

Industrial Designs Act 1972

CONSOLIDATED ACTS OF SAMOA 2008

INDUSTRIAL DESIGNS ACT 1972

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THE INDUSTRIAL DESIGNS ACT 1972

1972 No. 24

AN ACT to provide a system of registration and protection of industrial designs.

(19 December 1972)

(Commencement date : 19 December 1972)

1. Short title - This Act may be cited as the [Industrial Designs Act 1972](#).

2. Interpretation - In this Act, unless the context otherwise requires:

"Industrial design" means any assemblage of lines or colours designed to give a special appearance to an industrial or artisanal product, and any plastic form, whether or not associated with colours, provided such assemblage or form can serve as a pattern for the manufacture of an industrial or artisanal product but does not include anything in the industrial design which serves solely for the obtaining of a technical result;

"Minister" means the Minister of Justice.

"Registrar" means the Registrar of Designs who shall be the officer who for the time being is the Registrar of Patents.

3. Conditions governing protection - (1) Industrial designs shall have the protection of this Act if registered in accordance with the provisions specified herein.

(2) Registration of an industrial design can validly be granted only to the person who has first fulfilled the conditions for a valid application or who, in fulfilling the conditions, is the first validly to claim priority for an industrial design first applied for in another country.

(3) Subject to the provisions of this Act, an industrial design shall not be registered hereunder unless it is new.

(4) The fact of application shall create a presumption that the product forming the subject of the application was new at the time of the application.

(5) An industrial design is not new if, before the date of the application for registration or the date of priority validly claimed in respect of it, it has been made available to the public, anywhere and at any time whatever, by means of description, use, or in any other way, unless it is proved that the creator of the industrial design could not have had knowledge thereof.

(6) An industrial design shall not be deemed to have been made available to the public solely by reason of the fact that within the period of 6 months preceding the filing of the application for registration, the creator or the creator's successor in title has exhibited it in an official or officially recognized international exhibition.

(7) An industrial design is not new solely by reason of the fact that it differs from earlier designs only in immaterial details or in features which are variants commonly used in the trade.

4. Right to obtain legal protection - (1) Subject to the provisions of this Act, the right to obtain protection hereunder shall belong to the creator or the creator's successor in title.

(2) If two or more people have jointly created an industrial design, the right to obtain legal protection shall belong to them or their successors in title jointly; a person who has merely assisted in the creation of the industrial design, without having contributed any creative activity, shall not, however, be deemed to be a creator or co-creator.

(3) Any person who is the first to make application for the registration of an industrial design, or is the first validly to claim priority for an industrial design first applied for in another country, shall, subject to the provisions of this Act, be deemed to be the creator or the successor in title to the creator.

5. Copying creation of another person - (1) If the essential elements of an application for an industrial design have been copied from the creation of another person, without the latter having consented thereto or to the filing of an application, the person injured by such unlawful copying may demand that the application or the registration be transferred to that person.

(2) The consent of the first creator may be given subsequent to the making of the application, and in such event, it shall be retroactive to the date of the application.

6. Proprietorship of industrial designs - Subject to the legal provisions governing contracts for performing a certain work, and in the absence of contractual provisions to the contrary, the author of an industrial design shall be treated for the purposes of this Act as the proprietor of the design, provided that where the design is created by the author for another person for good consideration, that other person shall be treated for the purposes of this Act as the proprietor.

7. Requirements of application - (1) The application for registration of an industrial design shall be made to the Registrar and shall contain:

- (a) A request for registration of the industrial design;
- (b) The complete name and address of the applicant and, if the applicant's address is outside the country, an address for service within the country;
- (c) A specimen of the object incorporating the industrial design, or a photographic or graphic representation of the industrial design, in colour;
- (d) An indication of the kinds or classes of products for which the industrial design will be used.

(2) If the application is filed through an agent, it shall be accompanied by a power of attorney or other authority in writing signed by the applicant.

