



Australian Government

IP Australia

# Protect your creative

## A guide to Intellectual Property for Australia's Graphic Designers

Including multimedia, photography,  
advertising, animation, illustration,  
copywriting and paper merchandising

PATENTS

TRADE MARKS

DESIGNS

PLANT BREEDER'S RIGHTS

Robust intellectual property rights delivered efficiently

P

TM

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PBR

## DISCLAIMER

This information guide is designed to help you understand intellectual property issues. You should not regard this publication as an authoritative statement on the relevant laws and procedures. You should also note that the requirements and fees may change from time to time. While we make every effort to ensure the information presented is accurate, you should check the IP Australia website before making an application. While we can't give you advice about your particular circumstances, we can provide general information and answer questions about our processes and fees. IP related advice is best sought from a registered patent or trade marks attorney or an experienced IP professional. © 2008 State Government of Victoria.

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## FOREWORD

### MAKE YOUR DESIGN SKILLS BUSINESS READY

Design is a capability that transforms products and services to improve their functionality, efficiency and style. It is a fundamental building block of innovation, a critical enabler of competitive industries and vital to building liveable, sustainable and cohesive communities.

Of the estimated 76,350 people working in design roles in Victoria, the visual communication discipline is the largest group by sector and consultancy/in-house.

Design Victoria is pleased to partner with IP Australia and AGDA to produce the Design Victoria How To Kit, “A Guide to Intellectual Property for Australia’s Graphic Design Industry”.

Design Victoria’s Business Ready program empowers designers with the skills and knowledge to grow their business and build their competitiveness to better engage with local and international industries. Through this free practical guide, graphic designers are provided with valuable information to assist in understanding intellectual property issues.

I would like to thank and acknowledge this publication’s Working Group, lead by Kara Macleod and IP Australia, for their valuable contribution. The group’s diverse and collective expertise and knowledge has contributed to this informative publication – a practical and relevant resource for graphic designers to protect their creative output.

Michele Azzopardi  
General Manager, Design Victoria

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## DESIGN

Studio Round

## ABOUT DESIGN VICTORIA

Design Victoria is a \$15 million Victorian Government initiative to drive design excellence, create a more globally competitive design sector and encourage the designed growth of Victorian industries.

Design Victoria collaborates with major industry associations and bodies representing business, manufacturing and design sectors to deliver tailored seminars and workshops to increase industry's competitiveness, innovation and export performance.

For more information, visit [www.designvic.com](http://www.designvic.com)

## ABOUT IP AUSTRALIA

IP Australia is the Australian Government agency responsible for administering patent, design, trade mark and plant breeder's rights. By granting these rights, and contributing to the improvement of Australian and international IP systems, IP Australia is supporting Australia's economic development.

For more information, visit [www.ipaustralia.gov.au](http://www.ipaustralia.gov.au)

## ABOUT AGDA

The Australian Graphic Design Association (AGDA) is the national organisation for professional graphic designers. It facilitates the advancement of the graphic design profession in Australia and aims to establish fair and productive working relationships between graphic designers and their clients. AGDA also works to increase awareness of the value and importance of graphic design in business, education and culture.

For more information visit [www.agda.com.au](http://www.agda.com.au)



# What is IP to me?

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**“The biggest component of a graphic designer’s job is to create intellectual property. It would be a waste for them not to find out how to protect it.””**

Australian Graphic Design Association, AGDA



## WHAT IS IP TO ME?

Working in the visual communications field? Then you need to understand how to protect the products of your intellect and the creative ideas you produce as part of your work.

Graphic designers, including those in multimedia, photography, advertising, animation, illustration, copywriting and paper merchandising, are at the cutting edge of Australia's creative industries.

The ARC Centre of Excellence in Creative Industries and Innovation estimated that in 2006, over half a million Australians were employed in the creative industries, a sector that also generated nearly \$28 billion in annual earnings in the same year.

The mind power that goes into all that creativity and design generates not only a lot of great ideas, but also a lot of intellectual property (IP), the product of your mind.

Designers are regularly generating new IP, sometimes on a daily basis, but perhaps don't know it. As a designer or visual communicator, your IP could include a company logo you have developed, a photograph you took, an illustration you created for a book, or a website you designed. Each of these creations has value, which is why you should consider IP protection.

## GET IP SAVVY

Being IP savvy means being able to recognise IP as a valuable business asset, just as you would your computer and office space. Just like you protect your physical assets and property with alarms, locks and other security measures, you invest time and money into your creativity, so you should take the protection of your creative output just as seriously.

This guide will help you understand the different types of IP protection available to you, and help you identify the ones that will work best for your circumstances.

## IP AT A GLANCE



### WHAT IS PROTECTED

*Dance songs, art, literature, music, film, broadcasts, computer programs*

### TYPE OF IP PROTECTION

Copyright

### WHAT IT MEANS

The owner's original expression of ideas is protected, but not the ideas themselves

*Logos, words letters, numbers, colours, a phrase, sound, scent, shape, picture, aspect of packaging or any combination of these*

Trade marks

A trade mark identifies the particular goods or services of a trader as distinct from those of other traders

*Product design*

Design registration

The visual appearance of a product is protected, but not the way it works

*Inventions and new processes*

Patents

A patent protects how an invention works or functions

*Trade secrets and confidential information*

Other

These types of IP rights give creators certain rights and privileges depending on the type of IP protection







# Copyright

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**Copyright protection lasts throughout the life of the author or creator, plus an extra 70 years from the author or creator's death.**

## UNDERSTANDING THE SYMBOL

The Australian Copyright Council says it's not necessary, but it is a good idea, to put the copyright notice on your work. The copyright notice is the symbol © followed by the name of the copyright owner and the year the work was created or first published. For example, © John Smith 2008.



