

## Design Law

### **THE INDUSTRIAL DESIGNS ACT, 1974**

#### **PART I: PRELIMINARY**

1. This Act may be cited as “The Industrial Designs Act, 1974”.
2. In this Act, unless the context otherwise requires:-

“Court” means Province Court; <sup>1</sup>

“Industrial Design” means any composition of lines or colors formed to give a special appearance to any industrial or hand-made product or any plastic form whether or not it is restricted to color on condition that, the form or composition can be used as an industrial design or a handicraft design;

“Minister” means the Minister of Finance and Economic Planning;

“Industrial Designs Office” means the office established in accordance with Section 3:

“Successor” means one who takes the place of an inventor and has all his rights vested in him;

“Rules” means the rules made in accordance with this Act;

“Fixed Address” means any address within the Democratic Republic of the Sudan fixed by an applicant for registration as the place where directions and notices may be sent to him.

#### **PART II: INDUSTRIAL DESIGN OFFICE AND CONSULTATIVE COMMITTEE FOR INDUSTRIAL DESIGNS**

3. The Minister may establish an office for industrial designs to carry out the functions vested in it by the provisions of the ACT.

4. The Minister may set up a committee known as “The Consultative Committee for Industrial Design” for the purpose of giving of opinions on applications for registration of industrial designs, the functions of such committee shall be specified by the Minister.

#### **PART III: SCOPE OF AND CONDITIONS FOR PROTECTION**

5. (1) Industrial designers shall enjoy the rights provided for in this Act, so long as they comply with all conditions and procedures laid down by this Act without prejudice to any rights vested in them under any other law.

(2) Protection given by this Act shall not extend to any part of an industrial design if the purpose of the industrial design is solely to achieve a technical result.

6. (1) Industrial designs shall not enjoy protection under this Act unless they are

registered in accordance with its provisions.

(2) Registration of an industrial design shall according to law, be given to the first the conditions, shall be lawfully the first to apply for priority of registration on the ground of having made an application for registration in a foreign country at an earlier date.

7. (1) Only new industrial designs shall enjoy the protection provided for in this Act.

(2) Industrial designs, which, are against the public interest or morals shall not be protected under this Act.

8.

(1) The forwarding of an application shall be a presumption of novelty of an industrial design at the time of such application.

(2) An industrial design shall not be considered new if it is available to the public, at any place and by any means whether by prior use or description before the date of an application for its registration or before the date when it can be legally claimed and unless its designer proves that he was not in a position to know about the availability of the design to the public.

(3) An industrial design shall not be deemed to have been made available to the public solely by reason of the fact that, within a period of six months preceding the filing of an application for registration, the designer or his successor has exhibited it in a nationally or internationally recognized exhibition.

(4) An industrial design shall not be considered as new because it contains minor difference from preceding industrial designs, or because it related to process different from that to which the other industrial designs are related.

9. The provisions on international conventions whether bilateral or multinational to which the democratic Republic of the Sudan is or will become a party shall be applied to regulate the right of the nationals of member states to such conventions or their representatives.

10. Foreigners who do not come under the preceding section shall have the same rights as citizens, so long as no order is made by the Minister, suspending the application of these provisions to the nationals of a country or like persons on the ground that such country does not give reciprocal treatment.

#### **PART IV: RIGHT TO LEGAL PROTECTION**

11.

(1) Subject to the provisions of section 13 a designer or his successor shall have the right to ask for legal protection.

(2) If two persons jointly create an industrial design, the right of legal protection shall vest in them or in their successors jointly. But if a person has merely assisted in the creation of an industrial design and has made no contribution of a creative nature he shall not be deemed to be a co-designer.

(3) Any person, who is first to file an application for registration of an industrial design, or the first person to claim a right to an industrial design in a foreign country shall, subject to the provisions of sections 12 and 13, be deemed to be the designer or his successor.

12.

(1) If the essential elements of an industrial design, the subject of an application, have been obtained from a design of another person without the consent of that person on the filing of such application, the rightful owner may request that the registration or the application be transferred to his name.

(2) The original designer of an industrial design, may give his consent subsequent to the filing of an application, and shall be deemed to have given it on the date of the filing of the application.

13.

(1) Subject to the provisions of this Act, in private contracts providing for the making of a specific design and in the absence of a provision to the contrary, the ownership of an industrial design made in execution of such a contract shall be the property of the person who was asked to do it or the property of his employer.

(2) The preceding provisions shall apply if the contract of service does not require creative work from the employee.

