

**IN THE HIGH COURT OF SINDH, KARACHI**

**Suit No.2223 of 2015**

ORO Industries

*vs.*

Muhammad Hanif, Sole Proprietor,  
Trading as Mubeen Enterprises

**J.M.No.09 of 2016**

Muhammad Hanif

v/s. Registrar of Design & others

**Before: Mr. Justice Zulfiqar Ahmad Khan**

Date of Hearing : 20.03.2017

Plaintiff : Through Mr. Abdul Hameed Iqbal, Advocate

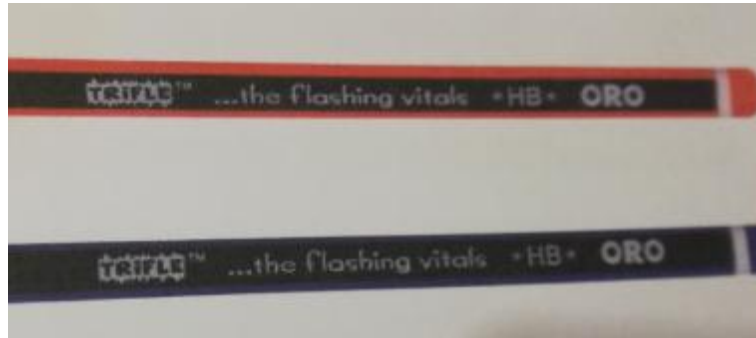
Defendant : Through Mr. Abdul Salam Memon, Advocate

**ORDER**

**Zulfiqar Ahmad Khan, J.:-** This single order will dispose of C.M.A. No.16652/2015 moved by the Plaintiff in Suit No.2223 of 2015, seeking injunction against the Defendant from using the getup and design of Design No.17023-D owned by the Plaintiff, as well as, restraining the Defendant from using trade mark “ZORRO” on the ground that the Plaintiff is the registered proprietor of trade mark “ORO”, as well J.M.No.09/2016 filed by the Defendant will also be disposed off, through which cancellation of the Plaintiff’s registered design has been sought by the Defendant.

While it is admitted that the Plaintiff owns trade mark “ORO” which has been registered by it with the Trade Marks Registry in respect of class 16 goods w.e.f. 22.09.2010, it also has secured registration of the design of pencils (under dispute) as provided under the mechanism laid down by the Registered Designs Ordinance, 2000. An examination of the Design Registration Certificate dated 23.01.2014 shows that the

novelty of the design has been claimed to reside in the ornamental pattern as applied to pencils, as fully illustrated in the representation of the design. To fully understand the design of the pencils as registered by the Plaintiff, representations as filed by the Plaintiff are reproduced hereunder:



Allegation levelled by the counsel for the Plaintiff are that the Defendant taking benefit of the attractive design of the Plaintiff commenced manufacturing of similarly designed pencils and to leave no stone unturned to reap benefit from the hard earned reputation and goodwill of the Plaintiff, even applied thereon trade mark “ZORRO”, which is allegedly deceptively similar with the Plaintiff’s trade mark “ORO”.

To have a comparison of the rival products, samples were called for and comparative picture of “ZORRO v/s ORO” is reproduced hereunder:



When attention is drawn to J.M.No.09/2016 in terms of which cancellation of Plaintiff’s registered design is sought, the grounds alleged for such a cancellation are that the design registered by the Plaintiff is not new, easily available in the local and international market thus there is no element of novelty therein which is mandatory for

obtaining registration of a design. In support of his contentions, learned counsel for the Defendant produced a large number of pencils manufactured by third parties, which seemingly look alike the design registered by the Plaintiff. It was contended by the counsel that the said design was introduced in 1990 by M/s. Staedtler Mars GmbH & Co. a German company for its 'Noris' range of pencils, which have been globally sold since then. In support of his contentions, he attached copies of Noris pencils.

As mentioned in the foregoing, to have a design registered under the Ordinance and to have a monopoly created thereon, it is essential that the design must have element of newness or originality under section 3(2) of the Ordinance and in the absence of the said newness or originality, no design could be registered. The condition of newness and originality, which under the previous 1911 Patent and Design Act was only limited to Pakistan, was extended globally under the 2000 Ordinance meaning thereby to have a design registered under the 2000 Ordinance, the design must be globally new or original.

The term 'design' is defined by clause (e) of section 2 of the Ordinance to mean (in the given context) 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. Sub-section (2) of section 3 requires that a design not to be registered unless it was 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. Explanation to the said section provides that designs would not be new or original if they do not significantly differ from known designs or combination of design

features. It is important to keep in mind that Section 3 is couched in the negative terms, and requires that the design which is not new or original cannot be registered. The expression, "new or original" appearing in section 3 means that the design had been invented for the first time or it has not been reproduced by anyone before. As mentioned in the foregoing, since a design is to be judged solely by the eye, the said definition read with application for registration makes it clear that the shape or particular configuration has to have visual newness or originality. Such design, once it is registered cannot be copied by any other person, as long as the design is new or original and never ever reproduced by any other person. In the case at hand a large number of triangular shaped pencils, which were produced before this Court were allegedly available in the market and such shape of triangular shaped pencils being in common knowledge for decades, hence by no stretch of imagination such pencils which have been registered by the Plaintiff could be said to be new or original and invented by the Plaintiff. A simple search in Google for the phrase "triangular shaped pencils" shows about over 1.7 million hits. The fact is that these triangular shaped pencils have been in use since long for teaching toddlers how to write effectively as the circular pencils are hard to be held by small hands, being easy in grip, the said design has thus been popular and widely sold for decades. In *Phillips v. Barbro Rubber Company* (1920) 37 R.P.C. 233, Lord Moulton emphasized that it is the duty of the court to take special care that no design is to be counted as new and original design unless it distinguished from that previously existed by something essentially new or original which is different from ordinary trade variants. The very intent of section 10 of the Ordinance is to remove registrations of such designs from the Register which were registered in violation of substantive requirements prescribed by the Ordinance. In the case at hand it is abundantly clear that the design registered by the Plaintiff is devoid of newness or originality and it could also not be said that the Plaintiff had

induced creative ingenuity in this very commonly available design to the extent that the resulting design could withhold the threshold of newness or originality and stay registered as such. Accordingly, the J.M.No.09/2016 is allowed on the ground of lack of newness and originality in the Plaintiff's designed pencils.

Notwithstanding the above conclusion, a comparison of the rival pencils as shown above reveals that the Defendant has not only used identical colour scheme and getup (trade dress) of pencils used by the Plaintiff, as well as, its trade mark "ZORRO" embodies Plaintiff's complete trade mark "ORO" in full, therefore, when *Moron in a Hurry* test as developed by Mr. Justice Foster in the 1978 Morning Star Cooperative Society v Express Newspapers Limited [1979 FSR 113] is applied, there is no doubt that an unwary purchaser will not be deceived on account of the startling resemblances between the rival pencils. Accordingly the application filed under Order XXXIX Rules 1 & 2 C.P.C. by the Plaintiff succeeds.

The residual effect of the above is that while the Plaintiff has lost his design Registered No.17023-D on account of forceful attack made by the Defendant through J.M.No.09/2016, the Defendant is still restrained from using deceptively similar "ZORRO" trademarked pencils embodying the typical colours scheme (trade dress) adopted by the Plaintiff.

Judge