# Copyright

Copyright is relevant to visual communicators because it can provide protection for websites, photographs, graphics and illustrations along with a host of other creative outputs. It also covers the typographical arrangements of published editions, as well as the literary works they contain. For example, the design layout of this publication is covered by copyright, as is the text you are now reading.

Copyright is free and automatically safeguards your original work from the moment you create your graphic design.

Remember, it is **not the concept or the idea in the work**, but its expression that is protected by copyright law. **Copyright does not protect your ideas, or the information, styles or techniques**, used in creating the work.

The Australian Copyright Council advises that if you own copyright in a creative work generally only you, and those who have your permission, are allowed to:

- reproduce the work (for example, by photographing, photocopying, copying by hand, filming, scanning into digital form or printing from a digital file)
- publish the work for the first time (for example, by making copies available for sale)
- communicate the work to the public (for example, by putting it on the internet or an intranet site, emailing or faxing it, or broadcasting it).

## MYTH: YOU ARE ALLOWED TO COPY UP TO 10 PER CENT OF A WORK

There is a 10 per cent rule that applies in relation to fair dealing, which allows copying for the purposes of research or reporting the news. However, you can't reproduce any percentage of someone's work for commercial purposes without their permission.

## MYTH: FONTS ARE FREE

If you are supplying a font to a client, you need to be aware of the copyright licence. The Font Shop, for example, is an online company that sells customised fonts to graphic designers under a limited licence.

Your client should pay this fee. This means you can only use the font for the client who has paid for the licence. If you need to use the font for another client you will need to purchase it again.



## So who owns what?

Think twice before you borrow or use other people's creative as part of your work, even if it's just for an initial creative concept. The Council also advises that scanning an image to produce a digitised version, or producing a new image by altering a digitised image, can be a breach of copyright.

Generally, if you create an artistic work, like a logo design, photograph or website, you're the copyright owner. There are some exceptions however. According to the Council, if you're an employee and create the work as part of your job, generally your employer will own the copyright.

The exception to this rule is if you work as a freelancer or volunteer. If you are working for a client, the copyright ownership will be according to the agreement with the client.

If you create work for the Australian Government, or for a state or territory government, or if a government is the first publisher of your work, they will generally be the copyright owner.



### WANT TO COPYRIGHT YOUR WORK?

#### CHECKLIST

- ✓ You don't need to go through a formal copyright registration process—it is automatic and free in Australia.
- ✓ Producing a logo, website, photograph or other artistic creation? It is a good idea to include the copyright notice and symbol on your artwork.
- ✓ Preparing a design concept or preliminary creative? Think twice before borrowing or using other people's creative to express your ideas, even if it's just temporary.
- ✓ Want further protection? Keep reading for information on other forms of IP protection that might suit your requirements.

## Infringement

If your work has been reproduced, communicated or published without your permission, your copyright may have been infringed. You'll need to get advice from a lawyer about the steps you need to take to enforce your copyright, as it can be costly if you need to go to court to defend it. Visit [www.copyright.org.au](http://www.copyright.org.au) for more information.

## International copyright

Most countries grant copyright protection to Australian material as a result of international treaties. Some countries have copyright registration systems. In most cases, registration is not necessary for protection, but can provide advantages if your work is distributed in that country.

For example, in the United States there is a registration process available through the Copyright Office of the Library of Congress. For more information about international copyright, visit [www.copyright.org.au](http://www.copyright.org.au).

## A COMPETITIVE PITCH

A design firm found itself in a competitive pitch for corporate identity work.

When they finally got a chance to present their ideas, the client's marketing manager cooed over the "wonderful approach" taken with the proposed identity, so the partners of the design firm started to feel very confident about their chances. It came as a huge shock to them when they were told that they had lost the pitch to the incumbent designer. Worse still, they were outraged to find out that the designer had adopted many of their innovations in her work.

Their lawyer advised them that the unauthorised use of their ideas was a breach of their copyright, and, after a few stern letters, the incumbent designer agreed not to copy.



# Trade marks

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A trade mark can be a logo, picture, word, phrase, letter, number, sound, scent, shape, an aspect of packaging or a combination of these.

Trade marks are used to distinguish the goods and services of one trader from those of another. For example, Australian brand Lonely Planet® has built its reputation over 30 years as a producer of well-researched and current travel guides. The Lonely Planet® logo is what distinguishes it from other travel guides, such as Rough Guides™ and Eyewitness™. Without trade mark protection, Lonely Planet® would be at risk of others trading under its name or using its logo, compromising its reputation.

