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# Protecting Your Design Overseas

## Introduction

This is a brief guide to some of the issues involved in applying for design protection in a foreign country.

## General Considerations

Before you apply for design protection in a foreign country, you should consider the following:

- While design registration systems are broadly the same from country to country, the laws and procedures of foreign industrial property offices can differ greatly;
- If the industrial property office of a foreign country does not use English as an official language, you may have to translate all documents and correspondence into an official language used by that office. This can be a major expense;
- In some countries, you have to use the services of a patent agent if you are not a resident of that country. In others you may be able to arrange for a friend or business contact to forward correspondence to you in Australia;
- The fees for obtaining and maintaining a registered design vary from country to country; and

- Certain countries, such as the USA and the Philippines, will only accept applications made in the designer's name.

## Applying for a Design Overseas

You can apply for a design in a foreign country by following one of two strategies. They are:

- (i) make a new application in each foreign country as if you were making an application for your design for the first time – i.e. a normal national application application,
- (ii) make a new application in each foreign country within six months of your Australian application, and specify that you are claiming the date on which you lodged your Australian application as the priority date of your application – i.e. a national Convention application.

## National Applications

In very broad terms, to apply for a design in a foreign country you will need to prepare representations of the design and complete some forms, all in the style required by the foreign country. You would file the application in the industrial property office of the foreign country, using the services of a patent agent in that country if desired or requested.



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## Convention Applications

Australia belongs to the International Convention for the Protection of Industrial Property, the Paris Convention. There are some 100 member countries of this treaty, including all major industrial countries.

The treaty has the following effect. If you file an application for a design in Australia (called the basic application application), and within a period of six months you file an application in a country that is a party to the treaty, the foreign application is entitled to have the date you filed your Australian application as its priority date. Such an application is a Convention application, and it claims 'Convention priority' from the basic application.

A Convention application has several advantages. The main one is that you have a period of up to six months to decide whether or not you want to apply in a foreign country. During this time you keep the date of filing of your Australian application as the priority date. As a result, any public disclosure during those six months of what you have disclosed in your Australian application will not affect the newness of your foreign application.

If you lodge your foreign application more than six months after your Australian application, you can not have the date of filing of your Australian application as the priority date. In this event any disclosure of your design before you file your foreign application could affect the newness of that application.

You make a Convention application in a foreign country in the same way as a national application in that country. But in addition, you will need to supply a certified

copy of your original Australian application, the 'basic document'. Also if English is not an official language used by the industrial property office of the country, you may need to supply a translation of the basic documentation into an official language used by that office.

You can obtain certified copies of your Australian application by writing to the Registrar of Designs. The postal address is PO Box 200 Woden ACT 2606. The fee for each certified copy is \$100.

The Designs Office of IP Australia does not provide application forms, receive applications, or receive fees, for or on behalf of industrial property offices in other countries. It does not give advice or assistance on prosecuting applications in foreign countries. You will need to ask the foreign industrial property offices to send you details of their requirements for registering designs in their country.

If you are considering applying for a design overseas, you should also consider seeking the professional advice of a registered patent attorney. The Yellow Pages Directory list names and contact details of patent attorneys.

More information on making international applications can be found on the IP Australia website at the following link  
[http://www.ipaustralia.gov.au/designs/international\\_index.shtml](http://www.ipaustralia.gov.au/designs/international_index.shtml).

A list of worldwide intellectual property offices, and links to their web sites can also be found on the IP Australia website at the following link:  
[http://www.ipaustralia.gov.au/resources/international\\_index.shtml](http://www.ipaustralia.gov.au/resources/international_index.shtml).



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**Disclaimer:**

This information is intended to help the reader gain a basic understanding of some IP principles. It is not designed to provide legal, business or other relevant professional advice. IP Australia recommends that you seek independent legal, business or other relevant specialist advice.

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