

DRAFT



INDUSTRIAL DESIGNS ACT, 2014

INDUSTRIAL DESIGNS ACT

It is enacted by the Senate and House of Representatives of the Republic of Liberia in Legislature Assembled:

PART I

PRELIMINARY PROVISIONS

§1.1. Short Title

This Act may be cited as the “Liberia Industrial Designs Act”.

§1.2. Repealer

Chapter 4 Industrial Designs as well as Part V General Provisions as relates thereto of the Industrial Property Act of Liberia, April 30, 2003 are hereby repealed.

§1.3. Definitions

Unless the context otherwise requires,

“Court” means a court of justice in Liberia;

“Designer” means the person who creates the industrial design;

“Exploitation” of a registered industrial design means the making, offering, putting on the market or selling of products that embody the industrial design, or importing such products for those purposes;

“Harare Protocol” means the Protocol on Patents and Industrial Designs adopted in 1982 in Harare, Zimbabwe;

“Industrial design” means any composition of lines or colors or any three-dimensional form, whether or not associated with lines or colors is deemed to be an industrial design provided that such composition or form gives a special appearance to a product of industry or handicraft and can serve as a pattern for a product of industry or handicraft;

“International classification” means the classification according to the Locarno Agreement of October 8, 1986 establishing an International Classification for Industrial Designs;

“Paris Convention” means the Paris Convention for the Protection of Industrial Property of March 20, 1883, as last revised;

“Priority date” means the date of the earlier application that serves as the basis for the right of priority provided for in the Paris Convention; and

“Protection of a registered industrial design shall extend only to the acts referenced in the definition of exploitation that are performed in respect of any type of product or the same type of product for which the industrial design was registered.

“Register” means the Register of Industrial Designs.

PART II

INDUSTRIAL DESIGNS

§2.1. Subject Matter of Protection

(a) Registration under Part II of this Act shall not be granted to a design the features of which are dictated solely by technical or functional considerations.

(b) An industrial design shall not be registered if it is determined that its commercial exploitation would be contrary to public order or morality.

§2.2. Registrable Industrial Designs

(a) An industrial design is registrable if it is independently created and new or original.

- (b) An industrial design shall not be regarded as new if it does not significantly differ from designs disclosed to the public anywhere in the world, by publication, exhibition, use in trade or in any other way, prior to the filing date or, where applicable, the priority date of the application for registration.
- (c) An industrial design applied to or embodied in a product that is a component part of a complex product shall only be considered to be new if the component part remains visible during the normal use of the complex product. To this effect “normal use” means use by the end user and does not include maintenance, servicing or repair work in relation to the product.
- (d) For the purposes of determining novelty, disclosure to the public of an industrial design shall not be taken into consideration if it occurred within twelve months preceding the filing date or, where applicable, the priority date of the application, and if it was by reason or in consequence of an abuse committed by a third party with regard to the applicant or his predecessor in title, or by reason of any act committed by the applicant or his predecessor in title, other than the filing of an application to register or otherwise obtain legal protection for the industrial design with an industrial property authority.

§2.3. Right to Registration of Industrial Design; Naming of Designer

- (a) The right to registration of an industrial design shall belong to the designer.
- (b) If two or more persons have jointly created an industrial design the right to registration shall belong to them jointly.
- (c) The right to registration of an industrial design may be assigned, and may be transferred by succession.
- (d) Where an industrial design is made in execution of an employment contract the purpose of which is to create one or more designs, the right to registration of the industrial design shall belong, in the absence of contractual provisions to the contrary, to the employer. If the economic gains obtained by the employer from the commercial exploitation of the industrial design rise above the reasonable expectations of gain of the employer at the time he hired the designer, the latter shall be entitled to an equitable remuneration.
- (e) Any anticipated promise or undertaking by the designer to the effect that he will waive any remuneration he is entitled to under this section shall be without legal effect.
- (f) The designer shall be named as such in the registration of the industrial design, unless he indicates to the Director General in writing that he wishes not to be named. Any promise or undertaking by the designer to the effect that he will make such a declaration shall be without legal effect.

