere after the grace period. The registration certificate, provided by protection under industrial design law, may prove useful in cases of infringement, as it provides firm grounds to enforce your exclusive rights. Copyright in works considered to be original subsists without formalities. While registration is not necessary for protection, you may deposit your design and obtain a certificate.

### Duration

Industrial design protection lasts for a period of 30 years in aggregate. It must also be borne in mind that the process of registration of industrial designs may take some time, and may not always be adequate for products that are linked to passing trends (e.g. fashion products). Copyright remains valid and enforceable for the life of the author and 50 years after his death.

### Scope of protection

The right conferred by registration of an industrial design is an absolute right in the sense, that there is infringement whether or not there has been deliberate copying. To enforce rights under copyright law, the copyright owner must prove that the allegedly infringing work is a direct or indirect reproduction of the work

protected by copyright.

### Types of products

In Pakistan, not all designs can be protected by copyright. However designs that fall under the category of works of art may be protected under the Copyright Ordinance, 1962. While the distinction may not always be clear, some designs, such as the shape of manufactured products, are unlikely to be protectable under copyright law, while others, such as textile designs, may be covered by both forms of protection.

### Costs

Registering your design in the countries you are interested in means that you will have to pay the applicable fees. In addition, it may be useful or necessary to use the services of an IP agent to assist you in drafting the application, which will incur additional costs.

Given that no formal registration of works protected by copyright is required by most national copyright laws, there are generally no direct costs relating to copyright protection. However, there may be costs related to (a) the deposit of the work at the copyright depository, in countries where it exists, and (b) demonstrating proof of ownership in case of disputes.

In summary, while the protection granted by registered industrial designs is stronger in that it covers even unintentional infringement and provides a registration

certificate which may be an important proof in case of infringement, it involves more effort (financial and administrative) because it requires registration, and is shorter in duration.

In any case, and particularly if the design is not registered, it is generally advisable to keep good records of every step in the development of the design. Signing and dating each sketch, and properly archiving them, may help in case of infringement. Example: In a recent survey of fabric designers in the United Kingdom, 80% of respondents said they always kept a record of their original design documents and were aware of their importance for proving copyright ownership.

When can trademark law protect a design?

A trademark is a distinctive sign (generally a word, a logo or a combination of the two) used to differentiate the products of one company from those of others. There are circumstances in which the form, design or packaging of a given product may be considered to be a distinctive feature of the product in question and may be protectable as a three-dimensional trademark. However, the Trade Marks Ordinance, 2001, places a restriction that the shape which gives substantial value to the goods cannot be registered. Since a design generally adds to the value of goods, therefore, practically the chances of registration of a design that may qualify for registration under the Designs Ordinance

being considered as Trademark are very low. It is advisable to consult an IP agent to determine whether a particular design may be registered as trademark.

Trademark protection has the advantage of being renewable indefinitely, while industrial design protection is protectable for a limited period of time (30 years).

There may also be a difference in the costs of registering trademarks as compared with industrial design protection depending on the fee of attorney.

## Using Trademarks and Industrial Design Protection effectively

M/s Kalamkaar Interior Designers has been operational since 1991. It started with a small set-up in Lahore, their core enterprise competency was producing 5-10 exquisitely designed furniture products with high quality wood and upholstery. At the time this firm started, customers had already built a long term relation with furniture giants like M/s Interwood and M/s Indesign. Nevertheless, believing in core enterprise values, and continuously designing beautiful furniture items, they created their own niche market. During early 2000 they registered their Trade Mark and as more and more small furniture shops started to open up, they started to get their furniture designs



protected under Industrial Design Protection. This enabled Kalamkaar to carry on with its exclusive work and ward off copiers as they were protected by intellectual property. Over the years, the firm has expanded its operation internationally as well in countries like Canada, UAE, USA, etc. by entering into franchise deals and partnerships and even exporting their furniture products. On the whole, while the firm was a small enterprise it safeguarded its limited number of designs through Industrial Design Protection. However, having grown in size and that each year they produce over 50 designs the firm has shifted its focus to only protecting its brand name, saving money, time and energy involved in protection of designs.