Shapes, sounds and even smells can also be trade marks. The distinctive triangular peaks of the famous Swiss chocolate Toblerone® is a registered shape trade mark and the well-known Nokia® mobile phone ringtone is a registered sound mark in Australia. IP Australia has also received an application for a scent trade mark for the smell of beer on dart flights (the feathers on the end of darts).

As a graphic designer you may be asked to develop a logo for a company.



Australian graphic designer Ken Cato has designed some well-known registered Australian trade marks, including the yellow and black Commonwealth Bank logo, which symbolises the Southern Cross, and the SBS logo, which symbolises opening up the globe.

## Why register a trade mark?

A trade mark is an integral part of the marketing strategy for any business. The public identifies a certain quality, reputation and image with goods and services bearing a trade mark.

Essentially everything a business does can affect the way consumers view their trade mark. Thus, the more successful a business is, the more valuable the trade mark becomes.

You don't have to register a trade mark to use it (this is known as an unregistered trade mark). The symbol ™ can be used with a trade mark at any time and indicates you are claiming that word or logo as a trade mark. However, without a registered trade mark it's harder to stop others from copying or imitating your IP.

The symbol ® is used to indicate a registered trade mark. The benefits of registration are that it's much easier to protect and defend yourself against infringement—that is, someone else using your trade mark without your permission. To pursue infringement action of an unregistered trade mark, you will have to rely on common law, which can be time-consuming, expensive and stressful. To register a trade mark you need to submit an application to IP Australia. Visit [www.ipaustralia.gov.au](http://www.ipaustralia.gov.au) for more details.

## Getting ready to register

Before going through the process of registering a trade mark, you and your client should brainstorm a range of names or logos in case the preferred option is unavailable.

IP Australia has a service called TM Headstart to help you determine whether or not a proposed mark is suitable for registration. It's simple, easy to use, fast, and can help reduce costs in the long run. To find out more, visit [www.ipaustralia.gov.au](http://www.ipaustralia.gov.au)

When you apply you need to nominate the goods and/or services you want to register or trade mark for. Goods and services are divided into 45 classes. For instance, cars are in class 12, while beer is in class 32.

A plain English information kit about trade marks and the application process is also available. To download a copy, visit [www.ipaustralia.gov.au](http://www.ipaustralia.gov.au)

## Extent of your rights

A trade mark can live forever. A trade mark is initially registered for a period of 10 years and continues indefinitely as long as the renewal fees are paid every 10 years and the mark is used.



### TRADE MARK TIPS

Not all logos or names can be registered as a trade mark.

To increase chances of registration, a trade mark needs to be something that other traders don't need to use in the normal course of their trade.

Invented words like Kodak and names that don't have a direct correlation to the product, such as Apple for computers, are often more likely to be able to be registered.

It's also very difficult to register a geographic name or a common surname as a trade mark.

There may be an exception for an applicant who has used one extensively for a considerable time.



## Time for your trade mark to take a trip?

Thinking about launching a brand overseas? Maybe your graphic design company is working on international projects. Or perhaps you have a client who trades internationally.

Trade mark protection operates on a country by country basis so if you or your client have a registered trade mark in Australia, then protection is for Australia only.

Australians can access trade mark protection overseas through an international treaty called the Madrid Protocol.

The protocol has a number of advantages:

- only a single international application is required
- protection can be sought in one, some or all of the other member countries
- it is filed through the trade mark office of the home country
- it's in three languages—English, Spanish and French.

It is always wise to seek professional advice before embarking on overseas strategies as there can be a number of different processes.

### MYTH: YOUR BUSINESS OR COMPANY NAME GIVES YOU TRADE MARK PROTECTION

The difference between trade marks, business, company and domain names can be confusing. Registering a business, company or domain name doesn't in itself give you any proprietary rights—only a trade mark can give you that kind of protection. For example, a new Victorian graphic design business registered its company name (also its trading name) with the Australian Securities and Investments Commission believing this was sufficient protection for its brand.

After six months of operation, it received a “cease trading” letter from another company that used the same name and held a registered trade mark.

The Victorian company was forced to re-brand at the cost of over \$50,000 and faced demands of \$25,000 to cover legal costs of the other company.

It also risked losing a component of its client base, which would not recognise the new company and trading name.







## DESIGNING A LOGO OR SLOGAN?

### CHECKLIST

- ✓ Brainstorm a range of ideas to increase your chances of securing one that you want.
- ✓ Always search the trade marks database and check out other goods and services in the market to ensure you're not infringing on an existing mark.
- ✓ IP Australia can help. TM Headstart at [www.ipaustralia.gov.au](http://www.ipaustralia.gov.au) is easy to use and can save you time and money.
- ✓ If you have any doubts, get professional advice.

# Designs

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**What is a design?**

**In IP terminology a design refers to the overall appearance of a product**



## **MYTH: YOUR BUSINESS OR COMPANY NAME GIVES YOU TRADE MARK PROTECTION**

A design must be new and distinctive to be registered. This means it can't be the same or similar to designs already produced, even in a sketch.

To protect yourself, you or your client shouldn't publicly disclose your designs through exhibition or sales before either of you have considered design registration.

For more details on how to register a design, visit [www.ipaustralia.gov.au](http://www.ipaustralia.gov.au)



## Designs

A registered design protects the visual appearance of a product. The visual features that form the design include the shape, configuration, pattern and ornamentation. This is different from graphic design terminology, where design refers to anything that is visually communicated such as posters, brochures, websites, advertisements and visual identities. Product design incorporates the 'design' process as well as the finished product – the completed design.