(3) In the case provided for in sub- section (2) an employee designer shall have the right to a payment, taking into consideration, his salary and the importance of his industrial design. Such payment shall, in absence of agreement between the parties, be fixed by the Court.

14.

(1) The designer of an industrial design shall have the right to have his name stated in the registration as such.

(2) There shall be no agreement contrary to the immediately preceding provisions.

## **PART V: PROCEDURE FOR REGISTRATION**

15.

(1) An application for registration of an industrial design shall be addressed to the Industrial Designs Office and shall contain the following:-

(a) an application for registration of the industrial design;

(b) the name and address of the applicant in full, and if the applicant's address is outside the Sudan, he shall state his fixed address;

(c) a specimen of the material of which the industrial design is made or a photographic picture or sketch drawing of the industrial design in color, if possible, or an architectural model or any other means of production which is shown by such representation;

(d) an indication of the method of production of the industrial design, and if the rules provide for classification an indication of the class or classes to which it belongs.

(2) If the actual designer of the industrial design wishes to have his name stated in the registered particulars he shall be required to attach a certificate bearing his name, address and signature.

(3) If the application is filed through an agent, it shall be accompanied by a power of attorney, signed by the applicant. Ratification or certification of a signature shall not be necessary.

(4) The application may contain from 1 to 50 industrial designs if the relevant products are of the same kind or kinds, or, if there are rules providing for classification, they are of the same class or classes.

(5) The rules shall stipulate the details and particulars which shall be contained in an application for registration of an industrial design.

16. The application for registration of an industrial design who wishes to benefit from priority of an earlier application filed in another country shall be required to attach to his application a written statement indicating the date and number of the earlier application, the country in which it was filed and the name of the applicant, and he shall forward, a period of three months from the date of the later application, a copy of the earlier application certified as being correct by the responsible authority in the country where such application was filed.

17. An application for registration of an industrial design, shall not be accepted except after payment of such fees as may be prescribed in accordance with the rules.

18.

(1) The Industrial Designs Office shall examine the application so as to make sure that it confirms with section 7 (2), 15, 16 and 17.

(2) If the provisions of sections 7 (2), 15 and 17 are not complied with, the Industrial Designs Office shall refuse to register the industrial design, provided that priority may not be questioned.

19.

(1) When the examination provided for in section 18 shows that the application has satisfied the requirements of sections 7 (2), 15 and

17, then the industrial design shall be registered in accordance with the application, and without further examination and in particular without examination as to whether or not the registration contravenes section 7 (1).

(2) If the examination provided for in section 18 shows that the requirements of section 16 have been complied with, the Industrial Designs Office shall record the priority claimed for the registration.

20.

(1) The Industrial Designs Office shall establish a registry for industrial designs, which shall be recorded in chronological order. All the details of every design, required by this Act to be

registered, shall be recorded therein.

(2) Subject to the provisions of section 22 relating to wax-sealed applications, the industrial designs register shall contain a true copy of the industrial design in which the registration number, the name, and address of the registered owner are shown. If his address is abroad it shall contain his fixed address together with the date of both the application and the registration. If there is any claim for priority it shall be noted together with the number, the date of the claim, the country where the claim was presented and the basis for the claim for priority and reference to the different stages of production according to the provisions of section 15 (1) (d) and finally the name and address of the true designer if his name is required for registration.

(3) The office shall issue a certificate of registration of the industrial design and send it by registered mail to the address of the registered owner and if his address is abroad, to his fixed address.

(4) The office shall record any change in the address, or in the fixed address, and the owner of the registered industrial design shall notify the office of this change.

(5) If there is no provision to the contrary in this Act, correspondence issued in accordance with this Act shall be addressed and sent to the latest recorded address of the registered owner of the industrial design and at the same time to the latest registered fixed address.

21.

(1) The office shall publish registered industrial designs in the order of their registration showing all the details mentioned in section 20 (2) provided that the publication shall be in the form and within the period provided for in the rules.

(2) It shall be possible to make a search, free of charge, against all industrial designs and all the recorded dealings in relation thereto in the Industrial Designs Office. Any person may have a copy of a design on payment of the prescribed fees and the cost incurred in making copies.

22.

(1) An application for registration may require that his lodged industrial design be kept secret for a period not exceeding 12 months from the date of application. In such case the industrial design shall be forwarded in an envelope sealed with red wax.

2) Registration and publication provided for in section 21 shall not contain a copy of the industrial design, but after the opening of the sealed envelope the registration shall be completed by forwarding a copy of the industrial design referred to in section 20 (2) and this copy shall be published with reference to the previous application.