(3) Provided the products indicated are of the same kind or kinds, or are in the same class

or classes, the application may comprise one to 50 industrial designs.

8. Right of priority - (1) The applicant for registration of an industrial design who wishes to avail himself or herself of the priority of an earlier application filed in another country shall append to his or her application a written declaration indicating the date and number of the earlier application, the country in which the applicant or the applicant's predecessor in title filed such application, the name of the applicant, and a copy of the earlier application, certified as correct by the appropriate officials of the country where it was filed.

(2) The Minister by notice under his or her hand may suspend applications by nationals of any country which does not grant adequate reciprocity with Samoa.

9. Payment of fees - (1) An application for registration of an industrial design shall not be accepted unless the prescribed fees have been paid.

(2) The fees to be paid in respect of applications, registrations and other matters shall be in accordance with the scale set out in the Schedule.

(3) The Head of State, acting on the advice of Cabinet, may from time to time by Order alter or amend the scale of fees.

10. Registration of industrial design - (1) If the application satisfies the requirements of [section 7](#) of this Act, the industrial design may be registered by the Registrar in accordance with the application, without the necessity of examination.

(2) If the application shows that the provisions of [section 8](#) of this Act have been observed, the Registrar shall record, in connection with the registration, the priority claimed.

11. Contents of register and issue of certificate - (1) The Registrar shall keep a register

in which shall be registered industrial designs, numbered in order of their registration, and in which shall be recorded, in respect of each industrial design, all transactions to be recorded by virtue of this Act.

(2) The registration of an industrial design shall include a reproduction of the industrial design and shall mention: its number; the name and address of the registered owner and, if the registered owner's address is outside the country, the owner's address for service within the country; the dates of application and registration; if priority is claimed, an indication of this fact, and the number, date and country of the application, the basis of the priority claimed; and finally, an indication of the kinds or classes of products for which the industrial design will be used.

(3) The Registrar shall issue a certificate of the registration of the industrial design to the registered owner at the registered owner's address or, if the registered owner's address is outside the country, at his or her address for service.

(4) The Registrar shall record any change of address, or address for service, which shall be notified to the Registrar by the registered owner of the industrial design.

(5) In the absence of any provision to the contrary in this Act, communications to be made to the registered owner of an industrial design by virtue of this law shall be sent to the registered owner at his or her last recorded address, or at the registered owner's last recorded address for service.

12. Inspection of register - Industrial designs registered at the office of industrial designs may be inspected free of charge at that office, and any person may obtain copies at that person's own expense.

13. Appeals - Any person aggrieved by a final decision of the Registrar taken by virtue of the provisions of this Act, shall have the right to appeal to the Supreme Court within a period of one month after receiving notice of such decision.

14. Duration of registration - The registration of an industrial design shall be effective for a period of 5 years calculated from the date of application, subject to earlier expiration or renunciation or annulment.

15. Renewal - (1) Registration of an industrial design may be renewed for 2 further consecutive periods of 5 years merely by paying the appropriate fee for renewal within the 12 months preceding the expiration of the period of registration, provided that a period of grace of 6 months may be granted for the payment of the fee after such expiration, subject to payment of a surcharge.

(2) The Registrar shall record in the register renewals of registrations.

16. Rights conferred by registration - (1) Registration of an industrial design shall confer upon its registered owner the right to restrain other persons from any of the following acts in Samoa:

- (a) The reproduction of the industrial design in the manufacture of a product;
- (b) The importation, the offering for sale, the sale and the utilisation of the product reproducing the industrial design protected;
- (c) The holding of such a product for the purposes of offering it for sale, for selling it, or for utilising it.

(2) The acts referred to in subsection (1) of this section are not rendered lawful merely by the fact that the reproduction differs from the industrial design protected in immaterial details or in features which are variants commonly used in the trade or that it concerns products of a kind other than those of the said industrial design.

(3) The rights conferred by the registration of an industrial design shall only extend to acts done for industrial or commercial purposes.

