

Intellectual Property - Pakistan

Myth or reality: three-dimensional shapes as trademarks

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In the past, shape marks were considered non-distinctive – a trademark was considered separate from the goods, a material sign to be affixed to the goods or their container. Another view was that three-dimensional objects were more properly registrable under the designs legislation if they were novel and original.

The Trademarks Ordinance 2001 (the current trademarks law in Pakistan) recognises, among other things, words, letters, devices, figurative elements, colours, sounds and combinations thereof as trademarks as long as they can distinguish the goods or services of one undertaking from those of other undertakings. This is a broad definition of what may constitute a trademark and is arguably wide enough to include three-dimensional shape marks, such as package designs.

Section 14 of the ordinance contains the absolute grounds for refusal of registration. The most relevant provision of this section (which applies directly to shape trademarks) is in Subsection 2, which prohibits registration of certain kinds of shapes, such as those that:

- result from the nature of the goods themselves;
- are necessary to obtain a technical result; and
- give substantial value to the goods.

Thus, if a shape has significant functional features, there is a strong likelihood that other traders will need to use that shape for their similar goods. Therefore, the shape will not be inherently adapted to distinguish the goods and as such, will fall under the above-mentioned grounds for rejection.

The other conditions that a three-dimensional shape trademark must fulfil are those in Clauses b, c and d of Section 14(1), which state:

"14. Absolute grounds for refusal of registration. (1) The following shall not be registered, namely:-

(a) marks which do not satisfy the requirements of clause (xlvii) of section 2;

(b) trade marks which are devoid of any distinctive character;

(c) trade marks which consist exclusively of marks or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services; and

(d) trade marks which consist exclusively of marks or indications which have become customary in the current language or in the bona fide and established practices of the trade:

Provided that a trade mark shall not be refused registration by virtue of clause (b), (c) or (d) if, before the date of application for registration, it has, in fact, acquired a distinctive character as a result of the use made of it or is a well known trade mark."

Thus far, several marks have been registered in Pakistan comprising three-dimensional shapes, subject to disclaimers or other conditions. Among these, one of the oldest registrations relates to the shape of world-famous TOBLERONE chocolates. The zig-zag shape of TOBLERONE chocolates, as well as the triangular shape of the TOBLERONE packaging, are registered trademarks in Pakistan of the Swiss

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confectionary manufacturer Kraft Foods Schweiz AG.

The High Court of Sindh at Karachi recently granted an *ad interim* injunction against a Pakistani entity, restraining it from selling chocolates in zig-zag shapes and triangular packaging. In this particular case, the Pakistani entity – in addition to the zig-zag shape of TOBLERONE chocolates and the triangular shape of the TOBLERONE packaging – also copied the overall look and packaging of TOBLERONE chocolates.

Other non-traditional trademarks, including colours and sounds, are specifically included in the definition of a mark and may therefore be registered under the ordinance. While applications have been filed for registration of colours as trademarks, it appears that no application for registration of a sound has yet been made. However, there are no procedures or guidelines prescribed by the registry in this regard.

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