The range of Apple Ipad® personal music players has an unmistakable look, shape and style that is recognised around the world. The Ipad® media device is a great example of how unique design can differentiate one product from a range of others.

As a registered design covers the overall appearance of a product and is usually 3D, it will only be relevant to graphic designers if they are involved in 3D packaging. For example, as a graphic designer, you may be commissioned to develop the 2D graphics for a limited edition Apple Ipad® media device. In this instance, Apple would be responsible for ensuring it was protected with a registered design.

## Make your idea an exclusive

Design registration gives a designer or the client exclusive IP rights to the visual appearance of the product, but not its feel, material or how it works (patents protect function). For example, a new and distinctive design of a desk could be registered, but not the workings of the height adjuster.

A registered design can be a valuable commercial asset as the owner:

- has the exclusive right to use the design
- has the exclusive right to authorise other people to use the design (normally through a licensing deal)
- has a registered design that is personal property and can grow in value and be sold
- has a registration that is valid throughout Australia
- can take action to stop other people using their design (after a certificate of examination has been issued).

This protection is initially granted for five years and can be renewed for a further five years.

## Don't publicly disclose designs before you or your client submit a design application with IP Australia



### CHECKLIST

- ✓ Consider registering your product to secure an exclusive IP right for its visual appearance.
- ✓ Want to get registered? IP Australia has a plain English application kit to introduce you to the process.  
Visit [www.ipaustralia.gov.au](http://www.ipaustralia.gov.au)
- ✓ Before you apply make sure your design is new and distinctive. Check existing design records at [www.ipaustralia.gov.au](http://www.ipaustralia.gov.au) or seek professional advice.

### 2D GRAPHICS

2D graphics are critical in giving particular products a distinctive impression in the market. For example, graphics applied to clothing, bed linen, wall paper, toilet paper, packaging and other products provide these products with distinguishing features. Depending on the end purpose of your graphic work, you may need to consider how best to protect your effort. The artist, Ken Done, has registered designs for a range of his graphics applied to products including garments, textiles, bed linen and watches.

# Your ideas to the market

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Your ideas to the market, Trevor Choy, Choy Lawyers, takes you on a journey through the creative process.

**“It is important that graphic designers can avoid the business pitfalls of inadvertently losing control over IP that they really need to keep and protect.”**

Trevor Choy, Choy Lawyers

YOUR  
IDEAS  
TO THE  
MARKET

## Stage 1 — pitching

Pitching for a new project is an exciting opportunity to showcase your skills, but there are two common risks:

- The client takes your idea without paying or hiring you
- You use someone else's images without permission.

The risks are the same regardless of whether the pitch is free or not.

### ARE YOU GOING TO SHOW THE CLIENT IDEAS?

Remember that anything you show them can end up being fair game. The client can take the ideas and give them to another design firm to develop. This happens more regularly than you think because Australian business culture doesn't seem to see this as wrong.

One way to stop this is to get an acknowledgement from the client that the ideas are confidential, neatly slotting you under the protective umbrella of the law of confidentiality.

Ideally, you would use a confidentiality contract, but often clients refuse to sign these because they look 'too legal'. Their lawyers will have warned them about signing contracts without getting them checked and the last thing you want to do is let a lawyer hold up the pitch.

The next best thing is to set up the pitch with confidential circumstances. When making the appointment, tell the client that you'll be showing them specially created ideas that are confidential. Ask for some kind of acknowledgement that the client understands this. An email response will do. Clients are less likely to object to this because it appears less formal. For example:

*We're really excited about next Tuesday's pitch, and we've come up with some great new ideas to show you. Of course, these ideas are confidential and we will own them until we do a deal with you. Please confirm by return email that you're happy with this.*

Then display a confidentiality note at the start of your presentation and repeat the warning verbally:

*All ideas are presented in confidence and are owned by Studio X.*

At the bottom of every presentation slide or example, clearly state copyright and confidentiality warnings.

This is not watertight, but it's better than nothing. If the client misbehaves and you find out that another designer uses your idea, your lawyer will have a comeback.

Some large corporate clients make designers sign pre-pitching contracts by saying, "you have to sign this so we can pay you the pitch fee". Clients sometimes see the pitch fee as their payment for your ideas.

Watch out – one of the common clauses says that any ideas you show during the pitch automatically becomes the client's property. You should either negotiate the removal of this clause or otherwise rework your pitch.

### **YOU ARE USING SOMEONE ELSE'S IMAGES WITHOUT PERMISSION**

You may have decided that you need to use someone else's images in your pitch to give the client a feel for what you will be creating for them.

Even though you may not have any intent to use the images in a campaign, you are still infringing the copyright of the original artist or photographer.

Of course, the only people who will know that you have copied someone's image, will be the people sitting around the table. So unless that includes the owner of the image or a friend, the chances of getting caught are small in reality. But why chance it at all?

Stock image libraries will often allow comps to be used without paying a licensing fee. This makes usage 100 per cent legal.