(3) In every case, after the expiry of 12 months, the sealed envelope shall be opened automatically, and the applicant or his successor may, at any time, require the transfer of his application from a sealed application to an open application and the sealed envelope may also be opened if a Court so requires, provided that it shall be resealed with wax.

(4) An industrial design shall not be protected as provided for in this Act before the opening of the sealed envelope.

(5) Details of the aforementioned procedures shall be determined by the rules.

#### **PART VI: TERM AND RENEWAL OF REGISTRATION OF AN INDUSTRIAL DESIGN**

23. If the term does not earlier expire in accordance with sections 35 to 37, the registration of an industrial design shall be valid for 5 years from the date of application.

24.

(1) Registration of an industrial design may be renewed for two successive five year periods after payment of the renewal fees provided in the rules.

2) Renewal fees shall be paid within 12 months preceding the period of termination of registration, nevertheless a period of six months shall be allowed to pay any additional fees after the lapse of the legal period, provided that any additional fees determined by the rules shall be paid.

(3) The Industrial Designs Office shall record renewal decisions and shall publish them in such form as may be prescribed and within the period specified by the rules.

#### **PART VII: RIGHTS CONFERRED BY REGISTRATION OF INDUSTRIAL DESIGNS**

25.

Registration of an industrial design shall give the registered owner the right to prevent others from doing the following:

(a) using the industrial design in manufacturing a commodity;

(b) importing a commodity produced in accordance with the design or exhibiting it for sale or selling or utilizing it or reproducing it after protection is acquired;

(c) keeping that commodity with the intention of exhibiting it for sale, selling or utilizing it.

2) The dealings mentioned in sub-section (1) shall not be lawful merely because they accentuate minor differences in the protected industrial design or because they relate to products other than by productions of the industrial design previously mentioned.

26.

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

(2) The rights conferred by registration of an industrial design shall not extend to protection of a commodity by using the protected industrial design if the products have been lawfully sold in the Sudan.

#### **PART VIII: ASSIGNMENT AND TRANSFER OF APPLICATIONS AND REGISTRATION OF JOINT PROPERTY RIGHTS CONFERRED BY REGISTRATION**

27.

- (1) Application for registration of industrial design may be assigned or transferred by inheritance.
- (2) Transfer of applications and registrations shall be in writing and signed by the contracting parties.
- (3) Assignment for transfer of registered industrial designs by inheritance shall be recorded in the Industrial Designs Office after payment of the fees prescribed by the rules, and assignment and transfer of applications shall be registered previously after payment of the fees. After registration of an industrial design it shall be registered in the name of the assignee or beneficiary.
- (4) The assignment or transfer shall not be effective against third parties unless recorded in the register.

28. In the absence of any agreement to the contrary between the contracting parties, any or the owners participating in a registered industrial design may assign his share or benefit in the industrial design and exercise the rights conferred by section 25, provided that there shall be no license to third parties to utilize the industrial design without their unanimous consent.

#### **PART IX: LICENSES**

29.

- (1) The owner of an industrial design may grant by contract or by undertaking to another person a license to utilize an industrial design.
- (2) The license shall be in writing and signed by the contracting parties.
- (3) The license or an appropriate summary thereof shall be registered in the Industrial Designs Office after payment of the fees stipulated by the rules. The license shall not be effective against third parties unless registered.
- (4) Registration of a license shall be cancelled on the application of the registered owner of the industrial design after proving the expiry of the license.

30.

- (1) The conditions set out in a license or connected thereto shall be void if they impose on the license in the industrial or commercial field restrictions not derived from the rights granted by registration of the industrial design or not necessary for the protection of those rights.
- (2) The following special cases are not regarded as restrictions:-
  - (a) restrictions concerning the extent of the use of an industrial design or its scope or the term or method or amount of production for which an industrial design may be used;
  - (b) obligation of a license not to do anything which may affect the legality of the registration of an

industrial design.

31.

(1) Unless otherwise provided in a license, a licensor may grant additional licenses to other persons to use an industrial design. He may also use it himself.

2) If a license is absolute, the licensor shall not grant licenses to other persons to use the same industrial design or use it himself unless there is an express provision to that effect.

32. Unless otherwise provided in the license a licensee shall have the right to do all the things referred to in section 25 during the period of registration and the renewal of registration inside the Sudan, and anything related to applications in respect of the industrial design.

33.

(1) Unless otherwise provided in the license, the license shall not be transferable to third parties, and the licensee shall not have a right to grant sub-licenses.

(2) If the licensee is entitled by contract to transfer his license or to grant sub-licenses, sections 29 to 32 together with section 34 shall be applicable.