Courtesy: M/S Kalamkaar

[www.kalamkaar.com](http://www.kalamkaar.com)

## Annex I

1. Intellectual Property Organization of Pakistan (IPO Pakistan)  
Headquarter:  
House No. 23, Street 87, Ataturk Avenue (West), Sector G-6/3, Islamabad - Pakistan.  
Tel: +92-51-99208146  
Fax: +92-51-99208157  
Website: [www.ipo.gov.pk](http://www.ipo.gov.pk)  
Email: [info@ipo.gov.pk](mailto:info@ipo.gov.pk)

IPO-Pakistan provides following services to its clients with special focus on SMEs:

- (i) Advice on Industrial Design filing (detailed procedure of filing of applications for grant of Industrial Design by IP Helpline, different application forms for the purpose may be downloaded by visiting IPO website at [www.ipo.gov.pk](http://www.ipo.gov.pk));
- (ii) Processing of Industrial Design registrations;
- (iii) Hearings of the applications;
- (iv) Organizing seminars/workshops/lectures through out the country for providing information regarding the registration of Industrial Design to the members of the Chambers, Associations, Academia etc. that mostly comprises small and medium enterprises;
- (v) Online application filing and tracking;
- (vi) Online search of Industrial Design database.

IPO Pakistan Reginal Office  
3rd Floor, Farid Tower,  
19 Temple Road, Lahore,  
Pakistan.  
Tel: +92-42-37224395  
Fax: +92-42-37224396  
Email: [lahore@ipo.gov.pk](mailto:lahore@ipo.gov.pk)

Trademarks Registry  
Registrar Trade Marks Registry  
Plot No. CD-3, Behind KDA  
Civic Centre, Gulshan-e-Iqbal  
Block- 14, Karachi.  
Tel: +92-21-99230538  
Fax: +92-21-99231001  
Email: [tmr@ipo.gov.pk](mailto:tmr@ipo.gov.pk)

Patent Office  
Controller of Patents & Designs  
2nd Floor Kandawala Building,  
M. A. Jinnah Road, Karachi.  
Tel: +92-21-99215488  
Fax: +92-21-99215489  
Email: [patent@ipo.gov.pk](mailto:patent@ipo.gov.pk)

Copyright Office  
Registrar Central Copyright Office  
Ground Floor, Liaquat Memorial  
Library Building, National Stadium  
Road, Karachi.  
Tel: +92-21-99230140  
Fax: +92-21-99230140  
Email: [copyright@ipo.gov.pk](mailto:copyright@ipo.gov.pk)

# Annex I

2. Small and Medium Enterprises Development Authority (SMEDA)  
SMEDA Head Office:  
6th Floor, L.D.A Plaza, Egerton Road, Lahore-54000  
Tel: 042-111-111-456  
Fax: (042) 36304926  
Website: www.smeda.org.pk

In order to encourage and urge small and medium entrepreneurs to effectively use the IP system for their business success, SMEDA is providing the following services to SMEs:

a) IP Helpline:

SMEDA 'IP Helpline' assists SMEs on all forms of IPs including trademarks, patent, copyrights and industrial designs. SMEs may contact our regional legal services officers for solving their queries on IP matters.

B) Training Programs:

Keeping in view the information needs of SMEs, SMEDA conducts on regular basis IP awareness programs across Pakistan in collaboration with local chambers of commerce and industry, IPO Pakistan and Trade Association. Likewise, IP awareness programs are planned especially for small trade bodies in different regions for wider outreach.

## REGIONAL OFFICES

### PUNJAB

8th Floor, L.D.A Plaza, Egerton Road  
Lahore-54792  
Tel: 042-111-111-456  
Fax: (042) 36304926  
Email: helpdesk@smeda.org.pk

### SINDH

5th Floor, Bahria Complex 2,  
M.T.Khan Road, Karachi  
Tel: (021) 111-111-456  
Fax: (021) 35610572  
Email: helpdesk-khi@smeda.org.pk

### NWFP

Ground floor  
State Life Building  
The Mall, Peshawar  
Tel: (091) 9213046-47  
Fax: (091) 286908  
Email: helpdesk-pew@smeda.org.pk

### BALUCHISTAN

Bungalow No. 15-A  
Chaman Housing Scheme  
Airport Road, Quetta.  
Tel: (081) 2831702/2831623  
Fax: (081) 2831922  
Email: helpdesk-qta@smeda.org.pk

# Annex II

## Annex II

### Classification of Goods for Industrial Designs in Pakistan

- Class 1:* Articles composed wholly of metal or in which metal predominates, & jewellery.
- Class 2:* Books and bookbinding of all materials.
- Class 3:* Articles composed wholly or India-rubber, wood, bone, ivory, papier mache, celluloid, bakelie, or like substances, or of materials in which such substances predominate (except articles included in Class 10)
- Class 4:* Articles composed wholly of glass, earthenware or porcelain, clay (burnt or baked), or cement or in which such materials predominate.
- Class 5:* Articles composed wholly of paper, card-board, mill-board or straw-board (except articles included in class-2 and paper hangings), or in which such materials predominate.
- Class 6:* Articles composed wholly of leather or in which leather predominates, not included on other classes.
- Class 7:* Paper hangings.
- Class 8:* Carpets, rugs and floor coverings in all materials.
- Class 9:* Lace.
- Class 10:* Boots, shoes and the like foot-wear.
- Class 11:* Millinery and wearing apparel (except articles included in Class 10).
- Class 12:* Goods not included in other classes.
- Class 13:* Printed or woven design on textile goods (other than checks or stripes).
- Class 14:* Printed or woven designs on textile goods being checks and stripes