Many pre-pitching contracts contain a clause in which designers guarantee that they will not infringe copyright in preparing pitches. By sticking to legal images you will avoid breaching these contracts.

### **AGDA IS UNEQUIVOCALLY OPPOSED TO COMPETITIVE FREE PITCHING**

AGDA sees this as “unfair manipulation of designers with the aim of garnering unpaid work”.

It has developed a code of ethics, which is a powerful tool in arguing against competitive free pitching, as it serves to enhance client's understanding of graphic design.

For more information see [www.agda.com.au](http://www.agda.com.au).



## Stage 2 — concepts

### OWNER SHIP OF ALL OPTIONS

There is always the risk that the client will expect to own all options. It must be spelled out that they don't own every proposed design, only the one finally selected for further development. The rejected designs remain yours. After all, they are of no use to the client once rejected.

One way to do this is to explain at concept stage that you will use material that you do not own, but are licensed to use. Explain that this is just to give the client a feel for the outcome without spending their money buying copyright to images that they may never need.

It's very common in client-drafted contracts or purchase order terms to find a clause where you give clients ownership of all options. Watch out!

### RISK ARE AS WHEN DOING CORPORATE IDENTITY WORK

There are two main areas of risk here, which are:

- generating names
- creating logos.

In both instances there's the possibility of infringing upon someone else's trade mark rights. To avoid this you must do trade mark searches to find out if similar names or logos are registered.

Seek professional help or use IP Australia's TM database or TM Headstart service.

Don't give the client the impression you can do it all because you leave yourself open to a lawsuit. We don't suggest organising searches for the clients either. Give the client the details and tell them to do it themselves.

Note: many contracts contain a warranty clause that says you “warrant that your work will comply with all laws”, so if you don't include trade mark searching as part of your work, you are vulnerable.

### USING OTHER PEOPLE'S CREATIVE

There are risks involved when using other peoples creative. This includes using the work of previous designers and that of other creatives.

### PREVIOUS DESIGNERS

If the client asks you to work from another designer's material, whether it is a logo or anything else, and the designer still owns copyright, you and the client can be sued.

To use another designer's work legally, the client must have legal documentation proving that the original designer has transferred ownership to the client.



The document will normally contain the word ‘assignment’, and say words to the effect that ‘title in all copyright is assigned to [the client]’.

Don’t accept verbal assurances. Written assignments are compulsory under copyright law.

If in doubt, call the other designer to check. This may be uncomfortable but anything is better than being in the legal firing line. If you are unable to check, insist that the client gives you a guarantee that you are safe—what lawyers call an indemnity against loss. Request a lawyer to help you with this—you can’t afford loopholes.

**“Designers have a responsibility to protect themselves through contractual agreements.”**

Richard Henderson,  
CEO and Creative Director, R-Co



## ANY OTHER CREATIVES

Don't copy other people's work. It doesn't matter how much you change it, copying is unlawful. The myth that if you change it by more than 10 per cent, you'll be okay, is just that—a myth.

If you copy, the rightful owner can sue you and possibly your client too. Your client would likely demand that you pay their legal costs as well—that's two sets of expensive, specialised lawyers. If you lose, you can expect to pay the penalties imposed by the court as well as a big chunk of the owner's legal costs. It could be upwards of a few hundred thousand dollars.

You may be tempted to reference, imitate or parody a wellknown existing concept. The McDonald's golden arches, Coca-Cola's bottle shape and the blue Viagra pill are tempting targets for humour. Don't.

What all billion-dollar brands have in common are teams of lawyers and over-protective brand managers who have no sense of humour. They will fiercely defend their intellectual property (as they are worried about any negative effect on the billion dollar brand as a result of your humour). If they can sue you, they will. There are exceptions in copyright law for allowing certain parodies—for example in comedy and news reporting—but commercial use in advertising is frowned upon.

## MYTH: JUST BECAUSE THE CLIENT PAID FOR IT DOESN'T MEAN THEY OWN IT

Copyright ownership will remain with you as the creator, unless your agreement with your client states or implies otherwise.



## Stage 3 — Job Finished

### UNPROTECTED CLIENT BRAND — ADDING VALUE

If your client's brand is at risk of being copied, your work is at risk of being copied. If your client can't prevent copying, then its investment in your design services has benefited someone else and the client may see it as a waste of money.

It's a good idea for the client to protect itself and the best way to do this is to register a trade mark. Recommend to the client that it does so.

Don't do this yourself. The client will own the trade mark and it's best that they prepare and lodge the application. If they are struggling, IP Australia has a helpful service—TM Headstart—that you can refer them to for help.

Visit [www.ipaustralia.gov.au](http://www.ipaustralia.gov.au) for more information about TM Headstart.

### FOOD FOR THOUGHT

At the heart of creative endeavour is the search for a solution and the idea that will power it. The designer is equipped with intuition and an enquiring mind which thrives on the challenge of problem solving. Bringing the solution to life, in a way that communicates, differentiates, inspires and motivates within a business paradigm, is achieved through imagination and dedicated process. This work can be valued using a time and cost equation, but the essential 'creative idea' that underpins the entire solution is not that easy to measure.

Exploitation of creativity is endemic and will be ongoing. Designers have a responsibility to protect themselves through contractual agreements. Ideas and imagination do have value—but if creatives don't safeguard their talent and their uniqueness, who else will?