34. Without prejudice to the provisions of the Finance (Exchange Control Regulations) 1966, no license or amendment thereof may be lawfully renewed if that involves payment of fees abroad, unless the license, amendment or renewal is approved by the Minister and provided that the needs of the country and its economic development shall be considered.

#### **PART X: RENUNCIATION AND NULLITY**

35.

(1) The registered owner of an industrial design renounces his registration by a written submission addressed to the Industrial Designs Office.

(2) Renunciation may be limited to one manner of production or if the rules provide for classification for one variety or production, or if the application contains a number of industrial designs, the renunciation may be limited to a part of such industrial designs.

(3) Renunciation shall be registered and published immediately by the Industrial Designs Office and shall not be valid unless registered.

(4) If the Industrial Designs Office registers a license of an industrial design, the renunciation of such license shall not be registered except after the submission of a statement by the licensee accepting renunciation, unless the licensee expressly waives such right in the license.

36.

(1) The Court shall on the application of any person having a legal interest or any competent authority and after giving the registered owner an opportunity to make submissions declare a registration void if it was not made in accordance with section 6 (2) or if it did not comply with the conditions in sections 6 (1) and 7, the Court with regard to section 7 (2), shall not take into consideration any reasons not existing at the time of issuing the decision of nullity.

(2) In the case of an application, which includes many industrial designs and where the reasons for avoidance of registration relate to some of them only, the registration shall be declared void in relation only to them.

37. (1) Whenever a registration is finally declared wholly or partially void, the registration shall be deemed, within the limits of the declaration void with effect from the date of such registration.

(2) Provided that if there were licenses granted the Court may decide that avoidance of registration does not necessitate the refund of money paid by a licensee.

(3) Whenever a declaration of avoidance is final, the registrar of the Court shall notify the Industrial Designs Office and that office shall record it in the register and publish it as soon as possible.

#### **PART XI: INFRINGEMENT OF RIGHTS CONFERRED BY REGISTRATION OF INDUSTRIAL DESIGNS**

38.

(1) The registered owner of an industrial design whose rights conferred on him by section 26 are threatened with infringement or are infringed may take legal proceedings necessary to prevent such infringement or stop its continuation.

(2) In the case of infringement of the aforesaid rights, the registered owner of the industrial design may apply for damages or any other civil remedy. <sup>2</sup>

39.

(1) Any intentional infringement of the rights of a registered owner of an industrial design under section 25 shall be deemed an offence.

(2) Such an offence shall be punishable with imprisonment for a term not exceeding six months or with a fine of Ls. 1,000 or with both; provided that the maximum penalty shall be doubled if the offender has been convicted of a similar offence within 5 years preceding this offence.

40.

(1) Any license may require the registered owner of an industrial design by registered letter to take legal action for civil or penal remedies for infringement of rights conferred by section 25 on the registered owner.

(2) Unless otherwise provided for in the license a registered licensee, may if the registered owner refuses or neglects to take the requisite legal action within three months from such request, either

claim damages from the registered owner if it is proved to the Court that the rights conferred by section 25 have been infringed or after warning the registered owner, take such action on his behalf and without prejudice to the rights of the registered owner to intervene in those proceedings. The licensee shall be responsible to the registered owner to intervene in those proceedings. The licensee shall be responsible to the registered owner for any damage that may be incurred by him as a consequence of the unauthorized action of the license.

41.

(1) The Courts shall have jurisdiction to hear disputes arising out of the application of this Act, and in particular appeals against the decisions of the Industrial Designs Office, the right to legal protection, the determination of payment to designer employees, licenses and the avoidance of registrations and the infringement of rights in industrial designs.

(2) The competent Court shall be the Court of the domicile of the defendant but if he resides abroad the competent Court shall be the Court in the Jurisdiction of which the Industrial Designs Office is situate.

(3) Decisions of the Court shall be subject to appeal and cassation according to the Civil Procedure Act, 1974.

42. In case of the commission of an offence under this Act by any corporate body, any person who is a manager, general manager, or secretary or like official is a corporate body or is acting as such at the time of the commission of the offence, shall be deemed to commit it unless proved that the commission of the offence was without his consent or connivance and that he had taken the necessary measures to prevent it taking into consideration the nature of his work and the surrounding circumstances.

43. The Ministry may make rules for the implementation of the provisions of this Act, and without prejudice to the generality of this power those rules may provide for the matters referred to in section 4, 15, 17, 21 (1), 22 (5), 27 (3), and 29 (3).