

CHAPTER 9
OWNERSHIP
(OF AN UNREGISTERED DESIGN)

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INTRODUCTION

- 9.1 Sections 19 and 20 of the Designs Act tells who can be the owner of an unregistered design. Only the owner of the unregistered design is entitled to apply for the registration of that design. This ownership is established by a statement in support. This statement of support is also referred to as the devolution of title and the Form I part II or part III. In this section it is called "the statement".

WHO IS THE AUTHOR?

- 9.2 The author is the natural person who conceives the design and then reduces it to its visible form. This form would be a drawing, a model or the actual design. The author could also be referred to as the designer of the design. The author can be one or more natural persons.

WHO IS THE OWNER?

- 9.3 The owner is the actual person applying for design registration. Subsection 20(1) provides that the owner of the design is entitled to make application for the registration of the design. Also, if there are joint authors they may apply to register the design (see subsection 20(2)). Before the application reaches registration the owner is referred to as the applicant.

WHO CAN BE AN OWNER?

- 9.4 There are four ways in which an applicant can be entitled to apply for a design registration. They are referred to under s19 of the Designs Act. Briefly, the four ways are:
- a) the author of the design is the owner
 - b) an agreement for valuable consideration between the author and the owner
 - c) the author made the design whilst employed by the owner
 - d) by way of assignment from the author to the owner

Further detail and explanation of the above four is given below.

These are the only four ways that an owner is entitled to apply for a design. If none of the above four have been established then the owner is not entitled to apply.

THE AUTHOR OF THE DESIGN IS THE OWNER

- 9.5 This is the basic rule. Unless otherwise stated, the author of the design is the owner.

AGREEMENT FOR VALUABLE CONSIDERATION

- 9.6 If a person or his/her employee make a design for the another person under a agreement for valuable consideration then the other person is entitled to apply.

EMPLOYEE

- 9.7 When a person makes a design in the course of his/her employment with an employer, his/her employer is the owner of the design.

ASSIGNMENT

- 9.8 This is the case where the author or owner of the design can assign (sell) all or part of their interest in the design. This assignment has to be done in writing and signed by either the assignor or on his behalf and the assignee.

STATEMENT IN SUPPORT

- 9.9 The ownership of a design is established by the statement of support. The requirements are listed below:
- i) The statement has to be made by an individual or individuals. It can not be made by a company, firm, corporation, business etc. This individual can be either the owner, if the owner is an individual, or someone authorised by the owner to make the statement.
 - ii) The first part of the statement actually refers to the declarant being either the applicant or authorised by the applicant to make the statement. One of these has to be chosen correctly.
 - iii) The next part of the statement states who is the author of the design. This may be one or more individuals.
 - iv) After the name of the author(s) the facts upon which the owner is entitled to make the application have to be given (these facts are not necessary if the applicant is the author). These facts have to refer to or clearly imply one of the four parts referred to in s19. This reference or implication to s19 has to be clear and unambiguous.
 - v) The statement has to be dated and then signed by the declarant(s). The signature has to be original and not a copy.

SUMMARY

- 9.11 The above is all that is required in the statement. If the above is all complied with, the statement is acceptable. If however any of the above are not adhered to, a fresh statement will have to be forwarded by the owner or agent. Unlike the application form, the statement cannot be amended.

MULTIPLE DEVOLUTION

- 9.12 It is possible to have more than one step between the author(s) and the owner. An example would be "Party A" contracted the author(s) to make the design and "Party A" then assigned the design to the owners. This is a two step devolution. There is no limit to the number or type of steps. The only requirement is that one of the four requirements of s19 is met for each individual step.

DESIGN TEAMS

- 9.13 It is possible that the author(s) of the design is not clearly identifiable. This may be the case in a large company (a good example is Lego) where many sections might be involved in making a design or a contracted/assigned company with similar circumstance.

In this instance reference to the relevant part of s19 would be sufficient. It is not a desirable practice but is unavoidable in some circumstances. When no authors are given the owner or agent should be queried as to why no authors have been given. If the reasons given sound reasonable the above would apply. Examples of how the authors would be given would be "employees of Party A", "designs team of Party A" etc.

NO STATEMENT LODGED

- 9.14 A statement is not required at lodgement. Often the statement is not lodged before examination. In this instance the examiner will have to simply request that it be lodged. Once it is received it will have to be examined as normal.

PROOF

- 9.15 The owner is not required to lodge proof such as deeds of assignment, being authorized, contracts etc. It is assumed that what is said in the statement in support is true.