In my experience it is up to the designer to be clear about the business relationship and obtain expert advice to assist in making proposals understandable to the client, before the work commences. Richard Henderson, CEO and Creative Director, R-Co



## UNAUTHORISED FOLIO USE

Generally two laws apply to prevent unauthorised folio use:

- copyright
- misrepresentation.

Don't assume that you automatically have the right to put work into your folio. Copyright law says that the owner can control and prevent any unauthorised usage. If you have transferred copyright to the client, they can stop you from using it in your folio.

In most cases, the client's concern is whether or not the design is already in the public sphere. Naturally, the client doesn't want a new design to be shown to the market via your folio before it launches the design properly.

For this reason, get agreement as early as possible—when the client signs your estimate—that you can put work in your folio provided the client has already presented it to the public.

Another concern, especially for big companies, is whether you are telling the market that it endorses your services. Again, the best way to deal with this is to be upfront with your expectations.

Get permission.



# Enforcement

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An infringement is the unauthorised use of IP rights. To take action against an infringer is called enforcement.

## **ENFORCEMENT — STANDING UP FOR YOUR RIGHTS**

Although IP Australia processes and maintains databases of registered rights (designs, patents, trade marks and plant breeder's rights varieties), it is not responsible for enforcing rights—this is the task of the IP owner. The same applies for copyright (unregistered IP right).

## **AVOIDING INFRINGEMENT**

As the old adage goes, prevention is better than cure. Infringement can be costly, so it's best to take steps to avoid having to take action.

Before using or applying to register IP, search the databases at [www.ipaustralia.gov.au](http://www.ipaustralia.gov.au) first. Searching can help you understand the rights of others and to take steps to avoid infringing on those rights.

If you own IP, you can use appropriate marking or symbols (®, ™, ©, Pat Pending, Registered Des) to show your ownership. Using appropriate marking can be a useful warning to put others on notice.

## **MAINTAINING YOUR RIGHTS**

If you own registered IP, keep track of important dates (such as renewal) and ensure your details are kept up-to-date on all registers, both in Australia and in other countries where you have registered rights. IP professionals, such as registered patent and trade mark attorneys, offer services to help you track your IP portfolio.

Regular audits of your IP can help ensure your rights protect you for the goods and services that you manufacture or sell. This means identifying all the IP associated with your business, working out who owns the IP and compiling a list of registered and unregistered IP with a dollar value attached.

## ENFORCING YOUR RIGHTS

Your IP is important for business success and income. You need to know your rights and be prepared to act if they're infringed.

Before taking action there are some things you should consider, such as:

### Who is at fault?

More than one person can be liable for IP infringement. For example, you could sue a third party, a contractor, the directors of a company or the company itself.

### Could the tables turn?

If you make unsubstantiated claims about an infringement on your IP you can be sued. It's important to review all relevant documents to ensure you have the IP rights you say you have.

### Could litigation be bad for business?

Court proceedings are made public, unless covered by a confidentiality agreement, which means you may be airing your dirty laundry. It could also look bad to customers if you lose. You'll need to decide whether you see any publicity as good publicity.

There is a range of options available before court, such as a warning letter and negotiations. Above all, you should consider getting help from a professional before enforcing your rights. IP professionals can help you understand the costs and risks involved in infringement action, as well as advise on the best course of action.

## MYTH: IP Australia will police your IP rights

There is a common misconception that IP Australia will defend your IP rights if they are infringed. It is up to the IP owner to defend their IP rights through the legal system. IP Australia is simply the government agency that assigns rights.

## Always check you're not infringing on someone else's IP before you enter the market

### CHECKLIST

- ✓ Do you know what IP you have? Do an IP audit.
- ✓ How long since you registered your IP? Make sure you know when it's due for renewal.
- ✓ Have you altered your registered IP? Check that it's still protected.
- ✓ Has someone infringed on your IP? Get advice from an IP professional.



## CASE STUDY

A design firm was hired to create the packaging for an ice cream bar to be sold only in Australia.

“Only in Australia?” asked the designer in an email. “Yes, only in Australia. So please don’t charge us too much and we’ll definitely use you for future packaging work,” replied the client.

The product was very successful in Australia, and the client received offers from overseas distributors. The designer was delighted when he saw ads for the product on TV while he was on holiday in London.

In fact, the client had enjoyed so much success with the product that it was not manufacturing anything else, so the designer did not get any other jobs. Despite the international success, the client refused to pay the designer for overseas use.

Through a lawyer, the designer explained to the client that it had exceeded the terms of its licence, and use overseas without payment was copyright infringement.

Eventually the client agreed to pay the designer a considerable amount to settle the dispute.

The key here was that the designer had, at the very beginning:

- confirmed in writing that the packaging was just limited to Australia (the extent of the licence)
- confirmed in writing that fees reflected this.