(4) The rights conferred by the registration of an industrial design shall not extend to acts

in respect of a product incorporating the protected industrial design after that produce has been lawfully sold, other than duplication or substantial copying of the protected industrial design.

17. Assignment and transmission of registrations - (1) Registrations of an industrial design may be assigned, or transmitted by succession, and shall be recorded by the Registrar on payment of the appropriate fee.

(2) The assignment of registrations shall be made in writing and shall require the signature of the contracting parties.

(3) Assignments and transmissions shall have no effect until they have been recorded.

18. Joint ownership of rights conferred by registration - In the absence of any provision to the contrary between the parties, joint owners of a registered industrial design may separately transfer their respective interests, utilise the industrial design and exercise the rights conferred by registration but may only jointly grant a licence to a third party to exploit the industrial design.

19. Licence contracts- (1) The owner of an industrial design may, by contract, grant to some other person or undertaking a licence to exploit the industrial design.

(2) The licence contract must be in writing and shall require the signatures of the contracting parties.

(3) The licence contract or an appropriate extract thereof shall be recorded by the Registrar on payment of the appropriate fee and the licence shall have no effect against other persons until so recorded.

(4) The recording of a licence shall be cancelled on request of the registered owner of the industrial design, upon evidence of termination of the licence.

20. Right of licensor to grant further licences - (1) In the absence of any provision to the contrary in the licence contract, the grant of a licence shall not prevent the licensor from granting further licences to other persons for the exploitation of the same industrial design, nor from exploiting the same industrial design himself or herself.

(2) The grant of an exclusive licence shall prevent the licensor from granting licences to other persons for the exploitation of the same industrial design and, in the absence of any provisions to the contrary in the licence contract, from exploiting the industrial design himself or herself.

21. Rights of licensee - In the absence of any provision to the contrary in the licence contract, the licensee shall, be entitled to do all the acts referred to in [section 16](#) of this Act during the whole duration of the registration, including renewals, in Samoa, and in respect of all applications of the industrial design.

22. Non-assignability of licences - (1) In the absence of any provisions to the contrary in the licence contract, a licence shall not be assignable to other persons and the licensee shall not be entitled to grant sub-licences.

(2) If the licensee is entitled by contract to assign his or her licence or to grant sub-licences, [sections 19](#) to [21](#) and [23](#) of this Act shall apply thereto.

23. Licence contracts involving payments abroad - The Minister may, by order, provide that licence contracts or certain classes of them, and amendments or renewals of such contracts, which involve the payment of royalties abroad, shall require the approval of the Minister, taking into account the needs of the country and its economic development.

24. Renunciation of registration - (1) The registered owner of an industrial design may renounce the registration by means of a written declaration addressed to the Registrar.

(2) The renunciation may be limited to one kind of product or to one class of products or, if the application comprises several industrial designs to one part of such industrial designs.

(3) The renunciation shall be immediately registered by the Registrar and shall be effective upon registration.

(4) If a licence in respect of a design is recorded by the Registrar, renunciation of the registration shall only be recorded upon the submission of a declaration by which the registered licensee consents to the renunciation, unless the latter has expressly renounced this right in the licence contract.

25. Nullity of registration - (1) On the request of any person showing a legitimate interest, or of any competent authority, the Supreme Court, after having given the registered owner an opportunity to be heard, shall declare the registration of an industrial design null and void if it fails to satisfy the conditions of protection set out in [section 3](#) of this Act.

(2) In the case of a registration covering several industrial designs and in which the grounds of nullity of registration only apply to a portion thereof, nullity of registration shall only be pronounced in respect of that portion.

26. Effects of declaration of nullity - (1) When a decision declaring total or partial nullity of a registration becomes final, the registration shall be deemed, within the limits of the decision, to have been null and void from the date of such registration:

PROVIDED THAT where licences have been granted, the Court may decide that nullity of the registration shall not entail the repayment of royalties paid by any licensee in so far as the licensee has effectively profited from the licence.

