

Shape Trademark and Industrial Design Protections in GCC

Mohammed Ali - Senior Associate - Intellectual Property
m.ali@tamimi.com - Dubai International Financial Centre

March 2011

The shape of a product is often significant value to a business. This article briefly considers the use of trade mark law and industrial design law to secure the intellectual property value of a product with a commercially significant shape.

INTRODUCTION TO TRADEMARKS AND INDUSTRIAL DESIGNS:

Trademarks:

A 'trademark' is a word, name, sign, symbol, colour or shape which is used to identify a particular product or service offered by a particular manufacturer or from a particular source.

A trademark distinguishes the product of a particular manufacturer from similar products offered by others. The owner of a registered trademark has the right to prevent others from using the same or similar trademark on their products.

A registered owner of a trademark can prevent use and registration of an infringing mark based on the basic rule: a trademark is not available for use and registration if it resembles a trademark already registered and the resemblance is likely to cause confusion, mistake or deception.

Industrial Designs:

An 'industrial design' is the ornamental or aesthetic aspect of an article. A design may consist of three-dimensional features, such as the shape or surface of an article, or of two-dimensional features, such as patterns, lines or color.

Industrial designs are applied to a wide variety of products of industry and handicraft, from technical and medical instruments to watches, jewelry, and other luxury items; from house wares and electrical appliances to vehicles and architectural structures; from textile designs to leisure goods.

To be protected under most national laws, an industrial design must appeal to the eye. This means that an industrial design is primarily of an aesthetic nature, and does not protect any technical or functional features of the article to which it is applied.

Unlike trademarks, to be protected, an industrial design must be novel. The display of the product in public or in the marketplace will destroy the novelty of a design. Thus, protection for an industrial design should be in place before the launch of the product in question. In this regard, it is pertinent to note there is no requirement for the industrial design to be registered to meet the novelty requirement. An application for registering the design lodged properly before the industrial design registry of the relevant country is sufficient. Once an industrial design is applied in a country which is member to the Paris Convention, a six months grace period will be available for the applicant to apply for the design in other member countries of interest, claiming priority from the base application. Launch of the product in any such countries during the six months priority period will not destroy the novelty of the design.

Shape Trademark vs. Industrial Design:

From the definition of a trademark above, it is noted that shape of a product is also qualified to be protected as a trademark. Although shape trademark protection is recognized by most of the countries in the GCC, industrial design is the correct form of protection to protect the shape and configuration of an article.

The ornamental or aesthetic nature of an article can be protected by registering a shape trademark. One benefit of protecting a shape trademark is the term of protection of a trademark is perpetual, as it can be renewed any number of times, whereas the protection term of an industrial design is fixed to a maximum of 15 years in most jurisdictions. Furthermore, in the GCC, courts are familiar with trademarks and thus laws for enforcing trademark rights are more developed for the laws for design rights. In fact, design regimes are still in the developing stage.

Based on the above, ensuring protection is in place for an article by way of shape trademark registration, as well as industrial design registration, can be considered, subject to both the forms of protection being available in the country of interest. Other considerations are significance of the countries in question to the business and the budget.

Country	Shape Trademark registration	Industrial Design registration
Bahrain	Yes	Yes
Kuwait	Yes	Yes
Oman	Yes	Yes
Qatar	Yes	No
Saudi Arabia	No	Yes
UAE	Yes	Yes

The table above shows the status of the GCC countries in terms of registrability of shape trademarks or industrial designs or both.

How similar the infringing products should be in order to take legal action is always a question of degree. However, as a general rule, an object with a design, that is substantially similar or confusingly similar to the design claimed in an industrial design or in a shape trademark cannot be made, used, copied or even imported into the country in question.