# End to end checklist

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- ✓ **Do you know the different types of IP?**  
Copyright, design, trade mark, patent.
- ✓ **Have you identified who the owner of your IP is?**  
You, your employer or your client?
- ✓ **Have you visited IP Australia's website at [www.ipaustralia.gov.au](http://www.ipaustralia.gov.au)?**  
The website has easy to understand information about IP.
- ✓ **Are you the owner of registered IP?**  
You can register a design, trade mark or patent through IP Australia.
- ✓ **Have you made sure you're not infringing on other people's IP?**  
You can search existing IP through [www.ipaustralia.gov.au](http://www.ipaustralia.gov.au).
- ✓ **Have you put others on notice about your IP?**  
While it's not compulsory, using appropriate marking or symbols (®, ™, ©, Pat Pending, Registered Des) lets others know you take your IP seriously.
- ✓ **Have you sought advice from an IP professional?**  
They can help you understand what your IP rights are.
- ✓ **Have you checked the renewal dates for your registered IP?**  
If you miss your renewal payments, you lose your protection.
- ✓ **Have you conducted an IP audit?**  
An audit of your IP can help you find out if you have unregistered IP and keep track of registered IP.





## COST AND TERMS OF PROTECTION

TYPE OF IP PROTECTION	COST	TIME
<hr/> <i>Copyright</i>	Free	Copyright protection lasts throughout the life of the creator or author, plus an extra 70 years from the creator or author's death
<hr/> <i>Trade marks</i>	The minimum fee to commence an application is \$120. Entry to the TM Headstart service commences from \$90.	A trade mark is initially registered for a period of 10 years and continues indefinitely as long as the renewal fees are paid every 10 years
<hr/> <i>Design registration</i>	The minimum fee to start an application is \$200	A design can be registered for a maximum period of 10 years

\*Fees correct at time of publication. For current fees visit [www.ipaustralia.gov.au](http://www.ipaustralia.gov.au)

# FAQ

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**Q: *What's the difference between the trade mark symbols <sup>TM</sup> and ®?***

**A:** You can use the ® (Registered symbol) next to your trade mark once it has been registered. If your trade mark is registered overseas but not in Australia, you may use the TM symbol to indicate that the mark is your trade mark. Anyone can use the <sup>TM</sup> symbol as this does not indicate that the trade mark is registered.

**Q: *What benefit is there in trade mark registration as opposed to common law protection?***

**A:** If a trade mark is not registered and another person uses it, the owner may have to take action under common law to stop the infringement. In general they will have to prove that they have developed a reputation in the trade mark and that use of the trade mark by another person would be likely to confuse or deceive the public. This can be difficult and expensive. If the trade mark is registered, a letter from an IP professional such as a registered trade marks attorney or lawyer experienced in trade mark matters may be all that is needed to deter the infringer.

**Q: *Do I need to use a lawyer or attorney to file my application?***

**A:** No, but early advice from an IP professional, such as a registered patent or trade mark attorney, can be crucial in understanding the specific issues affecting your proposed patent, trade mark or design, and ensuring that any application is professionally prepared and adequately covers your ideas and products.

IP professionals can also provide you with IP related business advice, as well as advice on preparing applications, infringement action, licensing, IP audits and maintaining your rights.

**Q: *How do I register my copyright and how much will it cost?***

**A:** In Australia, copyright is automatic and free from the moment it is recorded. This means there is no need to register your work and no need to pay a fee to gain copyright protection.

**Q: *How does IP translate in the case of an employee's rights of ownership of their design work? For example, is a designer allowed by law to take design files to work on their folio once they have left a job?***

**A:** Generally speaking, IP created in the course of employment usually belongs to the employer, not the employee. An exception is if there is a specific employment contract with a clause on ownership of IP created on the job.

**Q: *Most of our IP issues revolve around naming. What can we do as designers to search and cover as much ground before a name is presented to a client, and before a lawyer is engaged?***

**A:** Designers can do some research when it comes to choosing names for their clients, however it is a practice that comes with some risk.

Conducting a search of the Australian Trade Mark database may help in selecting a name that isn't the same or similar to a registered trade mark however, it will make you legally responsible for the viability of the name and unfortunately your professional indemnity insurance probably will not cover this.

It is recommended that designers present a list of 10 or 20 names to the client for their legal advisors to then check.

Searching the Trade Mark database needs to be done thoroughly and professionally so you and your client don't run into problems down the track. When selecting a name, an IP professional should be used to undertake the relevant searches before you produce the final product or enter the marketplace.

**Q: *If I can't register my copyright, how do I prove that I'm the owner?***

**A:** If a dispute about copyright ownership goes to court, the court needs to consider all the relevant evidence. This usually means oral evidence by witnesses as to who the copyright owner is. Other evidence may include a copy of an agreement between you and your client, or drafts of the work.

# Useful contacts

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## IP Australia can provide useful information if you are:

Seeking registered IP protection with a patent, trade mark, design or plant breeder's right.

Researching existing IP documents and searching patents, trade marks, designs or plant breeder's rights databases.

Interested in promoting IP within your organisation.