(2) When a declaration of nullity becomes final, the Registrar shall forthwith enter it in the register.

27. Civil proceedings - (1) The registered owner of an industrial design whose rights under [section 16](#) of this Act are threatened with infringement, or are infringed, may institute legal proceedings designed to prevent the infringement or to prohibit its continuation.

(2) In case of infringement of those rights, the registered owner of the industrial design may also claim damages and any other appropriate remedy within the jurisdiction of the Court.

28. Offences - Any wilful infringement of the rights of the registered owner of an industrial design under [section 16](#) of this Act shall be an offence against this Act, and on conviction the offender shall be liable to a fine not exceeding 5 penalty units.

29. Legal proceedings by licensee - (1) Any licensee may, by registered mail, require the registered owner of the industrial design to institute legal proceedings in respect of any infringement of the rights granted by [section 16](#) of this Act.

(2) In the absence of any provisions to the contrary in the licence contract, the licensee under a recorded licence may, if the registered owner refuses or neglects to institute such proceedings within 3 months after being requested to do so, institute such proceedings in his or her own name, without prejudice to the right of the registered owner to intervene in such action.

30. Legal Proceedings to be in the Supreme Court - All legal proceedings arising out of this Act shall be brought in the Supreme Court which shall have exclusive jurisdiction over all such cases and no appeal shall lie from any decision of the Supreme Court arising under this Act.

31. Regulations - The Head of State may, from time to time, acting on the advice of Cabinet, make such regulations as may be necessary or expedient for giving full effect to the provisions of this Act and for the due administration thereof.

SCHEDULE

Section 9

FEES

Item No.	Subject	Amount \$
1	On application for registration of an industrial design to be applied to a single article	45.00
2	On application to register one design to be applied to a set of articles	69.00
3	On first application for renewal	45.00
4	On second application for renewal	69.00
5	On request to record assignment, transmission or license contract:- In respect of one design For each additional design	 24.00 6.00
6	On alteration of address, or address for service:- In respect of one design For each additional design	 9.00

		3.00
7	On application for cancellation	9.00
8	Duplicate certificate of registration	9.00
9	On application for annulment	69.00
10	On appeal to the Supreme Court against decision of the Registrar	45.00
11	For typewritten or photographic copy of design or document	Reasonable cost

REVISION NOTES 1997

The [Industrial Designs Act 1972](#) appearing in this reprint comprises that Act as it appears in the 1977 reprint together with the amendments to the Schedule contained in the Schedule to the Omnibus Fees and Charges Amendment Act 1988.

REVISION NOTES 2008

This law has been generally edited as provided for by [section 5](#) of the [Revision and Publication of Laws Act 2008](#). The following general revisions have been made –

- (a) References to Western Samoa have been amended to Samoa in accordance with an amendment to the Constitution of Samoa in 1997.
- (b) The fines have been amended and are stated as penalty units as provided for by the Fines (Review and Amendment) Act 1998.
- (c) All references to the male gender have been made gender neutral.
- (d) Amendments have been made to conform to modern drafting styles and to use modern language as applied in the laws of Samoa.
- (e) Other minor editing has been done in accordance with the lawful powers of the Attorney General.

The following amendments have been made to specific sections of the Act to incorporate amendments made by Act of Parliament passed since the publication of the Western Samoa Statutes Reprint 1978-1996 –

First Schedule	The fees in the First Schedule were amended by the Miscellaneous Fees Amendment Act 1998 (No. 16).
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Under the supervision of Teleiai Lalotoa Sinaalamaimaleula Mulitalo (Parliamentary Counsel)

REVISION NOTES 2008 No. 2

The commencement date has been inserted after the date of assent.

Revised and consolidated by Sarona Caroline Fuimaono Rimoni

Under the supervision of Teleiai Lalotoa Sinaalamaimaleula Mulitalo (Parliamentary Counsel)

**The [Industrial Designs Act 1972](#) is
administered in the Ministry of Justice and Courts Administration.**