§2.4. Application; Right of Priority

(a) An application for the registration of an industrial design shall be filed with the Director General and shall contain:

- (i.) a request for registration;
- (ii.) a graphic representation of each industrial design included in the application;
- (iii.) an indication of the product or products in respect of which each design is to be used;
- (iv.) proof of payment of the prescribed application fee for each design; and
- (v.) shall comply with other prescribed requirements.

(b) Where the applicant is not the designer, the request shall include a statement justifying the applicant's right to the registration of the industrial design.

(c) The application may contain up to one hundred industrial designs provided they all refer to products that belong to the same class of the International Classification.

(d) The application may contain a request that the publication of the industrial design be deferred for a specified period not exceeding 30 months from the date of filing or, if priority is claimed, from the date of priority, of the application.

(e) The application may, in accordance with Article 4 of the Paris Convention, contain a declaration claiming the priority of one or more earlier applications filed for the same industrial design by the applicant or his predecessor in title in or for any State party to the said Convention or any Member of the World Trade Organization.

(f) The period of priority shall be of six months and shall be computed in accordance with the provisions of Article 4 of the Paris Convention, that is from the date of filing of the first application, but shall exclude the day of filing in the six months period, and shall end on the last day of the period unless an official holiday or a day the Intellectual Property Office is not opened in which case the period shall be extended until the next working day.

(g) The effect of the claiming of priority shall be as provided in Article 4B of the Paris Convention. In particular, an application filed within the priority period shall not be refused or invalidated by reason of any acts occurring during that period, in particular, another filing or the publication or exploitation of the industrial design, and such acts shall not give rise to any third-party right or any right of personal possession.

(h) Where the application contains a declaration claiming priority, the Director General may request the applicant to furnish, within the prescribed time limit which shall not be less than three months following the date of filing, a copy of the earlier application certified as correct by the foreign authority with which it was filed. The Director General may also request that the

copy be accompanied by a certificate from that authority showing the date of filing, and by a translation into a prescribed language.

- (i) If the Director General finds that the conditions for the right of priority or the requirements for claiming priority have not been fulfilled, the declaration claiming priority shall be considered not to have been made.
- (j) The applicant may amend or correct the application at any time during its pendency. An amendment or correction shall not be accepted if it involves a change in or addition to any of the designs contained in the initial application.
- (k) The applicant may divide his application at any time during pendency in order to separate into two or more applications the designs contained in the initial application. A division shall not be accepted if it involves a change in or addition to any of the designs contained in the initial application.
- (l) Each divisional application shall retain the filing date and the right of priority of the initial application. After the division, each divisional application shall be independent. If publication of the application occurred before the division, the publication shall have effect for each divisional application.
- (m) The applicant may withdraw the application entirely or in respect of one or more designs at any time during its pendency.

§2.5. Filing Date; Examination; Registration and Publication

- (a) The filing date of an application for registration of an industrial design shall be the earliest date on which the application contains at least the following:
 - (i.) an express or implicit request for the registration of one or more industrial design;
 - (ii.) indications allowing the identity of the applicant to be established or allowing the applicant to be contacted;
 - (iii.) a representation of each industrial design for which registration is sought;
 - (iv.) an indication of the product or products in respect of which each design is to be used;
 - (v.) proof of payment of the prescribed application fee for each design.
- (b) The Director General shall examine whether the application complies with the requirements of Section 2.4 and the Regulations pertaining thereto, and whether the industrial design for which

registration is sought complies with the definition contained in Section 1.3 and with Section 2.1 and Section 2.2 of this Act.

- (c) If the application does not comply with the prescribed requirements, the Director General shall notify the applicant accordingly requesting him to correct the application within two months from the date of the notification. Upon justified request, that period may be extended by the Director General.
- (d) If the required correction is not made within the specified period, the application shall be considered withdrawn.
- (e) Where the Director General finds that the conditions referred to in subsection (2) are fulfilled he shall cause the application to be published in the prescribed manner.
- (f) Where a request has been made under Section 2.4(d) for deferment of publication, the application shall not be published until the expiry of the period of deferment.
- (g) The Director General shall publish the industrial design upon request by the applicant at any time before the expiry of the period of deferment.
- (f) Fees for securing protection for textile designs in particular with respect to examination or publication shall not unreasonably impair the opportunity to seek protection.

