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APPELLANT'S REGISTERED DESIGN DISSIMILAR FROM ALLEGED PRIOR ART – ORDER OF SINGLE JUDGE REVERSED

Appellant: DOLLAR INDUSTRIES (PVT) LTD.

Respondent: BROTHERS INDUSTRIES

Decision: Appeal Allowed

Appellant was the registered proprietor of a pen design under No.12247-D dated May 9, 2005 which was used and exported from Pakistan since then. Respondent sought registration of its own design bearing No.13314-D on March 14, 2007 and around October 2008, pens manufactured by Respondent started showing up in the local markets; while the exterior of Respondent's pen resembled with its registered design but when the cap was removed, it had identical design elements comprising the features of parallel lines specifically protected by Appellant vide its design registration No. 12247-D.

Appellant filed two suits in the High Court alleging infringement of its registered design and obtained restraining order against Respondent from manufacturing and selling its products. Appellant also filed an application before the registrar of designs for cancellation of Respondent's registered design No.13314-D which was transferred to the High Court, as the suits for infringement were proceeding before the High Court.

Respondent filed a counterblast in the High Court for cancellation of Appellant's registered design No.12247-D alleging that Appellant's design was:

- (i) not original and new, as required under s.3(2) of the Registered Designs Ordinance; and
- (ii) a copy of a prior published German design for a pen known to the world as "Hauser 737 Mayor Rollerball".

On the basis of German 'Hauser' 95 catalogue, the court concluded that there was no originality or newness in design No. 12247-D of Appellant as mandated in Section 3(2) and allowed the petition of Respondent by cancelling the design registration of Appellant. In appeal against the said order, the counsel for Appellant submitted that the said Hauser catalogue did not mention the date of publication, as well as, the certificate produced by Respondent in support of its claim that Hauser 737 Mayor Rollerball branded identical pens were made available since 1994 by a company, Innowell GmbH of Germany was also fake and the specimen of the pen presented before the court as Hauser pen was locally produced specifically for the purposes of the case which was not made in Germany.

The counsel for Respondent reiterated arguments that Appellant's design was a copy of the German Hauser 737 Mayor Rollerball pen published in the Hauser 1995 catalogue, thus its cancellation was rightly ordered by the learned single judge on account of the design's failure to pass through the test of global novelty and newness prescribed under s.3(2) of the Ordinance.

The Appeal Court after hearing the arguments and perusal of records fully agreed with the legal rationale of the single judge that once a publication has been made prior to the date of filing of a design in Pakistan and goods of similar

designs have been offered for sale anywhere in the world, there is no novelty in identical design and such a design cannot be registered in Pakistan under the Designs Ordinance but observed that:

In relation to Hauser 95 Catalog it did not suggest that the same was for the year 1995, as the title page only said 95. Defendant had to prove that the said publication was of the year 1995 (or any date prior to the date of filing of the design by Plaintiff) to defeat the newness claim made by Plaintiff under s.3(2) of the Ordinance, which onus of proof, unless discharged, could have been assumed by the Court. Certificate purported to have been issued by Innowell GmbH looked fake, as no German company would issue such an untidy document. The trademark "Hauser" belonged to an Indian company which was purportedly manufacturing "Hauser" branded pens. Comparing the design of prior art pen appearing in the Catalog 95 alongside the design of Appellant's pen, there were apparent dissimilarities in the first look. Looking at the overall visual impression of both the pens, one would note that prior art was a roller ball/ballpoint and Appellant's pen was soft-liner with a fixed line thickness of 0.3 mm, which was intended to be used by different class of purchasers looking for pens for different purposes, which discrepancy set apart the class of divergent users of each pen. Prior art being a roller pen used heavy pressure of hand and thus could create carbon copies. However, the soft-liner could not produce any carbon copies. The quality of Hauser pen produced as evidence was very poor which did not meet German standards. The Court also looked at the specific features of both the pens, such as difference between the nib, cap, colours, hardness of the material of the main body and overall finish of the rival pens. Applying the 'ordinary observer' test through the eyes of an observer familiar with pens, High Court concluded that Plaintiff's design and the prior art were plainly dissimilar and there was no possibility of an ordinary observer be deceived by similarities of two designs if the pens were available side-by-side and consequently held that registration of Plaintiff's design was not hit by s.3(2) of the Ordinance on account of the prior art. As such, the High Court allowed Plaintiff's appeal and set aside the impugned order for the cancellation of the registered design of Plaintiff.