### COMPANY NAMES

Australian Securities and Investments Commission T  
1300 300 630  
[www.asic.gov.au](http://www.asic.gov.au)

### COPYRIGHT

Australian Copyright Council  
T 02 8815 9777  
[www.copyright.org.au](http://www.copyright.org.au)

Attorney-General's Department  
Copyright Law Branch  
T 02 6250 6655  
[www.ag.gov.au](http://www.ag.gov.au)

### INDUSTRY RE PRESENTATION

Design Victoria  
T 03 9925 4195  
[www.designvic.com](http://www.designvic.com)

### INTERNET DOMAIN NAMES

.au Domain Administration  
T 1300 732 929  
[www.auda.com.au](http://www.auda.com.au)

### IP LAWYERS

Contact the Law Society in your state or territory

Intellectual Property Society of Australia and New Zealand  
[www.ipsanz.com.au](http://www.ipsanz.com.au)

Licensing Executives Society of Australia and New Zealand  
[www.lesanz.org.au](http://www.lesanz.org.au)

### IP RIGHTS ASSOCIATIONS AND INTEREST GROUPS

Australian Design Awards  
T 02 8206 6090  
[www.designawards.com.au](http://www.designawards.com.au)

Australian Graphic Design Association (AGDA)  
T 02 9955 3955  
[www.agda.com.au](http://www.agda.com.au)

The Australian Manufacturers of Patents, Industrial Designs, Copyright and Trade Mark Association  
T 02 9458 7416

## **PATENT AND TRADE MARK ATTORNEYS**

For a full list of registered patent and trade mark attorneys visit [www.psb.gov.au](http://www.psb.gov.au).

Institute of Patent and Trade Mark Attorneys of Australia  
T 03 9857 0311  
T 1800 804 536  
[www.ipata.com.au](http://www.ipata.com.au)

## **PATENTS, TRADE MARKS, DESIGNS AND PLANT BREEDER 'S RIGHTS**

IP Australia has a range of resources including:

### **— Application kits**

Kits are available for designs, patents, trade marks and plant breeder's rights to help you file for an IP right

### **— Don't give away your most valuable asset brochure**

Designed to introduce you to IP

### **— IP Toolbox**

A comprehensive IP guide for business

### **— Smart Start**

A tailored product for small to medium-sized businesses  
T 1300 651 010  
[www.ipaustralia.gov.au](http://www.ipaustralia.gov.au)

# Key terms

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## ATTORNEY

Patent and trade mark attorneys are experienced professionals who can assist clients to protect and exploit their IP rights.

## BUSINESS NAME

A business name is a name under which a business operates. Business name registration provides a means of identifying the owners of the business and is obtained under state or territory legislation. Registration of a business name does not provide proprietary rights.

## COMPANY NAME

A company is the name given to a corporate entity incorporated within the Commonwealth of Australia. This may not necessarily be the business name that the company trades under. An entity may trade under its company name without having a registered business name. Registration of a company name does not provide proprietary rights.

## CONFIDENTIAL INFORMATION

Information and materials of commercial or personal value kept secret from the public.

## COPYRIGHT

Copyright protects the original expression of ideas, not the ideas themselves. It comes into existence automatically and gives you the right to control and exploit the copying of your original works of art, literature, music, films, broadcasts and computer programs. Copyright usually lasts for the author's life plus 70 years. The copyright notice generally indicates that the work is protected and identifies the copyright owner, although it is not necessary to display this notice for copyright to apply.

## DESIGN REGISTRATION

Design registration protects the way products look. Design refers to the visual features of shape, configuration, pattern or ornamentation.

## DOMAIN NAME

A domain name is the unique name that corresponds with an internet protocol address. It is often easy and intuitive to remember. For example, IP Australia's domain name is [www.ipaustralia.gov.au](http://www.ipaustralia.gov.au). Registration of a company name does not provide proprietary rights.

## INFRINGEMENT

Infringement occurs when someone consciously or inadvertently uses IP without permission.

## **INNOVATION PATENT**

An innovation patent is a form of protection available in Australia for innovative and technological improvements. Protection is available for up to eight years.

## **INTELLECTUAL PROPERTY (IP)**

IP is generated through intellectual or creative activity. Types of IP include patents, trade marks, designs, confidential information, trade secrets, copyright, circuit layout rights and plant breeder's rights.

## **IP RIGHTS**

The right to prevent use by others of your intellectual property, e.g. patents, designs, copyright, trade marks, plant varieties or confidential information.

## **PATENT**

An exclusive right to exploit an invention commercially, granted for a limited term in return for public disclosure of the invention

## **PLANT BREEDER'S RIGHTS**

Plant breeder's rights are used to protect new varieties of plants by giving exclusive commercial rights to market a new variety or its associated reproductive material.



## **PRIORITY DATE**

A priority date is a concept in IP law whereby the first to take a particular action is entitled to a right that excludes others who may have innovated later. For example, in most countries, if two people apply independently for a patent on the same invention, the earlier application has priority and so can prevent the second succeeding. Also public disclosures made before the priority date are relevant for determining whether an invention is new and inventive for patents and new and distinctive designs.

## **TRADE MARK**

A trade mark is a sign used commercially to distinguish goods and services of one trader from those of another. It can be logos, words, letters, numbers, colours, a phrase, sound, scent, shape, picture, aspect of packaging or any combination of these. A registered trade mark gives the owner the exclusive right to use, license or sell it within Australia (and any other country in which it is registered) for the goods and services for which it is registered.

## **TRADE SECRET**

A trade secret is information known to a trader and kept out of the public domain for business advantage. The law protects against damage done to a business through unauthorised disclosure of trade secrets, but not against independent discovery of the trade secret.









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