§2.6. Rights Conferred by Registration; Duration; Extension

- (a) The registration of an industrial design shall confer on its holder the right to prevent others from exploiting the registered industrial design in Liberia. This right shall extend to designs that so closely resemble the registered industrial design that they produce the same overall impression.
- (b) Where an industrial design is registered only for a part of a product that is integral and inseparable from that product, infringement of the registered design shall be assessed taking into account the overall aspect of the product embodying the registered design, and not just that part in isolation.
- (c) Nothing in this Act shall prevent a registered industrial design from enjoying any protection to which it may be entitled under the law of copyright.
- (d) The rights conferred by the registration of an industrial design shall not extend to:
 - (i.) acts in respect of a product that embodies the industrial design after the product has been put on the market in Liberia or abroad by the registered holder or by a person acting with the holder's consent or having an economic tie to the holder; to this effect an economic tie shall exist between two persons where one of them may exercise on the other a decisive influence

with respect to the exploitation of the industrial design, or where a third party may exercise such an influence on both persons;

- (ii.) the use of the industrial designing the body or gear of aircraft, land vehicles or vessels that temporarily or accidentally enter the jurisdiction of Liberia, or the importation of spare parts or accessories for the purpose of repairing such aircraft, vehicles or vessels;
- (iii.) acts done privately and for non-commercial purposes;
- (iv.) acts done for purposes of teaching, education or scientific research in academic, educational or research institutions;
- (v.) acts done only for experimental purposes relating to the industrial design;
- (vi.) the reproduction of any features of the industrial design that are dictated solely by functional or technical considerations or that are necessary to fulfill a technical function or purpose;
- (vii.) the reproduction of any features of the industrial design that must necessarily be reproduced in their exact form in order to permit the product in which the design is embodied to be mechanically connected to or placed in, around or against another product so that each product may perform its function;
- (viii.) the reproduction of any features of an industrial design, that is embodied in a component part of a complex product, where that part is used for the purpose of repairing that product so as to restore its original appearance.

(d) An international application may designate Liberia for an industrial design under the Harare Protocol.

(e) The owner of a protected industrial design shall have the right to prevent third parties not having the owner's consent for making, selling, or importing articles bearing or embodying a design which is a copy or substantially a copy of the protected design, when such acts are undertaken for commercial purposes.

§ 2.7. Duration of Registration; Extension

- ((a) The registration of an industrial design shall be for a period of ten (10) years from the filing date of the application for registration.
- (b) Upon payment of the prescribed fee in the prescribed manner, the registration may be extended for an additional period of ten (10) years. Advance payment may be made at any time.

(2) A period of grace of six months following the expiration of each period of registration shall be allowed to apply for extension of the registration, on payment of the prescribed surcharge.

§ 2.8. Invalidation

- (a) Any interested person may request the Director General or the court to invalidate the registration of an industrial design.
- (b) The registration shall be invalidated if it is established that the object of the registration is not an industrial design in accordance with the definition provided in Section 1.3 or that the requirements of Section 2.1 or Section 2.2 have not been complied with.
- (b) When the grounds for invalidation are established with respect to only one or some of the designs included in the registration, invalidation shall be limited accordingly.
- (c) Any invalidated registration shall be regarded as null and void from the date of the registration and shall be deemed not to have been granted.
- (d) Any dispute over the right to registration of the industrial design under Section 2.3 shall be heard by the court. An interested person may request the court to transfer the registration of the industrial design to him or, alternatively, to invalidate the registration. In case the plaintiff claims to be a joint designer, he may request the court to have his name added as joint designer and, where applicable, as co-holder of the corresponding registration.
- (e) Any final decision of a court on an action taken under this section shall be notified to the Director General who shall record it and publish a reference thereto as prescribed.

§2.9. Regulations; Administrative Instructions

- (a) Regulations shall be issued on industrial designs by the Director General of the Office to further implement this Act and which shall include general provisions pertaining
 - (i.) Changes in Ownership;
 - (ii.) Licenses/compulsory licenses;
 - (iii.) Correction of errors;
 - (iv.) Extension of time;
 - (v.) The register;

- (vi.) Official Gazette;
- (vii.) Exercise of discretionary powers;
- (viii.) Representation;;
- (ix.) Competence of the court;
- (x.) Appeals.