# Annex III

## Annex III

### Form 15

Fee Rs. 450.00

### **Registered Designs Ordinance, 2000**

Application for registration of designs  
(Section 3)

<sup>1</sup>Insert number of class

You are requested to register the accompanying design in Class No. <sup>1</sup>\_\_\_\_\_ in the  
name of <sup>2</sup>\_\_\_\_\_

<sup>2</sup> Insert (in full) the name,  
address, and nationality

\_\_\_\_\_

\_\_\_\_\_

who claim (s) to be proprietor (s) thereof.

<sup>3</sup> State whether drawings,  
photographs or specimens.

Four exactly similar <sup>3</sup>\_\_\_\_\_

of the design accompany this request.

<sup>4</sup> Insert name of article or  
articles to which the design  
is to be applied

The design is to be applied to <sup>4</sup>\_\_\_\_\_

\_\_\_\_\_

\_\_\_\_\_

<sup>5</sup> Strike out these words if  
no previous registration  
has been effected

<sup>5</sup>The design has been previously registered in Classes \_\_\_\_\_

\_\_\_\_\_ under No \_\_\_\_\_

Address for service in Pakistan is <sup>6</sup>:-

\_\_\_\_\_

<sup>6</sup> Unless an address for  
service in Pakistan is  
given, the request may not  
be considered.  
See Rule 4

Dated this \_\_\_\_\_ day of \_\_\_\_\_, 200

(Signed) \_\_\_\_\_

To,

THE CONTROLLER OF PATENTS AND REGISTRAR OF DESIGNS.

THE PATENT OFFICE, KARACHI.

#### NOTE:

For further information on the other business-oriented content and publications on intellectual property rights please visit WIPO's SME website at [www.wipo.int/sme/en/](http://www.wipo.int/sme/en/). In addition, you may also subscribe to the free electronic monthly newsletter of the SMEs Division of WIPO, available at [www.wipo.int/sme/en/documents/wipo\\_sme\\_newsletter.html](http://www.wipo.int/sme/en/documents/wipo_sme_newsletter.html). Recent activities on IP matters by SMEDA are available at [www.smeda.org/services/Intellectual-Property-for-Bussines-Success.html](http://www.smeda.org/services/Intellectual-Property-for-Bussines-Success.html)

For more information contact

Small and Medium Enterprises Development Authority (SMEDA)

SMEDA Head Office:

6th Floor, L.D.A Plaza, Egerton Road, Lahore-54000

Tel: (042) 111-111-456

Fax: (042) 36304926-7

Website: [www.smeda.org.pk](http://www.smeda.org.pk)

Intellectual Property Organization of Pakistan (IPO Pakistan)

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Tel: +92-51-99208146 Fax: +92-51-99208157

Website: [www.ipo.gov.pk](http://www.ipo.gov.pk) Email: [info@ipo.gov.pk](mailto:info@ipo.gov.pk)

World Intellectual Property Organization (WIPO)

34, Chemin des Colombettes

CH-1211 Geneva 20

Switzerland

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Fax: +41 22 733 54 28

e-mail: [wipo.mail@wipo.int](mailto:wipo.mail@wipo.int)

or its New York Coordination Office at:

2, United Nations Plaza

Suite 2525

New York, N.Y. 10017

United States of America

Telephone: +1 212 963 6813

Fax: +1 212 963 4801

e-mail: [wipo@un.org](mailto:wipo@un.org)

Visit the WIPO website at: [www.wipo.int](http://www.wipo.int)

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34, chemin des Colombettes

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Switzerland

Fax: +41 22 338 87 60

e-mail: [sme@wipo.int](mailto:sme@wipo.int)

Web page: [www.wipo.int/sme](http://www.wipo.int/sme)

Available at SMEDA Head Office and downloadable from  
[www.smeda.org/services/Intellectual-Property-for-Bussines-Success.html](http://www.smeda.org/services/Intellectual-Property-for-Bussines-Success.html)  
and the WIPO Electronic Bookshop at [www.wipo.int/ebookshop](http://www.wipo.int/ebookshop)

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