(b)The Director General of the Office may also issue Administrative Instructions relating to the procedures under Act pertaining to lay-out designs.

PART III

ENFORCEMENT AND LEGAL PROCEEDINGS

§ 3.1. Infringement of Industrial Design

An industrial design registered under this Act shall be infringed by the performance of any act referred to in the definition of exploitation under Section 1.3 of this Act by a person other than the registered holder of the industrial design and without the holder's agreement.

§ 3.2. Remedies

On the request of the registered holder of the industrial design, or of a licensee if he has requested the holder to institute court proceedings for a specific relief and the holder has refused or failed to do so within ninety days, the court may grant an injunction to prevent infringement or an imminent infringement, award damages and grant any other remedy provided for in the general law or under this Act.

§3.3. Provisional Measures

- (a) All provisional remedies under the Civil Procedure Law of Liberia including injunctions shall be applicable to civil proceedings relating to industrial designs primarily to prevent an infringement from occurring and preserve relevant evidence in regard to the alleged infringement;
- (b) Time limitations for action for damages under the Civil Procedure Law of Liberia shall be applicable to industrial designs.

(c) The aggrieved party's entitlement to compensation shall be pursuant to the Civil Procedure Law of Liberia.

§3.4 Evidence

(a) Any party to proceedings relating to industrial designs shall be governed by the provisions of the Civil Procedure Law relative to evidence including burden of proof, the right to compel production of documents and to designate documents as privileged or confidential.

(b) Any registration issued under this Act of an industrial design registered on the principal register for industrial designs and owned by a party to an action shall be admissible in evidence and shall be prima facie evidence of the validity of the registered industrial design and of the registration of the industrial design, of the registrant's ownership of the industrial design, and of the registrants' exclusive right to use the industrial design.

§3.5. Damages

(a) An aggrieved party to proceedings involving industrial design rights may seek and obtain a court order that the infringer pay the right holder damages adequate to compensate for the injury the right holder has suffered because of an infringement by an infringer who knowingly, or with reasonable grounds to know, engaged in infringing activity, inclusive of expenses such as attorney fees, or an order for the recovery of profits and or payment of pre-established damages where the infringer with reasonable grounds to know engaged in infringing activity.

(b) An order may also be sought and obtained that the infringer to inform the holder of the right of the identity of third persons involved in the production and distribution of the infringing goods or rendering of services and of their channels of distribution, where this would be in proportion to the seriousness of the infringement.

§3.6. Indemnification of Defendant

Any party to industrial design proceedings who abuses enforcement proceedings may be required by Court order to indemnify the defendant for injury suffered for such an abuse pursuant to the Civil Procedure Law of Liberia.

§3.7. Unfair Competition

Unfair competition legislation in Liberia prohibiting dishonest practices in industrial or commercial matters shall be applicable to industrial designs.

§3.8. Appeals

- (a) An applicant for registration of an industrial design , party to an opposition proceeding, or applicant for renewal or other infringement proceedings who is dissatisfied with the decision of the Director General may appeal to the courts.
- (b) The appeal shall follow the procedure provided under the Civil Procedure Law of the Republic of Liberia.

§3.9. Further Sanctions

When a person has been found liable for infringement under this Act, to create an effective deterrent to further infringement, the infringer may be subjected to a court order for seizure, forfeiture or disposal of the infringing goods and of any materials and instruments the predominant use of which have been in the commission of the infringement.

PART IV

OFFENSES

§4.1 . Unlawful importation

A person is guilty of unlawful importation of industrial, which shall constitute a felony of the second degree under the Penal Law of Liberia, who, without the consent of the right holder, knowingly imports for commercial purposes a protected industrial design.

§4.2 . Unlawful Sale or other distribution

A person is guilty of unlawful sale or distribution of industrial design, which shall constitute a felony of the second degree under the Penal Law of Liberia, who, without the consent of the right holder, knowingly sells or distributes for commercial purposes a protected industrial design.

This Act shall take effect immediately upon publication into Handbills by the Ministry of Foreign Affairs.

ANY LAW TO THE CONTRARY NOTWITHSTANDING